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File Number: T 560/90 - 3.3.2
Application No.: 83 303 962.1
Publication No.: 0 101 178
Title of invention: Topical anti-inflammatory compositions

Classification: A61K 9/06

D E C I S I O N
of 19 March 1991

Proprietor of the patent: Pfizer Corporation
Opponent: Hexal-Pharma GmbH & Co. KG

Headword:

EPC Articles 106, 107, 108 and 113(2), Rules 67 and 68(2)

Keyword: "Appealable decisions" - "Time limit for appeal" - "Party status"
"Substantive procedural violation" - "Form of decision"

Headnote



((2))

Case Number : T 560/90 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 19 March 1991

Appellant :
(Proprietor of the patent) Pfizer Corporation
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Respondent :
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Decision under appeal : Decision of the Opposition Division of the
European Patent Office dated 7 May 1990
maintaining European patent No. 0 101 178
unamended.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : C. Holtz
U. Kinkeldey

Summary of Facts and Submissions

- I. Against the mention of the grant of European patent No. 101 178, a notice of opposition was filed by the respondents, requesting revocation of the entire patent. On 6 February 1989, the appellants filed a new single claim, requesting that the patent be maintained on the basis of this claim. In addition, they requested oral proceedings.
- II. The respondents submitted extensive comments on the amended claim, maintaining their request for revocation of the patent as a whole.
- III. A summons to oral proceedings to take place on 18 January 1990 was issued on 20 October 1989.
- IV. With a letter filed on 15 January 1990, the respondents withdrew their opposition, without expressly stating any conditions. On 16 January, the Formalities Officer issued a communication - via facsimile - to the parties to the effect that the oral proceedings were cancelled and that the procedure would continue in writing.
- V. On the same date, 16 January 1990, the Opposition Division took a decision (EPO Form 2354) that the opposition proceedings would not be continued by the Office of its own motion. On behalf of the Opposition Division the Formalities Officer issued on 22 January a decision (EPO Form 2352, hereinafter referred to as the "January decision") to the effect that "The opposition proceedings shall be terminated" (preprinted text). Further, the following text on the form was ticked off in the appropriate box: "The opponent Hexal-Pharma has withdrawn

the opposition by letter of 15.01.90. The European Patent Office has no cause to continue the proceedings of its own motion as the dossier now stands." Finally, it is noted on the form that the decision is open to appeal, and information is given as to applicable time limits, fees etc.

- VI. On 7 May 1990, the Formalities Officer issued a communication (hereinafter referred to as the May communication) to the parties, informing them that, as no appeal against the 22 January 1990 decision had reached the files within the prescribed time limit for appeal, the opposition proceedings were terminated and the European patent irrevocably maintained unamended.
- VII. On 7 June 1990, the appellants filed a letter with the European Patent Office, addressed to the Boards of Appeal and containing the following requests:
- 1) Correction of the 7 May 1990 communication, maintaining the European patent in amended form with the single claim as filed on 6 February 1989;
 - 2a) alternatively (in the form of an appeal), cancellation of the finding that the European patent is irrevocably maintained in unamended form, instead maintaining it with the single claim as filed on 6 February 1989;
 - 2b) as a subsidiary request, the re-establishment of the appellants' right to appeal against the 22 January 1990 decision, and accordingly,

(in the form of an appeal) cancellation of the decision to maintain the patent in unamended form, replacing it with a decision to maintain the patent

with the single claim as submitted on
6 February 1989;

3. the reimbursement of any fee not due and of the appeal fee.

The appeal fee and the fee for re-establishment of rights were paid on the same date.

The appellants further requested that the case be assigned to the Legal Board of Appeal, as being concerned only with purely legal problems.

- VIII. In support of their requests, the appellants argue essentially as follows:

It is obvious from the file that the appellants had requested maintenance of the patent with a single amended claim. In view of this restricted claim the respondents withdrew their opposition. The decision of 22 January 1990 stated nothing to contradict this state of affairs. The reference to the dossier "as it now stands" could only be construed to encompass all requests made by that time, i.e. including the amended claim and the withdrawal of opposition. Consequently, there was no reason for the appellants to appeal this decision. Only in the 7 May 1990 communication did it become apparent that the patent was maintained unamended.

The appellants believe that a communication which states something for which there is no legal basis can be corrected at any time. If not, the communication must be regarded as having the same significance as a decision and must accordingly be appealable.

If none of the above remedies are available, appellants must have a right to re-establishment under Article 122 EPC, since the true meaning of the 22 January 1990 decision did not become apparent until the 7 May 1990 communication was issued. Thus, the appellants were unable to observe the appeal period, in spite of all due care.

- IX. The respondents concur in the arguments submitted by the proprietors. In particular, the respondents point to the fact that they, as opponents, must be able to rely on the state of the proceedings as of the date of the decision, 22 January 1990, i.e. that the new patent claim constituted this state. It was all the more surprising to receive the communication of 7 June 1990 as it contradicted the 22 January decision.

The respondents request that the decision of 22 January 1990 be confirmed so as to mean that the patent has been maintained on the basis of the claim as submitted on 6 February 1989, and that consequently the Opposition Division be ordered to execute its decision accordingly, which reflects the will of both parties.

Reasons for the Decision

1. Admissibility

1.1 Appealable decisions

According to Article 21(1) EPC, the Boards of Appeal of the European Patent Office are responsible for the examination of appeals from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and of the Legal Division. Decisions from those bodies are

appealable according to Article 106(1) EPC, provided that they terminate proceedings vis-à-vis the parties (unless allowing separate appeal).

To distinguish decisions from mere communications one element is basically required, i.e. that a legal effect arises from the decision. One or more issues are resolved through the decision. A decision is final when it resolves all outstanding issues in such a way that the proceedings before the body seized with the case are terminated. If not, the proceedings must continue, which normally means that the decision is not appealable. The principle of appealability as pertaining only to final decisions is expressed in Article 106(3) EPC by the limitation that "a decision which does not terminate the proceedings ... can only be appealed together with the final decision".

As established by decision J 08/91 (OJ EPO 1982, 10) a decision may be, but ought not to be, given in a document which in form appears to be merely a communication. Whether a document constitutes a decision or a communication depends on the substance of its content, not upon its form.

1.2 The present case

Although the "January decision" terminated the proceedings according to the wording of the decision itself, its extent, as subsequently revealed by the May communication, was not clear.

At first sight, the "January decision" seems straightforward enough. It states an effect - termination of the proceedings - and the reason therefore - the withdrawal of the opposition. As the normal consequence of a withdrawal would be the termination of proceedings

there is seemingly nothing out of the ordinary connected to the decision. As for the ensuing legal effect, a termination would normally result in the patent being maintained as originally granted, i.e. a *status quo ante* would be established.

However, the actual effect of the decision was obscure, since both parties to the opposition procedure, presuming that the words "as the dossier now stands" meant that the request for amendments had been examined, read the decision as meaning that the patent had been maintained as amended.

If the Opposition Division meant to say that an unconditional withdrawal of the opposition must necessarily mean that proceedings are terminated, irrespective of any pending request from the other party, it was incumbent upon the Division to mention this in the decision, as a reason for not considering that request.

It is obvious that forms with such a preprinted text, which could be interpreted in different ways depending on the situation at hand, must be used with prudence. Normally, preprinted forms should only be used in routine cases, since forms by nature are inflexible.

Through the statement in the May communication the parties to the opposition procedure were for the first time informed unequivocally about the exact content and legal effect of the "January decision". In this respect, the "communication" would qualify as a decision appealable under Article 106 EPC.

The constant practice of the EPO is to look beyond formal headings to consider the substantive contents of documents. The parties having relied on the original

"January decision" to conform to pending requests (in the absence of any indication to the contrary) thus could not react until they were made aware of the true content of the decision. The fact that a communication regarding appeals was attached to the "January decision" is irrelevant. Neither do considerations towards the public change this conclusion, since any third party who might have consulted the file would have arrived at the same result regarding the effect of the decision to terminate proceedings, i.e. that the requested amendments had been allowed.

Although the "January decision", according to its wording, terminated proceedings, this could at most only pertain to the opposition as such. The case must still be considered as pending with regard to the request for amendment, otherwise the appellants would have been subjected to *déni de justice*.

The matter pending before the Opposition Division could thus be said to have been resolved in two steps, by a "decision" in January 1990 regarding the opposition, and a final decision in May of the same year regarding the one outstanding substantive issue of amendment.

In view of the fact that the true content of the Opposition Division decision was not revealed until the parties received the May communication, the Board of Appeal finds that the decision was not issued in full until the date of this communication. Consequently, the notice of appeal has been filed within the time limit given in Article 108.

1.3 The submissions filed by the appellants

The submissions filed by the proprietors on 7 June 1990, in so far as they have requested them to be considered an appeal, are admissible also with regard to the other requirements prescribed by Articles 106 to 108, as well as Rule 64 EPC.

As the Board has arrived at the conclusion that the appeal was filed within the prescribed time limit, there is no need to consider the remaining requests as regards admissibility.

The appeal is admissible.

2. Competence of the Technical Board of Appeal

The appellant's request that the appeal be transferred to the Legal Board of Appeal cannot be granted. Under the EPC, the bodies responsible for considering appeals from decisions of the Opposition Division are, without exception, Boards of Appeal consisting either of two technically qualified members and one legally qualified member or for certain cases extended to include three technically qualified members and two legally qualified members (Article 21(4) EPC), i.e. the EPO bodies known as Technical Boards of Appeal.

In a decision of 6 August 1990 in case T 272/90, to be published in the OJ EPO, the Technical Board of Appeal 3.2.1 has referred the question to the Enlarged Board of Appeal (G 2/90) whether the Legal Board of Appeal is responsible for appeals from decisions which have been delegated to the Formalities Officer under Rule 9(3) EPC. In point 3 of this decision reference is made to the established interpretation of Article 21 EPC, which concurs with what is set down above. It is noted that the

appellate instance may shift, not according to the issues involved, but according to which body took the decision in the first instance, the Receiving Section or the Examining/Opposition Division.

In the circumstances of the present case, it is not necessary to await the Enlarged Board's decision.

3. Party status

The respondents having withdrawn their opposition during the opposition proceedings would normally not be considered a party under Article 107, second sentence, EPC (cf. EPO Guidelines, Part D, Chapters 1, 6). In view of the exceptional circumstances ensuing from the decision appealed from and that this decision was a direct result of that withdrawal and contrary to both parties' expectations, the respondents have been granted the opportunity to submit observations in the appeal proceedings. As a consequence of the Board's finding that the matter was still pending at the time of the May communication, the opponents were still parties to the proceedings. Furthermore, Article 107 EPC grants party status to any party to proceedings adversely affected. Where the appeal was made by the applicant or patent proprietor the opponents would, under the same Article, second sentence, be parties to the appeal proceedings as of right.

4. The substance of the appeal

The appellants have requested that the decision of the first instance be cancelled and the patent be maintained with the single claim as submitted on 6 February 1989.

As there has been no examination of this claim in the first instance, the appellants would forego their right of a two-tiered consideration of their case if the Board of Appeal would consider this request on its merits already at this stage. The Board of Appeal, therefore, makes use of its powers under Article 111 EPC to remit the case to the first instance.

5. Reimbursement of fees

5.1 Article 113

In terminating the proceedings without considering the request for amendment by the appellants, the Opposition Division violated Article 113 EPC. In fact, it should have proceeded in reverse from what it actually did, firstly by issuing a communication, explaining why the amendment could not be considered, and secondly by issuing a decision, using a form without the risk of any ambiguity.

With regard to the substantial procedural violation and to the outcome of the appeal, Rule 67 EPC requirements as to equitability are met. Consequently, the appeal fee is to be reimbursed.

5.2 Other fees

The appellants have also requested the reimbursement of any fee "which has not fallen due", i.e. the fee for re-establishment. Since re-establishment did not come under consideration, this fee is also to be reimbursed.

Order

For these reasons, it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the Opposition Division for further examination.
3. The appeal fee is reimbursed.
4. The fees for re-establishment of rights is reimbursed.

The Registrar:

The Chairman:

M. Beer

P.A.M. Lançon