

Internal distribution code:

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

D E C I S I O N
of 31 May 2005

Case Number: T 0654/04 - 3.3.4

Application Number: 96119350.5

Publication Number: 0776976

IPC: C12P 13/04

Language of the proceedings: EN

Title of invention:

A process for the industrial preparation of phosphatidylserine

Patentee:

CHEMI S.p.A.

Opponent:

Degussa BioActives Deutschland GmbH & Co. KG

Headword:

Phosphatidylserine/CHEMI

Relevant legal provisions:

EPC Art. 111(1)
EPC R. 67, 68(2)
PPBA Art. 10

Keyword:

"Substantial procedural violation (yes)"
"Remittal to the first instance (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0654/04 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 31 May 2005

Appellant: CHEMI S.p.A.
(Proprietor of the patent) Via dei Lavoratori, 54
I-20092 Cinisello Balsamo (Milano) (IT)

Representative: Pistolesi, Roberto
Dragotti & Associati srl
Via Turati 32
I-20121 Milano (IT)

Respondent: Degussa BioActives Deutschland GmbH & Co. KG
(Opponent) Lise-Meitner-Strasse 34
D-85354 Freising (DE)

Representative: Hiltl, Elmar, Dr.
DIEHL.GLAESER.HILTL & PARTNER
Patentanwälte
Augustenstrasse 46
D-80333 München (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
23 January 2004 concerning maintenance of
European patent No. 0776976 in amended form.

Composition of the Board:

Chairwoman: U. Kinkeldey
Members: M. Wieser
S. C. Perryman

Summary of Facts and Submissions

I. The appeal was lodged by the Patent Proprietor (Appellant) against the decision of the Opposition Division of 23 January 2004 whereby European patent No. 0 776 976 was maintained in amended form pursuant to Article 102(3) EPC.

The patent had been opposed by one party under Article 100(a) EPC on the ground of lack of inventive step (Article 56 EPC).

II. The decision under appeal was exclusively based on claims 1 to 9 submitted as "Amended Auxiliary Request 1" on 2 December 2003 during oral proceedings before the Opposition Division. Claim 1 was a combination of claims 1 and 2 as granted, claims 2 to 9 corresponded to claims 3 to 10 as granted.

III. At the beginning of these oral proceedings the Appellant requested, as main request, that the patent should be maintained on the basis of claims 1 to 11 as granted, or as an auxiliary measure on the basis of auxiliary request 1 or auxiliary request 2. Auxiliary request 1 consisted of claims 1 to 10, wherein the features of claim 2 as granted were introduced into claim 1 and claims 2 to 10 corresponded to claims 3 to 11 as granted. Auxiliary request 2 consisted of claims 1 to 9, wherein the features of claims 2 and 3 as granted were introduced into claim 1 and claims 2 to 9 corresponded to claims 4 to 11 as granted (see point (5.1) of the minutes of the oral proceedings before the Opposition Division).

IV. During discussion of the substantive requirements of the EPC the Patentee stated that he was ready to drop claim 11 in case the Opposition Division would request so (see point (6.3) of the minutes of the oral proceedings before the Opposition Division).

After deliberation by the Opposition Division the Chairman expressed the doubts of the Opposition Division concerning an inventive step of the subject-matter of claim 11 of the main request (claim 10 of auxiliary request 1, claim 9 of auxiliary request 2), (see point (9) of the minutes of the oral proceedings before the Opposition Division).

V. Points (9.1) and (10) of the minutes of the oral proceedings before the Opposition Division read as follows:

"(9.1) In response to this the patentee proposed to drop claim 11 if the patent could be maintained as requested in Auxiliary Request 1. By doing this the patentee also dropped his main request that the patent should be maintained as granted.

(10) The Chairman announced that the Main Request was considered not inventive and the intention of the Opposition Division to maintain the patent as amended in Auxiliary Request 1 without claim 11 (further designated as Amended auxiliary request 1). The proprietor was kindly requested to amend the description and claims accordingly."

VI. At the end of the oral proceedings the Chairman announced that "...the patent is maintained in amended

form pursuant to Article 102(3) EPC on the basis of Amended Auxiliary Request 1 (without claim 11) and the amendments made to the description during Oral Proceedings" (see point (12) of the minutes of the oral proceedings before the Opposition Division).

- VII. Notice of appeal was filed by the Appellant against this decision on 19 March 2004. In the grounds for appeal, submitted on 21 May 2004, it was requested that the decision under appeal be set aside and the patent be maintained on the basis of a main request, claims 1 to 10 as granted, or on the basis of claims 1 to 11 of a first auxiliary request.

The Opponent (Respondent) requested to dismiss the appeal.

Both parties requested oral proceedings in case their requests were not allowed.

- VIII. The Board dispatched a written communication on 12 November 2004, wherein, in order to clarify the admissibility of the appeal, the Appellant and the Respondent were asked to comment on their understanding of what requests were maintained by the Patentee at the end of the oral proceedings before the Opposition Division.

The parties were informed that, if the board then came to the conclusion that several requests, including in particular the main request without claim 11, were maintained by the patentee before the Opposition Division then the appeal would be admissible, but the decision under appeal would be set aside and the case

would be remitted to the Opposition Division for a fully reasoned decision. The appeal fee would be reimbursed. Once the Opposition Division issued a new decision either party could appeal this.

If however the board came to the conclusion that the Opposition Division maintained the patent on the sole remaining request before it, the appeal would be rejected as inadmissible, and the decision of the Opposition Division of 23 January 2004 would enter into full legal force.

IX. The submissions made by the Appellant in the response of 24 January 2005 may be summarized as follows:

He never proposed to drop claim 11 if the patent could be maintained as requested in auxiliary request 1, as stated in point (9.1) of the minutes, but, on the contrary was prepared to drop claim 11 from all requests, that is from the main request, auxiliary request 1 and auxiliary request 2. By doing so he effectively dropped the request that the patent should be maintained as granted, but also asked that a decision be issued with respect to an amended main request, i.e. former main request without claim 11, to an amended auxiliary request 1, i.e. former auxiliary request 1 without claim 11, and to an amended auxiliary request 2, i.e. former auxiliary request 2 without claim 11. The fact that the Chairman announced that the main request was considered not inventive proved that it was not withdrawn at any point during oral proceedings. Moreover, the Opponent (Respondent) had not objected the admissibility of the appeal, which meant implicitly that he acknowledged that the Patentee

(Appellant) was adversely affected by the decision. The Board when deciding that the appeal was admissible should not remit the case to the Opposition Division but should keep on the proceedings.

- X. The submissions made by the Respondent, received on 4 March 2005, may be summarised as follows:

To his best knowledge there was no express statement given by the Patentee's representative that any of the requests not containing claim 11 were considered withdrawn. As far as he remembered the situation at the end of the oral proceedings, the Chairman of the Opposition Division as well as the Patentee's representative considered the main request (without claim 11) to still exist. It was hence assumed that the appeal was admissible and requested that the case should be referred back to the Opposition Division for a fully reasoned decision.

- XI. The Board issued a further communication on 30 March 2005 wherein the Appellant was asked whether he maintains the request for oral proceedings in case the Board intends to remit the case to the first instance.

With a letter dated 6 April 2005 the Appellant confirmed that he withdrew the request for oral proceedings if the case was remitted to the first instance.

Reasons for the Decision

Admissibility of the appeal

1. The provision of Article 107 EPC that any party adversely affected by a decision may appeal, is considered in the established case law of the Boards of Appeal (see Section 7.3.2 of the Case Law of the Boards of Appeal, 4th edition 2001, English version, page 523) as meaning that a party is adversely affected if the decision does not accede to his main request or his auxiliary requests if these were maintained.

2. In the light of the submissions of the Appellant of 24 January 2005 (see section (IX) above) and of the Respondent received 4 March 2005 (see section (X) above), and considering the contradictory statements in points (6.3), (9.1) and (10) of the minutes of the oral proceedings before the Opposition Division on 2 December 2003, the Board accepts that the Appellant maintained a request with claims corresponding to claims 1-10 as granted before the Opposition Division. As the decision under appeal does not accede to this request the Appellant is adversely affected.

3. Accordingly, the appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC and is regarded as admissible.

Rule 68(2) EPC

4. Rule 68(2) EPC, first sentence, requires that decisions of the European Patent office which are open to appeal

shall be reasoned and shall be accompanied by a written communication of the possibility of appeal.

5. The decision under appeal of 23 January 2004 gives reasons only why the grounds of opposition did not prejudice maintenance of the patent with the set of claims 1 to 9 of the amended auxiliary request 1 set out on pages 4 to 5 of the decision. No reasons are given for refusing any other request with a different set of claims.
6. However, such other request, i.e. an amended main request with a set of claims 1 to 10 as granted, was still maintained at the end of the oral proceedings before the Opposition Division. The lack of reasoning concerning the rejection of this request is in violation of Rule 68(2) EPC, and amounts to fundamental deficiency. For proper appeal proceedings the Board considers it a fundamental requirement to have a reasoned decision by the first instance on the very point that was decided adversely to the Appellant.
7. According to Article 10 of the Rules of Procedure of the Boards of Appeal a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings.

Thus, the Board under Article 111(1) EPC, remits the case to the Opposition Division to provide a fully reasoned decision why Appellant's amended main request, claims 1 to 10 as granted, was refused.

8. The problems in this case have arisen because at the end of the oral proceedings before the Opposition Division, the Patentee was under the impression that he had maintained his main request in amended form, but the Opposition Division was under the impression that it had been withdrawn. The question of what requests were maintained, and in particular what request was maintained as main request, is critical for whether an appeal by the Patentee will be admissible or not. If broader requests are to be treated as withdrawn there should be clear evidence that this corresponds with the Patentee's intention, for example this can be obtained by asking the Patentee to resubmit his broadest maintained request relabeled as "main request", and asking him to sign and date this.

Rule 67 EPC

9. 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 substantial procedural violation incurred to reimburse the appeal fee (Rule 67 EPC), as the question the Appellant wishes the Board to consider cannot fairly be considered by the parties or the Board until there is a reasoned decision why the main request, claims 1 to 10 as granted, was refused.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey