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**D E C I S I O N**  
**of 12 May 2005**

**Case Number:** T 0343/01 - 3.3.4

**Application Number:** 90916891.6

**Publication Number:** 0512997

**IPC:** C12P 7/64

**Language of the proceedings:** EN

**Title of invention:**

Process for the heterotrophic production of products with high concentrations of Omega-3 highly unsaturated fatty acids

**Patentee:**

Mertek Biosciences Corporation

**Opponents:**

01. Nagase Biochemicals, Ltd
02. Aventis Research & Technologies GmbH

**Headword:**

Omega-3 highly unsaturated fatty acids/MARTEK

**Relevant legal provisions:**

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

**Keyword:**

"Right to be heard violated (yes)"  
"Substantial procedural violation (yes)"  
"Remittal to the first instance (yes)"

**Decisions cited:**

T 0133/87, T 0669/90, T 0125/91, T 0892/92, T 0808/94,  
T 0165/99, J 0020/85, J 0003/90

**Catchword:**

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Case Number: T 0343/01 - 3.3.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.4**  
**of 12 May 2005**

**Appellant I:** Martek Biosciences Corporation  
(Proprietor of the patent) 6480 Dobbin Road  
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**Representative:** Mallalieu, Catherine Louise  
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**Appellant II:** Aventis Research & Technologies GmbH  
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**Representative:** Ahrens, Gabriele, Dr  
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**Other Party:** Nagase Biochemicals, Ltd  
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**Representative:** MacLean, Martin Robert  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
22 January 2001 concerning maintenance of  
European patent No. 0512997 in amended form.

**Composition of the Board:**

**Chairwoman:** U. Kinkeldey  
**Members:** M. Wieser  
G. Weiss

## Summary of Facts and Submissions

I. Appeals were lodged by Appellant I (Patent Proprietor) and Appellant II (Opponent 02) against the decision of the Opposition Division, whereby the European Patent No. 0 512 997 was maintained in amended form pursuant to Article 102(3) EPC.

The patent was opposed by two parties under Articles 100(a), (b) and (c) EPC. Opponent 01 is party to the appeal proceedings as of right according to Article 107 EPC.

II. Summons to attend oral proceedings before the Opposition Division on 12 December 2000 were submitted to the parties on 10 April 2000. The final date for making written submissions and/or amendments was set for 10 November 2000. Appellant I filed a new main request together with auxiliary requests 1 to 8 on 10 November 2000.

At the beginning of the oral proceedings, on 12 December 2000, Appellant I requested to replace the requests on file by a new main request and new auxiliary requests 1 to 4.

III. The Opposition Division decided not to admit the main request and auxiliary requests 1 to 3 into the proceedings as being late filed according to Article 114(2) EPC. They found that these requests had *prima facie* serious defects and "*... decided not to enter in a more detailed discussion about the allowability of the late filed main and auxiliary requests one to three with the proprietor. The*

*provisions of Article 114(2) EPC and of Rule 71a EPC would make no sense if late filed facts, such as amended claims, would be discussed in substance and in detail before the office being allowed to reject them as being belated.*" (cf point 5, last paragraph of the decision under appeal).

According to the minutes of the oral proceedings before the Opposition Division (cf points (2) to (3)) the parties were not heard before the Opposition Division announced this decision.

The reasons why the said requests *prima facie* contravened the requirements of the EPC were given in writing (cf pages 4 to 5 of the decision under appeal).

- IV. The Opposition Division was of the opinion that auxiliary request 4, also filed at the beginning of the oral proceedings, appeared *prima facie* to be a serious attempt to overcome pending objections, and decided to allow it into the proceedings. The final decision of the Opposition Division was that the patent in its amended form according to the fourth auxiliary request met the requirements of the EPC and could thus be maintained under the provision of Article 102(3) EPC.
- V. The Board expressed its preliminary opinion in two communications dated 6 April 2004 and 27 October 2004. Oral proceedings were held on 12 May 2005 in the absence of Opponent 01 who had informed the Board on 6 May 2005 that he would not attend. During the oral proceedings the Board drew the attention of the parties to decision T 165/99 of 3 March 2003.

VI. The requests by the parties were as follows:

Appellant I requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution and the appeal fee be reimbursed.

Appellant II requested that the decision under appeal be set aside and the patent be revoked.

Opponent 01 did not file any request.

VII. The submissions made by Appellant I as far as they are relevant to the present decision may be summarised as follows:

The Opposition Division took the decision not to admit the new main request and auxiliary requests 1 to 3, filed at the oral proceedings, without hearing the parties. In detail, the Patent Proprietor was not given the possibility to comment on the *prima facie* serious defects identified by the Opposition Division which were the basis for this decision. Appellant's I right to be heard (Article 113(1) EPC) had therefore been violated which represented a substantial procedural violation.

According to Article 10 of the Rules of procedure of the Boards of Appeal, a Board should 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. No such special reasons could be identified in the present case. The Opposition Division

did not give an opinion on a single ground for opposition with regard to Appellant's I main request, neither in the written phase nor orally during oral proceedings. The general interest that proceedings were brought to a close within an appropriate period of time could not prevail over the fact that Appellant I, as a consequence of a substantial procedural violation during first instance proceedings, was denied of its right of appeal by not being allowed to be heard by two instances.

VIII. The submissions made by Appellant II as far as they are relevant to the present decision may be summarised as follows:

The new main request and auxiliary requests 1 to 4 submitted by Appellant I at the beginning of the oral proceedings before the Opposition Division were filed after the final date set for making final submissions and/or amendments according to Rule 71a EPC. It was therefore at the discretion of the Opposition Division to disregard these requests as being late filed in accordance with Article 114(2) EPC.

The exact course of the oral proceedings, which took place more than four years ago, could not be remembered. The parties were not heard before the Opposition Division announced the decision not to admit Appellant's I late filed main request and auxiliary requests 1 to 3, however, before interrupting the proceedings for a deliberation on this question, Appellant I was asked by the Opposition Division if he wanted to proceed on the basis of the newly filed requests. Appellant I was not hindered to file further

requests. His right to be heard was not violated by the Opposition Division's decision not to admit his late filed requests.

When deciding whether or not a case should be remitted to the first instance according to Article 111(1) EPC certain criteria had to be regarded. It had been acknowledged in the jurisprudence of the Boards of Appeal that there was no absolute entitlement for a party to have every aspect of a case examined in two instances. Taking into consideration that the patent in suit claims a priority date from 1989, upon remittal to the first instance it may well be that a final decision on the validity of the patent would not be taken before its expiry. This situation that would create legal uncertainty not only for Appellant II but for the whole public had to be seen as a "special reason" not to remit the case, as foreseen in Article 10 of the Rules of procedure of the Boards of Appeal. No new aspects justifying remittal had been presented by Appellant I, who had sufficient time to do so during the written phase of the appeal procedure. In the sense of accelerating the procedures before the EPO and to bring the case to a close within an appropriate period of time the present case should not be remitted to the first instance for further prosecution. Instead a final decision should be taken by the Board.

## Reasons for the Decision

### *Article 113(1) EPC*

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, point 4(a) of the reasons 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 decisions T 669/90, OJ EPO 1992, 739 and T 892/92, OJ EPO 1994, 664, for example).

The parties may present their comments either in writing, or orally during oral proceedings.

2. In the present case, the minutes of the oral proceedings before the Opposition Division do not contain an indication that the parties were heard on any formal or substantial aspect with regard to Appellant's I main request and auxiliary requests 1 to 3 filed at the oral proceedings. This is confirmed by the last paragraph on page 5 of the decision under appeal. According to the minutes, the Opposition Division, after having pointed out that said requests were received after expiry of the time limit set in view of Rule 71a EPC and might be disregarded under Article 114(2) EPC, interrupted the oral proceedings



for deliberation. After this interruption the Opposition Division, immediately and without hearing the parties, announced their decision that the main request and auxiliary request 1 were *prima facie* not admissible under Article 84 EPC, that auxiliary request 2 was not admissible under Article 123(2) EPC and that auxiliary request 3 was not admissible under Article 123(3) EPC.

Appellant II, although saying that he cannot exactly remember the course of the oral proceedings before the Opposition Division which took place more than four years ago, did not dispute that the parties were not heard before the Opposition Division announced their decision.

3. The Board therefore is convinced that in the course of the oral proceedings before the Opposition Division, the parties were not heard on the *prima facie* serious defects of Appellant's I main request and auxiliary requests 1 to 3 identified by the Opposition Division, which were the reason to not admit the requests into the proceeding.

In the Board's view the parties' right to be heard should also be granted before late-filed submissions (here: requests) are rejected as such, so that the parties can verify whether the submissions were in fact filed late and, if so, whether they should nevertheless be taken into consideration.

4. Accordingly, 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.

*Article 111(1) EPC*

5. 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.

6. 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 decisions 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 for a party to have every aspect of a case examined in two instances (cf decision T 133/87 of 23 June 1988, for example). Other criteria, e.g. the general interest that proceedings are brought to a close within an appropriate period of time, have also to be taken into account.

7. Since the right to fair procedure and a fair hearing is one of the most important principles of procedural law generally recognized in the Contracting States which has to be taken into account by the EPO under

Article 125 EPC and since Appellant I who's right to be heard has been violated requests the remittal of the case to the first instance, in the present case this request, clearly and exclusively occasioned by the violation of the right to be heard, should have precedence over apprehensions regarding an undue delay of the procedure.

8. Appellant II argues that remittal to the first instance for further consideration would be of no practical use, as Appellant I had plenty of time and occasions to bring forward any evidence in favour of their arguments during the appeal proceedings.

However, the reasoning for the decision under appeal has been given in writing after the oral proceedings and is based on grounds and evidence on which Appellant I did not have an opportunity to present comments in accordance with Article 113(1) EPC as he was not given the opportunity at the oral proceedings to address these issues. Thus, any argument which the Appellant I wanted to present in this respect at the oral proceedings, which he 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, Appellant's I arguments might have influenced the decision taken by the Opposition Division. Since Appellant' I right to be heard has been violated by the Opposition Division, being an authority of the first instance, this violation cannot be corrected by hearing Appellant I on these issues before an authority of the second instance, but only by remitting the case to the first instance.

9. Moreover, the Board notes that, in support of his request not to remit the case, Appellant II also mentioned economy of procedure and possible infringement proceedings. However, these arguments are not convincing for the following reasons. Firstly, the file history does not show a particular interest of Appellant II in a speedy procedure. For example, no request for accelerated examination was filed. On the contrary, with a letter of 10 August 2004, Appellant II, during the appeal procedure, requested an extension of the time limit to file observations. Secondly, as regards the possibility of infringement proceedings, Appellant's II representative stated at the oral proceedings that, according to the best of her knowledge, no such proceedings in Europe were pending.
10. The Board is aware of decision T 165/99 of 3 March 2003, where the competent Board decided not to remit the case but to decide it themselves (cf points (22) to (24)). However, the specific situation underlying this case cannot be compared to the present situation. The Board in case T 165/99, having decided that the Opposition Division wrongly exercised its discretion not to admit a new ground for opposition and further violated the Appellant's (Opponent's) right to be heard by not letting him speak to this issue, was confronted with the following request by the Respondent (Patentee): Should the Board come to the conclusion that the new ground of appeal, which was wrongly not admitted by the first instance under violation of Article 113(1) EPC, should in fact conflict with the maintenance of the patent, then the case should be remitted to the first instance for further prosecution (cf section (XV)).

This request, which required that the Board firstly came to a decision on the new ground for opposition and then, depending on the outcome, decided on the remittal, was rejected by the Board.

11. The Board concludes that in the present case 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 of Appellant I is reimbursed.

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey