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**Datasheet for the decision
of 15 July 2011**

Case Number: T 1700/10 - 3.3.09

Application Number: 98949403.4

Publication Number: 1023003

IPC: B32B 27/06

Language of the proceedings: EN

Title of invention:

Multilayer conductive appliance having wound healing and analgesic properties

Patentee:

Argentum International, LLC

Opponent:

Paul Hartmann AG

Headword:

Composition of Opposition Division/ARGENTUM INTERNATIONAL

Relevant legal provisions:

EPC Art. 19(2), 111(1)
EPC R. 103(1)(a)

Keyword:

"First and second examiner of Opposition Division having participated in examination proceedings"
"Relevance of parties' position to defective composition of Opposition Division (no)"
"Substantial procedural violation (yes) - Remittal (yes) - Reimbursement of appeal fee (yes)"

Decisions cited:

T 0251/88, T 0939/91, T 0382/92, T 0476/95, T 0838/02,
T 1349/10



Case Number: T 1700/10 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 15 July 2011

Appellant:
(Opponent)

Paul Hartmann AG
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D-89522 Heidenheim (DE)

Representative:

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Respondent:
(Proprietor)

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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 8 June 2010
rejecting the opposition against European
patent no. 1023003.

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
F. Blumer

Summary of Facts and Submissions

- I. European patent No. 1 023 003 was granted on the basis of European patent application No. 98949403.4. The mention of the grant of the patent was published on 21 May 2008. The decision to grant said patent was signed, *inter alia*, by Mr M.S. as first examiner and Mr J.S.M. as second examiner.
- II. Opposition was filed on 19 February 2009. In its decision of 8 June 2010, the Opposition Division rejected the opposition. Mr M.S. signed said decision as first examiner, and Mr J.S.M. signed it as second examiner.
- III. On 9 August 2010, the Appellant (Opponent) filed a notice of appeal and paid the appeal fee on the same day. On 11 October 2010, the Appellant filed its statement setting out the grounds of appeal.
- IV. The Appellant requested that the decision under appeal be set aside and that the patent be revoked. The appellant also requested oral proceedings as an auxiliary measure.
- V. The Respondent, in its letter dated 22 February 2011, requested that the appeal be dismissed and that oral proceedings be held.
- VI. In a communication posted on 10 March 2011, the Board observed that the composition of the Opposition Division did not satisfy the requirements of Article 19(2) EPC since two of its members had already taken part in the grant proceedings. The Board indicated that it intended to remit the case to the

department of first instance and to reimburse the appeal fee because the faulty constitution of the Opposition Division was a substantial procedural violation. In the same communication, the Board also invited both parties to indicate their position with respect to oral proceedings.

- VII. In its letter of 29 April 2011, the Appellant withdrew its request for oral proceedings and requested oral proceedings (after remittal) before the Opposition Division. The Respondent, in its letter of 29 April 2001, also withdrew its request for oral proceedings in view of the Board's views expressed in the communication of 10 March 2011.

Reasons for the Decision

1. The appeal is admissible.
2. Under Article 19(2), first sentence, EPC, "[a]n Opposition Division shall consist of three technically qualified examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates." (emphasis added)
3. In the present case, the first and the second examiner of the Opposition Division (Mr M.S. and Mr J.S.M.) had taken part in the proceedings for the grant of the opposed patent. For example, they had signed Form 2035.4 (dated 22 October 2007) and they had been identified as first and second examiners in the communication under Rule 51(4) EPC 1973 posted on

26 November 2007. As members of the Opposition Division, Mr M.S. and Mr J.S.M., *inter alia*, were present at the oral proceedings before the Opposition Division and signed the decision of the Opposition Division dated 8 June 2010. Only one of the examiners signing the decision of the Opposition Division had not taken part in the proceedings for the grant of the patent. For this reason, the composition of the Opposition Division violated Article 19(2), first sentence, EPC.

4. Violations of Article 19(2) EPC were considered to be substantial procedural violations which led to a remittal of the case under Article 111(1) EPC and to the reimbursement of the appeal fee in several cases (see decisions T 251/88, T 939/91, T 382/92, T 476/95, T 838/02, T 1349/10, none of them published in the OJ EPO).

5. The Board is aware that in two of the cases mentioned above (T 251/88 and T 838/02), the boards asked the appellant or all parties whether they invoked the procedural violation before they decided on the remittal. In both cases, the patent had been revoked by the Opposition Division. In the judgment of this Board, violations of Article 19(2) EPC should lead to a remittal regardless of the parties' position at least in situations where third parties are affected by the outcome of the defective first instance proceedings, like in the present case where the patent was maintained in the opposition proceedings (see also decision T 1349/10, point 5 of the reasons).

6. The decision under appeal therefore has to be set aside and the case has to be remitted to the department of first instance. As the remittal is the consequence of a substantial procedural violation, the reimbursement of the appeal fee under Rule 103(1)(a) EPC is equitable in the Board's judgment.
7. The Appellant's request regarding oral proceedings before the Opposition Division after remittal of the case relates to issues that have to be decided by the Opposition Division and should therefore be addressed to the Opposition Division.

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 reimbursed.

The Registrar:

The Chairman:

G. Röhn

W. Sieber