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D E C I S I O N
of 6 February 1996

Case Number: T 0487/93 - 3.3.4

Application Number: 89309381.5

Publication Number: 0359574

IPC: A61L 2/00

Language of the proceedings: EN

Title of invention:

Aqueous antimicrobial solutions for contact lens care

Applicant:

ALCON LABORATORIES, INC.

Opponent:

-

Headword:

Antimicrobial solutions/ALCON

Relevant legal provisions:

EPC Art. 113(1), 96(2)

EPC R. 67

Keyword:

"Substantial procedural violation (yes)"

Decisions cited:

T 0640/91, T 0951/92, T 0197/88

Catchword:

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Case Number: T 0487/93 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 6 February 1996

Appellant: ALCON LABORATORIES, INC.
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Texas 76134-2099 (US)

Representative: Kyle, Diana
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Decision under appeal: Decision of the Examining Division of the European Patent Office posted 13 January 1993 refusing European patent application No. 89 309 381.5 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: L. Galligani
J. Saisset

Summary of Facts and Submissions

- I. European patent application No. 89 309 381.5 published under No. 0 359 574 with title "Aqueous antimicrobial solutions for contact lens care" was refused by the Examining Division.

The decision was taken on the basis of Claims 1 to 11 in the two versions for all designated contracting states except Spain (ES) and Greece (GR), and for ES/GR which were filed with letter dated 23 October 1992 in response to the first communication by the Examining Division dated 13 May 1992.

Claim 1 in the version for non-ES and non-GR States read as follows:

"An aqueous, hypotonic contact lens composition, comprising:

a quaternary ammonium antimicrobial agent in an amount effective at disinfecting contact lenses; and

an anionic complexing agent in an amount effective at preventing the quaternary ammonium compound from binding with a hydrophilic lens;

the composition having an osmolarity of between 210 and 240 mOsm/kg."

Dependent Claims 2 to 9 and 11 related to specific embodiments of the composition according to Claim 1. Claim 10 related to a method of use of the composition according to Claims 1 to 8.

- II. On 13 January 1993, without further communication, the Examining Division issued the decision of refusal of the application under Article 97(1) EPC on the ground that Claim 1 did not comply with the requirements of

Article 84 EPC because it did not clearly define the compounds usable for the composition and it merely expressed a result to be achieved. The said decision contained also some considerations on novelty and inventive step which however - as made clear by the last sentence of the decision ("The application is rejected according to Article 84 EPC") - were not the decisive grounds for the refusal.

- III. The Appellant lodged an appeal against this decision with payment of the appeal fee and filed on 19 May 1993 the statement of grounds of appeal together with a new set of Claims 1 to 8 (non-ES, non-GR States) (Claims 1 to 6 for ES and GR) and new page 5 of the description.
- IV. The appealed decision was not rectified by the Examining Division which remitted the file to the Board of Appeal pursuant to Article 109 EPC.
- V. In a further letter dated 4 September 1995, the Appellant complained about the unfair treatment by the Examining Division which, in his opinion, should have issued a further communication before rejection the application. Had this been done, the case could have been dealt with satisfaction during substantive examination.
- VI. The Board made clear with the Appellant's representative that consideration by the Board only of the new set of Claims 1 to 8 (non-ES, non-GR States) (Claims 1 to 6 for ES and GR) filed on 19 May 1993 was requested.
- V. The Appellant requests that the decision under appeal be set aside and the case be allowed on the basis of the claims on file.

Reasons for the Decision

1. The appeal is admissible.
2. The claims presently on file have not yet been subjected to substantive examination by the Examining Division. The Board thus comes to the conclusion that the decision under appeal must be set aside and makes use of its power under Article 111(1) EPC to remit the case to the first instance for its further prosecution on the basis of the said claims.

Reimbursement of the appeal fee

3. Although drawing the Board's attention on an alleged unfair treatment by the Examining Division, the Appellant did not formally request the reimbursement of the appeal fee on the ground of a substantial procedural violation. However, under Rule 67 EPC the Board of Appeal can order such reimbursement of its own motion if this is considered equitable by reason of a substantial procedural violation. By the expression "procedural violation" is to be understood, in principle, that the rules of procedure have not been applied in the manner prescribed by the Convention. A procedural violation is **substantial** when, for instance, it infringes the right of a party to a fair treatment and results in a decision adversely affecting said party. According to established case law (cf., for example, decisions T 640/91, OJ EPO 1994, 918 and T 951/92 of 15 February 1995, to be published in the OJ EPO), such violation occurs in cases where the Examining Division does not comply with the necessary legal obligation under Article 113(1) EPC to invite further observations from applicants before issuing a decision adversely affecting them, e.g. a rejection of a patent application.

4. In the present case the application was refused after only one communication from the Examining Division and observations in reply from the Appellant. Such a procedure does not per se contravene the EPC if it is established that the decision of refusal is only based on grounds or evidence on which the Appellant had an opportunity to present comments.

5. In the present case, in its first and only communication the Examining Division raised an objection under Article 84 EPC against Claim 1 as originally filed with the following statement: "Claim 1 in its present formulation is too broad comprising all ammonium compounds, among surely are some not suitable for the instant purpose. The same applies to the complexing agents. Moreover, the term 'effective amount' is not clear." The Examining Division suggested to incorporate Claims 2 to 4 into Claim 1 in order to render it clear. Furthermore, the Examining Division acknowledged novelty having regard to the citation EP-A-0 076 136, but denied it in the case of edetate. Further, it invited the Appellant to file more examples with other compounds to prove their efficacy on the ground that only citrate had been exemplified. The Appellant's attention was also drawn to the necessity to "evade claiming compounds which are already listed in the examples of EP-A-180 309 and WO-A-8 704 091 in combination with the biguanides." The Examining Division also requested the cancellation of the term "about".

6. In reply to said communication, the Appellant filed by letter dated 23 October 1992 amendments to the description and new claims aimed at overcoming the objections raised by the Examining Division, in particular the objection under Article 84, submitted arguments in support thereof also with reference to the prior art cited by the Examining Division and enclosed

additional examples 1 to 5 showing the results of further complexing agents and quaternary ammonium compounds. Moreover, the term "about" was deleted from the specification.

7. The next official action by the Examining Division was the decision to refuse the application. In point 4 of this decision the Examining Division stated that: "Since the pertinent Applicant in his reply did not show any willingness to cooperate with the Examining Division a rejection of the application without further discussing once again the same objections has been performed."

8. The Board observes that, apart from the fact that there is nothing in the reply letter of the Appellant which could possibly justify the finding of unwillingness to cooperate, such finding by the Examining Division seems to be based upon a misconception of what is required from an applicant when replying to objections raised by an Examining Division in its first communication. This issue is extensively treated in decision T 640/91 (supra, in particular point 10 of the Reasons). The Board agrees with the statement therein that applicants are entitled to put forward any possible arguments (both legal and technical) against the objections raised by the Examining Division, in support of the text of the application as filed. In this respect, the quoted decision indicates that "if the Examining Division considers that the arguments put forward on behalf of the applicant are weak, it is of course entitled to reject such arguments (and to refuse the application after only one communication if the circumstances justify that). But the presentation of arguments which are considered to be weak is not an indication ... of "lack of proper collaboration" ... by the applicant. There is no obligation upon an applicant or his representative to "collaborate" with the Examining

Division in the sense of accepting the latter's objections. The interest of an applicant may be to obtain a patent with a text which confers a particular extent of protection, and the duty of a professional representative is then to put forward arguments in favour of such text, whereas the duty of the Examining Division is only to grant a patent which complies with the requirements of the EPC. In such a situation there is no possibility of "collaboration", in the above sense, and there is no proper basis for expecting it."

9. The relevant question in the present case is whether or not it was possible to refuse the application without issuing a second communication, in particular whether there was a necessary legal obligation for the Examining Division under Article 113(1) EPC to invite further observations and, possibly, amendments from the Appellant before issuing a decision adversely affecting him.

10. In the Board's judgment, it was necessary under Article 113(1) EPC to invite further observations and/or amendments from the Appellant for the following reasons:

(i) the lack of clarity objection raised in the first official communication was based on a rather sketchy reasoning with quite general statements (cf. point 5 supra). It cannot be said that such reasoning contained sufficient legal and factual information to enable the Appellant to understand the alleged serious nature of the objections raised. Only in the later decision of rejection, this reasoning was somehow amplified and completed by including also some observations on how the broad formulation of Claim 1 could result in a novelty objection (cf. point 5 of the decision). Consequently, before receiving the contested

decision, the Appellant had not been given the proper opportunity to comment upon such reasons and/or to propose amendments so as to avoid refusal of the application as required by Article 113(1) EPC (cf. e.g. decision T 951/92 supra, in particular point 3 of the Reasons).

- (ii) After the submission by the Appellant of detailed arguments in support of the wording of the new claims as well as of additional examples in reply to the explicit request of the Examining Division (cf. point 5 supra), the situation of the file was such that it was necessary for the Examining Division under Article 96(2) EPC to issue a further communication with a more detailed explanation of the grounds why, notwithstanding the said submissions, the requirements of the EPC, in particular of Article 84 EPC, were not complied with. As a matter of fact, the observations and the amended claims had been put forward by the Appellant as a bona fide attempt to overcome the objections raised by the Examining Division and the decision to refuse the application took the Appellant by surprise (cf. T 197/88, OJ EPO 1989, 412, in particular point 4 of the Reasons).

- 11. For these reasons, the contested decision was issued in violation of Article 113(1) EPC. This constitutes a substantial procedural violation within the meaning of Rule 67 EPC. Consequently, it is equitable to reimburse the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside;
2. The case is remitted to the Examining Division for further prosecution on the basis of Claims 1 to 8 (for non-ES, non-GR States) and Claims 1 to 6 for ES and GR and new page 5 of the description filed on 19 May 1993;
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairwoman:

L. McGarry

U. Kinkeldey