

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 2 December 2004

Case Number: T 1126/00 - 3.3.4

Application Number: 90911002.5

Publication Number: 0477295

IPC: A61K 38/54

Language of the proceedings: EN

Title of invention:
Platelet aggregation inhibitors

Patentee:
Millennium Pharmaceuticals, Inc.

Opponent:
INTEGRA LIFESCIENCES, CORP.

Headword:
Platelet aggregation inhibitors/MILLENNIUM

Relevant legal provisions:
EPC Art.

Keyword:
"Appellant (Opponent) and Respondent (Patentee) filed the same request"

Decisions cited:
G 0007/91, G 0008/91, G 0009/91, G 0009/92

Catchword:
-



Case Number: T 1126/00 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 2 December 2004

Appellant: INTEGRA LIFESCIENCES, CORP.
(Opponent) 103 Springer Building
3411 Silverside Rd.
Wilmington, DE 19810 (US)

Representative: Weber-Quitzeau, Martin, Dr.
Uexküll & Stolberg
Patentanwälte
Beselerstrasse 4
D-22607 Hamburg (DE)

Respondent: Millennium Pharmaceuticals, Inc.
(Proprietor of the patent) 75 Sidney Street
Cambridge,
Massachusetts 02139 (US)

Representative: Grund, Martin, Dr.
Dr. Volker Vossius
Patentanwaltskanzlei - Rechtsanwaltskanzlei
Geibelstrasse 6
D-81679 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 September 2000
rejecting the opposition filed against European
patent No. 0477295 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: M. Wieser
Members: R. Gramaglia
R. Moufang

Summary of Facts and Submissions

- I. The Appellant (Opponent) lodged an appeal against the decision of the Opposition Division on the rejection of the opposition against European patent No. 0 477 295.
- II. Opposition had been filed against the patent under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC).
- III. In its notice of appeal the Appellant requested that the impugned decision be set aside and the patent be revoked in its entirety.
- IV. In the course of the written appeal proceedings the Respondent (Patentee) filed several requests, including a main request seeking dismissal of the appeal and maintenance of the patent with the claims as granted and eleven auxiliary requests containing amended sets of claims.
- V. During oral proceedings on 2 December 2004, the Respondent withdrew all previous requests and filed a new main request comprising:
 - claims 1 to 13, and
 - an adapted description including new pages 5, 6, 6A, 6B, 6C, 7 to 11 and 16 to 20.

Both the Respondent (Patentee) and the Appellant (Opponent) requested at the oral proceedings that the decision under appeal be set aside and that the patent

be maintained in amended form on the basis of the new main request.

Reasons for the Decision

1. The Board considers that, by requesting, together with the Respondent, that the patent be maintained in amended form, the Appellant has limited the extent of his appeal which originally was directed at the revocation of the patent. The question arises whether under these circumstances the Board is deprived of its power to examine the substantive merits of the subject-matter of the claims of the new request.

2. The importance of the principle of party disposition in opposition appeal proceedings has been acknowledged by the established case law. Decisions G 7/91 and G 8/91 (OJ EPO 1993, 356 and 346) held that, in so far as the substantive issues are concerned, appeal proceedings are terminated, when the sole appellant withdraws the appeal. In decision G 9/92 (OJ EPO 1994, 875, point 1) it was noted that the initial request of a party determines the extent of the proceedings in view of the principle "ne ultra petita". According to decision G 9/91 (OJ EPO 1993, 408) a Board of Appeal has the power to decide on the revocation or maintenance of a patent only to the extent to which the patent is opposed in the notice of opposition.

3. In the light of the above case law, the Board adopts the following approach to the requests made: if both the Patentee and the Opponent who is the sole Appellant request the maintenance of the patent in amended form

according to a new set of claims, the power of the Board of Appeal to examine the subject-matter of these claims in substance is limited due to the principle of party disposition. The power no longer extends any more to those claims which were already contained in the set of claims of the patent as considered and maintained by the Opposition Division.

4. Claims 1 to 9 and 11 of the new request are identical with independent claim 10 and its dependent claims 11 to 18 and 26 as granted, respectively. Independent claim 10 is identical with claim 19 as granted. Independent claims 12 and 13 correspond to claims 35 and 36 as granted and have only been modified with respect to their - now more limited - back-reference to preceding claims. Thus, all of the claims of the new request were already contained in the set of claims as granted and maintained by the Opposition Division. This has the consequence that none of the claims is open to scrutiny by the board.

5. As far as the adaptation of the description is concerned, the Board considers that it still has to examine whether the changes made comply with the requirements of the EPC. However, as was also accepted by the Appellant, the new pages of the description contain either deletions of embodiments no longer claimed or text passages clarifying that the invention does not cover more than the subject-matter of the claims. Therefore, the Board does not see any reason to object to the adaptation of the description.

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 with the order to maintain the patent on the basis of the following documents:
 - Claims 1 to 13 of the new main request filed at oral proceedings;
 - Description pages 3, 4, 12 to 15 and 21 to 38 of the patent specification;
 - pages 5, 6, 6A, 6B, 6C, 7 to 11 and 16 to 20 as filed at the oral proceedings; and
 - Figures 1 to 43B of the patent specification.

The Registrar:

The Chairman:

U. Bultmann

M. Wieser