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**Datasheet for the decision
of 24 July 2013**

Case Number: T 2177/12 - 3.2.02
Application Number: 06751411.7
Publication Number: 1896117
IPC: A61M 39/02, A61M 39/04
Language of the proceedings: EN

Title of invention:

Power injector system for injecting contrast media into an intravenous line

Patent Proprietor:

C.R.Bard, Inc.

Opponents:

AESFULAP AG & Co. KG
Fresenius Kabi Deutschland GmbH
pfm medical ag

Headword:

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Relevant legal provisions:

EPC Art. 68, 101, 105a, 107, 112(1), 113(2)
RPBA Art. 16(1)(e)
EPC R. 71(3), 91

Keyword:

"Adversely affected (no)"
"Admissibility of the appeal (no)"
"Referral to Enlarged Board (no)"
"Apportionment of costs (no)"

Decisions cited:

T 0329/88, T 0655/01, T 0961/00, G 0009/93

Catchword:

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Case Number: T 2177/12 - 3.2.02

DECISION
of the Technical Board of Appeal 3.2.02
of 24 July 2013

Appellant: C.R.Bard, Inc.
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 1 August 2012 revoking European patent No. 1896117 pursuant to Article 101(3) (b) EPC.

Composition of the Board:

Chairman: E. Dufrasne
Members: P. L. P. Weber
C. Körber

Summary of Facts and Submissions

I. The appeal was filed by the proprietor against the decision of the Opposition Division posted on 1 August 2012 to revoke the patent.

II. During the opposition proceedings the proprietor filed a letter on 27 July 2012 with the following content:

"Patentee hereby expressly disapproves of the text of the granted patent.

Patentee does not request maintenance of the patent.

Patentee resiles from its request for oral proceedings.

Attention is directed to Article 113(2) EPC. There is now no text agreed by the Patent Proprietor on the basis which the Division can examine the opposition.

Attention is invited, to Decision T0655/01, which sets out what has become the standard practice in these circumstances."

III. The decision under appeal (EPO Form 2345) reads as follows:

"Decision revoking the European Patent (Art. 101(3)(b) EPC)

European Patent No. 1896117 is revoked.

Reasons for the decision:

The patent proprietor, by statement filed on 27.07.2012

requested that the patent be revoked.

stated that he no longer approves the text in which the patent was granted.

As a consequence there is no longer a version of the text submitted and/or approved by the patent proprietor (Art. 113(2) EPC), in which the patent can be maintained, therefore the European Patent must be revoked pursuant to Article 101 (3) (b) EPC."

IV. On 2 October 2012 the notice of appeal was filed and the appeal fee was paid.

In this notice of appeal the following requests were made :

(1) Reversal of the decision and maintaining the patent as granted;

(2) In the event the petition according to (1) should not be granted, the scheduling of oral proceedings before the Board of Appeal.

V. On 11 December 2012 the appellant filed the statement setting out the grounds of appeal. In this statement the appellant formulated the following questions to be referred to the Enlarged Board of Appeal:

a) Does the European Patent Convention provide the EPO with the authority to revoke a patent which has been surrendered by:

a1) expressly disapproving the text upon which the patent has been granted and indicating that no new text will be presented;

a2)...

b) Does the EPC provide the EPO with the right to interpret a statement of a Proprietor as the equivalent to a request for revocation of the patent when the statement concerns

b1) the indication that the Proprietor no longer approves the text of the patent in which it was granted and that the Proprietor will not provide a new text;

b2)...

VI. A summons to oral proceedings with an annexed communication was issued by the Board on 15 March 2013.

VII. Oral proceedings were held on 24 July 2013.

The appellant (patent proprietor) requested that the appeal proceedings be discontinued or, in the alternative, that the decision under appeal be set aside and that the appeal proceedings be closed. It further requested that the questions set out in point V above be referred to the Enlarged Board of Appeal.

Respondent 01 (opponent 01) and respondent 03 (opponent 03) requested that the appeal be dismissed. They further requested apportionment of costs under Article 16(1)(e) RPBA.

Respondent 02 had informed the Board with letter filed on 28 June 2013 that it would not be attending the oral proceedings.

VIII. The arguments of the appellant can be summarised as follows, as far as necessary for the present decision:

The decision of the Opposition Division was flawed in that it stated that the patent had to be revoked under Articles 113(2) and 101(3)(b) EPC. Article 113(2) EPC only gave the Opposition Division the authority to decide on a text which had been agreed to by the proprietor. However, in the present case the proprietor had explicitly disapproved the granted text and not filed any replacement text, so that the Opposition Division did not have any power to issue a decision under Article 101 EPC. A revocation under this article presupposed that the Opposition Division had examined the case and made an opinion on whether a ground for opposition prejudiced the maintenance of the patent. Disapproval was not an amendment of the text which required an opinion of the Opposition Division. Consequently the proprietor's withdrawal of its agreement had "paralysed" the Opposition Division, which should have closed the file. The proprietor's intention had been to save time in view of the notoriously slow (national) renunciation procedures. Possibly a mention of the disapproval could have been put into the Register, but this had to be decided by the legislator as nothing was foreseen in the EPC. Not closing the proceedings had adversely affected the appellant as any revocation created the impression for the general public that there was an obstacle to the maintenance of the patent, or in other words that the patent was not in conformity with the EPC, whereas a closure of the proceedings following the proprietor's disapproval of the granted text would only be the expression of the proprietor's wish not to follow or

maintain any of the rights it had obtained with the grant, such a disapproval of the granted text having an ex-tunc effect.

In a similar situation in T 329/88 the board had closed the file, so the Opposition Division should have done the same.

The proprietor was also adversely affected because in fact it had never explicitly requested revocation, so the Opposition Division had not followed the wish of the proprietor. Moreover, revocation might have different legal consequences.

Such disapproval of the granted text could also not be interpreted as a request for revocation because such a request for revocation was formally forbidden in opposition proceedings by Article 105a(2) EPC and would additionally also have been against the prohibition on a proprietor opposing its own patent.

Furthermore, the citation of T 655/01 in the letter of 27 July 2012 was not to be considered as a sign that the proprietor wanted revocation of the patent, but as an invitation to take a position contrary to that decision. That letter had also referred to Article 113(2) EPC and to the fact that the Opposition Division no longer had a text on which to base an examination. So the Opposition Division should not have issued a decision to revoke the patent.

In any case, if there was no ground of opposition prejudicing the maintenance of the patent, as was the case when there was no text, pursuant to Article 101(2) EPC the Opposition Division had no other option than to

reject the opposition. Moreover, the initial request that the oppositions should be rejected was still pending.

Therefore there were several reasons why the proprietor was adversely affected by the decision of the Opposition Division.

Question to the Enlarged Board of Appeal

Article 113 was a fundamental EPC provision and the case law was in conflict with it, which in itself already justified a referral of the questions to the Enlarged Board. The questions to be referred were also linked to the question of admissibility of the appeal, because they concerned the question whether the Opposition Division had a right to revoke the patent even if it had not been requested to do so. Since the existing practice and case law (e.g. T 655/01) were contrary to the provisions of the EPC, the legislator should take action to amend the EPC accordingly.

Apportionment of costs

The proprietor could not see any abuse of procedure which would justify an apportionment of costs. It had merely appealed against a decision of revocation in order to clarify the matter, and since the patent had been renounced in the designated Contracting States the respondents clearly had no further need to be involved.

IX. The arguments of respondents 01 and 03 can be summarised as follows:

In its letter of 27 July 2012 the appellant had explicitly indicated that it was not requesting maintenance of the patent so the Opposition Division, in conformity with the case law, had no other choice than to revoke the patent. In inter-partes proceedings, doing otherwise, i.e. closing the file, would be to refuse the requests of the respondents, opponents in the opposition proceedings, since they had requested revocation of the patent.

Referral of the appellant's questions to the Enlarged Board of Appeal was not necessary. The Opposition Division had applied established case law, so there was no doubt about uniform application of the law, or any point of law of fundamental importance to be decided.

The appellant could not claim that the public would consider that the patent had been revoked because a ground of opposition prejudiced its maintenance, since in the reasons for the decision under appeal it was clearly mentioned that the patent had been revoked because the proprietor no longer approved the text in which the patent had been granted.

Apportionment of costs

In the opposition proceedings the proprietor had explicitly disapproved of the text of the granted patent and indicated that it did not want the patent to be maintained. Going back on that request now in the notice of appeal, by requesting maintenance of the patent as granted was therefore an abuse of procedure justifying apportionment of costs. Because of this request the respondents had been obliged to deal with

the case again, although the patent had been revoked, which had involved additional costs. They had also to check whether there were any residual rights in each contracting state in which the patent had been renounced; that too had involved additional costs. The appellant's intention of "paralysing" the Opposition Division was also an abuse of procedure.

Respondent 02 did not file any requests or arguments.

Reasons for the Decision

1. Admissibility of the appeal

1.1 The first sentence of Article 107 EPC reads as follows:

"Any party to proceedings adversely affected by a decision may appeal."

It follows from this sentence that the appeal proceedings are open only to a party which was adversely affected by the impugned decision.

There is ample jurisprudence of the boards of appeal on the question of whether or not a party is adversely affected by a decision. In this respect the present Board agrees with the findings of e.g. T 961/00, point 1 of the reasons.

"According to the established jurisprudence of the Boards of Appeal a party is only considered to be adversely affected by a decision if the decision does not accede to its requests (Benkard, EPÜ, Europäisches

Patentübereinkommen, Munich 2002, Article 107, Note 13 and the decisions cited therein, Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, VII.-D, 7.3.2, and the decisions cited therein)."

...

"There is therefore an adverse effect if the result of the decision as defined by its order does not come up to the party's request (T 244/85, OJ EPO 1988, 216, point 3 of the reasons, T 114/82, T 115/82, OJ EPO 1983, 323, Benkard-EPÜ, loc. cit.). Conversely, there is no adverse effect when the decision is consistent with what the party in question has requested (T 506/91, point 2.8 of the reasons)."

1.2 In the present case there was no explicit final request in the opposition proceedings. In its letter of 27 July 2012 (see point II above) the proprietor, in the first sentence, expressly disapproved of the text of the granted patent. In the second sentence, it stated that it did not request maintenance of the patent, and it further indicated that there was no text agreed to by the proprietor. In the last sentence, it drew the attention of the Opposition Division to decision T 655/01, which it said set out what had become the standard practice in these circumstances.

The proprietor disapproved of the text of the granted patent. In other words, it withdrew the approval given for grant of a patent in the text proposed in the communication according to Rule 71(3) EPC of 16 August 2010. This declaration can objectively only

be interpreted as meaning that it did not wish the patent to be maintained as granted.

By indicating in the second sentence that it did not request the maintenance of the patent and, further, that there was no agreed text, it not only confirmed that it did not wish the patent to be maintained as granted, but also that it did not want the patent maintained in any form, i.e in any amended form.

T 655/01 concerns a case in which the proprietor, after receiving the summons to oral proceedings in the appeal proceedings, informed the board that it no longer approved the text of the patent as granted and that it considered the proceedings as terminated. The board then concluded, in application of the principle expressed in numerous decisions, that the patent had to be revoked (point 6 of the reasons).

In the present case, by citing this decision at the end of its letter and indicating that this was the standard practice, the proprietor invited the Opposition Division to follow that standard practice, i.e. to revoke the patent.

Thus, in the opinion of the Board, when the proprietor, in the same short letter, declares its disapproval of the text of the granted patent, specifically indicates that it is not requesting maintenance of the patent and cites a decision in which, in a similar case, the patent was revoked, this can, on the basis of an objective and bona fide reading, only mean that the proprietor wished the patent to be revoked. Nothing

else can objectively be derived from the proprietor's statement.

Hence the order of the impugned decision of the Opposition Division to revoke the patent corresponds exactly to the wish of the proprietor, so that the Board cannot see how it could possibly be adversely affected by the decision.

1.3 The Board would also like to emphasise that it agrees with the established practice of revoking the patent pursuant to Article 113(2) EPC in such procedural situations. As a matter of fact, when a proprietor disapproves of the text in which the patent was granted and does not submit any amended text, this can only mean that it wishes to prevent any text whatsoever of the patent from being maintained. In the absence of any other legal mechanism in the EPC, and since the patent cannot be maintained against the will of its proprietor, revocation on the basis of Article 113(2) EPC is the most appropriate way to terminate the proceedings in the interest of legal certainty and without affecting the proprietor.

1.4 The appellant argued that its letter had to be read as meaning that it wanted closure of the opposition proceedings, not revocation, so that the Opposition Division did not accede to its request and consequently it was adversely affected. It also argued that the last but one paragraph of its letter, drawing attention to Article 113(2) EPC and in which it was pointed to the fact that there was no agreed text on the basis of which the division could examine the opposition, was an indication that it wanted the file to be closed.

As explained above, the Board considers that from a bona fide reading of the letter it can only be concluded that the proprietor wanted revocation. The Board considers more specifically that even if whatever doubts as to the intention of the proprietor might have been present after having read only the first sentence, in which the proprietor disapproved of the text as granted, these were in any case dissipated by the statement that maintenance of the patent was not requested, by the absence of any proposal for an amended text, and by the citation of a decision in which the patent had been revoked in a similar case. If the proprietor wanted closure of the opposition proceedings or anything else, it should have made that clearer in its letter. The proprietor cannot expect the Opposition Division to apply a procedure different from that usual in such procedural situations, if this has not only not been requested, but in addition, as in the present case, case law is cited which supports the usual procedure.

Additionally, even if the proprietor's letter were to be interpreted as a request for closing the opposition proceedings, the Board fails to see how revocation would have adversely affected the appellant. The appellant submitted that there were possible legal consequences, but failed to indicate what these might be. Nor did it dispute that its disapproval of the text of the granted patent had an ex-tunc effect, as does revocation (Article 68 EPC), so that in both cases the patent would have been legally deemed non-existent from the outset.

The appellant also submitted that it made a difference for the public, because revocation gave the impression that the patent had been revoked as not in conformity with the EPC, whereas closure of the proceedings did not. The Board does not share this view, because it is clearly apparent from the reasons for the decision under appeal (see point III above) that the patent was revoked because the proprietor stated that it no longer approved the text in which the patent had been granted. The public could therefore see that the conformity with the EPC had not been examined.

In a different line of argument, the appellant also submitted that its letter dated 27 July 2012 did not contradict its request to have the oppositions rejected. In the Board's opinion, since rejection of an opposition means maintenance of the patent, such rejection was made impossible by the proprietor's disapproval of the text of the granted patent.

Moreover, T 329/88 cited by the appellant concerns a different situation, namely one in which the opponent-appellant did not wish to continue the appeal proceedings after the patent had lapsed in all Contracting States. The Board applied Rule 60(1) EPC 1973 (relating to the opposition proceedings) *mutatis mutandis* and closed the proceedings. In the present case there is no opponent-appellant.

- 1.5 Furthermore, the appellant argued that the Opposition Division could not interpret its letter as a request for revocation because Article 105a(2) EPC formally forbade it, and in any case it would be against the

case law forbidding the filing of an opposition by the proprietor.

Article 105a EPC is part of the set of articles defining the limitation and revocation proceedings introduced in the EPC 2000. These proceedings are open to a proprietor wishing to limit its patent or have it revoked in the absence of opposition proceedings. In such a case the proprietor has to file a request and pay a fee (Article 105a(1) EPC) and the Examining Division will then examine its request (Rule 91 EPC). Article 105a(2) EPC thus forbids the filing of a limitation or revocation request under these specific proceedings (which are subject to payment of the corresponding fee) when opposition proceedings are pending. This is only logical, firstly in order to avoid having two different instances competent simultaneously, and possibly reaching diverging conclusions, and because the proprietor can limit or even request the revocation of its patent during opposition proceedings.

Thus, Article 105a(2) EPC does not prevent the proprietor from filing a request for revocation during opposition proceedings, nor does it prevent the Opposition Division from dealing with such requests. Finally, limitation or revocation proceedings are specific proceedings which require formal acts (request, fee, etc.) and are clearly distinct from opposition proceedings as in the present case.

In G 9/93 (OJ EPO 1994, 891) the Enlarged Board of Appeal decided that a European patent could not be opposed by its own proprietor. However, this clearly only limits the proprietor's right to file an

opposition but, again, does not prevent the proprietor from filing a request for revocation of its own patent during opposition proceedings initiated by another party.

- 1.6 The appellant argued that the Opposition Division could not revoke the patent under Article 101(3)(b) EPC, because this article was limited to cases in which the Opposition Division revoked a patent when, after examining amendments, it concluded that at least one ground for opposition prejudiced the maintenance of the patent. In the present case, there was no amended text to examine.

Even if the appellant were right, the Board fails to see how the Opposition Division mentioning this article of the EPC would adversely affect the appellant, as this would not have avoided revocation under Article 113(2) EPC. Nor has the appellant presented any argument, apart from those already set above, as to why this might be the case.

- 1.7 For the reasons set out above, the Board considers that the appellant was not adversely affected by the impugned decision, so that the appeal does not fulfil the requirement of Article 107 EPC and is to be rejected as inadmissible pursuant to Rule 101(1) EPC.

2. Request for referral of questions to the Enlarged Board of Appeal

Article 112(1) (a) EPC provides for a Board of Appeal, during proceedings on a case and following a request from a party to the appeal, to refer any question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises.

Hence, following a request from a party it lies within the power of the Board to decide whether a decision of the Enlarged Board is required in the given case.

In the present case, as explained above, the Board considers that the appellant was not adversely affected by the decision under appeal, and that therefore the appeal is to be rejected as inadmissible.

The questions submitted by the appellant can be summarised as follows: if a proprietor disapproves of the text in which the patent has been granted and indicates that no new text will be presented, i) does the EPC provide the EPO with the right to interpret such a statement by the proprietor as equivalent to a request for revocation, or ii) does the EPC provide the EPO with the authority to revoke the patent?

The Board fails to see how these questions are linked to whether or not the appellant was adversely affected by the decision under appeal. In other words, the Board fails to see how they are linked to the admissibility of the present appeal. As mentioned above, in the

present case the Board is confirming established practice and case law, and therefore does not see any problem of uniform application of the law, nor any important point of law requiring a decision from the Enlarged Board of Appeal.

Therefore, the request for referral of the questions to the Enlarged Board of Appeal is rejected.

3. Apportionment of costs

The respondents argued that the filing of this appeal was an abuse of procedure by the appellant which justified apportionment of costs pursuant to Article 16(1)(e) RPBA. More particularly they submitted that the request for maintenance of the patent as granted was an abuse because it contradicted the final request of the proprietor in the opposition proceedings.

The Board does not share this view. If a party is of the opinion that the first instance did not accede to its request, it may consider that it was adversely affected by the decision and may consequently decide to file an appeal. This is no more than its legitimate right to avail itself of the appeal procedure provided for in the EPC. When a proprietor, after revocation of its patent, files an appeal, the revocation decision is suspended and any opponents-respondents have to deal with the appellant's submissions and possibly file replies if they wish to defend the impugned decision. Nothing different has happened in the present case.

Thus, in the present case the Board cannot see any abuse of procedure in a party filing an appeal after disapproving of the text of the patent as granted and obtaining a revocation decision.

Therefore, the requests for apportionment of costs are rejected.

4. The appeal being inadmissible, the Board does not have to consider any of the other requests of the appellant or the respondents.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. The request to refer questions to the Enlarged Board of Appeal is rejected.
3. The requests for apportionment of costs are rejected.

The Registrar:

The Chairman:

D. Hampe

E. Dufrasne