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**D E C I S I O N**  
**of 22 January 2004**

**Case Number:** T 0366/00 - 3.3.2  
**Application Number:** 90904670.8  
**Publication Number:** 0414920  
**IPC:** A61K 9/12  
**Language of the proceedings:** EN

**Title of invention:**  
Aerosol preparation for external use

**Patentee:**  
TAISHO PHARMACEUTICAL CO. LTD

**Opponent:**  
Henkel Kommanditgesellschaft auf Aktien  
KPSS-Kao Professional Salon Services GmbH  
Wella AG

**Headword:**  
Aerosol preparation/TAISHO LTD

**Relevant legal provisions:**  
EPC Art. 54, 56, 83, 113, 123  
EPC R. 88, 57a

**Keyword:**  
"Main request - novelty - no"  
"First auxiliary request - unallowable amendment"  
"Second auxiliary request - novelty and inventive step - yes -  
better cooling effect"

**Decisions cited:**  
G 0004/92

**Catchword:**  
-



Case Number: T 0366/00 - 3.3.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.2**  
**of 22 January 2004**

(Opponent 1) Henkel  
Kommanditgesellschaft auf Aktien  
TFP / Patentabteilung  
D-40191 Düsseldorf (DE)

**Representative:** -

**Appellant:** KPSS-Kao Professional Salon Services GmbH  
(Opponent 2) Pfungstädterstrasse 92-100  
D-64297 Darmstadt (DE)

**Representative:** -

(Opponent 3) Wella AG  
Berliner Allee 65  
D-64274 Darmstadt (DE)

**Representative:** -

**Respondent:** TAISHO PHARMACEUTICAL CO. LTD  
(Proprietor of the patent) 24-1 Takata 3-chome  
Toshima-ku  
Tokyo 171 (JP)

**Representative:** Lamb  
MARKS & CLERK  
57-60 Lincoln's Inn Fields  
London WC2A 3LS (GB)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 24 March 2000  
rejecting the opposition filed against European  
patent No. 0414920 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** H. Kellner  
J. H. P. Willems

## Summary of Facts and Submissions

I. The respondent is proprietor of European patent No. 0 414 920 which was granted with 9 claims on the basis of European patent application No. 90904670.8, filed on 16 March 1990 and claiming priority of 17 March 1989 from JP 63768/89.

Claim 1 as granted reads as follows:

"A foam-forming aerosol preparation for external use which when sprayed adheres as a cooling sherbet-like foam, which aerosol preparation comprises:

- (A) a propellant having vapor pressure of 2 to 5 kg/cm<sup>2</sup> at 20°C comprising a liquefied petroleum gas, dimethyl ether or a mixture of these gases, and
- (B) a concentrate composed of a mixture of water, a lower alcohol having 1 to 4 carbon atoms in a weight up to the weight of water, and a nonionic surface-active agent, the weight ratio of propellant (A) to concentrate (B) being from 95:5 to 50:50, and the amount of nonionic surface-active agent in the aerosol preparation being 0.1 to 15% by weight."

II. Oppositions were filed against the granted patent by the appellant (opponent 2), opponent 1 and opponent 3. The patent was opposed under Article 100(a) EPC for lack of novelty and inventive step and under Article 100(b) EPC for insufficiency of disclosure.

The following documents were cited inter alia during the proceedings before the opposition division and the board of appeal:

- (1) EP-A-0 376 104 (first priority 27 December 1988; publication date 4 July 1990)
- (1a) JP 334975/1988 (application date 27 December 1988; publication date 16 October 1990 as JP-A-02255889)
- (2) DE-A-36 30 065
- (10) Encyclopaedia Britannica, 1996, key word "liquefied petroleum gas"
- (11) Dictionary of Science and Technology, Chambers (1974), page 707; keyword "LPG"
- (12) Römpps Chemie-Lexikon, 1981, page 1169, keyword "Erdöl"
- (13) Encyclopedia of Chemical Technology, Kirk-Othmer, Third Edition, Volume 17, 1982, pages 132, 183, 186 and 227

III. The opposition division rejected the opposition under Article 102(2) EPC.

As to Article 83 EPC, the opposition division expressed the view that the skilled person, by using his own common general knowledge in the field of aerosols, would be able to carry out the invention. It held that this common general knowledge, especially with respect to the meaning of "liquefied petroleum gas", was

represented by documents (10) to (13). Finally since the limits for the vapour pressure of the propellant were duly given in claim 1, the person skilled in the art knew which gases out of the group meaning the "liquefied petroleum gases" he had to use and in which relationships.

Concerning Article 54 EPC, the opposition division was of the opinion that the invention was neither anticipated by the teachings of document (1a), submitted as a translation in English language and corresponding to document (1), nor by the teaching of document (2). None of these documents nor any of the other documents cited during the opposition procedure disclosed a propellant having a specific vapour pressure within the range of vapour pressure claimed in the patent in suit.

As to Article 56 EPC, the opposition division found that the subject-matter of claim 1 was inventive since none of the available prior art documents taught that an aerosol preparation as claimed showed a long-lasting cooling effect as demonstrated by the comparative examples of the application originally filed and by the submissions and the test report filed during the opposition procedure.

- IV. The appellant (opponent 2) filed a notice of appeal against the decision of the opposition division and submitted a statement setting out the grounds of appeal.
  
- V. The appellant's submissions can be summarised as follows:

As to Article 83 EPC it still stated that by the term liquefied petroleum gas ("LPG") the type of propellant to be used in the claimed aerosol was not disclosed in a manner sufficiently clear and complete to enable a person skilled in the art to carry out the teaching of the patent.

Moreover it still considered the teaching of the patent not to be new regarding either document (1) or (2). Especially the general description of each of its subject-matters together with the knowledge of the person skilled in the art, meaning the well-known substitution of fluorocarbons by aliphatic hydrocarbon or similar ethers, anticipated the subject-matter of the patent in suit.

This said knowledge of the skilled person could also be used to contest the existence of an inventive step in view of document (2).

- VI. Opponents 1 and 3 filed no arguments during the appeal proceedings.
  
- VII. On 22 January 2004, oral proceedings took place before the board in the presence of the representative of the proprietor (respondent); duly summoned appellant and opponents 1 and 3 had informed the board in advance that they did not wish to attend the hearings.

During the hearings the respondent submitted two auxiliary requests:

The wording of claim 1 of the first auxiliary request is:

"A foam-forming aerosol preparation for external use which when sprayed adheres as a cooling sherbet-like foam, the aerosol preparation being a blend of propellant and concentrate:

- (A) the propellant having a vapor pressure of 2 to 5 kg/cm<sup>2</sup> gauge at 20°C and comprising a liquefied petroleum gas, dimethyl ether or a mixture of these gases, and
- (B) the concentrate being composed of a mixture of water, a lower alcohol having 1 to 4 carbon atoms in a weight up to the weight of water, and a nonionic surface-active agent, the weight ratio of propellant (A) to concentrate (B) being from 95:5 to 50:50, and the amount of nonionic surface-active agent in the aerosol preparation being 0.1 to 15% by weight."

For both of the auxiliary requests, claim 2 as granted was amended by introducing the word "gauge" after "2 to 4 kg/cm<sup>2</sup>" and in claims 8 and 9 as granted, "a propellant" and "propellant" respectively was changed to "the propellant", with the following wording as a result (bold letters introduced by the board):

"8. A method for manufacturing an aerosol container filled with an aerosol preparation of concentrate and propellant, wherein concentrate components are heated and emulsified to form a concentrate, and the concentrate with **the** propellant is filled into an aerosol container, characterized in that the aerosol preparation is as defined in any of claims 1 to 7.

9. A method for manufacturing an aerosol container filled with an aerosol preparation of concentrate and propellant, wherein concentrate components are mixed and stirred to dissolve or disperse them uniformly to prepare a concentrate, the concentrate is filled into a pressure-resistant container, a valve is mounted for filling with **the** propellant, and a propelling snout attached, characterized in that the aerosol preparation is as defined in any of claims 1 to 7."

Claim 1 of the second auxiliary request reads:

"A foam-forming aerosol preparation for external use which when sprayed adheres as a cooling sherbet-like foam, the aerosol preparation being a blend of propellant and concentrate:

- (A) the propellant having a vapor pressure of 2 to 5 kg/cm<sup>2</sup> gauge at 20°C and consisting of a liquefied petroleum gas, dimethyl ether or a mixture of these gases, and
- (B) the concentrate is composed of a mixture of water, a lower alcohol having 1 to 4 carbon atoms in a weight up to the weight of water, and a nonionic surface-active agent, the weight ratio of propellant (A) to concentrate (B) being from 95:5 to 50:50, and the amount of nonionic surface-active agent in the aerosol preparation being 0.1 to 15% by weight."

Additionally, the second auxiliary request includes an amendment in claim 7, where the sentence introducing



the six alternatively claimed embodiments was changed to:

"An aerosol preparation which **is** one of the following formulations:"

by replacing the word "comprises" by the word "is" (bold letters introduced by the board).

VIII. The respondent's arguments in written form and during the oral proceedings may be summarised as follows:

The claimed subject-matter of the main request remained both novel and inventive since none of the available prior art documents taught the use of a propellant following the claimed range of vapour pressure to render an aerosol preparation for external use exhibiting a long-lasting cooling effect.

In this respect, the respondent referred particularly to the test report filed with date 24 November 1998, showing *inter alia* that the vapour pressure data of all mixtures of propellants disclosed in documents (1) and (2) were outside the claimed range (see especially table 2 and table 3 in the written statement).

Said test report will be referred to hereafter simply as "the test report".

Additionally, the respondent filed a graph showing the relationship between the vapour pressure at 20°C and the boiling points of propellants possibly to be used. It pointed out that the vapour pressure ranges corresponding to the temperature ranges disclosed in

the prior art documents were different to the vapour pressure range of the patent.

With respect to the use of the term "comprised" in claim 1 the person skilled in the art would know that in the aerosol preparation all propellant components together would be supposed to exert their common vapour pressure within the range expressed in claim 1 of the alleged patent. Thus there would be no possibility of any other ingredient being present possessing the properties of a potential propellant. Nor could there be any interpretation of this claim 1 allowing a fluorocarbon to be part of the aerosol preparation. This should be true given the meaning of claim 1 of the patent in suit and particularly in the light of the sentence "... the concentrate to be applied without the need for using a fluorocarbon as a propellant" (see page 2, lines 20 to 21 of the patent specification).

Concerning the subject-matter of the auxiliary requests, the arguments given in the respondent's opinion were all the more valid since it was much more precisely defined there what the range of vapour pressure meant and what the ingredients of the claimed aerosol preparations were.

- IX. The respondent (patentee) additionally requested that the admissibility of the correction of an error in the application as originally filed be considered. This correction had already been proposed during the opposition procedure. With reference to Rule 57a EPC, the respondent submitted that as a reaction to some of the grounds of the opposition, it was necessary and immediately obvious to the skilled person, to change

the word "water" on page 2, last line of the patent specification, to the word "ice". The amendment clarified the origin of the cooling effect of the sherbet-like foam. It was necessary because the error had occurred during the translation of the Japanese priority document.

- X. The appellant (opponent) requested in writing that the decision under appeal be set aside and that European patent No. 0 414 920 be revoked.
  
- XI. The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained (main request), alternatively on the basis of auxiliary requests I or II.

Furthermore, he requested a correction of an error in the application as originally filed.

### **Reasons for the Decision**

- 1. The appeal is admissible.
  
- 2. *Correction relating to the application as filed*

The request for correction (see point IX above) had already been filed during the opposition procedure.

The substitution of the word "water" on page 2, last line of the patent specification by the word "ice" as a correction of a translation error is not allowable under Rule 88 EPC, since using each of the words "ice" and "water" gives reasonable results explaining a

cooling-effect. Water is basically also a good means for cooling, similar to ice and would also be able to supply the cooling-effect claimed for the subject-matter of the patent in suit. Thus the correction is not obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

The requested change of words, by way of an amendment, is not allowed under Article 123 EPC either because in the relevant part of the application as filed only the word "water" is to be found (see page 3, line 37 of the description filed on 16 November 1990).

3. *First and second auxiliary requests: admissibility*

The board notes that the subject-matters of these requests are restricted to a narrower range of possible mixtures for aerosol, propellant or concentrate. Therefore the corresponding amendments a priori must be considered to be occasioned by the novelty and inventive step objections raised during the proceedings, in particular the question of absolute or relative (gauge) pressure for the claimed range of vapour pressure and the question of the consequences of using the word "comprising" twice in claim 1.

Accordingly these requests fulfil the requirements of Rule 57a EPC and they are therefore admitted into the procedure.

4. *Main request, first and second auxiliary requests:  
Article 83 EPC*

Since for a skilled person the definition of "liquefied petroleum gas" (LPG) as a group of several special gases emerges clearly from documents (10) to (13) and since the person skilled in the field of aerosols apparently uses gases being members of this group (see e.g. (1), all examples, except No. 4 and (2) column 4, lines 16 to 17), he will also know how to compose a mixture of them corresponding with a range of 2 to 5 "kg/cm<sup>2</sup>" gauge in vapour pressure.

The appellant has even submitted that possible ingredients of LPG, such as Ethylene or Propene or some Mercaptane, are not usable by themselves in propellants for aerosols, ie the skilled person would know not to use them ("Solche Zusammensetzungen sind sicherlich nicht als Aerosoltreibmittel geeignet", see its statement setting out the grounds of appeal dated 3 May 2000, page 1, last line but one).

Thus, the board in this respect has no reason to depart from the reasoning or the conclusion of the opposition division in the impugned decision.

5. *First and second auxiliary requests: Articles 84 and 123(2) and (3) EPC*

5.1 In the circumstances of the present case as for the requirements of Article 84 EPC the board is convinced that the skilled person reading the unit kg/cm<sup>2</sup> in relation to vapour pressure is ready to think of "kg-force", meaning in reality kp. This is also clear from

pressure data mentioned in document (2) in units  $\text{kg/cm}^2$  as well and even the correct relation between " $\text{kg/cm}^2$ " and bar (see column 4, lines 26 to 27 and 34) given there.

In addition, the person skilled in the art, reading the pressure data will be aware of the two possibilities, namely "absolute pressure" and "pressure relative to the normal pressure of the atmosphere (gauge pressure)". In order to understand the real meaning of the range of vapour pressure given in the claims without any definition of absolute or relative pressure, this person has to decide which of the two possibilities is meant. Since the only clue is in the pressure data given in the examples (gauge pressure in all of them), it will be clear to him that the pressure data given in the claims relate to the same possibility (gauge pressure).

According to this point of view, the respondent, in all its submissions used the gauge-pressure data of the gases and liquids possibly to be used themselves or for mixing them in order to obtain propellants. These data, specifically set out in the respondent's reply to the notices of opposition and in the enclosed test report, were not contested by the opponents.

Consequently, in the circumstances of the present case the person skilled in the art will have no doubt concerning the definition of the range of vapour pressure claimed in the patent in suit.

- 5.2 The common features of the two auxiliary requests
- "the aerosol preparation being a blend of propellant and concentrate",
  - "**the** propellant having a vapor pressure of 2 to 5 kg/cm<sup>2</sup>" and
  - "**the** concentrate ..."  
in claim 1 and the use of the term
  - "**the** propellant"  
in claims 8 and 9 respectively (bold letters introduced by the board)
- find their basis in the application as originally filed (see description originally filed, page 2, lines 7 to 15).

The said originally-disclosed wording means however that there is one concentrate and one propellant, and this propellant has to be produced from "liquefied petroleum gas, dimethyl ether or a mixture of these gases" (see description as originally filed, page 2, lines 9 to 10). So it is not permissible to refer to "**the** concentrate" and "**the** propellant", leaving the ingredients for the propellant open. The wording in claim 1 of auxiliary request I "the propellant having a vapour pressure ... and comprising a liquefied ..." consequently is not disclosed in the application as filed with respect to an aerosol preparation being a blend of one concentrate and one propellant.

Accordingly, auxiliary request I cannot be allowed under Article 123(2) EPC.

With respect to the set of claims of auxiliary request II, however, the board is convinced that there are no objections concerning Article 123(2) EPC because

there the propellant has to "consist of liquefied ..." and the aerosol preparations following claim 7 "**are** one of" the six cited compositions" and do not "**comprise** one of the following preparations ...".

5.3 Auxiliary request II also meets the provisions of Article 123(3) EPC since its subject-matter is restricted compared to the subject-matter of the patent in suit, as already shown in point 3, paragraph 1 above.

6. *Main request*

6.1 As regards the novelty of the subject-matter of claim 1 of the main request, in the opinion of the board, an aerosol composition **comprising** a concentrate (B) and "a propellant having vapor pressure of 2 to 5 kg/cm<sup>2</sup> at 20°C **comprising** a liquefied petroleum gas, dimethyl ether or a mixture of these gases" may additionally contain another liquid, even if this liquid was in some way also able to act as a propellant.

Document (1a) and the corresponding document (1) represent the state of the art with respect to Article 54(3) EPC.

This prior art discloses, as example 3 in table 1 on page 8, an aerosol composition consisting of:

(A)

- a propellant having vapor pressure of 2 to 5 kg/cm<sup>2</sup> at 20°C comprising a liquefied petroleum gas
  - that is, 35 parts by weight i-butane showing a vapour pressure - gauge - of



2.2 kg/cm<sup>2</sup> at 20°C (see annex to the test report given by the patentee: Data 1)

- and

(B)

- a concentrate composed of a mixture of water, a lower alcohol having 1 to 4 carbon atoms in a weight up to the weight of water,
  - that is, 30% aqueous ethanol solution
  
- and a nonionic surface-active agent,
  - that is - which is not contested by the appellant - PBC-44, polypropyleneglycol-cetylolether produced by Nikko Chemicals Co., Ltd (see (1), p 17, "Note")
  
- the weight ratio of propellant (A) to concentrate (B) being from 95:5 to 50:50,
  - that is, the ratio of parts i-butane to the sum of the parts of the ingredients for the concentrate being to be found between the given limits
  
- and the amount of nonionic surface-active agent in the aerosol preparation being 0.1 to 15% by weight,
  - that is, 0.5% by weight,
  
- and 35 parts by weight i-pentane.

As mentioned above, such 35 parts by weight of i-pentane (boiling point 28°C) may also be an ingredient comprised in an aerosol preparation

according to the patent in suit and thus all the features with respect to the ingredients and their relations in weight claimed in this patent are realised in the aerosol composition disclosed as example 3 in document (1).

Because of this, example 3 must also on its own show the same ability - when sprayed - to adhere as a cooling sherbet-like foam, as the subject-matter of the patent in suit is supposed to do, since in such a composition the same properties follow from the same measures of preparation.

Therefore, claim 1 of the patent in suit, being the subject of the main request, is anticipated by the teaching of document (1) and (1a) respectively.

- 6.2 The board could not follow the respondents' arguments that the person skilled in the art would know that in the aerosol preparation all propellant components together would be supposed to exert their common vapour pressure within the range expressed in claim 1 of the alleged patent, since the skilled person has to read a claim in its broadest possible sense.

Accordingly the double use of the word "comprise" in claim 1 of the main request extends - in any case - the scope of the claim to all other possible ingredients.

7. *Second auxiliary request*

7.1 *Novelty*

Claim 1 contains the clear wording that the aerosol preparation has to be a blend of **the** propellant (A) and **the** concentrate (B), and that the propellant has to consist of a liquefied petroleum gas, dimethyl ether or a mixture of these gases. The mixture of 35 parts by weight of i-pentane and 35 parts by weight i-butane contained in example 3 of document (1) now has to be considered as the only propellant present in the preparation. This mixture has a vapour pressure of 1.1 "kg/cm<sup>2</sup>" gauge as the appellant submitted correctly in its letter dated 24 November 1998, table 2, which fact was not contested. The preparation according to example 3, like all other aerosol preparations mentioned in (1), therefore falls outside the claimed range of 2 to 5 kg/cm<sup>2</sup> gauge at 20°C. Thus the subject-matter of claim 1 in auxiliary request II is novel over document (1) and document (1a) respectively.

The same is true of document (2). The preferred range of boiling points for the propellants to be used is -5 to +5°C, which corresponds to 1.5 to 0.7 "kg/cm<sup>2</sup>" gauge, ie outside the range of the patent in suit (see (2), column 4, line 10, together with the graph submitted by the patentee, which in the view of the board gives correct relationships). Moreover the propellants disclosed in document (2) have to comprise a high amount of dichlorotetrafluoroethane (see (2), claim 1), which conflicts with the teaching of claim 1 of auxiliary request II.

Finally the other documents mentioned in the proceedings are no closer to the teaching now claimed than either (1), (1a) or (2). Thus the board finds that its novelty is beyond doubt.

7.2 *Problem-and-solution approach for assessing inventive step*

7.2.1 The patent in suit concerns a foam-forming aerosol preparation for external use.

Document (2) represents the closest state of the art.

The subject-matter of this prior art is also a foam-forming aerosol preparation. It shows nearly all the features of the subject-matter of claim 1 of auxiliary request II (see (2), claim 1, together with column 1, lines 25 to 27, and column 2, lines 42 to 47). Only the correct vapour pressure range of the propellant and the feature "absence of chlorofluorocarbons" (see point 8.1, paragraph 2 of this decision and document (2), claim 1, lines 15 to 17) are missing.

7.2.2 In the light of the disclosure of document (2), the technical problem underlying the patent in suit may be seen in the provision of a foam-forming aerosol preparation having a long-lasting cooling effect without the need for using a fluorocarbon as a propellant (see also patent in suit, page 2, lines 20 to 21).

The solution to this problem is the provision of the aerosol preparation according to claim 1, especially

with respect to the range defined therein for the vapour pressure.

Comparative example 5 (see table 4) of the test report filed by the patentee, shows that aerosol preparations according to document (2) do not exhibit any remarkable, good cooling effect after being sprayed onto a surface to be treated.

It is furthermore plausible that a relatively high amount of propellant exerting high vapour pressure causes some ice in the foam ("sherbet-like") by pressure relief and evaporation and thus that the above stated problem is indeed solved.

- 7.2.3 The problem of providing cooling capacities by means of an aerosol preparation is addressed in neither citation (2) nor any other document cited in the proceedings and there is therefore nowhere any suggestion that the vapour pressure of the propellant be raised to the claimed range in order to achieve this goal.

Even if it would have been the natural consequence of the pollution control discussion at the time of priority of the alleged patent to substitute fluorocarbons by liquefied petroleum gases, there was still no way of arriving in an obvious way at the very special type of gases to use and the control of vapour pressure as provided for in claim 1 of auxiliary request II.

- 7.2.4 In the absence of additional arguments by the opponents, the board can only conclude that the subject-matter of

claim 1 of auxiliary request II involves an inventive step and is allowable pursuant to Articles 52(1) and 56 EPC.

7.3 *Further claims from auxiliary request II*

Dependent claims 2 to 7 relate to specific elaborations of the subject-matter of claim 1 and are therefore also allowable. This also holds for claims 8 and 9 directed to methods of manufacturing "aerosol containers filled" with aerosol preparations as defined in any of claims 1 to 7.

8. The Enlarged Board of Appeal has interpreted the provisions of Article 113(1) EPC concerning the right to be heard as meaning that a decision against a party which has been duly summoned but which fails to appear at oral proceedings may not be based on facts put forward for the first time during those oral proceedings (see decision G 4/92, OJ EPO 1994, 149, Conclusion 1). Notwithstanding this, in its decision the Enlarged Board of Appeal clearly viewed the possibility of holding hearings in a party's absence, as provided for in Rule 71(2) EPC, in relation to the need for proper administration of justice, in the interests of which no party should be able to delay the issue of a decision by failing to appear at oral proceedings. This can only mean that parties to the proceedings must expect that, on the basis of the established and plainly relevant facts, any decision may go against them. It can further be inferred from this, in the board's opinion, that a decision against an absent party may be based on a modified request discussed for the first time during oral proceedings,

at least if the stage reached is such that the absent - albeit duly summoned - party could have expected such a modified request to be filed and discussed and was aware from the proceedings to date of the actual bases on which it would be judged. Applying the principles elucidated above to the present case, the board's conclusions are the following:

- 8.1 First, in the appeal statement the appellant maintained its objections, *inter alia*, to the patentability of the subject-matter of claims 1 to 9 as granted. In these circumstances, it could legitimately have expected that the respondent would amend the patent and that the case would be discussed during the hearings before the board on the basis of a consequentially modified request.
- 8.2 Second, the extent of the patent was amended during the oral proceedings before the board in a restrictive way. This being the case, the appellant had in the course of the appeal proceedings sufficient opportunity to present in writing its comments on the subject-matter of virtually all remaining claims 1 to 9 forming the respondent's current request.
- 8.3 Thirdly, the decision to maintain the patent in amended form is entirely based on grounds, facts and evidence which were already known to the appellant and also the other opponents from the proceedings before the opposition division and which were again brought to the party's attention during the appeal proceedings. If they preferred not to attend the oral proceedings, they availed themselves of the opportunity to present their comments during the oral proceedings before the board.

8.4 On the basis of the above considerations, the board is of the opinion that, in the circumstances of the present case, considering and deciding in substance on the maintenance of the patent in amended form does not conflict with the conclusions of the Enlarged Board of Appeal in decision G 4/92 and does not contravene the appellant's and the other opponents' procedural rights as laid down in Article 113(1) EPC, in spite of their absence during oral proceedings.

## **Order**

### **For these reasons it is decided that:**

1. The request for a correction in the application is refused.
2. The decision under appeal is set aside and the case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:
  - claims 1 to 9 of the auxiliary request II, filed during today's oral proceedings and a description to be adapted.

The Registrar:

The Chairman:

A. Townend

U. Oswald