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D E C I S I O N
of 13 September 2000

Case Number: T 0960/94 - 3.3.4
Application Number: 84901462.6
Publication Number: 0135587
IPC: C07H 21/00
Language of the proceedings: EN

Title of invention:

Defined sequence single strand oligonucleotides incorporating reporter groups, process for the chemical synthesis thereof, and nucleosides useful in such synthesis

Patentee:

SYNGENE, INC

Opponent:

Roche Diagnostics GmbH
Chiron Corporation

Headword:

Incorrectly composed division/SYNGENE

Relevant legal provisions:

EPC Art. 54(2), 113, 116
EPC R. 67, 68(1)(2), 76

Keyword:

"Opposition division differently composed for decisions given at oral proceedings and in writing respectively - decisions void"

"Refusal to let party comment at oral proceedings on ground raised by another party - procedural violation"

Decisions cited:

T 0390/86, T 0243/87, T 0862/98

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0960/94 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of -

Appellant:
(Opponent)

Roche Diagnostics GmbH
- Patentabteilung -
D-68298 Mannheim (DE)

Representative:

-

Appellant:
(Opponent 02)

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Representative:

Hallybone, Huw George
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London WC1A 2RA (GB)

Respondent:
(Proprietor of the patent)

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California 92121-2789 (US)

Representative:

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office given at oral
proceedings on 10 March 1994 with written
decision posted 6 October 1994 concerning
maintainance of European Patent No. 0135587 in
amended form pursuant to Article 102(3) EPC

Composition of the Board:

Chairman: U. Kinkeldey
Members: S. C. Perryman
D. D. Harkness

Summary of Facts and Submissions

- I. Notices of opposition to European patent No. 135 587 were filed by two opponents. All parties conditionally requested oral proceedings. These took place on 10 March 1994, before three members of the Opposition Division. All three parties were represented at the oral proceedings and submissions were made on their behalf in relation to the substantive issues which were raised by both opponents. Appellant 01 (opponent 01) was however refused permission to comment on novelty. At the end of the oral proceedings, the Chairman announced the decision of the Opposition Division to maintain the European Patent as amended during the proceedings. The Proprietor was given a period of 3 months within which to bring the description into line with the amended claims.
- II. A communication dated 29 March 1994 pursuant to Rule 76(4) EPC, signed by a Formalities Officer was sent to the parties enclosing Minutes of the oral proceedings which recorded the decision as set out above, and which were signed by two of the three members of the Opposition Division, namely the Chairman and the Second Member acting as minute writer, before whom the oral proceedings had taken place, and to which was attached a set of claims. By a Communication dated 6 May 1994 signed by a Formalities Officer a further copy of the Minutes of the oral proceedings with as attachment the correct set of claims as amended during the oral proceedings was sent to the parties. On 11 August 1994 the respondent (patentee) filed an amended description.

- III. On 6 October 1994 a written Interlocutory Decision within the meaning of Article 106(3) EPC was issued by the Opposition Division, which was signed by three members of that Division, of whom however the first member was not the first member stated as present at the Oral Proceedings in the minutes thereof. No record of any notification to the parties of this change in the composition appears on the file.
- IV. On 14 and 9 December 1994 respectively, appellant 01 (opponent 01) and appellant 02 (opponent 02) filed notices of appeal and paid the appeal fees.
- V. On 14 February 1995 appellant 01 filed grounds of appeal arguing first that its right to be heard pursuant to Article 113(1) EPC had been violated in that, as evidenced by point 8 of the Minutes of Oral Proceedings it had been denied the right to comment on novelty, despite the other opponent having raised this issue and, based on this substantial procedural violation, requesting as main request that the decision under appeal be set aside, the matter be remitted to the first instance, and reimbursement of the appeal fee pursuant to Rule 67 EPC. As auxiliary requests it requested that the patent be revoked for lack of novelty and lack of inventive step over a number of documents, and that oral proceedings be held if the board did not propose to allow its appeal.
- VI. On 16 February 1995 appellant 02 filed grounds of appeal requesting that the decision under appeal be set aside and the patent be revoked in toto, and auxiliarily asking for oral proceedings. The grounds given were lack of novelty and lack of inventive step

over a number of documents, and insufficiency. The grounds of appeal referred by name to the first examiner present at the oral proceedings, and this reference was not to the first examiner whose name appears on the written decision.

- VII. The respondent replied to the statements of grounds and requested that the appeals be dismissed and the patent be maintained on the basis of the claims as amended during the Opposition Proceedings, and made an auxiliary request for oral proceedings.
- VIII. By letter received 30 August 1996, appellant 02 withdrew from the appeal proceedings, and by letter received 6 September 1996 withdrew its appeal.
- IX. In a communication dated 8 March 2000, the Board drew the parties attention to the fact that the written decision had been given in a different composition to that of the division which had already announced its decision at the oral proceedings without the parties being informed of or being asked to consent to such change. The Board indicated its preliminary view that this required the purported decision to be treated as a nullity so that the decision would have to be set aside, the appeal fees repaid and the matter remitted to the first instance. The Board also indicated its preliminary view that once the issue of novelty had been raised in an opposition, every opponent, whether or not he himself had raised the issue of lack of novelty, was entitled to submit comments on lack of novelty. The denial of this right to appellant 01 thus appeared to be a substantial procedural violation which would also require the decision under appeal to be set aside, the case remitted to the opposition division,

and this appellant's appeal fee to be reimbursed. The appellant 01 and respondent were asked whether they wished to have oral proceedings prior to any decision of the Board on the above lines.

- X. The respondent indicated by letter dated 18 May 2000, that it did not want oral proceedings for the purpose of discussing the procedural issues raised in the communication of 8 March 2000 from the board. Appellant 01 indicated by letter of 2 May 2000 that it agreed with provisional opinions expressed in the board's communication, and did not wish for oral proceedings if its appeal was allowed.

Reasons for the Decision

1. The appeal of appellant 01 is admissible. The withdrawal by appellant 02 of its appeal is treated as a withdrawal from any active role but still, pursuant to Article 107 EPC, leaves it as a party for formal purposes, as the appeal of appellant 01 has been maintained.

2. The Minutes of the oral proceedings clearly indicate that at the oral proceedings on 10 March 1994 the Chairman on behalf of the Opposition Division pursuant to Rule 68(1) EPC first sentence announced a substantive decision, namely maintenance of the patent with the amended set of claims as submitted during the oral proceedings. To comply with Rule 68(1) second sentence and Rule 68(2) EPC a written reasoned decision confirming the orally announced decision was required. Following the reasoning of decision T 390/86 (OJ EPO 1989, 030) to which reference is made for much more detailed reasoning, which this board adopts as its own, such a written reasoned decision must be issued on

behalf of the very same members of the opposition division who were present at the oral proceedings, as the task of giving a written reasoned decision is personal to those members of the opposition division present at the oral proceedings and cannot be delegated to a differently composed opposition division, even if two of the members remain the same. Whereas in case T 390/86 in fact all three members of the division had changed between the oral and the written decision, the reasoning applies also where, as here, only one member of the division has changed between oral and written decision. This reasoning has also been followed in cases T 243/87 of 30 August 1989 and T 862/98 of 17 August 1999, where in each case only one member had been changed. As no confirmatory written decision has been issued in the names of the members present at the oral proceedings, the decision given orally on 10 March 1994 is void and must be set aside.

3. In this case all parties had asked for oral proceedings pursuant to Article 116 EPC before the opposition division. Issuing the written decision dated 6 October 1994 on behalf of an opposition division whose first member was not present at the oral proceedings, amounts to a substantial procedural violation of both Articles 113(1) and 116 EPC, as it was issued on behalf of a first member before whom the parties were given no opportunity to present their comments at oral proceedings. The written decision too thus has to be set aside.
4. For the reasons set out above, the appeal of both Appellants must be allowed, and the substantial procedural violation that occurred makes it equitable to reimburse the appeal fees of both Appellants (Rule 67 EPC).

5. Appellant 01 also complained that its right to be heard had been violated at the oral proceedings, in that it was not allowed to present arguments on novelty, even though this issue had been raised by the other appellant in its opposition, and both this other appellant and the respondent were allowed to comment on novelty at the oral proceedings. Opposition proceedings are to be treated as unitary proceedings, and each party must be allowed to comment on any ground legitimately raised in the proceedings even if that ground was not initially relied on by the party who wishes to comment but by some other opponent. Certainly if one party is allowed to comment on an issue at oral proceedings, the same opportunity must be afforded to the other parties. The refusal by the Opposition Division to allow appellant 01 to make comments on novelty is evidenced by point 8 of the minutes of the oral proceedings. The refusal amounts to another substantial procedural violation in the proceedings before the Opposition Division.

6. The procedural violations that have occurred require the decision under appeal to be set aside and oral proceedings to be repeated before the opposition division.

Order

For these reasons it is decided that:

1. The Decision of the Opposition Division given orally on 10 March 1994, and the written decision posted 6 October 1994 are set aside.
2. The appeal fees of both Appellants are to be reimbursed.
3. The case is remitted to the Opposition Division for re-examination.

The Registrar:

U. Bultmann

The Chairwoman:

U. Kinkeldey
U. Kinkeldey

