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**Datasheet for the decision
of 2 March 2009**

Case Number: T 0111/06 - 3.3.02

Application Number: 00910789.7

Publication Number: 1158992

IPC: A61K 33/00

Language of the proceedings: EN

Title of invention:

Use of xenon for preparing a pharmaceutical preparation for treating neurointoxications

Patentee:

Air Products and Chemicals, Inc.

Opponent:

L'AIR LIQUIDE, S.A. A DIRECTOIRE ET CONSEIL DE

Headword:

Use of xenon/AIR PRODUCTS AND CHEMICALS, INC.

Relevant legal provisions:

EPC Art. 113(1)

EPC R. 68(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Remittal - yes: Procedural violation"

Decisions cited:

-

Catchword:

-



Case Number: T 0111/06 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 2 March 2009

Appellant: Air Products and Chemicals, Inc.
(Patent Proprietor) 7201 Hamilton Boulevard
Allentown
PA 18195-1501 (US)

Representative: Clyde-Watson, Zöe
D Young & Co
120 Holborn
London EC1N 2DY (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 November 2005
revoking European patent No. 1158992 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
J. Van Moer

Summary of Facts and Submissions

I. European patent No. 1 158 992, based on European application No. 00 910 789.7, was granted on the basis of 15 claims.

Independent claim 1 as granted read as follows:

"1. Use of xenon or xenon gas mixtures for preparing a pharmaceutical preparation for treating neurointoxications."

II. A notice of opposition was filed against the patent under Article 100(a) EPC for lack of novelty and inventive step.

III. By decision pronounced on 23 September 2005, the Opposition Division revoked the patent under Article 102(1) EPC because the claims as granted did not meet the requirements of Article 56 EPC.

IV. The appellant (patentee) lodged an appeal against the said decision.

V. In its grounds of appeal dated 27 March 2006, the appellant expressed surprise at the conclusions of the Opposition Division during the oral proceedings.

In that respect, it referred to the communication of 2 March 2005 containing the Opposition Division's preliminary opinion. In this notification, the Opposition Division, exercising its discretionary power pursuant to Art. 114(2) EPC disregarded document (4), had taken the view that the *in vitro* examples of the patent showed the claimed effect, which it had held to

be predictable for the *in vivo* effect, and had expressed the provisional opinion that the facts, evidence and arguments raised by the opponent did not prejudice the maintenance of the granted patent.

In the light of this preliminary opinion, the appellant argued that it was most surprising that the Opposition Division had decided during the oral proceedings that document (4) was a relevant document, which it had introduced into the proceedings without giving it enough time to study it, and that it had changed its favourable view as to inventive step. It was further most surprising to read in the Opposition Division's decision, contrary to the preliminary opinion, that the *in vitro* experiments of the patent were considered to be unpredictable for the claimed *in vivo* effect because this had not been discussed at all during the oral proceedings

The appellant also stated that it had not been allowed to present any argument during the oral proceedings as to why its auxiliary request, presented for the first time during the oral proceedings, should be admitted as a reaction to the new and unexpected situation indicated above, with the result that this auxiliary request had been simply not admitted into the proceedings as late filed.

Finally, the appellant submitted further arguments in favour of inventive step and filed auxiliary requests 1 to 3.

VI. With its letter dated 14 June 2007, the respondent withdrew its opposition.

- VII. In a communication dated 5 February 2009, the Board expressed its agreement with the appellant's written submissions that the right to be heard had been violated by the Opposition Division (Article 113(1) EPC) and that, moreover, the Opposition Division's decision was also deficient in that no reasons were given as to the inadmissibility of the auxiliary request (Rule 68(2) EPC), so that the case should be directly remitted to the Opposition Division. The appellant was invited to reconsider its request for oral proceedings.
- VIII. In reply to this communication, the appellant withdrew its request for oral proceedings, subject to the entire case being remitted to the Opposition Division on the grounds of procedural violation (appellant's letter dated 9 February 2009).
- IX. The appellant requested in writing that the Opposition Division's decision be set aside or that the patent be granted on the basis of auxiliary requests 1 to 3 filed with its grounds of appeal. It also requested a refund of the appeal fee.

Reasons for the decision

1. The appeal is admissible.
2. *Rule 68(2) EPC*
 - 2.1 The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department.

A reasoned decision issued by the first-instance department meeting the requirements of Rule 68(2) EPC is accordingly mandatory.

- 2.2 In the present case the appellant submitted in its grounds of appeal that the Opposition Division had refused to admit into the proceedings its auxiliary request filed during the oral proceedings.

The Board notes that the Opposition Division's decision is totally silent on that issue. The decision is indeed strictly restricted to the set of claims as granted.

It is however clear from the minutes (page 4, paragraphs 4 and 6) that the appellant did indeed file an auxiliary request during the oral proceedings.

The absence, in the decision itself, of any reasoning as to why this request was not admissible or did not fulfil the requirements of the EPC is a clear infringement of Rule 68(2) EPC .

- 2.3 The duty to provide substantiated reasons in administrative decisions is a fundamental principle in all contracting states, Rule 68(2) EPC simply being an expression of that principle. Further, from the point of view of the practical functioning of the system envisaged in the EPC, in the absence of the documents and a related adequately reasoned decision within the meaning of Rule 68(2) EPC the Board is unable to properly examine the appeal as to its merits (Article 110 EPC).

3. *Article 113(1) EPC*

The appellant provided in its grounds of appeal various arguments as to why the auxiliary request should not be considered as late-filed and should be introduced into the proceedings (see point V. above). It further stated that it "was not allowed to present any argument as to why the proposed auxiliary request should be allowed [during the oral proceedings]" (grounds of appeal, page 3, paragraph 2).

In that respect, the Board observes that the decision is totally silent about any such arguments provided by the appellant in favour of the admissibility of its auxiliary request. In addition, the minutes are also totally silent on any arguments from the appellant relating to the auxiliary request, whereas on the contrary they clearly mention the opponent's arguments and the Opposition Division's conclusions as to the late filing of the request (minutes, page 4, paragraph 6).

Thus, the Board is very much inclined to believe the appellant when it states that it was not allowed to present its arguments.

Accordingly, the Board considers that the right to be heard has been violated, which constitutes a second severe procedural violation.

4. Under these circumstances, the decision under appeal must be set aside and in accordance with the established case law of the boards of appeal, the case

remitted to the department of first instance for further prosecution.

The appeal is allowed to the extent that the decision under appeal is set aside, and the appeal fee is reimbursed pursuant to Rule 67 EPC, on account of the two substantial procedural violations constituted by non-compliance with Rule 68(2) EPC and Article 113(1) EPC.

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 appeal fee is to be reimbursed.

The Registrar:

The Chairman:

N. Maslin

U. Oswald