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**Datasheet for the decision
of 19 October 2006**

Case Number: T 0811/05 - 3.3.04

Application Number: 96944726.7

Publication Number: 0813424

IPC: A61K 45/06

Language of the proceedings: EN

Title of invention:

Oral pharmaceutical dosage forms comprising a proton pump inhibitor and an antacid agent or alginate

Patentee:

AstraZeneca AB

Opponent:

Reckitt Benckiser Healthcare (UK) Limited

Headword:

Oral pharmaceutical dosage forms/ASTRAZENECA

Relevant legal provisions:

EPC Art. 111(1)

EPC R. 68(2)

Keyword:

"Substantial procedural violation (yes)"

Decisions cited:

G 0009/91, G 0010/91, T 0292/90

Catchword:

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Case Number: T 0811/05 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 19 October 2006

Appellant: Reckitt Benckiser Healthcare (UK) Limited
(Opponent) 103-105 Bath Road
Slough Berkshire SL1 3UH (GB)

Representative: Brierley, Anthony Paul
Appleyard Lees
15 Clare Road
Halifax, West Yorkshire HX1 2HY (GB)

Respondent: AstraZeneca AB
(Patent Proprietor) S-151 85 Södertälje (SE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
6 June 2005 concerning maintenance of the
European patent No. 0813424 in amended form.

Composition of the Board:

Chair: U. Kinkeldey
Members: R. Gramaglia
G. Weiss

Summary of Facts and Submissions

- I. The appeal was lodged by the opponent (appellant) against the interlocutory decision of the opposition division stating that European patent No. 0 813 424 was maintained in amended form pursuant to Article 102(3) EPC on the basis of the first auxiliary request.
- II. In the "Notice of Opposition to a European Patent" the opposition was based on the grounds that (a) the subject matter of the European patent opposed was not patentable (Article 100(a) EPC) because it did not involve an inventive step (Article 52(1); 56 EPC) and (b) the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC, see Article 83 EPC). Lack of novelty was not raised as a ground for opposition.
- III. During the opposition proceedings the appellant filed two new documents, E12 and E13, and based on the disclosure of these documents, argued that the subject matter of the claims as granted was not novel.
- IV. In their reasons for the decision for rejecting the patentee's (respondent's) main request (claims as granted), on page 13, point 2 under the heading "Novelty (Art. 54 EPC) and admissibility of documents (Art. 114 EPC)" the opposition division stated the following:
- "Since document E12 is a *prima facie* relevant document it is allowed into the procedure.

It is the aim of the opposition procedure to avoid invalid patents and the opposition division considers that at least claim 1 of the contested patent as granted was not novel over document E12...."

- V. In the written submissions in the appeal proceedings none of the parties raised any objection to the above "reasons" for the decision to reject the respondent's main request.
- VI. Oral proceedings were held on 19 October 2006, at the beginning of which the board drew the parties' attention to the above-quoted "reasons" for rejecting the respondent's main request for lack of novelty and provided time for the parties to consider this and to reformulate their requests in case they would consider the opposition division's way to "reason" their decision a procedural violation in the light of the obligation (Rule 68(2) EPC) of any departments of the EPO to give reasons for their decisions. The parties then requested the following:

The appellant (opponent) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution.

The respondent (patentee) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution.

Reasons for the Decision

1. The issue in this decision is whether or not the "reasons" in the decision of the opposition division to reject the respondent's main request for lack of novelty in the light of the disclosure of late filed document E12 and the request by the appellant during opposition proceedings that the patent be revoked for lack of novelty, a ground for opposition not raised with the notice of opposition (see section II above), fulfil the requirements of Rule 68(2) EPC.
2. Under Rule 68(2) EPC, decisions of the EPO which are open to appeal must be reasoned. In accordance with a considerable body of established case law of the boards of appeal (see Case Law of the Boards of Appeal, 4th Edition, 2001, VI.L.6 and in particular decision T 292/90 of 16 November 1992), Rule 68(2) EPC ensures a fair procedure between the EPO and parties to the proceedings, and the EPO can only properly issue a decision against a party if the grounds on which it was based have been adequately reasoned.
3. The sole "reasons" given by the opposition division for rejecting the respondent's main request: "It is the aim of the opposition procedure to avoid invalid patents and the opposition division considers that at least claim 1 of the contested patent as granted was not novel over document E12" obviously amount to no more than a mere statement of the result of a deliberation by the opposition division without providing the parties or the board with the slightest idea of a logical chain of thinking and argument as to why their conclusion of lack of novelty of at least claim 1 was

justified. A statement of this kind is nothing more than an unsubstantiated allegation. That, however, enables neither the parties nor a board of appeal to examine whether a decision was justified or not. This absence of reasoning is thus considered by the board to be a violation of the basic requirement of Rule 68(2) EPC.

4. In view of the above the board decides to set aside the decision under appeal, to order the reimbursement of the appeal fee and, as foreseen by Article 10 of the Rules of Procedure of the Boards of Appeal, to exercise its power under Article 111(1) EPC and - as also requested by both parties (see section VI above) - to remit the case to the opposition division for further prosecution.

5. Although the above-given reasons alone are more than enough to establish a substantial procedural violation with the given consequences, the board further notes for a fair and adequate further prosecution before the opposition division the following: nowhere in the reasons for the decision to reject the respondent's main request on the basis of the disclosure of the "late" filed document E12 for lack of novelty is a remote glimmer offered as to why this document was, despite its late filing, allowed into the proceedings - the "reason" given was: "Since document E12 is a *prima facie* relevant document it is allowed into the procedure". Thus, here again, the opposition division has not given any reason as to why the content of this document is *prima facie* relevant, without a single word of explanation as to why the new ground for opposition, i.e. lack of novelty, was allowed into the proceedings

(see decisions G 9/91, OJ EPO 1993, 408 and G 10/91, OJ EPO 1993, 420).

Order

For these reasons it is decided that:

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

The Registrar:

Chair:

P. Cremona

U. M. Kinkeldey