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D E C I S I O N
of 4 July 2002

Case Number: T 0694/01 - 3.3.4

Application Number: 88303744.2

Publication Number: 0291194

IPC: G01N 33/543

Language of the proceedings: EN

Title of invention:
Immunoassays and devices therefor

Patentee:
UNILEVER N.V.

Opponents:
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(02) Carter-Wallace Inc.
(03) GENZYME CORPORATION
(04) Andrea von Preen
(05) Int. Mycoplasma
(06) Technical Chemicals & Products Inc.
(08) ORAMON Arzneimittel GmbH
(09) Pharma Peter
(10) ulti med Products (Deutschland)
(11) Cardimac Gesellschaft für Diagnostische Schnellteste mbH

Headword:
Test device/UNILEVER

Relevant legal provisions:
EPC Art. 105

Keyword:
"Intervention during pending appeal proceedings -
admissibility (yes)"

"New ground of opposition - void"
"Scope of appeal limited to adaption of description"
"Claims - res judicata"

- 2-

Decisions cited:

T 0843/91, T 0113/92, T 0167/93, T 0296/93, T 0450/97,
T 0068/98, G 0004/91, G 0001/94, G 0001/97

Headnote:

An intervention is dependent on the extent to which
opposition/appeal proceedings are still pending.

Where a board has decided that a patent be maintained on the
basis of a given set of claims and a description to be adapted
thereto, in subsequent appeal proceedings confined to the
issue of the adaption of the description, the intervener
cannot challenge the res judicata effect of the previous board
of appeal decision by introducing a new ground for opposition.



Case Number: T 0694/01 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 4 July 2002

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Decision under appeal: Interlocutory decision of the Opposition Division of the European Patent Office posted 24 April 2001 concerning maintenance of European patent No. 0 291 194 in amended form.

Composition of the Board:

Chairman: U. M. Kinkeldey

Members: L. Galligani

S. U. Hoffmann

Summary of facts and submissions

- I. Opponents 01 and 10 (appellants I and II) lodged an appeal against the interlocutory decision of the opposition division dated 24 April 2001 by which European patent No. 0 291 194 was maintained in amended form on the basis of the claims of the main request filed by the respondents on 27 January 2000 and amended pages of the description filed as an auxiliary request with a letter dated 14 February 2001.
- II. In decision T 681/98 of 27 January 2000 (hereinafter: decision of 27 January 2000), following an appeal filed by six parties against the decision of the opposition division to reject the oppositions against the patent in suit under Article 100(a) EPC, the board had decided to set aside the decision under appeal and to remit the case to the department of first instance with the order to maintain the patent on the basis of the respondents' main request, submitted in the oral proceedings on 27 January 2000, and of a description to be adapted thereto.

Claim 1 of the said request read as follows:

"An analytical test device comprising a dry porous carrier (10), unlabelled specific binding reagent for an analyte which unlabelled reagent is permanently

immobilised in a detection zone (14) on the porous carrier and is therefore not mobile in the moist state, and in the dry state in a zone (12) upstream from the detection zone a labelled specific binding reagent for the same analyte which labelled specific binding reagent is freely mobile within the porous carrier when in the moist state, such that liquid sample applied to the device can pick up labelled reagent and thereafter permeate into the detection zone, characterised in that the porous carrier and the labelled specific binding reagent are contained within a hollow casing (30) constructed of moisture-impervious solid material, the porous carrier communicates directly or indirectly with the exterior of the casing such that liquid test sample can be applied to the porous carrier, the casing incorporates means (32) enabling the extent (if any) to which the labelled reagent becomes bound in the detection zone to be observed, the label is a particulate direct label, the labelled reagent is contained in a first zone (12) of the dry porous carrier, and the unlabelled reagent is immobilised in a detection zone spatially distinct from the first zone, the two zones being arranged such that liquid sample applied to the porous carrier can permeate via the first zone into the detection zone."

Dependent claims 2 to 21 concerned specific embodiments of the test device, while claim 22 related to a method using it.

III. The appellants put forward their arguments in their statement of ground of appeal.

IV. On 13 November 2001, CARDIMAC GESELLSCHAFT FÜR DIAGNOSTISCHE SCHNELLTESTE mbH (intervener/opponent

11), which on 20 August 2001 had been served with a writ of summons relating to an action for infringement of European patent No. 0 291 194, filed a notice of intervention under Article 105 EPC in a written reasoned statement and paid both the opposition fee and the appeal fee. It requested that the patent be revoked in respect of claims 1 to 16 and 19 to 23 on grounds of lack of sufficient disclosure (Articles 83 and 100(b) EPC).

V. In a communication dated 12 March 2002, the board summoned the parties to oral proceedings. The communication annexed to the summons outlined the board's preliminary opinion on the intervention, indicating the possibility of referring questions to the Enlarged Board of Appeal. These questions read as follows:

1. Is an intervention which otherwise complies with the conditions laid down in Article 105 EPC admissible even then when during opposition/appeal proceedings the board of appeal has already decided on the wording of the patent claims and the only issue still pending is the adaptation of the description?

2. If so, can the intervener challenge the wording of the patent claims already decided by the board of appeal:

on the basis of a new ground of opposition or

is the extent of such an intervention limited to an attack against the description to be adapted?

3. Does a third party which intervenes in opposition proceedings before the board of appeal obtain an independent position as an appellant if it pays the opposition fee, and additionally the appeal fee pursuant to Article 108 EPC?
-
- VI. On 21 March 2002, the respondents (patent proprietors) filed a reply to the appellants' statement of grounds of appeal.

 - VII. Submissions on the issue of intervention and/or on the merit of the appeal were made on 4 June 2002 by the respondents and by appellants I and II. On 30 June 2002, the intervener filed comments on the respondents' submissions.

 - VIII. Oral proceedings took place on 4 July 2002.

 - IX. As regards the intervention, the appellants argued essentially that it was admissible because there had not yet been a final decision on the opposition proceedings, which therefore, pursuant to decision G 1/94 (OJ EPO 1994, 787), were still pending. According to this decision, delays arising from an intervention did not constitute grounds for considering the intervention inadmissible. It also had to be borne in mind that the respondents had themselves given rise to the intervention through their infringement action. Adaptation of the description was not a secondary issue, as it had a major bearing on national courts' interpretation of the extent of protection conferred by the patent under Articles 84 and 69 EPC. Thus the intervener could not be debarred from putting forward all its objections. The principles set out in decision G 1/94 (supra) were also applicable to the present

case, which meant that the EPO was obliged to consider the new ground for opposition as well. The *res judicata* effect of the decision of 27 January 2000 was no obstacle to its being considered, as the intervener had not been party to those proceedings, and remittal would initiate a "new" case in which the *res judicata* effect of the earlier decision was not binding. By paying the appeal fee the intervener had acquired independent party status.

Appellants I further requested that the points of law raised by the board of appeal in its communication of 12 March 2002 be referred to the Enlarged Board of Appeal.

On the same issue, the intervener submitted that the time limit for intervention under Article 105 EPC had been met because it had been served notice of the infringement proceedings on 20 August 2001. What was meant in Article 105 EPC by the instituting of proceedings was governed by German procedural law. Under § 253 of the German Code of Civil Procedure (Zivilprozeßordnung (ZPO)), service of notice was held to institute proceedings.

Pursuant to decision G 1/94 (*supra*), the intervener was entitled to raise the new ground for opposition under Article 100(b) EPC. The granted European patent was to be revoked in full because claims 1-16 and 19-23 did not disclose the invention clearly enough for a skilled person to carry it out. Hence the appeal board should dispose of the appeal proceedings by remitting the case to the department of first instance for consideration of the new ground of opposition. Decision G 1/94 (*supra*) had construed Article 105 EPC as meaning that a

party attacked by an infringement action was to have an opportunity to have the patentability of the patent in suit examined precisely because a national revocation action against the patent was not yet possible owing to pending opposition proceedings. According to decision G 1/94 (supra), no *res judicata* effect of the decision of 27 January 2000 arises against that party, because it had not been party to the said proceedings and was basing its case on a new ground for opposition.

The intervener had paid the appeal fee in order to attain party status independently of the other appellants. For carefully considered reasons it was waiving its right to request refunding of that fee.

The intervener further requested that the points of law raised by the board of appeal in its communication of 12 March 2002 be referred to the Enlarged Board of Appeal.

As regards the issue of adaptation of the description, the appellants and the intervener argued in essence that it was evident from the wording of claim 1 as allowed by the decision of 27 January 2000 and, from the reasons for the decision, that the test device was a "one-step" device wherein the porous carrier was a single piece in which the labelled specific binding reagent and the unlabelled specific reagent were disposed, and on which the liquid sample was deposited (see in claim 1 the expressions "**a** dry porous carrier", "on **the** porous carrier", "within **the** porous carrier", "**the** porous carrier", "**the** dry porous carrier" (emphasis added by the board); see the expressions "**the** support membrane" and "**the same** matrix" (emphasis added by the board) in points 10 and 13 respectively of the

reasons for decision of 27 January 2000).

In their view, these limitations required the deletion and/or amendment of a number of passages in the description which, by referring to the possibility of the carrier being made of more than one piece, were inconsistent with the claims as allowed and with the *ratio decidendi* of the board. If not removed, such passages could in subsequent national proceedings contribute to a different construction of the claims. In particular, they indicated that embodiments 3 and 4 and thus the corresponding Figures 8 to 10 had to be deleted as they related to **two** porous carriers and did not represent an interrupted flow situation. Moreover, the presentation of prior-art document (6) (WO-A-86/03839), which came closest to the claimed subject matter, was insufficient.

- X. As regards the intervention, the respondents argued that it was inadmissible because notice of it had not been filed within the three-month period set in Article 105 EPC. The time limit began to run on the date when the infringement action was filed with the court, not when the intervener was served notice thereof. Article 105 EPC was to be construed with reference solely to the Convention, not to national law. Its wording referred only to the instituting of proceedings, not to service of notice. As national procedural laws had differing definitions of the institution of proceedings, the notion of "service of notice" would likewise differ in meaning in relation to Article 105 EPC, and that was unacceptable in the interests of uniform application of law. Furthermore, in applying German procedural law, § 270(3) ZPO had to be taken into account, under which a time limit had

been met once the action was filed with a court, provided that the writ was served immediately. Thus even under German procedural law the intervention was late and therefore inadmissible.

Furthermore, the intervention was inadmissible because the reasons given conflicted with the *res judicata* effect of the decision of 27 January 2000, which had maintained the patent with an amended extent of protection and included a clear and binding instruction to the opposition division merely to adapt the wording of the description to the claims as granted. The respondents' interest in a speedy conclusion of the proceedings, the public's confidence in the *res judicata* effect of a decision on the claims, and the complicated procedural situation likely to be created by the intervention were conclusive reasons for seeing an intervention based on a new ground for opposition as an abuse of procedure. The intervener challenged the claims as granted (as published on 16 February 1994), while the appellants addressed the claims as amended pursuant to the board of appeal decision of 27 January 2000. If the intervention was deemed admissible, it would be completely unclear which court had to decide on what and how. Since in many national infringement actions the court awaited the outcome of the European opposition proceedings, the *res judicata* effect of a board of appeal decision was drastically restricted if an intervention were to be deemed admissible at so late a stage in the proceedings, and this would make European patents open to sabotage.

As regards adaptation of the description, the respondents submitted that it was not possible to infer from the wording of claim 1 that the porous carrier was

one single piece. Nor was there a specific reference to such an interpretation in the decision of 27 January 2000. All that mattered was that the carrier in the casing, no matter whether it was in one or more than one piece, had to be porous in order to ensure an uninterrupted flow. Thus, no further amendments to the description other than those accepted by the opposition division were necessary.

XI. Appellants I requested that the decision under appeal be set aside and that the patent be revoked, or as an auxiliary request that the questions of law set out in the submissions of 4 June 2002 be referred to the Enlarged Board of Appeal.

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

The intervener requested that the decision under appeal be set aside and that the patent be revoked, or auxiliarily that the case be remitted to the first instance for further prosecution on the basis of the new ground for opposition (Article 83 EPC) or further auxiliarily that the questions of law defined by Appellants I be referred to the Enlarged Board of Appeal.

The respondents requested that the appeals and the intervention be dismissed and that the patent be maintained.

Reasons for the decision

Admissibility

1. The appeals of appellants I and II meet the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and thus are admissible.

2. The admissibility of the intervention is governed by Article 105 EPC.

2.1 Under Article 105, first sentence, EPC a person who proves that proceedings of infringement of the patent have been instituted against him may intervene in opposition proceedings pending before the EPO as a new party to proceedings even after the nine-month opposition period (Article 99(1) EPC) has expired, provided that notice of intervention is given within three months of the date on which the infringement proceedings were instituted.

Thus the first issue to be considered in the present case is whether the conditions for the start of this time limit were met and whether notice of intervention was given within three months.

2.2 The respondents do not deny that infringement proceedings were instituted against the intervener, but they claim that this took place on 2 August 2001 when the action was filed with the regional court in Düsseldorf/Germany. The three-month period under Article 105(1) EPC had therefore expired on 2 November 2001, yet the intervener had not given notice of intervention until 13 November 2001, when it filed a submission with the EPO. The intervention was therefore inadmissible.

2.3 Article 105, first sentence, EPC does not stipulate when infringement proceedings are deemed to have been

instituted. As they can only be instituted before the national courts, the wording of Article 105 EPC, even if not explicitly, sets this date by reference to the relevant national procedural laws, thus in the present case to the German Code of Civil Procedure (hereinafter: DE-ZPO).

Under § 253 DE-ZPO, what institutes proceedings is the service of notice on the defendant, not the initial filing of an action with the court. § 270(3) DE-ZPO provides that if a time limit is to be met or the period of limitation is to be interrupted by instituting proceedings, this effect already ensues upon the filing of the action, provided service is made immediately. Accordingly, the purpose of this provision is to protect the plaintiff against disadvantages that might arise from any delay in service of notice by the court over which the plaintiff has no influence. Thus, contrary to the respondents' view, the retroactive effect provided for in § 270(3) DE-ZPO cannot be applied to the start of the time limit under Article 105(3) EPC, as the serving of notice of the national infringement action is intended not to meet a time limit for the plaintiff in opposition proceedings before the EPO, but to start a time limit running for the intervener.

Even if Article 105(1), first sentence, EPC is construed without reference to national law (autonomous interpretation of the Convention), service of notice of the infringement action must be the basis for determining the start of the time limit, since the person who is granted a time limit needs to be aware when it begins running. That is quite clear from Article 105(1) EPC, as the intervener is required to

prove that proceedings for infringement have been instituted, and he cannot do that until he is aware that they have been. The board can see no reason to infer a different meaning for the point when the time limit starts according to Article 105 EPC comparing the English version of the EPC "infringement proceedings were instituted" with the German and French versions "Klage wegen Verletzung dieses Patents erhoben worden ist" and "l'action en contrefaçon a été introduite" respectively. Nor has the board found it necessary to establish whether the instituting of infringement proceedings in all EPC contracting states is dependent in terms of procedural law on service of notice of the action on the defendant. If any national procedural law does differ, a convention-compliant interpretation would at most entail making the start of the time limit under Article 105(1) EPC dependent, in such cases too, on service of notice or at least on the defendant's becoming aware that proceedings have been instituted.

For these reasons the Board takes the view that the starting point for the time limit defined in Article 105(1) EPC is governed by service of notice of the infringement action (see also T 296/93, point 2.7, OJ EPO 1995, 633).

- 2.4 By submitting the documents instituting the proceedings as sent by the court, together with the postman's record of the time of their delivery, the intervener proved that it had been served notice of the infringement action on 20 August 2001. Thus the three-month period under Article 105 EPC ended on 20 November 2001. Hence the intervention of which notice was given to the EPO on 13 November was in time.

2.5 The intervener gave sufficient grounds under Rule 55 EPC for its intervention and in particular, in keeping with letter (c) of that rule, gave a reasoned statement of the ground for opposition under Article 100(b) in conjunction with Article 83 EPC.

Together with the opposition fee, the intervener paid an appeal fee in order to gain party status independently of the other appellants. Thus in order to determine the admissibility of the intervention there was no need to decide whether an opposition fee and an appeal fee had to be paid, as both options were covered in any case.

In summary, the intervention fulfilled the further prerequisites under Article 105(2) EPC regarding written form, reasoned statement and payment of an opposition fee within the time limit.

2.6 The respondents considered the intervention inadmissible because the intervener based it on the ground for opposition under Article 100(b) in conjunction with Article 83 EPC. That ground was not subject matter of the appeal proceedings before the intervention was filed, and the intervener could no longer introduce it into the proceedings because the wording of the claims was already finalised and binding on the basis of the board of appeal decision of 27 January 2000. The *res judicata* effect of that decision ruled out consideration of the claims under a new ground for opposition.

2.7 The intervener referred to decision G 1/94 (*supra*). In this decision the Enlarged Board of Appeal (EBA) ruled that intervention of the assumed infringer under

Article 105 EPC was admissible even during pending appeal proceedings and could be based on any ground for opposition under Article 100 EPC. The term "opposition proceedings" in Article 105 EPC was to be construed as including "appeal proceedings". For reasons of procedural efficiency and equity, the intervener had to be able to raise new grounds for opposition, as otherwise an intervention would have no point. The purpose of intervention was to give an alleged infringer the earliest possible opportunity to defend himself by all available means.

2.8 However, the circumstances underlying decision G 1/94 (supra) differed from those of the present case. There the intervention came during appeal proceedings concerning the decision of the opposition division to reject the opposition in its entirety and hence the wording of the claims was subject matter, upon which the Opposition Division had decided. In the present case, the appeals challenge a decision of the opposition division solely concerning the adaptation of the description, the wording of the claims having already been established by the board of appeal in the decision of 27 January 2000.

A decision remitting a case to the opposition division with the order to maintain a patent on the basis of amended claims is binding in the sense that neither the wording nor the patentability of these claims may be further challenged in subsequent proceedings before the EPO. A finding of fact upon which this decision rests, i.e. a finding which is *conditio sine qua non* for the decision, is equally binding. Such a finding of fact is therefore not open to reconsideration pursuant to Article 111(2) EPC (T 843/91; EPO OJ 1994, 832).

Therefore, the decision of 27 January 2000 on the wording of the claims was binding on the opposition division (Article 111(2) EPC). The remittal purely concerned adapting the description to the amended claims. The opposition division's decision of 24 April 2001 on adapting the description also mentioned in the order the wording of the claims as maintained by the decision of 27 January 2000. This, however, merely has declaratory effect and has no influence on the *res judicata* effect of the decision of 27 January 2000. The wording of the claims is not once again subject matter of the appeal proceedings based on the appeals of appellants I and II, because the challenged decision offers no (new) substantive ruling on the issue, but simply implements the ruling given in the decision of 27 January 2000.

The remittal of a case for adaptation of the description to claims whose wording has already been finalised may in some cases prove problematical, as under Article 69 EPC the description is to be used to interpret the claims and the decision only on the wording of the claims is a decision which already predetermines the amendments required in the description; otherwise the granting of the amended claims would not be allowable in the light of Article 84, second sentence, EPC. The fact that such a procedural split might be inappropriate in some circumstances does not, in the present case, undermine the finality and *res judicata* effect of the decision of 27 January 2000.

That board of appeal decisions have the same status as court judgments is no longer open to question (see

G 1/97, point 5(c), OJ EPO, 2000, 322), so such decisions may also have *res judicata* effect.

2.9 This raises the question of whether the present intervention, which is based on a new ground for opposition, is inadmissible in the light of the *res judicata* effect of the decision of 27 January 2000 which ruled on the wording of the claims.

2.10 As the notion of *res judicata* is of primary importance, its principles will now be examined in some detail.

A decision handed down by a competent court has a *res judicata* effect if it is no longer open to appeal (formal *res judicata*). That applies both to final decisions and to interlocutory decisions. Also, even before any appeal period expires, the court is bound by its decision and cannot set it aside or amend it of its own motion.

The EBA has expressly ruled that board of appeal decisions have (formally) a *res judicata* effect as soon as they are issued (see G 1/97, *supra*, point 2(a), first paragraph) because there is no possibility of appeal against them.

Once a decision becomes formally *res judicata*, the substance of the court ruling is binding both on the (competent) court and on the parties to the proceedings (substantive *res judicata*). If the same parties in new proceedings dispute the same issue as has already been formally settled, the court is bound by the substance of the earlier decision (on the *res judicata* principle as a general principle recognized in all Contracting States of the EPO, see the detailed exposition in

T 167/93, OJ EPO 1997, 229). If proceedings are resumed before the same court following a final interlocutory decision, the court must take the substance of its decision as the basis for its subsequent decision. Moreover, a judgment need not be right to preclude further litigation, it need only be final and on the merits.

2.11 Both the formal and the substantive *res judicata* effect may be challenged by extraordinary means of redress. For reasons of legal certainty, however, these must be expressly formalised in law (see G 1/97, (*supra*), point 2(e), 7. paragraph), eg by provisions governing re-establishment of rights (in respect of German law cf. Schulte, Patentgesetz, 6. edition, Vor § 34, point 242).

2.12 Beyond that, the binding effect of a final decision applies only to the extent determined by the nature of the proceedings. A final decision in interim injunction proceedings, for example, given their defined purpose, has no *res judicata* effect on subsequent main proceedings. A patent grant confirmed in a final decision by an EPO board of appeal has no substantive *res judicata* effect for national courts in revocation proceedings pursuant to Article 138 EPC, even if the same parties are involved. The decision of a board of appeal in examination proceedings has no legally binding effect in relation to opposition proceedings (see T 167/93, *supra*, point 2.10), not only because different parties are involved but because the board of appeal under Article 111(1) EPC decides only within the competence of the examining division and its decisions have no substantive *res judicata* effect for opposition proceedings pursuant to Article 99 ff. EPC. The whole

purpose of the opposition procedure is to allow for review of decisions taken at the examination stage to the extent that the EPC provides for review at the request of third parties. Thus the limitation of the substantive *res judicata* effect of an appeal board decision in the examination procedure is derived from the EPC (Article 102) by virtue of express provisions governing the opposition procedure.

2.13 The intervener denies a substantive *res judicata* effect for the decision of 27 January 2000, because the introduction of the new ground for opposition based on Article 83 EPC meant that the board of appeal had to decide on different circumstances. The decision of 27 January 2000 had examined the patent in suit only on the grounds of lack of novelty and inventive step. The *res judicata* effect of the decision of 27 January 2000 did not preclude examining it now for lack of reproducibility.

2.14 The board does not agree with this interpretation, as the decision of 27 January 2000 ruled on the wording of the claims, and this ruling is final. As far as this effect is concerned, it does not matter which legal considerations lay behind the decision or whether they were correct. The intervener would be right only if the decision had expressly been taken as an interlocutory decision on the issues of novelty and inventive step. In that case the decision would have ruled on novelty and inventive step and would have acquired *res judicata* effect in respect of those issues only, whereas in the present case the final wording of the claims was decided upon and the case was remitted to the department of first instance only for the purpose of adapting the description to the amended claims.

2.15 The intervener further argues that the decision of 27 January 2000 on the wording of the claims was not legally binding for itself, since it had not been party to those proceedings. The present board likewise denies that the decision had any direct *res judicata* effect vis-à-vis the intervener, but does not agree with its conclusion that the intervention also challenges its *res judicata* effect vis-à-vis the previous parties to the proceedings.

2.16 The board has therefore examined the clash between, on the one hand, its being bound to the previous parties with respect to the decision of 27 January 2000 and, on the other, the intervener's right to have the wording of the claims examined in relation to a new ground for opposition.

2.17 The legal fact that the board is bound to the previous parties with regard to the subject matters decided upon in decision 27 January could only be set aside

(a) by a means of appeal against the decision of 27 January 2000 in favour of the intervener explicitly provided for in the EPC (loss of *res judicata* effect or suspension of formal *res judicata* effect) or

(b) through the nature of the proceedings triggered by the intervention (loss or restriction of substantive *res judicata* effect by virtue of special rules).

2.18 In case (a), the intervention would constitute a special means of appeal under which decisions with a formal *res judicata* effect for the previous parties

could be attacked in the same proceedings upon intervention by a third party. That would mean that a formal *res judicata* effect could not be acquired as long as intervention was still possible, or that it could be lost retroactively. As the principle of the formal *res judicata* effect of a decision is fundamental to the establishment of legal certainty in judicial matters, such a means of appeal would have to be expressly enshrined in the Convention, with the criteria to be met being explicitly indicated (see G 1/97, *supra*, point 3(a)). Article 105 EPC, in terms of its actual wording, does not authorise the amendment of final or interlocutory decisions of a board of appeal.

In purely formal terms, the objection to this is that Article 105 EPC provides no possibility of formally setting aside the decision of 27 January 2000, which is not (and could not be) challenged in the pending appeal proceedings, even if -for the sake of argument- the board considered it impossible to maintain the claims wording finalised in that decision when examining them in the light of a new ground for opposition. If, however, the board cannot set aside the decision of 27 January 2000 in its new ruling but were expressly to allow a different wording, the existence of two different, contradictory decisions in the same case would give rise to an unclear procedural situation not compatible with the due conduct of legal proceedings.

Yet in terms of substance, too, Article 105 EPC does not provide for a means of appeal for contesting a decision already taken in opposition-appeal proceedings. Opposition proceedings are designed to provide third parties (the public) with a means for

challenging the grant of a patent in examination proceedings, not decisions taken by the opposition division itself. Thus Article 105(1), first sentence, EPC refers to the intervention of the assumed infringer in ongoing opposition proceedings, not to the review of a decision taken during those proceedings. Lastly, Article 105(2), third sentence, EPC stipulates that "[t]hereafter the intervention shall [...] be treated as an opposition", thereby referring to pending opposition proceedings against the grant of a patent in examination proceedings.

Thus the board's conclusion is that the wording of Article 105 EPC does not satisfy the criteria set out in G 1/97 (*supra*) for a means of appeal which suspends or sets aside the formal *res judicata* effect of a board of appeal decision.

- 2.19 In case (b) (loss of substantive *res judicata* effect), intervention would have to initiate either an entirely new stage of proceedings or a new, independent opposition procedure to support the conclusion that the legal status of this procedure relative to the previous procedural step sets aside the substantive *res judicata* effect of decisions taken in opposition proceedings to date.

There is nothing in the EPC to suggest that the intervention of an assumed infringer opens a new stage of proceedings which invalidates binding results of the proceedings to date. According to Article 99(4) EPC, opposition is a unitary procedure to which all opponents must be parties. The idea that different oppositions could be grouped together on grounds of procedural economy and that each could in principle

also be settled on its own is not reconcilable either with the procedural provisions governing opposition as a centralised procedure or with the EPC's rules on patent maintenance or revocation in the interests of the public.

The formulation of Article 105(1) EPC refers to intervention in pending opposition proceedings. This excludes starting entirely new proceedings or an independent stage of proceedings with or without the previous opponents as parties. This applies above all to the intervener's suggestion of suspension of the appeal proceedings by remitting the case to the department of first instance with the order that a decision on the new ground for opposition should be taken. This would mean that new opposition proceedings concerning the new ground for opposition under Article 83 EPC separate from the proceedings to date would have to be conducted unlawfully.

- 2.20 There is no provision in Article 105(1) EPC for previous legal effects or decisions being suspended by the intervention or for a new case being opened. Interveners become involved in third-party proceedings and must accept the case as it is when they join it (see Günzel in Singer/Stauder, second edition, Article 105, point 20). This interpretation of Article 105 EPC is also in keeping with the ruling made in G 4/91 (OJ EPO 1993, 707) that an intervention has no legal effect if it is made after issue of the opposition division's decision and no admissible appeal is filed by the previous parties.

Nor does an intervention's dependence on the extent to which opposition/appeal proceedings are pending

constitute an infringement of the right to be heard, as someone joining third-party proceedings at a later stage is able to inform himself before intervening of legal consequences which might affect him.

To sum up, an intervention is dependent on the extent to which opposition/appeal proceedings are still pending. As the only thing still pending in the present opposition proceedings is the adaptation of the description at the appeal stage, the intervener is no longer entitled to intervene in the procedurally completed part of the opposition proceedings which concerned the validity of the wording of the claims.

- 2.21 The final issue is whether the above conclusions run counter to the decision in G 1/94 (*supra*).

As explained above, that decision was taken on the basis of a situation in which the entire opposition proceedings were subject to appeal, and no board of appeal decision having formally a *res judicata* effect, had been taken on any question of law or in particular on the wording of the claims in respect of the maintenance of the patent. It cannot be assumed that the EBA expressly intended to give a ruling covering the present legal situation, as that would clearly have been reflected in the stated reasons for the decision, given the complexity of the case. Nor can the board find in the reasons for the decision any indication that the admission of new grounds for opposition should override a so fundamental procedural principle as the formal and substantive *res judicata* effect of a decision without this being expressly provided for in the EPC. In the absence of such provision, there is no interpretive latitude that would make it possible to

cater to the intervener's interest in having the earliest possible opportunity to attack the patent by all available means. G 1/94 (supra) expressly relies on G 0004/91 (supra) and hence on the principle that the intervener may intervene in opposition proceedings before the board of appeal only to the extent that they are still pending before that board.

It must be stressed that the extent to which proceedings are pending must not be equated with the extent of examination in opposition proceedings. The extent of examination is defined by the grounds for opposition admissibly raised, but does not as such constitute the subject matter of the proceedings because it is an examination criterion. In other words, a subject matter which is not pending cannot be examined regardless of which grounds for opposition are admissibly introduced in the proceedings. For that reason, too, the ruling in G 1/94 (supra) that the intervener may raise new grounds for opposition at the appeal stage may not be (mis)interpreted as meaning that the present intervention sets aside the *res judicata* effect of the decision of 27 January 2000. Therefore, the intervener's challenge of the wording of the claims is equivalent to an appeal against the decision of 27 January 2000 which must be regarded as inadmissible, and the board has to examine whether or not this results in the intervention as a whole having to be considered inadmissible.

2.22 The board sees no basis in G 4/91 (supra) and G 1/94 (supra) for considering an intervention inadmissible solely because only part of the opposition proceedings is still pending before the board. Yet the consequence of the *res judicata* effect - as substantiated above and

applicable at the present stage of the proceedings - of the decision on the wording of the claims is that the new ground for opposition raised by the intervener (ie Article 100(b) EPC) is void. This is because it cannot be used in determining the extent of adaptation of the description deemed necessary in the decision of 27 January 2000. Article 105(2), EPC stipulates that written reasoned statement must be given for the intervention and which will then be treated as an opposition. Hence, the reasoned statement is prerequisite for the admissibility of the intervention. Under the special circumstances of the present case, the question arises under Article 105(2) EPC whether the written statement must set out arguments concerning a ground for opposition according to Article 100(a)-(c) EPC in any case or whether it is sufficient to present other arguments as to why the impugned decision is alleged to be incorrect.

- 2.23 In the present case, the intervener submitted both a ground of opposition under Article 100(b) in conjunction with Article 83 EPC and arguments against the extent of the adaption of the description admitted by the decision under appeal. The board sees no justification for considering the present intervention inadmissible because it partly cannot achieve its objective. As the intervener submitted reasons for both alternatives, there is no reason to decide on the question which alternative is required under Article 105(2), first sentence, EPC at the present stage of the proceedings. In any case, the notice of intervention can be considered to fulfill the formal requirement of a reasoned statement under Article 105(2) EPC.

2.24 Thus the board concludes that the intervention is admissible, but as the opposition/appeal proceedings are pending only to a limited extent, the intervener's involvement must be limited to the pending subject matter, i.e. the adaptation of the description to the amended claims on the basis of which maintenance of the patent had been ordered by the board in the decision of 27 January 2000. Re-examination of these claims under the new ground for opposition, Article 100(b) EPC, is inadmissible because the intervener is bound by the *res judicata* effect of the board of appeal decision of 27 January 2000.

Amendments made to the description

3.1 When the scope of a patent has been limited by amendment of the claims, the adaptation of the description thereto must follow the dictates of legal certainty (see T 113/92 of 17 December 1992, point 2), ie the restriction has to be taken into account by deleting all statements which do not relate to the now more limited subject matter of the patent and which are not necessary or useful for understanding the invention. However, amendments should be confined to the minimum necessary to avoid conflict between the description and the amended claims, and to the deletion of irrelevant or potentially misleading passages.

3.2 As stated in decision of 27 January 2000 (see point 2 of the decision), claim 1 as allowed resulted from the introduction into claim 1 as granted of the features of granted claim 2 and the further stipulation (i) that the labelled specific binding reagent for the analyte is "in the dry state in a zone (12) upstream from the detection zone", (ii) that "the porous carrier and the

labelled specific binding reagent are contained within a hollow casing", and (iii) that the casing (the device in the granted claim) incorporates means of observation. Both claims 1 and 2 as granted referred to "a dry porous carrier" and "**the** porous carrier". No change in the meaning of such expressions is seen to have been brought about by combining claims 1 and 2 and by introducing further features (i) to (iii). Claim 1 as allowed in decision of 27 January 2000 does not state whether the porous carrier is one piece or more than one piece. The claim refers, as the granted claims did, to "a" or "**the**" porous carrier, which:

- is contained within a hollow casing,
- communicates directly or indirectly with the exterior of the casing such that liquid test sample can be applied thereto,
- contains the labelled reagent in a first zone and the unlabelled reagent in a detection zone spatially distinct from the first zone, the two zones being arranged such that liquid sample applied to the carrier can permeate via the first zone into the detection zone.

None of these features indicates that the porous carrier must mandatorily be one piece. The description in fact shows that the carrier in the hollow casing can also comprise discrete portions (for example a porous portion extending out of the housing linked to the porous strip or sheet; see Figures 8 to 10, embodiments 3 and 4) as long as the arrangement allows permeation of the liquid to occur from one portion of the porous carrier to the next. The wording of claim 1 covers such

variant embodiments. Thus there is no reason to cancel the passages referring to them from the description.

3.3 Nor can a restricted interpretation of the scope of the claim be inferred from the reasons for the decision whereby the claim was considered to involve an inventive step, these being essentially (see point 15 of the reasons) that:

- the skilled person would not have readily envisaged combining any of the test systems according to documents (1), (2) or (3) with a particulate direct label as used in the assay format according to document (6) because all said systems relied on the use of soluble labelled reagents expected to be freely mobile within solid supports, including particulate solid supports; and
- the skilled person would also not have readily contemplated modifying the assay format exemplified in document (6) according to the model offered by the test systems of documents (1), (2) and (3), eg by creating on the insoluble matrix a first zone containing the labelled binding reagent wherefrom the formed complex would have migrated to a spatially distinct zone of the same matrix for detection by use of an immobilised binding reagent.

For the stated reasons, an inventive step was seen in the provision of a self-containing test device according to claim 1 in spite of its constitutive elements being known, either individually or in some combinations, from the prior art. Whether the porous

carrier within the hollow casing was made of one piece or discrete portions linked to each other was not relevant for arriving at this conclusion. Thus, no restrictive interpretation can be seen in the expressions "support membrane" and "same matrix" used in the decision.

3.4 Rule 27(b) EPC states that the description is to indicate the background art which can be regarded as useful for understanding the invention (see also T 450/97, OJ EPO 1999, 67). Document (6) which was considered the most relevant prior-art document is now acknowledged in the amended description, and the relevant part of its disclosure is correctly summarised along the lines of decision of 27 January 2000 (see point 5). Nothing more is required under the EPC.

3.5 It follows that the amendments to the description as allowed by the opposition division are held - in accordance also with the principles stated in point 3.1 above - to constitute an adequate adaptation of the description to the amended claims.

Requests

4.1 It follows from the above that the main requests of the appellants and the intervener for revocation of the patent are to be refused as unfounded.

4.2 The auxiliary requests for referral to the Enlarged Board of questions of law formulated in the board of appeal communication of 12 March 2002 (see point V above) are also to be refused. The board's decision is in keeping with earlier EBA decisions, in particular G 1/94 (supra) and G 4/91 (supra). As the appellants

have not withdrawn their appeals, the question whether the intervener has acquired an independent party status by paying the appeal fee is not material to the decision. Moreover, in the board's view, unequivocal answers to the questions of law raised are to be found directly in the EPC.

- 4.3 Lastly, the arguments in point 2 concerning the limited admissibility of the intervention indicate that the intervener's auxiliary request for the decision under appeal to be set aside and for the case to be remitted on the basis of the new ground for opposition (Article 83 EPC) must be refused.

Reimbursement of fees

5. At the oral proceedings the intervener expressly waived the filing of a request for reimbursement of the appeal fee.

A reimbursement order may however be considered, even without any such request, for a fee which never actually fell due or was not required by law. The requirement for an intervener to pay an opposition fee under Article 105 EPC is uncontested in the case law of the boards of appeal. As regards the payment of an appeal fee when a party intervenes only at the appeal stage, the case law contains different views (cf Case Law of the Boards of Appeal, 4th edition, 2001, Section VII, D, item 5.4.2). This dispute concerns the payment of an appeal fee equivalent to the appeal fee paid by the other opponents to institute an appeal against the interlocutory decision of the opposition division dated 24 April 2001.

In the present case as the intervener's substantive motion requested more than mere involvement as an opponent or an appeal against the interlocutory decision of the opposition division dated 24 April 2001 but included in substance an inadmissible appeal against the decision of 27 January 2000, the levying of an appeal fee under Article 108, second sentence, EPC is justified without the need to consider the issue of independent party status for the intervener.

Hence in the present case the board sees no justification for reimbursing the appeal fee of its own motion.

Order

For these reasons it is decided that:

1. The requests for referral of questions of law to the Enlarged Board of Appeal are refused.
2. The appeals and the intervention are dismissed.

The Registrar:

The Chairperson:

P. Cremona

U. Kinkeldey