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**D E C I S I O N**  
**of 6 May 2004**

**Case Number:** T 0594/00 - 3.3.4

**Application Number:** 90902964.7

**Publication Number:** 0454784

**IPC:** C12Q 1/18

**Language of the proceedings:** EN

**Title of invention:**

Apparatus and methods for antimicrobial susceptibility testing  
of microorganisms

**Patentee:**

ALAMAR BIOSCIENCES LABORATORY INC.

**Opponent:**

BioMérieux

**Headword:**

Antimicrobial susceptibility testing/ALAMAR

**Relevant legal provisions:**

EPC Art. 113(1), 111(1)

EPC R. 67

**Keyword:**

"Substantial procedural violation (yes)"

"Remittal to the first instance (yes)"

"Reimbursement of the appeal fee (yes)"

**Decisions cited:**

G 0010/91, G 0004/92, J 0020/85, J 0003/90, T 0133/87,

T 0125/91, T 0892/92, T 0808/94, T 1103/96, T 0642/97

**Catchword:**

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Case Number: T 0594/00 - 3.3.4

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.4  
of 6 May 2004

**Appellant:** BioMérieux  
(Opponent) Chemin de l'Orme  
F-69280 Marcy L'Etoile (FR)

**Representative:** Guerre, Dominique  
Cabinet Germain et Maureau  
12, rue Boileau  
BP 6153  
F-69466 Lyon Cedex 06 (FR)

**Respondent:** ALAMAR BIOSCIENCES LABORATORY INC.  
(Proprietor of the patent) 3401 La Grande Boulevard  
Sacramento, CA 95823 (US)

**Representative:** Baldock, Sharon Claire  
BOULT WADE TENNANT  
Verulam Gardens  
70 Gray's Inn Road  
London WC1X 8BT (GB)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
17 April 2000 concerning maintenance of  
European patent No. 0454784 in amended form.

**Composition of the Board:**

**Chairwoman:** U. Kinkeldey  
**Members:** M. Wieser  
R. Moufang

## Summary of Facts and Submissions

I. The appeal was lodged by the Opponents (Appellants) against the decision of the opposition division, whereby the European patent No. 0 454 784 was maintained in amended form pursuant to Article 102(3) EPC.

II. The Patent had been opposed under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC).

In the opposition procedure the Patent Proprietors (Respondents) filed an amended claim 1.

Lack of sufficient disclosure (Article 100(b) and Article 83 EPC) was introduced by the Appellants as new ground of opposition after the expiry of the nine month opposition period (Article 99(1) EPC).

III. The opposition division issued a communication together with summons to oral proceedings. The first point under the heading "Issues to be discussed at oral proceedings" read:

"Firstly, whether Article 83 EPC can be accepted as a new ground for opposition".

No further submissions referring to the new ground of opposition were made by the parties before the oral proceedings.

IV. The minutes of the oral proceedings before the opposition division read in point (3), second sentence:

"The Chairman further informed the parties that Article 83 EPC would not be considered because *prima facie* it did not seem to prejudice the maintenance of the patent."

The reasoning was given in writing on page seven of the decision under appeal.

- V. The board of appeal issued a communication on 22 October 2003 wherein their provisional opinion was expressed.

Oral proceedings before the board took place on 6 May 2004.

The Appellants requested that the decision under appeal be set aside, that the case be remitted to the first instance because of violation of the right to be heard and that the appeal fee be reimbursed (main request), or that the decision under appeal be set aside and that the patent be revoked (auxiliary request).

The respondents requested that the appeal be dismissed (main request) or that the decision under appeal be set aside and that the patent be maintained on the basis of claims 1 to 36 filed on 4 March 2004 (auxiliary request).

- VI. The submissions by the Appellants as far as they are relevant to the present decision may be summarized as follows:

Lack of sufficient disclosure was introduced as new ground of opposition after the expiry of the opposition

period in response to substantial amendments to the claims carried out by the Respondents.

The new ground was introduced and substantiated immediately after the filing of said amended claims.

The opposition division has made an essential procedural violation by indicating in the summons that the admissibility of the new ground for opposition will be discussed at the oral proceedings, and then at the beginning of said oral proceedings directly announcing that the new ground will not be considered.

Thus, the right to be heard according to Article 113(1) EPC has been violated.

Because of this substantial procedural violation the case should be remitted to the first instance for further prosecution (Article 111(1) EPC) and the appeal fee should be reimbursed (Rule 67 EPC).

VII. The submissions by the Respondents as far as they are relevant to the present decision may be summarized as follows:

No substantial amendment to the claims justifying the introduction of a new ground of opposition has been made. The feature introduced into claim 1 was already included in dependent claims 3 and 6 as granted. No evidence or written comments were provided by the Appellants that could be considered as *prima facie* case of insufficiency of disclosure, which would have been necessary before the opposition division was permitted to introduce the new ground of opposition under

Article 83 EPC, according to the decision of the Enlarged Board of Appeal G 10/91 (OJ EPO 1993, 420).

Appellant's right to be heard was not violated as they had plenty of time to respond in writing to the summons to oral proceedings which were dispatched six months before the oral proceedings.

No formal request to admit the new ground of opposition under Article 83 EPC was made by the Appellants at the oral proceedings before the opposition division.

The opposition division did not make a substantial procedural violation by announcing at the oral proceedings that the new ground would not be admitted, without hearing the parties. According to decision G 4/92 (OJ EPO 1994, 149) an opposition division or a board of appeal, when feeling bound by Article 114(1) EPC to examine new facts or evidence, must, in accordance with Article 113(1) EPC, give the other parties the opportunity to comment before issuing a reasoned decision. In the present case the opposition division did not feel bound by Article 114(1) EPC to admit the new ground for opposition and, accordingly the Appellants did not have to be afforded any additional opportunity to comment further.

Remittal to the first instance for further prosecution would make no sense and only delay the procedure, as the opposition division already in writing has given their reasons why Appellants arguments with regard to lack of sufficient disclosure were not considered to be well substantiated.

## Reasons for the Decision

1. According to Article 113(1) EPC the decision of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

This provision is a guarantor for the parties that proceedings before the EPO will be conducted openly and fairly (cf decisions J 20/85, OJ EPO 1987, 102 and J 3/90, OJ EPO 1991, 550). The right to be heard is intended to ensure that the parties to proceedings are not taken by surprise by grounds mentioned in an adverse decision (cf decision T 892/92, OJ EPO 1994, 664).

The parties may present their comments either in writing, or orally during oral proceedings. The express right to oral proceedings is enshrined in Article 116 EPC.

2. The minutes of the oral proceedings before the opposition division do not contain an indication that the Appellants were heard on the issue of whether or not the ground of opposition under Article 100(b) EPC were to be considered. According to the minutes, the chairman of the opposition division started the proceedings by inviting the parties to present their requests. After presentation and clarification of the requests, the parties were informed by the chairman that Article 83 EPC would not be considered.

According to Rule 76 EPC the minutes should contain "the essentials of the oral proceedings .. and the relevant statements by the parties". Since this provision does not require the minutes to reflect the full arguments of the parties, there is some discretion of the minute-writer as to what is considered "essential" or "relevant" (cf decision T 642/97 of 15 February 2001). The absence of a certain statement in the minutes does not automatically mean that the statement was not made.

However, in the present case the minutes repeatedly state with respect to other grounds of opposition that the chairman invited both parties to present their respective arguments. It can therefore be assumed that the minute-writer considered these invitations as essentials of the proceedings. It would therefore have been consistent to mention also an invitation with respect to the introduction of the opposition ground of Article 83 EPC into the proceedings if the invitation had been made by the chairman. Although it cannot theoretically be excluded that the invitation was in fact made and that the minutes are only incomplete in this respect, the board takes the view that the absence of the statement in the minutes constitutes *prima facie* evidence that the invitation was not made (cf decision T 1103/96 of 12 May 2000; point (2.1) of the reasons for the decision).

The Respondents, although saying that they cannot exactly remember the course of the oral proceedings before the opposition division which took place more than four years ago, did not dispute the content of the minutes and never requested their correction.



On this evidence on file the board concludes that in the course of the oral proceedings before the opposition division, the parties were not heard on the introduction of the opposition ground of Article 83 EPC.

3. It was not necessary that the Appellants did file a formal request at the oral proceedings before the opposition division to admit the new ground of opposition, as this request was made in writing on 17 December 1998.
  
4. Respondent's argument, that a party's right to be heard is satisfied if said party, which had requested oral proceedings according to Article 116 EPC, has had the opportunity to argue in writing, cannot be followed by the Board.

If this interpretation of Article 113(1) EPC were to be followed, the parties' right for oral proceedings safeguarded by Article 116 EPC would be obsolete, with the unacceptable consequence that an opposition division or a board of appeal with regard to an issue controversially discussed during written procedure, like for instance novelty or inventive step, would be entitled to give a decision right at the beginning of oral proceedings without hearing the parties.

5. The Respondents refer to decision G 4/92 (supra) as support that Appellants' right to be heard has not been violated.

Decision G 4/92 is concerned with the requirements of Article 113(1) EPC with regard to a party which, although duly summoned, fails to appear at oral proceedings. In point (8) of the reasons for the decision it is stated that an opposition division or a board of appeal when deciding to examine new facts and evidence (brought forward at these oral proceedings) according to Article 114(1) EPC, has to give the other parties, which have not appeared at the oral proceedings, the opportunity to comment before issuing a reasoned decision based on such facts and evidence.

The board cannot see the relevance of this finding in the present case but rather is of the opinion that this does not allow to draw the conclusion that an opposition division when not admitting a new ground of opposition introduced after the expiry of the opposition period, can take this decision without giving the Opponents, who are present at the oral proceedings requested, the opportunity to present their case.

6. The decision under appeal is based on grounds and evidence on which the Appellants have not had an opportunity to present their comments during the oral proceedings and thus contravenes the requirements of Article 113(1) EPC.
  
7. According to Article 10 of the Rules of procedure of the Boards of Appeal, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

When deciding whether or not to remit the case according to Article 111(1) EPC the board examined if such special reasons exist in the present case.

8. According to the case law of the Boards of Appeal the violation of the principle of the right to be heard is considered as a fundamental deficiency of first instance proceedings (cf decision T 125/91 of 3 February 1992 and T 808/94 of 26 January 1995).

It is, however, also acknowledged that there is no absolute right of a party to have every aspect of a case examined in two instances (decision T 133/87 of 23 June 1988). Other criteria, eg the general interest that proceedings are brought to a close within an appropriate period of time, have also to be taken into account.

9. Since the Appellants whose right to be heard has been violated request the remittal of the case to the first instance, in the specific situation of the present case this request should have precedence over apprehensions regarding an undue delay of the procedure.
10. The Respondents argue that remittal to the first instance for further consideration of the question of admissibility of the new ground of appeal would be of no practical use, as the Appellants have not brought forward any evidence in favour of their arguments besides those presented in their letter of 17 December 1998, which have already been dealt with by the opposition division in the decision under appeal and

which have been found to be insufficient to make a *prima facie* case of lack of sufficient disclosure.

However, the reasoning for this decision has been given in writing after the oral proceedings and is based on grounds and evidence on which the Appellants did not have an opportunity to present their comments in accordance with Article 113(1) EPC as they were not given the opportunity at the oral proceedings to address this issue. Thus, any argument the Appellants wanted to present in this respect at the oral proceedings, which they considered to be influential for the decision, could not be made, and is therefore not dealt with in the decision under appeal. One cannot know if, and to which degree, the Appellants' arguments might have influenced the decision taken by the opposition division. Since the Appellants' right to be heard has been violated by the opposition division, being an authority of the first instance, this violation cannot be repaired by hearing the Appellants on this issue before an authority of the second instance, but only by remitting the case to the first instance.

11. The board concludes that no "special reasons" in the sense of Article 10 of the Rules of procedure of the Boards of Appeal have been brought to their attention. The case is remitted to the first instance for further prosecution (Article 111(1) EPC).
  
12. The appeal is deemed to be allowable so that this prerequisite of Rule 67 EPC is also fulfilled. The board considers it to be equitable by reason of the

substantial procedural violation incurred to reimburse the appeal fee (Rule 67 EPC).

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey