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DECISION
of 28 April 2004

Case Number: T 0900/02 - 3.3.8

Application Number: 88117742.2

Publication Number: 0322533

IPC: C12N 15/31

Language of the proceedings: EN

Title of invention:

Bordetella pertussis toxin with altered toxicity

Patentee:

SCLAVO S.p.A.

Opponent:

Aventis Pasteur Limited

Headword:

-

Relevant legal provisions:

EPC Art. 23, 24, 117, 125

EPC R. 67

RPBA Art. 10

Keyword:

"Fundamental deficiencies in first instance proceedings -
remittal (yes)"

"Serious procedural violations - reimbursement of appeal fee
(yes)"

Decisions cited:

G 0005/91, T 0156/84, T 0234/86, T 0390/86, T 0243/87,

T 0714/92, T 0346/92, T 0960/94, T 0862/98

Headnote:

I. A suspicion of partiality must inevitably arise if a member of an Opposition Division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee is conducting a case pending before that member. The fact that this only occurred after the oral proceedings were held, and the decision if not the reasons known, makes no difference - to be above all suspicion of partiality, every member must avoid any such situation at any time during the proceedings. No-one can be seen as independent of both parties while in the employ of one of them. (See Reasons, paragraph 6)

2. That adaptation of a description is connected to the claims as maintained appears clear from the very term "adaptation" and it is inconceivable that the parties could or would expect anyone other than the same members of the Opposition Division who conducted the oral proceedings and made a decision on the claims to deal with the necessarily inter-related and dependent question of adapting the description. If for any reason (even quite acceptable and understandable reasons such as illness or retirement) the same three members are not available to deal with the description, then it must follow that the parties are to be offered new oral proceedings and that, without such an offer, both the use of a different composition to decide the description and the issue of two separate decisions signed by differently composed Opposition Divisions amount to fundamental deficiencies. (See Reasons, paragraph 13)

3. If delay were the only deficiency, the extreme length of that delay (three years and seven months between oral proceedings and issue of a written decision) and the consequent need to avoid further delay is a special reason why the case should not be remitted to the first instance under Article 10 RPBA. (See Reasons, paragraph 18)

4. If procedural deficiencies in first instance proceedings were so grave that the decision under appeal must be held invalid, that decision is thereby quashed and regarded as a nullity. In that event the case must be remitted to the first instance under Article 10 RPBA to ensure a procedurally proper first instance decision. (See Reasons, paragraphs 19 to 21)



Case Number: T 0900/02 - 3.3.8

D E C I S I O N
of the Technical Board of Appeal 3.3.8
of 28 April 2004

Appellant: SCLAVO S.p.A.
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
3 June 2002 concerning maintenance of European
patent No. 0322533 in amended form.

Composition of the Board:

Chairman: C. Rennie-Smith
Members: T. J. H. Mennessier
P. Julià

Summary of Facts and Submissions

- I. This appeal is by the patent proprietor from the interlocutory decision of the Opposition Division dated 3 June 2002, although the number and dates of the first instance decision or decisions are among the matters giving rise to this present decision of the Board. The subject of the opposition and appeal proceedings is European patent No. 322533 entitled "Bordetella pertussis toxin with altered toxicity". The result of the first instance proceedings was that the patent was maintained in amended form on the basis of the appellant's second auxiliary request and the appeal is limited to challenging the refusal of the main and first auxiliary requests on the single issue of sufficiency. The respondent (opponent) has not appealed.
- II. In its communication of 20 October 2003 the Board, alerted by comments made by the parties as to delay in the first instance proceedings, expressed the provisional opinion that a number of procedural irregularities had occurred after the first instance oral proceedings. The Board's concerns included:
- (A) Substantial delays, namely:
- (i) the delay between the oral proceedings and the despatch of the minutes of those proceedings (from 5 November 1998 to 11 August 1999, a delay of nine months);

(ii) the delay between filing of the proposed amended description and issuing a written decision (from 14 September 1999 to 3 June 2002, a delay of two years and eight months);

(iii) the overall delay of three years and seven months between the oral proceedings and the despatch of the written decision (in fact, two decisions - see (B) below).

The Board observed that shorter delays had been held in some earlier cases to be so long as to render decisions invalid (see e.g. T 390/86 OJ 1989, 30, Reasons, para. 9; T 243/87 of 30 August 1989, unpublished in OJ EPO, Reasons, para. 2).

(B) Apparent irregularities in the first instance decision(s) including:

(i) the fact that two decisions were issued, by two differently composed Opposition Divisions, both maintaining the patent in amended form: a longer decision dealing with all but the amended description and another shorter one dealing only with the description;

(ii) the dates appearing on the decisions, namely 15 June 2001 on the longer decision, 23 May 2002 on the shorter decision, and 3 June 2002 at the head of each page of the "Grounds for Decision" of the longer decision; and the date of despatch of both decisions, namely 3 June 2002;

(iii) the signature of the second member on the longer decision (compared, for example, with his signature on the minutes of the oral proceedings).

(C) The change in the composition of the Opposition Division after the oral proceedings including:

(i) the apparent uncertainty as to the date of this change;

(ii) whether, in view of this change, the written decision(s) could be seen as having been rendered by an Opposition Division of the same composition as that which conducted the oral proceedings (see the decisions cited at (A) above and T 960/94 of 13 September 2000 and T 862/98 of 17 August 1999, both unpublished in OJ EPO).

III. In addition to the case-law references cited above, the Board's communication referred the parties to Rule 67 EPC, first sentence; Article 111 EPC, second sentence; Article 10 RPBA (which requires the Board to remit a case to the first instance if "fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise"); and "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001, pages 376 to 378, 387 to 388, and 555 to 562.

IV. The communication then expressed the Board's view that, in the light of the facts and the law referred to above, remittal of this case to the first instance might be necessary. This would add further delay to a case which had already suffered from delay but it might be that

the interests of justice should override questions of inconvenience to either or both parties. The parties were directed to submit their observations on these matters and any related requests within two months of the deemed date of receipt of the communication, told no extension of that time limit would be allowed, and further directed to indicate whether they requested oral proceedings in respect of these procedural matters.

V. In a letter faxed on 22 December 2003 in reply to the communication, the appellant said it agreed with the Board's provisional view and did not request oral proceedings in respect of these matters. The respondent filed a substantial written submission dated 19 December 2003 (summarised in VI below) in which it disclosed that the member of the Opposition Division who left (see II(C) above) did so to enter employment with the respondent's representative's firm. The respondent also requested oral proceedings on these matters which the Board appointed for the earliest available date. The respondent was represented at the oral proceedings which took place on 28 April 2004. The appellant did not attend the oral proceedings, as announced in a letter faxed on 23 April 2004 in which it also answered certain of the respondent's arguments (see VII below).

VI. The respondent's arguments, in its written submissions of 19 December 2003 and at the oral proceedings, can be summarised as follows.

(A) The first instance oral proceedings were fairly conducted and the patentee had the benefit of an expert. The result, as confirmed by the written

decision, was that the patent in suit was maintained in a very limited amended form consisting of one claim to one embodiment. This rendered the patent commercially useless. The patentee sought, during the subsequent exchanges about amendment of the description, to broaden the language of the description and this was a significant reason for the delay which occurred.

(B) To set aside the decision under appeal would benefit the appellant and unfairly disadvantage the respondent. The appellant would gain a change of status by regaining the patent in its original form and, in some Contracting States such as Germany, this would allow the patentee to bring infringement proceedings which it clearly could not do with the patent in its amended and very limited form. The respondent could obtain no such benefit from remittal and this imbalance meant the respondent should not be prejudiced. The imbalance went further than mere inconvenience, it went contrary to the principle of balance and fairness between the parties mentioned in G 9/91 and G 10/91 (OJ EPO 1993, 408 and 420).

(C) In the present case, the delay did not lead to a different result from that reached at the end of the oral proceedings; justice was done albeit rather slowly. The record showed a consistent position since the oral proceedings on which the relevant public was able to rely. Delay could not be cured by further delay. There were no reported cases where remittal has been ordered for delay alone. Further, to remit in the present case would

cause legal uncertainty - in T 346/92 of 29 July 1993 (unpublished in OJ EPO), there was no remittal after a delay of two years so, if the Board were to remit the present case because of a delay of three and a half years, the point at which delay becomes unacceptable would be unclear. In T 346/92, the Board criticised the delay but dealt with the case itself as soon as possible. Neither the case-law nor the EPC gives a remedy for delay alone. If the position as regards delay were to be regularised, a rule would be required and that was the reason for the first and second questions to be referred to the Enlarged Board of Appeal (see IX below).

- (D) In the present case a member of the Opposition Division (the second examiner) approached the respondent's representative's firm, and other firms, in February 2001 inquiring about possible employment. At the end of March 2001, the representative had a serious accident which prevented him working or playing any part in the management of the firm until July 2001. In the meantime, the second examiner was offered employment with the firm by a letter of 19 April 2001. He accepted in a letter of 24 April 2001, and started employment with the firm on 16 July 2001. He only remained with the firm until 14 February 2002 when he left and re-entered the service of the EPO.

- (E) The only reasonable interpretation of the known facts was that, to deal with the departure of the second examiner, the Opposition Division secured

his signature on the substantive decision prior to his departure. The amendment of the description not having been finalised at that time, a new member was necessarily appointed to deal with that. It was not known why the decision signed by the second examiner who left was not actually issued until much later. However, what was done was done correctly. In T 714/92 of 18 September 1992 (unpublished in OJ EPO), there was no evidence to show an examiner had approved and signed the decision before he left; in this case, it was clear the departing examiner did sign before he left. A second decision was necessary to deal with the description, if only to make the case appealable. There was no rule of law saying there can never be a change of composition of an Opposition Division between oral proceedings and written decision; for example, illness might require it. The headnote of decision T 862/98 (see II(C)(ii) above) did not rule out such changes, in particular when, as in this case, no final substantive decision had been given orally. There was no guidance in the EPC as to what should be done in such circumstances and accordingly the third question to be referred to the Enlarged Board was appropriate (see IX below).

- (F) The respondent declined to comment on the actual signature of the second examiner on the first decision. Neither party nor the Board had the expertise to decide whether or not it was the genuine signature of the person in question. The case should not be decided on an issue of graphology. As regards the various dates appearing

on the two decisions, it was not known how this arose. Such factual issues could have been resolved by the Board summoning the members of the Opposition Division to give evidence under Article 117 EPC.

(G) T 390/86 (see II(A)(iii) above) held in headnote 1:

"An Opposition Division has power to give a final substantive decision (here, relating to the patentability of individual claims) before sending a communication under Rule 58(4) EPC."

In that case, all three members of the Opposition Division who signed the written decision were different from those who conducted the oral proceedings. This decision was approved in T 960/94 (see II(C)(ii) above), in which a change of even one member was enough to make the decision void. It followed that, in the present case, the correct procedure was followed because the same three members who conducted the oral proceedings all signed the first decision on 15 June 2001, about one month before the second examiner's departure.

T 234/86 (OJ EPO 1989, 79) held in headnote 3:

"Where the EPC does not lay down unambiguously the procedure to be followed in a given situation (in this case when main and auxiliary requests have been submitted), use of an incorrect procedure does not, as long as no established case law

exists on the matter, constitute a substantial procedural violation justifying reimbursement of the appeal fee."

The respondent considered that to be the position here - the Opposition Division was in uncharted territory and its decision should not be held invalid when it had no guidance from either the EPC or case law.

- (H) The Board had three choices. First, it could hold that the first decision was correct in accordance with T 390/86 (see II(A)(iii) above), the second decision was necessary and acceptable and the combination of the two left the public in no doubt as to the position and allowed an appeal. Second, the Board could hold that, in the absence of any established procedure, the Opposition Division, even if it followed an incorrect procedure, should be protected by the principle enunciated in headnote 3 of T 234/86 (see (G) above). Third, the Board could find that there were unresolved points of law and refer the questions filed by the respondent to the Enlarged Board of Appeal.

- VII. The appellant, in its letter of 22 December 2003, agreed with the Board's provisional opinion expressed in its communication of 20 October 2003 (see II to IV above). In its letter of 23 April 2004 in reply to the respondent's written arguments, the appellant also argued that the delay between the oral proceedings and the written decision could not be attributed to the appellant; questioned whether justice could be seen to be done when a member of the Opposition Division took

employment with the respondent's representative before the written decision was issued; and observed that the respondent's request for a referral to the Enlarged Board of Appeal (see IX below) was inconsistent with its argument that there should be no further delay.

VIII. The appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for re-hearing.

IX. The respondent's main request was that the Board should not remit the case to the first instance. Its auxiliary request was that the Board refer the following questions to the Enlarged Board of Appeal:

1. Can mere delay alone, between the date of an oral decision delivered by a first instance and the subsequent issue of a written decision, ever constitute a substantial procedural violation justifying the voiding of the first instance decision and remittal to the first instance by a Board of Appeal without first hearing the substantive issues in the case?
2. If the answer to question 1 is "yes", what criteria should be applied to determine when a delay constitutes such a substantial procedural violation?
3. Under what circumstances, if any, is it permissible without substantial procedural violation for there to be a change in the composition of the first instance after oral proceedings on the substantive issues in the case,

and where a verbal decision has been announced at those oral proceedings, but before a written decision is issued by the first instance?

Reasons for the Decision

1. The appeal is admissible. Since it became apparent to the Board, at an early stage of its examination of the appeal, that serious procedural deficiencies might have occurred at first instance which might lead to remittal (Article 10 RPBA), it decided not to consider the substance of the case until those procedural issues had been dealt with. Since the outcome is in fact remittal of the case to the first instance, it should be recorded that the Board has not considered the substantive matters at all and makes no comment thereon. It follows that the Board also makes no comment on one of the respondent's arguments, namely that "justice was done albeit rather slowly" (see VI(C) above). If that argument were to be accepted, it might appear the Board accepts that the Opposition Division made the correct decision on the merits. It will be apparent from this decision that the Board considers the Opposition Division's decision must be set aside for procedural reasons and, in that sense, the Board considers justice was neither done nor seen to be done. The Board expresses no opinion as to whether or not, in the absence of those procedural deficiencies, the substantive result would have been the correct result.

Delay

2. The Board has no hesitation in rejecting the respondent's argument (see VI(A) above) that the appellant patentee contributed to the delay between the oral proceedings of 5 November 1998 and the issue of the two written decisions on 3 June 2002. It may well be the case that if, as the respondent says, the patentee found itself after the oral proceedings with a commercially useless patent, it sought to improve its position by the amendments it proposed to the description. That is something the respondent should have expected and could have resisted, and indeed did resist. However, there is a world of difference between fighting one's case and causing delay; indeed, the file shows the patentee protested at the delay as much as, if not more than, the respondent. The delays which occurred are not, in the Board's opinion, attributable to either party in any degree but are attributable to the Opposition Division alone.

3. That the delays in this case were both exceptional and undesirable is beyond doubt. A total delay of three years and seven months from the oral proceedings, when the opposition was substantially decided, until the issue of the written decisions can hardly be criticised sufficiently. Indeed, if entire opposition proceedings took that long, criticism might be justified. Neither party sought to defend the delay and indeed both remarked on it in writing at the time (see the Appellant's letters of 23 December 1999, 21 December 2000 and 27 April 2001 and the Respondent's letter of 13 June 2001). The case law of the Boards of Appeal offers several examples of shorter but unacceptable

lapses of time between oral proceedings and written decision - for example, two years in T 390/86 (see II(A)(iii) above), Reasons, paragraph 9; more than one year in T 243/87 (see II(A)(iii) above), Reasons, paragraph 2; and more than two years in T 346/92 (see VI(C) above), Reasons, paragraph 7. It follows that the even longer delay in the present case of three years and seven months is all the more unacceptable. Such earlier cases also make clear the chief reason such long delays cannot be allowed is the risk of errors - this has been comprehensively demonstrated by the present case. The Board finds it truly appalling that, despite the abundantly clear message of those earlier cases, a delay of such extraordinary length was allowed to happen. It clearly amounts to both a substantial procedural violation under Rule 67 EPC and a fundamental deficiency in the first instance proceedings under Article 10 RPBA.

Suspected partiality

4. It is well-established in the case-law of the Boards of Appeal that a suspicion of partiality or bias may be sufficient to invalidate a first instance decision (see "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001, page 378). This reflects a basic principle of procedural law in the Contracting States of the EPC (cf. Article 125 EPC), namely that all the members of a tribunal must be above any suspicion of bias. Although often referred to as the rule against bias (or sometimes as a rule of natural justice), it is important to note that, in the majority of cases in which it is invoked, no actual bias or partiality is established and all that occurs

is an inference that one or more persons in a decision-making capacity might have reason to favour a particular party. It can be seen as one aspect of the principle that justice must not only be done but must be seen to be done. The EPC itself applies the rule against bias to the Boards of Appeal (see Articles 23(1)(2)(3) and 24 EPC) and the Enlarged Board of Appeal has extended its application to the first instance (see G 5/91 OJ EPO 1992, 617).

5. In G 5/91 the Enlarged Board held that the question whether or not an objection of suspected partiality was justified could only be considered in the particular circumstances of each individual case. The Board must therefore consider the appellant's objection (see VII above), taken after the respondent's very candid disclosure of the relevant facts (see VI(D) above), in the form of the question: can justice be seen to have been done in the circumstances of the present case, namely when a member of the Opposition Division took employment with the respondent's representative before the written decision was issued?

6. The Board has no hesitation in answering that question in the negative. The Board readily accepts that nothing untoward actually happened in the present case; none the less a suspicion of partiality must inevitably arise if a member of an Opposition Division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee is conducting a case pending before that member. The fact that this only occurred after the oral proceedings were held, and the decision if not the reasons known, makes no difference - to be above all

- suspicion of partiality, every member must avoid any such situation at any time during the proceedings. No-one can be seen as independent of both parties while in the employ of one of them.
7. It must be emphasised that the Board makes no criticism of either the respondent's representative or his firm. The representative was, at the time the examiner was recruited, so unwell he could take no part in his firm's business and, in his absence, none of his colleagues could have been expected to see the difficulty which might, and did in fact, result from employing the examiner. It remains possible that, on the representative's return to work, he might have appreciated that difficulty but, even if he did, it was then too late to avoid it.
 8. Accordingly the Board finds that the employment by the respondent's representative's firm of the second examiner was both a fundamental deficiency in the first instance proceedings within the meaning of Article 10 RPBA and a substantial procedural violation within the meaning of Rule 67 EPC.

Change of Composition - Two Written Decisions

9. The case-law shows it to be well-established that a signed written decision issued after oral proceedings should be the decision of those members of the first instance who conducted the oral proceedings and none others (see for example T 390/86 (see II(A)(iii) above), Reasons, paragraphs 7 to 9; and T 243/87 (see II(A)(iii) above), Reasons, paragraphs 3 to 5). The case-law also shows that a change of composition of an Opposition

Division between oral proceedings and the issue of a written decision should be avoided and, if that is not possible, parties should be offered new oral proceedings in the event of a change (see T 862/98 (II(C)(ii) above), Reasons, paragraphs 2.1 to 2.3).

10. In the present case, in which a member of the Opposition Division took employment with the respondent's representative's firm after the oral proceedings and before the decision was issued, there clearly was a change of composition and, equally clearly, there was no offer to the parties of new oral proceedings. As regards the written decision ultimately issued, this was done in the very strange form of two decisions - one signed by the Opposition Division in the composition which conducted the oral proceedings and dealing with everything but the adaptation of the description; and one in the new composition formed after the second examiner departed, dealing only with adaptation of the description. It appears that it was hoped in this way to comply with the requirement that the same three persons who conducted the oral proceedings must sign the written decision. There is no doubt that the principles referred to in paragraph 9 above appear to have been contravened, in which case these matters would also constitute fundamental deficiencies, and it is for the Board to decide whether any of the arguments put forward by the respondent avoid that conclusion.

11. The respondent argued (see VI(E) above) that the Opposition Division was correct to obtain the signature of the examiner who left before his departure and thereafter correct to issue a second decision to deal

only with the adaptation of the description. Since, the argument continues, there is no rule against changes of composition as such, changes must be possible, for example in the case of illness. However, that argument overlooks two fundamental matters. First, that in this case the change of composition was caused not by illness but by steps taken by a member of the Opposition Division which placed him in a position of suspected bias and, once that had occurred, nothing could avoid that suspicion. Second, even if there had been a change of composition for a quite innocent and acceptable reason (such as illness), it is well-established that such a change after oral proceedings should lead to an offer to the parties of new oral proceedings since otherwise both their right to be heard may be violated and the written decision will not be issued by exactly the same persons who heard the oral arguments.

12. The respondent argued (see VI(E) above) that the first sentence of the headnote of T 862/98 showed there was no absolute rule against changes of composition, in particular where no final substantive decision has been given orally which, it was argued, was the case here. However, reference just to the whole headnote shows this argument cannot be sustained. The entire headnote reads:

"Changes in the composition of an Opposition Division after oral proceedings should be generally avoided also in cases where no final substantive decision has been given orally. Where this is not possible, new oral proceedings must in general be offered to the parties under such circumstances (see the analogous regulation

of Article 7(1) of the Rules of Procedure of the Boards of Appeal). Such offers may be foregone in exceptional cases, in particular if the final decision given by a differently composed Opposition Division is not substantially based on findings arrived at during the oral proceedings but on fresh facts and arguments communicated to the parties in the resumed written proceedings (see point 2.3 of the reasons)."

As the word "also" in the first sentence makes clear, that headnote is extending even to cases where there has been no final substantive decision the principle that there should either be no change of composition or, in the event of a change, an offer of new oral proceedings. The suggestion that the decision taken at the oral proceedings in the present case was not final and/or substantive is, in the board's view, untenable. As explained in the next paragraph, it was final as regards the claims and determinative of the adaptation of the description. In the language of the T 862/98 headnote, the final decision given by a differently composed Opposition Division was (and could only be) substantially based on findings arrived at during the oral proceedings and not on fresh facts and arguments communicated to the parties in the resumed written proceedings.

13. For substantially the same reasons, the Board cannot accept the respondent's arguments based on headnotes in the earlier decisions T 390/86 and T 234/86 (see VI(G) above). As regards headnote 1 in T 390/86 which reads:

"An Opposition Division has power to give a final substantive decision (here, relating to the patentability of individual claims) before sending a communication under Rule 58(4) EPC."

this offers no support whatsoever for the proposition that the use of two separate decisions was correct. A Rule 58(4) EPC letter invites the parties to state their observations if they disapprove of the text in which the Opposition Division intends to maintain a patent. It is quite clear that such a letter presupposes the existence of both claims and description in the intended form. However, in the present case, the intended form of the claims (in fact, only one claim) had been established at the oral proceedings and the description remained to be adapted to that claim. That adaptation of a description is connected to the claims as maintained appears clear from the very term "adaptation" and it seems inconceivable to the Board that the parties could or would expect anyone other than the same members of the Opposition division who conducted the oral proceedings and made a decision on the claims to deal with the necessarily inter-related and dependent question of adapting the description. If for any reason (even quite acceptable and understandable reasons such as illness or retirement) the same three members are not available to deal with the description, then it must follow that the parties are to be offered new oral proceedings and that, without such an offer, both the use of a different composition to decide the description and the issue of two separate decisions signed by differently composed Opposition Divisions amount to fundamental deficiencies.

14. The respondent also relied on headnote 3 of T 234/86 which reads:

"Where the EPC does not lay down unambiguously the procedure to be followed in a given situation (in this case when main and auxiliary requests have been submitted), use of an incorrect procedure does not, as long as no established case law exists on the matter, constitute a substantial procedural violation justifying reimbursement of the appeal fee."

The Board notes that the exception within that headnote applies in the present case with considerable force - established case law does exist on the very matters, such as a change of composition without an offer of new oral proceedings, which give rise to procedural violations in this case.

15. Further, the Board considers headnote 3 of T 234/86 alone should not be relied on for the principle or proposition it appears to set out. That headnote concludes with the following reference:

"(cf. decision T 156/84, OJ EPO 1988, 372, point 3.13 of the Reasons)."

There is in fact no passage in decision T 234/86 itself which corresponds to headnote 3. The nearest that decision, which was concerned with the treatment of requests, comes to any such observation is paragraph 5.9 of the reasons which reads:

"In the present case the EPC was wrongly interpreted and the patent instead of being maintained in the form considered maintainable by the Opposition Division, was revoked. This does not constitute a substantial procedural violation, however, because the EPC does not clearly lay down the procedure to be followed in dealing with main and auxiliary requests (cf. T 156/84, point 3.13, OJ EPO 1988, 372)."

If one then consults T 156/84, a decision concerned with the late filing of documents in first instance proceedings, one finds that paragraph 3.13 reads:

"The Board considers it not possible to order reimbursement of the appeal fee in the present case since there has been no substantial procedural violation within the meaning of Rule 67 EPC. Although the Board feels that the Opposition Division did not act in accordance with correct procedure it cannot be held guilty of a substantial procedural violation because, to the knowledge of the Board, there is as yet no standardised procedure for dealing with documents not submitted in due time in proceedings before the first instance and the Guidelines for Examination in the European Patent Office merely state that in deciding whether to admit the facts or evidence not filed in due time their relevance to the decision, the state of the procedure and the reasons for the belated presentation are to be considered (cf. Part E-VI, 2)."

Thus neither T 234/86 nor T 156/84 are concerned with matters such as those in the present case, and neither of those two earlier cases actually contains in its decision any text corresponding other than in a general

way to headnote 3 of T 234/86. The words "as yet no standardised procedure" in T 156/84 have, in headnote 3 of T 234/86, been elevated to the somewhat different expressions "does not lay down unambiguously the procedure" and "as long as no established case law exists" for which no direct authority exists in either decision. Accordingly, headnote 3 of T 234/86 cannot be relied on as authority for the general proposition it purports to contain.

16. The Board places no significance on the signature of the second examiner on the first decision. The respondent argued (see VI(F) above) that neither the Board nor the parties have the expertise to decide whether the signature is genuine or not. The Board agrees, though adding that it does not require a handwriting expert to observe that two signatures said to be of the same person are so markedly different as to be suspicious. If that had not been the case, the Board would not have mentioned it in its communication of 20 October 2003. However, whether the signature is genuine or not is not determinative of the matter, nor indeed is the appearance of several dates on the two decisions (see II(B)(ii) above). It is because these matters could not affect the ultimate decision that the Board did not pursue them in the manner suggested by the respondent, namely summoning the members of the Opposition division to give evidence (see VI(F) above). Assuming that approach would have disclosed reliable facts, no reliable account could avoid the fundamental problems which arose in this case namely delay, the employment of the second examiner by a party's representative's firm, and the change of composition of

the Opposition Division without an offer of new oral proceedings.

Remittal to the First Instance

17. Accordingly the Board finds fundamental deficiencies in the first instance proceedings in three respects - excessive delay, suspected bias, and change of composition without an offer of new oral proceedings. The Board must now consider whether special reasons present themselves for not remitting the case to the first instance under Article 10 RPBA.

18. As regards the unacceptable delay, the respondent was correct when it submitted there is no reported decision of a case remitted for delay in the absence of any other deficiency. The Board would not go so far as to hold that a case should never be remitted on account of delay and notes, for example, that in T 243/87 (see II(A)(iii) above), Reasons, paragraph 2, Board 332 appeared to find delay sufficient to warrant remittal before it considered the further deficiency (a change of composition). However, it must often be the case that the best answer to excessive delay at first instance is to deal with the appeal as expeditiously as possible, as happened in T 346/92 (see VI(C) above). If delay were the only deficiency in this case, the Board would consider the extreme length of that delay and the consequent need to avoid further delay as a special reason why the case should not be remitted to the first instance under Article 10 RPBA.

19. As regards the suspicion of partiality, the Board finds no special reason not to remit the case to the first instance; on the contrary, this deficiency invalidates the decision under appeal which must therefore be treated as null and void. Accordingly the opposition proceedings have not been concluded and remittal is the only course open to the Board to ensure the matter can be the subject of a procedurally proper first instance decision.

20. As regards the change of composition, even in the absence of suspected partiality this deficiency would also mean the decision under appeal would have to be quashed. Thus, for the same reasons as in 18 above, the case must be remitted to the first instance in respect of this deficiency as well.

21. The respondent, in arguing against remittal, claimed remittal would create an imbalance between the parties (see VI(B) above). In summary, this imbalance would arise because the respondent would obtain no benefit from remittal whereas the appellant would obtain a substantial benefit in that its patent would revert to its granted form. However, by comparing the result of the decision under appeal with the result of remittal, this argument necessarily overlooks the fundamental fact that remittal in this case follows not simply because there has been one or more fundamental deficiencies in the first instance procedure but because those deficiencies are so grave that the first instance decision must be quashed. Any imbalance perceived by either or both parties, and the inconvenience which will certainly be caused to both parties, as a result of remittal is outweighed by the

need to ensure the public have confidence that such serious procedural mistakes will be corrected.

Reimbursement of the Appeal Fee

22. The Board also holds that the appeal fee must be reimbursed. Although any of the substantial procedural violations would have been such as to make such reimbursement equitable, since the result of the present appeal is that the decision under appeal must now be regarded as a nullity, it is above all equitable for the reason that the appellant should not have to pay a fee for an appeal which should not have been necessary.

Referral of Questions to the Enlarged Board of Appeal

23. The respondent supported its auxiliary request to refer certain questions to the Enlarged Board of Appeal with the argument that these questions concerned unresolved points of law (see VI(H) above). The Board refused this request because it was unnecessary to answer these questions in order to dispose of the appeal. Because of either the suspected bias or the change of composition without an offer of new oral proceedings or both, the first instance decision had to be held invalid. This follows from existing and well-established jurisprudence and the questions proposed by the respondent do not require a decision either to ensure uniform application of the law or because they raise important points of law.

Further First Instance Procedure

24. While it is not for the Board to decide how the first instance should conduct its proceedings, the Board does hope that the Opposition Division will recognise from this decision that there were several shortcomings in the earlier proceedings and that it will take steps to ensure that the further first instance proceedings following remittal are conducted impeccably. In the Board's view, this would require an Opposition Division of totally different composition so that the parties may have no doubt their case is being considered without any possible prejudice attributable to its unfortunate history. Further, in view of the substantial delays already experienced, it is very much to be hoped that the further proceedings will be accelerated.

Order

For these reasons it is decided that:

1. The decisions under appeal are set aside.
2. The case is remitted to the first instance.
3. The appeal fee is to be reimbursed.
4. The request to refer questions to the Enlarged Board of Appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

C. Rennie-Smith