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**Datasheet for the decision  
of 18 August 2006**

**Case Number:** T 1425/05 - 3.3.04

**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), 113(1), 116(1)

EPC R. 67

RPBA Art. 10

**Keyword:**

"Substantial procedural violation (yes)"

"Reimbursement of appeal fees (yes)"

**Decisions cited:**

T 0769/91, T 0892/92, T 0120/96, T 0679/97, T 0922/02,

T 0654/04, T 0742/04, T 1494/05

**Catchword:**

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Case Number: T 1425/05 - 3.3.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.04  
of 18 August 2006

**Appellant I:** CHEMI S.p.A.  
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**Representative:** Pistolesi, Roberto  
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**Appellant II:** Degussa BioActives Deutschland GmbH & Co. KG  
(Opponent) Lise-Meitner-Strasse 34  
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**Representative:** Hittl, Elmar  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
23 September 2005 concerning maintenance of  
European patent No. 0776976 in amended form.

**Composition of the Board:**

**Chair:** U. Kinkeldey  
**Members:** B. Claes  
R. Moufang

## Summary of Facts and Submissions

- I. This decision concerns the second appeal proceedings relating to the opposition against European patent No. 0 776 976.
- II. This board, albeit in a different composition, had set aside, with its decision T 654/04 of 31 May 2005, the interlocutory decision of the opposition division posted on 23 January 2004 maintaining the patent in amended form and had remitted the case to the first instance with the order for further prosecution. The patent, granted with 11 claims, had been opposed to the extent of claims 1 to 10 under Article 100(a) EPC on the ground of lack of inventive step (Article 56 EPC).
- III. During the appeal proceedings leading to decision T 654/04 (*supra*) the sole appellant (proprietor) had requested that the decision under appeal be set aside and the patent be maintained on the basis of a main request, i.e. consisting of claims 1 to 10 as granted (being identical to the amended main request before the opposition division) or on the basis of claims 1 to 11 of a first auxiliary request. The claims from the latter differed from the "amended auxiliary request 1" forming the basis for maintaining the patent by the opposition division in that they contained a new independent claim, i.e. claim 2, and a claim dependent thereon, i.e. claim 3.
- IV. In its decision T 654/04 (*supra*) the board found that the decision of the opposition division of 23 January 2004 gave only reasons why the invoked ground of opposition did not prejudice maintenance of the patent

with the set of claims 1 to 9 of an "amended auxiliary request 1" but did not give any reasons for refusing a higher ranking amended main request, comprising claims 1 to 10 as granted filed during the oral proceedings before the opposition division held on 2 December 2003. The board found the lack of reasoning for this request in the decision in violation of Rule 68(2) EPC and considered this to amount to a fundamental deficiency. For proper appeal proceedings, the board considered it a fundamental requirement to have a reasoned decision by the first instance on the very point that was decided adversely to the appellant. The board remitted the case to the first instance department and ordered reimbursement of the appeal fee (see T 654/04, *supra*, points 5 to 9).

- V. After remittal of the case to the first instance department, the opposition division issued the decision now under appeal, i.e. the further interlocutory decision posted on 23 September 2005 according to which the patent in amended form met the requirements of the EPC. This decision was posted without prior notification, communication or invitation to the parties from the opposition division for comments in writing or orally during oral proceedings.
- VI. In the decision the opposition division gave reasons why the ground of opposition under Article 100(a) EPC in conjunction with Article 56 EPC prejudiced maintaining the patent with the set of claims 1 to 10 of the main request (being identical to the amended main request filed during oral proceedings before the opposition division held on 2 December 2003) or with the set of claims 1 to 11 of the first auxiliary

request submitted before the board in the preceding appeal proceedings and repeated the reasons given in the first written decision why this ground for opposition did not prejudice maintenance of the patent with the set of claims 1 to 9 of the "amended auxiliary request 1" filed during the oral proceedings before the opposition division on 2 December 2003. The reasons pertaining to the first auxiliary request concluded that the subject matter of claim 2 of this request lacked inventive step.

VII. Both the patent proprietor (appellant I) and the opponent (appellant II) have lodged appeals against the interlocutory decision of the opposition division posted 23 September 2005. Appellant I requested to set aside the decision and to maintain the patent on the basis of a main request (claims 1 to 10 as granted), or on the basis of a (new) first (claims 1 to 10) or a newly filed second auxiliary request (claims 1 to 10), both auxiliary requests filed with letter of 23 January 2006. Appellant II requested to set aside the decision and to revoke the patent. Both parties requested oral proceedings in the event that the board was not to follow their requests.

VIII. With a communication dated 27 February 2006, the board informed the parties of its preliminary opinion that, taking into account the provision of Article 10 of the Rules of Procedure of the Boards of Appeal, the board should exercise its power under Article 111(1) EPC and remit the case once more to the opposition division for further prosecution. The parties were invited to clarify whether or not, in the event that the board were to remit the case to the first instance for

further prosecution, their requests for oral proceedings before the board were still valid. In reply, appellants I and II informed the board that their requests for oral proceedings were no longer valid if the board were to decide to remit the case to the first instance for further prosecution.

## **Reasons for the Decision**

### *Admissibility of the appeals*

1. The appeal of appellant I is admissible since it complies with the requirements of Articles 106 to 108 and Rule 64 EPC.
2. Appellant II did not appeal the first interlocutory decision so that the patent proprietor (appellant I) was the sole appellant in the previous appeal proceedings. In that decision the opposition division already came to the same conclusion as in the now appealed second interlocutory decision, namely that the patent in amended form on the basis of the "amended auxiliary request 1" filed during oral proceedings before the opposition division held on 2 December 2003 met the requirements of the EPC. It may therefore be argued that the principle of prohibition of *reformatio in peius* prevents appellant II from challenging the maintenance of the patent as thus amended.
3. However, this possible application of the principle of prohibition of *reformatio in peius* is a matter of **allowability**, not a matter of **admissibility** of the appeal filed by appellant II. The relevant question to

be asked in the context of admissibility is whether appellant II is adversely affected by the appealed decision in accordance with Article 107 EPC. This requires a comparison of the order of the appealed decision with the final requests of the appellant at the point of time when that decision was taken. In the present case, appellant II did not file any new request after the case was remitted to the opposition division. Since further prosecution proceedings on remittal have to be regarded as a continuation of the original opposition proceedings, the last request of appellant II in the opposition proceedings leading to the first interlocutory decision became effective again (*cf.* decision T 892/92, OJ EPO 1994, 664, point 2.2). This request was the request to revoke the patent, as stated in the minutes of the oral proceedings of 2 December 2003 at point 2.1. Given that the opposition division did not accede to this request, appellant II is adversely affected by the appealed decision. Therefore also the appeal of appellant II is admissible.

*Violations of Articles 113(1) and 116(1) EPC*

4. The basic issue to be decided in these appeal proceedings is whether or not the proceedings before the opposition division that took place after remittal suffer again from substantial procedural violation(s). The provisions relevant for this issue in the present case are those of Articles 113(1) and Article 116(1) EPC.
5. 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, VII.C.2.4),

Article 113(1) EPC generally requires that an express opportunity to present observations be given to the parties by the opposition division after remittal of a case to it for further prosecution by a board of appeal.

- 5.1 In its decision T 892/92 (*supra*), the board held that the term "opportunity" in Article 113(1) EPC can only be given effective meaning by applying the principles of good faith and the right to a fair hearing. If parties could be said to have been surprised, from an objective point of view, by the decision and the grounds and evidence on which it is based, then this opportunity could not have been sufficiently granted. No such opportunity could exist where a remittal by a board of appeal for further prosecution on the basis of new evidence was immediate, i.e. without an intervening communication announcing the resumption of the proceedings, followed by the revocation of the patent. It was necessary that the parties be expressly asked whether or not they wished to present their comments or in the case where the parties had already made detailed submissions during the preceding appeal proceedings, whether or not these submissions should be regarded complete. These principles were followed in decisions T 769/91 of 29 March 1994 (point 2), T 120/96 of 6 February 1997 (point 2.2), T 679/97 of 4 January 1999 (point 2.3.2) and T 742/04 of 14 July 2005 (points 2 and 3) for opposition proceedings and in decisions T 922/02 of 10 March 2004 (point 4) and T 1494/05 of 3 April 2006 (point 3) for examination proceedings.

Furthermore, decision T 892/92 (*supra*) held that resumed opposition proceedings were governed by the existing requests. It was therefore also desirable to



clarify at the same time whether any requests submitted originally, i.e. before the proceedings were interrupted by the appeal proceedings, were maintained, modified or withdrawn or whether further requests would be submitted. This principle was followed in decisions T 120/96 (*supra*, point 2.3), T 679/97 (*supra*, point 2.3.3) and T 742/04 (*supra*, points 2 and 3).

For the above reasons the board in decision T 892/92 (*supra*) found that the immediate termination of the opposition proceedings following remittal was not in accordance with the requirements of Article 113(1) EPC and therefore constituted a substantial procedural violation.

Although it was found not strictly necessary for the decision, the board in its decision T 892/92 (*supra*, point 2.2) refers in particular to the fact that "further prosecution" proceedings on remittal by a board of appeal should be regarded as a continuation of the original opposition proceedings. Consequently, the parties' original requests including any subsidiary request for oral proceedings became once more effective after remittal (*cf.* also above point 3).

6. The board adheres to the principles as established in the case law referred to above. The board considers that the immediate decision of the opposition division upon remittal of the case for further prosecution (see sections V and VI above) was not in accordance with the provision of Article 113(1) and Article 116(1) EPC for the following reasons.

- The parties were not expressly notified that the opposition proceedings had been resumed after remittal.
  
- The opposition division did not expressly request the parties to clarify whether or not in particular the comments and submissions made by the parties during the preceding appeal proceedings concerning the first auxiliary request should be regarded as complete (*cf.* section III above).
  
- The opposition division did not expressly establish whether or not requests which had been made before the opposition proceedings had been interrupted by the appeal proceedings, were maintained, modified or withdrawn, or whether further requests would be submitted. The board here refers *inter alia* to the conditional request for oral proceedings made during the first opposition proceedings preceding the appeal by the patent proprietor. In this context the board finds that the request of present appellant I (patent proprietor) for oral proceedings made during former proceedings was legally effective, but, contrary to Article 116(1) EPC, had not been taken into account by the opposition division.

The fact that the opposition division immediately issued a decision after remittal of the case to it therefore amounts to a fundamental deficiency within the meaning of Article 10 of the Rules of Procedure of the Boards of Appeal and to a substantial procedural violation within the meaning of Rule 67 EPC.

7. Although not directly relevant for the present decision the board is furthermore concerned about the following further procedural issues regarding the conduct of the opposition proceedings by the opposition division.

7.1 Neither the first interlocutory decision of the opposition division, subject to appeal case T 654/04, nor the decision under appeal makes reference, in the reasons for the decision, to the following issues arising from opponent's letter dated 31 October 2003:

- the introduction of a new ground for opposition against claim 1 under Article 123(2) (sic, i.e. 100(c)) EPC; and
- the late introduction of documents (5) and (6) into the opposition proceedings.

7.2 In connection with the above issues it follows from the minutes of the oral proceedings held on 2 December 2003 that:

- (a) the new ground for opposition against claim 1 was *"dismissed since the proprietor had responded adequately in his letter of 18.11.2003"* (see point 3.2);
- (b) after hearing the parties on the late introduction of documents (5) and (6) (see points 2.1 and 2.2), the division did not admit these documents into the proceedings since, *"in addition to being late filed and not translated, they did not seem prima facie relevant for the assessment of inventive step."* (see points 3.1)

- 7.3 The first interlocutory decision of the opposition division refers to the above points (a) and (b) in the section "facts and submissions" sections V, VI and VII. However, as stated above, the reasons for the decision are silent on these issues. The decision under appeal merely refers in section II to the "facts and submissions" mentioned in the first interlocutory decision of the opposition division.
- 7.4 During the first appeal proceedings, the opponent (then the respondent), with letter dated 12 October 2004, again relied on document (6), this time in translation, for arguing lack of inventive step of claim 1 of the main request. Furthermore, with the same letter, the opponent has introduced a new ground for opposition under Article 100(a) EPC in connection with Article 54 EPC on the basis of document (6) against claim 1 of the main request (i.e. claim 1 as granted).

*Reimbursement of the appeal fees*

*Remittal to the first instance department*

8. In view of the above the board decides to set aside the decision under appeal, to order the reimbursement of the appeal fees of both appellants 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 remit the case once more to the opposition division for further prosecution.
9. The board is concerned that this decision of the board again results in the case being remitted to the first instance without a final decision on the substantive

issues. However, the board notes that the aim to streamline the procedure before the EPO, an aim supported by the boards of appeal, must not be achieved at the expense of the parties' right to a fair procedure and the right to be heard.

10. The board wishes to point out that utmost attention should be paid, during the further prosecution before the first instance, to the above principles as well as to the avoidance of any further delay. In particular it will have to be ensured that the appellants are given an opportunity of establishing their requests and of commenting on any relevant grounds with regard to the patentability of the subject-matter claimed, and that the decision taken is reasoned in accordance with Rule 68(2) EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The appeal fees are to be reimbursed to appellants I and II.

Registrar:

Chair:

P. Cremona

U. Kinkeldey