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# Datasheet for the decision of 19 March 2018

**Case Number:** T 0802/13 - 3.2.02

**Application Number:** 05796880.2

**Publication Number:** 1819382

**IPC:** A61M5/145, A61M5/315

**Language of the proceedings:** EN

**Title of invention:**
INJECTION DEVICE WITH TORSION SPRING AND ROTATABLE DISPLAY

**Patent Proprietor:**
Novo Nordisk A/S

**Opponents:**
Genentech, Inc.
COPERNICUS sp. zo.o.
Ferring International Center S.A.
OWEN MUMFORD LIMITED
Ypsomed AG
Stöckeler, Ferdinand

**Headword:**

**Relevant legal provisions:**

EPC Art. 123(2), 111(1)
EPC R. 115(2)
RPBA Art. 15(3)

**Keyword:**

Oral proceedings - held in absence of two parties
Amendments - intermediate generalisation - added subject-matter (no)
Appeal decision - remittal to the department of first instance (yes)

**Decisions cited:**

G 0003/89, G 0011/91, G 0002/10, T 0714/00, T 1067/97, T 1906/11

**Catchword:**

Europäisches Patentamt
European Patent Office
Office européen des brevets

**Beschwerdekammern**

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**Case Number: T 0802/13 - 3.2.02**

# D E C I S I O N
# of Technical Board of Appeal 3.2.02
# of 19 March 2018

| | |
|---|---|
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**Decision under appeal:**
**Decision of the Opposition Division of the European Patent Office posted on 23 January 2013 revoking European patent No. 1819382 pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

| | |
|---|---|
| **Chairman** | E. Dufrasne |
| **Members:** | D. Ceccarelli |
| | P. L. P. Weber |

## Summary of Facts and Submissions

I. The patent proprietor has appealed against the Opposition Division's decision to revoke European patent No. 1 819 382.

The decision, dispatched on 23 January 2013, was based on the ground that the subject-matter of claim 1 of all requests admitted into the proceedings extended beyond the content of the application as originally filed. Several requests were not admitted.

The patent had been opposed on the grounds of extension of subject-matter, insufficiency of disclosure, lack of novelty and lack of inventive step.

II. Notice of appeal was received on 18 March 2013. The appeal fee was paid the same day. The statement setting out the grounds of appeal was received on 31 May 2013.

III. The Board summoned the parties to oral proceedings and set out its provisional opinion by communication dated 6 December 2017.

IV. The respondents opponent 1 and opponent 2 announced by letters dated respectively 17 January 2018 and 7 March 2018 that they would not attend the oral proceedings.

V. Oral proceedings took place on 19 March 2018.

The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of one of the main request, filed with letter dated 6 September 2012; auxiliary request 1, filed with letter dated 31 May 2013; auxiliary request 1A, filed

with letter dated 12 August 2014; auxiliary requests 2 to 7, filed with letter dated 31 May 2013; and supplementary auxiliary requests 3 to 5, filed with letter dated 31 May 2013.

The respondents opponents 3 to 6 requested that the appeal be dismissed. The respondent opponent 1 had requested in writing that the appeal be dismissed. The respondent opponent 2 had not submitted any requests.

The appellant further requested that the case be remitted to the department of first instance for further prosecution if any of the requests were found to comply with Article 123(2) EPC. The respondent opponent 5 also requested that the case be remitted in such an event. On the same condition, the respondents opponents 3 and 4 requested that the Board consider novelty and inventive step and not remit the case.

VI. Claim 1 of the main request reads as follows:

"An injection device comprising
- a housing (5) with an inner surface provided with threads (10),
- a dose setting member (1) adapted to set a dose to be ejected from the injection device,
- a torsion spring (12) operatively connected to the dose setting member (1), such that energy is accumulated in the torsion spring (12) upon rotation of the dose setting member (1) and released to eject automatically,

characterized in further comprising:

- a rotatably mounted display member threadely engaged with the threads (10) of the housing (5)

and operatively connected with the dose setting member (1) and adapted to display the dose to be ejected from the injection device in accordance with a setting of the dose setting member (1),

the rotatably mounted display member being rotatable over an angle corresponding to at least one revolution of the display member."

VII. The appellant's arguments may be summarised as follows:

*Article 123(2) EPC*

Compared with claim 1 as originally filed, claim 1 of the main request had been amended by the addition of five features identified as follows by the Opposition Division:

i) a housing with an inner surface provided with threads;

ii) such that energy is accumulated in the torsion spring upon rotation of the dose setting member;

iii) and released to eject automatically;

iv) [display member] threadely engaged with the threads of the housing;

v) [display member] operatively connected with the dose setting member.

The application as originally filed clearly provided an individual basis for each of them, in particular in relation to the first and second embodiments depicted in figures 1 to 4. Moreover, although it was accepted that claim 1 of the main request did not cover the

third embodiment depicted in figure 5, there was still a general basis in the section "SUMMARY OF THE INVENTION" on pages 2 to 5.

More particularly, the features of the housing and the display member in threaded engagement with each other were based on page 6, line 32, to page 7, line 3, in connection with the first embodiment of the invention and, implicitly, on page 2, lines 17 to 27, and page 3, lines 23 to 24.

The feature of the display member operatively connected with the dose setting member was based on claim 1 as originally filed, which recited that the display member was adapted to display the dose in accordance with a setting of the dose setting member. In other words, the displayed dose was a result of the dose setting, which implied an operative connection between the dose setting member and the display member. It followed that the added feature had exactly the same technical meaning as the definition in claim 1 as originally filed so that it was redundant and did not define any further limitation.

Similarly, claim 1 as originally filed defined that the dose setting member was adapted to set a dose to be ejected. This provided an implicit basis for the feature of the energy being accumulated in the torsion spring upon rotation of the dose setting member, in particular because the energy accumulation took place when the rotation was in the direction of the dose setting and not the dose ejection, as was clear from the description as a whole.

The feature "and released to eject automatically" found an explicit basis on page 7, line 28 and page 6, lines

26 and 27, and was also implicitly derivable from page 2, lines 1 to 11 and page 1, lines 10 to 15 and 21 to 31 of the application as originally filed.

Contrary to the findings of the Opposition Division in the impugned decision, the amendments did not represent intermediate generalisations infringing Article 123(2) EPC either. It was established case law, in particular in decisions T 714/00 and T 1067/97, that an amendment to a claim by the introduction of a feature originally disclosed only in combination with other features was permissible on condition that the introduced feature was not inextricably linked to other features of the combination, the removal of the omitted features passed the essentiality test, and the overall disclosure justified the generalising isolation of the feature and its introduction into the claim. Moreover, according to decision T 1906/11, a claim comprising such an amendment did not comply with Article 123(2) EPC only if an expert recognised additional technically relevant information included in the amended claim when compared to the original application. The amendments in claim 1 of the main request were permissible as they satisfied those conditions and did not not provide any new technical information.

More particularly, the features of the housing with an inner surface provided with threads and the display member in threaded engagement with the threads of the housing and operatively connected with the dose setting member ensured that the display member was rotatable over an angle corresponding to at least one revolution of the display member to display a different dose after one revolution of the dose setting member. This was rendered possible by the transformation of a rotational movement into an axial movement, performed by the

threads. There was no need for the claim to define other features in this respect. In particular, a dose indicator barrel provided with numerals and a window in the housing were not inextricably linked with the claimed features of the housing and the display member, since they related to a different aspect, i.e. simplifying the inspection of the set dose. Moreover, the dose indicator barrel was disclosed as optional in the original application (page 2, lines 28 and 29 and page 6, lines 11 to 15). Original claim 1 already defined in a general way a torsion spring operatively connected to the dose setting member. As a result, the Opposition Division's view that the dose indicator barrel had to be introduced because otherwise the torsion spring would have to be modified was wrong.

The amendments regarding the accumulation of energy in the torsion spring and its release to automatically eject concerned the purpose of the torsion spring in that the stored energy was used for the ejection process. Claim 1 as originally filed already defined a torsion spring, but left it open whether it was only for providing assistance to the ejection process or for providing automatic ejection. Claim 1 of the main request simply eliminated one of these possibilities by being limited to an automatic injection device. The amendments were only in relation to the spring properties, i.e. the torsion spring had to be strong enough for performing the automatic ejection. The mere fact that it could be connected directly or indirectly to many additional components in the specific mechanical arrangements according to some embodiments did not justify, as such, an objection under Article 123(2) EPC. These components had nothing to do with the provision of automatic ejection, since those mechanical arrangements were independent of the force

causing the ejection. It did not matter whether the latter was provided by the spring or by a user. For example, a ratchet and a locking member were features that simplified the dose-setting procedure but provided no effect during the ejection process. Moreover, they were disclosed as optional in the application as originally filed (page 4, lines 17 to 19; page 5, lines 3 to 5; page 6, lines 26 and 27, and page 7, lines 19 to 29). It did not matter whether the torsion spring was in the form of a helical spring. There was also no need to define an attachment of the torsion spring to the housing as this was something well-known to the person skilled in the art.

*Remittal*

It was requested that the case be remitted to the department of first instance for further prosecution.

Despite having expressed some negative opinions on novelty and inventive step in the section "Further Observations" in the impugned decision, the Opposition Division had not decided on the questions of novelty and inventive step, which were not addressed at all during the first-instance oral proceedings. The appellant did not have the chance to provide arguments against these surprising negative opinions.

In view of the number of prior-art documents cited by the six respondents and the fact that at first instance oral proceedings were summoned for three consecutive days, it was likely that the discussion of novelty and inventive step would need more than one day.

VIII. The respondents' arguments may be summarised as follows:

*Article 123(2) EPC*

The amendments made to claim 1 of the main request compared with claim 1 as originally filed constituted unallowable intermediate generalisations infringing Article 123(2) EPC.

According to decision T 1067/97, when a claim was to be restricted to a preferred embodiment it was normally not admissible to extract isolated features from a set of features which had been disclosed in combination for that embodiment.

Concerning the claimed features of the display member in threaded engagement with threads provided on an inner surface of the housing, and operatively connected with the dose setting member, they were derived from the first two specific embodiments disclosed in the application as originally filed, depicted in figures 1 to 4. These embodiments included a guiding sliding track arranged on an inner surface of a dose setting member and a dose indicator barrel having threads on an outer surface and a part engaging with at least a part of the track, so that the dose setting member and the dose indicator barrel were movable in a sliding relationship to each other. There was no disclosure in the application as originally filed that the skilled person could construct a device with those claimed features without the remaining structural features of those embodiments, as all of them were necessary for satisfying the further requirement of claim 1 of the main request that the display member could rotate over an angle corresponding to at least one revolution of the display member. Moreover, omitting the remaining features resulted in subject-matter unjustifiably

falling within the wording of claim 1 of the main request, although not being originally disclosed. The claim covered a threaded engagement of any type, for example the undisclosed configuration with outer threads on a housing surface and inner threads on the dose setting member. The statement on page 2, lines 21 to 22, of the application as originally filed that the display member could be moved axially between two end positions related to a functional property that could be implemented in many ways. In this regard, however, the application as originally filed described only a specific structure on pages 6 and 7. As for the claimed operative connection between the display member and the dose setting member, the wording of claim 1 as originally filed did not imply such a connection, i.e. a connection that caused an operation of one component to be transferred to the other. The expression "in accordance with" in claim 1 as originally filed merely gave an indication of some intellectual relationship between the dose setting member and the display member, while the expression "operatively connected" introduced some structural, narrower interaction covering undisclosed equivalents. Because of the combined translational and rotational movement of the dose indicator barrel in relation to the housing, the features of numerals being arranged along a helical path on the dose indicator barrel and of a window in the housing through which these numerals could be seen, disclosed on page 7, lines 4 to 9, of the application as originally filed, were also inextricably linked to the first two embodiments and had to be introduced in the claim.

The definition that energy was accumulated in the torsion spring upon rotation of the dose setting member covered all kinds of energy accumulation not disclosed

in the application as originally filed. For example, it covered actively rotating dose setting members, e.g. by a motor, and configurations in which energy could be accumulated irrespective of the direction of rotation of the dose setting knob. This was in clear contradiction to the first two embodiments. For compliance with Article 123(2) EPC the claim should also define that the dose setting member is attached to the housing via the torsion spring in order for energy to be accumulated in the torsion spring when the dose setting member is rotated, and that the torsion spring is a helical spring, in accordance with the first two embodiments.

Concerning the feature of the energy that was released to eject automatically, this was not limited to the spring structure and strength but was in a clear structural relationship between a drive member and many other components of the first two specific embodiments of the invention as disclosed in the application as originally filed. The only way disclosed for performing automatic ejection was with all of those components. All of them had to be included in the claim, otherwise other non-disclosed ways of performing automatic ejection would be unjustifiably encompassed. In particular, a ratchet and a locking member were key to the step of releasing.

Decision T 1906/11 did not help the appellant's case. It was concerned with the generalisation of a specific component originally disclosed, but the original disclosure as a whole comprised clear statements that such generalisation should be considered. An added feature covering a scope of protection including additional subject-matter would not be allowable in view of the conclusions drawn in T 1906/11.

The appellant's arguments that some elements of the first two embodiments of the application as originally filed had been disclosed as optional were flawed and the appellant had mixed up the questions whether a feature was sufficiently disclosed in the application as originally filed to support an amendment according to Article 123(2) EPC and whether the teaching of one part of the description was contradictory to the teaching of another part. With respect to originally filed claim 1 a selection was made of a number of the originally disclosed embodiments. For these selected embodiments those elements were not optional, but necessary.

*Remittal*

The respondent opponents 3 and 4 requested that the case not be remitted to the department of first instance for further prosecution.

A remittal would substantially delay the settlement of the case, keeping a status of legal uncertainty. Moreover, the Opposition Division had already expressed its view on novelty and inventive step in the section "Further Observations" in the impugned decision, which implied that it wanted to avoid being faced with the case again.

The respondent opponent 5 requested that the case be remitted in order to have a full discussion on novelty and inventive step before two instances.

As far as the issue of remittal was concerned, the respondent opponent 6 had no request.

## Reasons for the Decision

1. The appeal is admissible.

2. Although having been duly summoned by communication dated 6 December 2017, the respondents opponent 1 and opponent 2 were not present at the oral proceedings, as announced by letters dated respectively 17 January 2018 and 7 March 2018. In accordance with Rule 115(2) EPC and Article 15(3) RPBA, the proceedings were continued without these parties.

3. The invention

The invention relates to an injection device for administering different doses of medicament. Typically, such injection devices are used to perform self-injections of insulin by diabetic patients. In order to perform an injection, the user first sets the required dose, for example by rotating a dosing knob of the injection device. The set dose is indicated on a display. The injection is then performed, either manually, by pressing an injection button, or automatically, for example by actuating a release mechanism.

Claim 1 of the main request defines an injection device of the automatic type. Drawings of embodiments falling within its scope are reproduced below and shown in figures 1 and 4 of the patent.

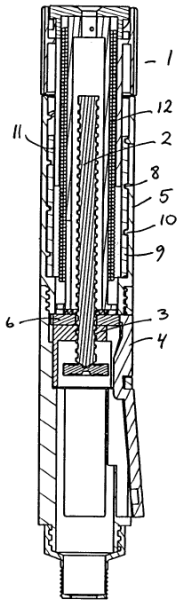


Fig. 1

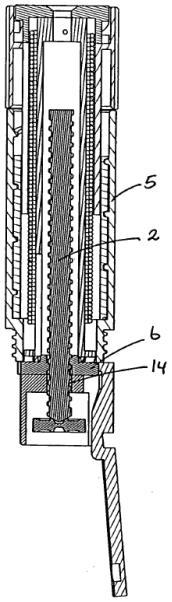


Fig. 4

The claimed injection device has a housing (5) and comprises a torsion spring (12) that accumulates energy when the dose is set by rotating a dose setting member (1). The set dose is displayed by a rotatable display member (9) in threaded engagement with threads (10) provided on an inner surface of the housing (5), and operatively connected with the dose setting member (1). The display member can rotate over an angle corresponding to at least one revolution of the display member.

According to the patent, this last feature provides a way to set a dose with a higher degree of accuracy (paragraphs [0007], [0023] and [0027]).

4. Article 123(2) EPC

4.1 As noted by the Opposition Division and the parties, the subject-matter of claim 1 of the main request is derived from claim 1 as originally filed, limited by

the following additional features:

- a housing with an inner surface provided with threads;

- the operative connection between the torsion spring and the dose setting member is such that energy is accumulated in the torsion spring upon rotation of the dose setting member and released to eject automatically;

- the display member is threadely engaged with the threads of the housing and operatively connected with the dose setting member.

4.2 In the impugned decision the Opposition Division held that the added features introduced several unallowable intermediate generalisations. The respondents' objections under Article 123(2) EPC were along a similar line. It seems to be common ground, however, that at least the first two specific embodiments of the invention disclosed in the application as originally filed provide a basis for the added features when taken individually.

The Board sees such a basis in particular in figures 1 to 4, and on page 6, line 32, for the claimed housing with an inner surface provided with threads; on page 6, lines 24 to 27, and page 7, lines 24 to 28, for the claimed accumulation and release of energy in relation to the operative connection between the torsion spring and the dose setting member; and on page 6, line 32, to page 7, line 6, for the claimed engagement and connection of the display member with the housing and the dose setting member respectively.

4.3 When a claim is restricted by the extraction of isolated features from the combinations making up the specific preferred embodiments disclosed in the application as originally filed, this is often referred to in the jurisprudence of the boards as "intermediate generalisation".

The Board shares the respondents' view that such extraction may well introduce subject-matter which was not disclosed in the application as originally filed, as also held in T 1067/97 (point 2.1.3 of the reasons). However, this is not necessarily the case.

What has to be established in order to assess compliance with Article 123(2) EPC is not specific to intermediate generalisations, but applies generally to all amendments. It is what has been explained in opinion G 3/89 and decision G 11/91, e.g. whether the amendments result in the skilled person being presented with technical information which he would not derive directly and unambiguously, using common general knowledge, from the application as filed. This was referred to as the "gold standard" in decision G 2/10 (point 4.3 of the reasons). In this context the Board concurs with the findings in T 1906/11 (point 4.2.2 of the reasons):

"*Ob eine Änderung sich unter dem Begriff 'Zwischenverallgemeinerung' subsumieren lässt oder unter anderen Begriffen, wie etwa 'Weglassen eines ursprünglich beanspruchten Merkmals' oder 'Mehrfachauswahl aus zwei Gruppen alternativer Merkmale', erlaubt noch keinerlei Aussage über die Zulässigkeit dieser Änderung nach Artikel 123(2) EPÜ. Ausschließlich relevant dafür ist die Frage, ob ein Fachmann, der mit der abgeänderten Fassung der*

*Anmeldung oder des Patents konfrontiert wird, im Vergleich zu einem Fachmann, der nur die ursprünglich offenbarte Fassung zur Kenntnis nehmen würde, der abgeänderten Fassung zusätzliche technisch relevante Informationen entnimmt.*"

("*Whether an amendment can be classified as 'intermediate generalisation' or otherwise, for example 'omission of an originally claimed feature' or 'multiple selection from two groups of alternative features' does not permit, as such, to draw any conclusion about the allowability of this amendment under Article 123(2) EPC. The only relevant question in this respect is whether a skilled man, who is confronted with the modified version of the application or of the patent, would infer from it additional technically relevant information compared to a skilled man who only had knowledge of the version as originally filed.*" - translation by the Board).

It is the Board's view that the skilled person is presented with additional technical information if only some of the features of an originally disclosed combination of "inextricably linked" technical features are extracted. This is the case if the original disclosure conveyed the teaching, explicit or implicit, that all the features of that combination had to be present together in order for a specific technical effect to be obtained. In such a situation, claiming only some of those features would present the skilled person with the different (additional) technical information that the omitted features were optional for that specific technical effect. However, this is not so for the present case.

4.4 Several arguments presented by the Opposition Division and the respondents, which led them to the conclusion that Article 123(2) EPC was not complied with, related to the fact that the subject-matter of claim 1 of the main request encompassed or covered equivalents, technical arrangements or possibilities which were not originally disclosed.

The Board notes that Article 123(2) EPC is not directly concerned with what is covered or encompassed, in other words what may be protected, by a claim. This is rather an issue of Article 123(3) EPC. Instead, Article 123(2) EPC is concerned with the disclosure content of an amendment compared to the original application as a whole. What is covered is clearly different from what is disclosed by a claim: for example on page 6, sixth paragraph of the impugned decision the Opposition Division stated that claim 1 of the main request "*would cover the case that the dose indicator barrel only comprised a pin that was threadely engaged with the threads of the housing*". Even if it were so, claim 1 of the main request obviously does not disclose an indicator barrel with such a pin.

It follows that the respondents' arguments that not originally disclosed subject-matter, such as a threaded engagement of any type between the display member and the housing, or all kinds of energy accumulation in the torsion spring irrespective of the direction of rotation of the dose setting member, or non-disclosed ways of performing automatic ejection, fell within the wording of claim 1 of the main request are of little relevance. Moreover, the Board notes that such subject-matter would necessarily fall within the wording of claim 1 as originally filed too, since all its features

were retained in claim 1 of the main request.

4.5 According to some of the respondents' arguments, accepted by the Opposition Division in the impugned decision, when features were originally disclosed in a functionally and structurally linked combination (page 6, first paragraph of the impugned decision) it was not permissible to extract and claim only some of them.

In general, it is the purpose of the disclosure of the embodiments of the invention to describe in detail a specific combination of functionally and structurally linked features exhibiting the teaching of the invention. These features, however, may produce different technical effects, and may not necessarily be inextricably linked to each other for the provision of one and the same technical effect.

The Board accepts the respondents' arguments that the features of the display member in threaded engagement with threads provided on an inner surface of the housing and operatively connected with the dose setting member were originally disclosed in embodiments also comprising a guiding sliding track arranged on an inner surface of a dose setting member and a dose indicator barrel having threads on an outer surface and a part engaging with at least a part of the track, so that the indicator barrel was slidably movable with respect to the dose setting member. Furthermore, according to those embodiments, because of the combined translational and rotational movement of the dose indicator barrel in relation to the housing, numerals were arranged along a helical path on the dose indicator barrel and a window, through which these numerals could be seen, was present in the housing. In those embodiments all these features cooperate to allow

the setting and display of a dose in a specific way.

However, claim 1 as originally filed, being broader than claim 1 of the main request, did not convey the information that the invention was limited to that specific way of setting and displaying the dose. In the remaining parts of the application as originally filed there is nothing that could convey that information to the skilled person either.

Based on a technical reading of the whole application as originally filed, the skilled person would extract the teaching that the housing and its threads provided on an inner surface, together with the display member in threaded engagement with those threads and operatively connected with the dose setting member, are for providing the technical effect that the display member can be rotated (with respect to the housing) over an angle corresponding to at least one revolution of the display member in order to solve the problem of more accurately indicating the desired dose (page 1, lines 10 to 18, of the application as originally filed). This was already (implicitly) defined in claim 1 and was explained on page 7, lines 10 to 15, of the application as originally filed. From this passage it is clear that the threaded engagement is the essential feature allowing the numerals to be arranged along a helical path, and thus obtaining the desired increase of accuracy in the indication of the dose set. Whether further structural features may have to be present in the injection device in order to obtain that technical effect, as argued by the respondents, is not decisive. What has to be considered is whether the application as originally filed provided the skilled person with the teaching that in order to obtain that technical effect, precisely all the features described

in relation to the specific embodiments were strictly necessary. The Board concludes that it did not. The skilled person would realise that mechanical arrangements other than the specific ones disclosed in connection with the embodiments of figures 1 to 4 would be suitable, and could be provided based on the common general knowledge.

As the operative connection between the display member and the dose setting member defined in claim 1 of the main request belongs to the teaching that can be extracted from the first two embodiments of the application as originally filed, it is irrelevant to establish whether the specific wording of claim 1 as originally filed, i.e. that the display member was "*adapted to display the dose in accordance with a setting of the dose setting member*", already implied such operative connection.

4.6 Similar considerations apply to the respondents' arguments that the first two embodiments of the application as originally filed disclosed energy accumulation in a torsion spring and release for performing automatic ejection only in connection with several other features, such as the dose setting member being attached to the housing via the torsion spring, the torsion spring being a helical spring, a ratchet and a locking member. The Board accepts the appellant's argument that energy accumulation in the torsion spring upon rotation of the dose setting member and subsequent release to eject automatically served the technical effect of performing automatic ejection, to which claim 1 of the main request was limited. This is the teaching that the skilled person would extract from a technical reading of the application as originally filed (page 6, lines 24 to 27, for example). It is not

in doubt that other specific structural features are to be implemented in an injection device in order to obtain that technical effect. However, the ones of the first two embodiments of the application as originally filed, even different as to how a translational movement is transferred to a piston rod of the injection device (page 6, lines 10 to 17), are not limitative, but only exemplary. The skilled person would figure out other arrangements based on the common general knowledge.

4.7 The Board therefore concludes that the first two embodiments of the application as originally filed provide a basis for the subject-matter of claim 1 of the main request taking into account also the teaching of the application as a whole as explained above. Hence, it is irrelevant to consider whether such a basis could also be derived generally from the section "SUMMARY OF THE INVENTION" or whether some elements of those two embodiments had been explicitly disclosed as optional.

4.8 In summary, the subject-matter of claim 1 of the main request complies with Article 123(2) EPC.

5. Remittal

According to Article 111(1) EPC, "following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution".

The Board notes that the impugned decision, as far as

the main request is concerned, was based only on non-compliance with Article 123(2) EPC. As the appellant observed, although some negative opinions on the issues of novelty and inventive step were expressed in the section "Further Observations", those issues were not addressed during the first-instance oral proceedings and, formally, are not reasons for the decision on which the appellant had the opportunity to be heard. In particular, those opinions could not take into account the arguments that the appellant might have provided orally in accordance with Article 116 EPC.

In view of the number of prior-art documents and the objections by the six respondents the Board deems important a thorough consideration of novelty and inventive step in particular, potentially before two instances, as also argued by the respondent opponent 5. This importance outweighs the inevitable delay for the settlement of the case. Hence, the case is to be remitted to the Opposition Division for further prosecution in accordance with Article 111(1) EPC.

The allegations of the respondents opponents 3 and 4 that the Opposition Division wanted to avoid being faced with the case again are nothing more than irrelevant speculations. In the Board's view the Opposition Division cannot be criticised for having provided further observations in its decision. On the contrary, those observations, often referred to as *obiter dicta*, are to be seen as valuable information, *inter alia* to the parties, who can take them into account when deciding whether to appeal. However, the presence of such observations cannot be seen as binding for the Board in particular in its evaluation of whether or not to remit the case to the department of

first instance.

6. Since the subject-matter of claim 1 of the main request complies with Article 123(2) EPC and the case is to be remitted for further prosecution on that basis, there is no need for the Board to consider the auxiliary requests and the objections to them raised by the respondents.

## 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.

The Registrar: The Chairman:

D. Hampe E. Dufrasne

Decision electronically authenticated