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Datasheet for the decision of 16 January 2018

Case Number: T 2536/16 - 3.3.01

Application Number: 02728841.4

Publication Number: 1390750

IPC: G01N33/53, G01N33/543, G01N33/537

Language of the proceedings: EN

Title of invention:
HYDROPHILIC DIAGNOSTIC DEVICES FOR USE IN THE ASSAYING OF BIOLOGICAL FLUIDS

Patent Proprietor:
ADHESIVES RESEARCH, INC.

Opponent:
Zacco GmbH

Headword:
Composition of the opposition division/ADHESIVES RESEARCH, INC.

Relevant legal provisions:
EPC Art. 19(2) sentence 1, 111(1)
EPC R. 103(1)(a)

Keyword:
First and second examiner of opposition division having participated in examination proceedings.
Substantial procedural violation (yes) - Remittal (yes) - reimbursement of appeal fee (yes)

Decisions cited:
T 1700/10

Catchword:
-

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Case Number: T 2536/16 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 16 January 2018

Appellant: (Opponent)	Zacco GmbH Bayerstrasse 83 80335 München (DE)
Representative:	Zacco GmbH Bayerstrasse 83 80335 München (DE)
Respondent: (Patent Proprietor)	ADHESIVES RESEARCH, INC. P.O. Box 100 Glen Rock, PA 17327 (US)
Representative:	Beck Greener Fulwood House 12 Fulwood Place London WC1V 6HR (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 28 September 2016 rejecting the opposition filed against European patent No. 1390750 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	A. Lindner
Members:	T. Sommerfeld
	L. Bühler

Summary of Facts and Submissions

I. European patent No. 1 390 750 is based on European patent application No. 02728841.4. The mention of the grant of the patent was published on 9 March 2011.

II. An opposition was filed and revocation of the patent in its entirety requested pursuant to Article 100(a) EPC for lack of novelty and inventive step, Article 100(b) EPC, and Article 100(c) EPC.

III. The appeal lies from the decision of the opposition division rejecting the opposition.

IV. In its statement of grounds of appeal, the appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 1 390 750 be revoked.

V. With its letter of reply, the respondent (patentee) requested that the appeal be dismissed. It also filed six auxiliary requests.

VI. In a communication dated 5 September 2017, the board observed that two of the three members of the opposition division had taken part in the proceedings for grant of the patent to which the opposition related, contrary to Article 19(2), first sentence, EPC. The board noted that this constituted a substantial procedural violation which justified remittal of the case under Article 111(1) EPC and reimbursement of the appeal fee under Rule 103(1)(a) EPC. The parties were invited to comment and to indicate whether they maintained their requests for oral proceedings should the board remit the case to the

opposition division and order reimbursement of the appeal fee.

VII. With letter dated 24 October 2017, the appellant asked for the case to be remitted to the opposition division and withdrew its request for oral proceedings provided that the case was remitted and the appeal fee reimbursed.

VIII. With letter dated 6 November 2017, the respondent observed that it seemed justified to remit the case. The respondent withdrew its request for oral proceedings provided that the case was remitted to the opposition division.

Reasons for the Decision

1. The appeal is admissible.

2. Pursuant to Article 19(2), first sentence, EPC, an 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.

3. The communication under Rule 71(3) EPC dated 22 July 2010 informing the applicant of the examining division's intention to grant a patent was signed by the first and second member of the opposition division as first and second examiner of the examining division, respectively (see EPO form 2035.4). By signing the communication which establishes the text of the patent to be granted, the first and the second member of the opposition division have taken part in the proceedings for the grant of the opposed patent. This holds true in spite of the fact that the communication under

Rule 71(3) EPC dated 22 July 2010 (EPO form 2004) and the decision to grant a patent dated 10 February 2011 (EPO form 2006A) mention a different person as second examiner of the examining division. As is evident from EPO form 2035.4, the second examiner signed this document substituting for the second member originally foreseen whose pre-printed name on that form had been deleted and replaced by the hand-written name of the substitute examiner. Apparently, it had been overlooked to enter the change of the composition of the examining division into the EPO's data base. Therefore, EPO form 2004 and EPO form 2006A still bore the pre-printed name of the original second member who had been replaced. For the requirements of Article 19(2) EPC, however, what matters is that the participation of the first and second member of the opposition division in the proceedings for the grant of the opposed patent is established by their respective signatures on EPO form 2035.4. Therefore, the composition of the opposition division was contrary to Article 19(2), first sentence, EPC.

4. Violations of Article 19(2) EPC are considered to be substantial procedural violations which lead to a remittal of the case under Article 111(1) EPC and to the reimbursement of the appeal fee (T 1700/10, point 4 of the Reasons). In the present case, the issue of whether and in which circumstances violations of Article 19(2) EPC should lead to a remittal regardless of the parties' position (see T 1700/10, point 5 of the Reasons) does not need to be decided. In the absence of any request to the contrary and of any special reasons for doing otherwise (Article 11 RPBA), the decision under appeal is to be set aside and the case is to be remitted to the department of first instance. As the remittal is the consequence of a substantial procedural

violation, the board considers the reimbursement of the appeal fee under Rule 103(1)(a) EPC to be equitable.

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:

M. Schalow A. Lindner

Decision electronically authenticated