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**D E C I S I O N**  
**of 19 December 2001**

**Case Number:** T 0224/96 - 3.3.4

**Application Number:** 87901921.4

**Publication Number:** 0258404

**IPC:** G01N 33/569

**Language of the proceedings:** EN

**Title of invention:**

Method of detecting antibody against HTLV-III

**Patentee:**

Centocor, Inc.

**Opponent:**

Insitut Pasteur

**Headword:**

Detecting HTLV-III/CENTOCOR

**Relevant legal provisions:**

EPC Art. 107

**Keyword:**

"Adverse effect - (no)"  
"Appeal admissible - (no)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0224/96 - 3.3.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.4**  
**of 19 December 2001**

**Appellant:** Institut Pasteur  
(Opponent) 25-28 rue de dr. Roux  
F-75015 Paris (FR)

**Representative:** Gutmann, Ernest  
Ernest Gutmann -Yves Plasseraud S.A.  
3, rue Chauveau-Lagarde  
F-75008 Paris (FR)

**Respondent:** Centocor, Inc.  
(Proprietor of the patent) 244 Great Valley Parkway  
Malvern, PA 19355 (US)

**Representative:** Holdcroft, James Gerald, Dr.  
Graham Watt & Co.  
Riverhead  
Sevenoaks, Kent TN13 2BN (GB)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 13 December 1996  
revoking European patent No. 0 258 404 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** U. M. Kinkeldey  
**Members:** R. E. Gramaglia  
S. C. Perryman

## Summary of Facts and Submissions

- I. European Patent 258 404 was revoked by a decision of the Opposition Division posted 13 December 1995 on the ground that claims 1, 2, 5, 6 and 9 as granted lacked novelty with respect to the disclosure of document D10, WO-A-86/06099.
- II. Despite the patentee not having made any auxiliary request for maintenance of the patent with a more restricted set of claims, in its decision the Opposition Division also remarked that it considered Claims 3, 4, 7, 8, 10 and 11, limited to the amino acid sequence of Figure 5 of the patent in suit to be both novel and inventive, despite contrary arguments put forward in the opposition.
- III. The appellant (opponent) filed a notice of appeal by telefax on 19 February 1996 and paid the appeal fee on the same date. The appellant indicated that, notwithstanding the full revocation of the patent, he was filing an appeal as a precautionary measure in case the patentee filed an appeal with a request limited to the claims which the opposition division had indicated to be allowable.
- IV. No appeal was filed by the respondent (patentee).
- V. The Board issued a communication by telefax on 15 April 1996 indicating its provisional opinion to the effect that:
- (i) The appeal was inadmissible because the appellant was not adversely affected.

(ii) Where the patent had been revoked in accordance with the request of the opponent who had not during the opposition proceedings indicated that he would consent to the maintenance of the patent with any form of claims, the opponent had no need to file any appeal. If the patentee should appeal, even on a basis that the opposition division had indicated would have been allowable, the opponent would be entitled on appeal to argue against maintenance of the patent on such basis. An appeal by the opponent in these circumstances was neither necessary nor admissible. If the patent had been revoked no question of "*reformatio in peius*" could arise in favour of the patentee which would preclude the opponent from challenging maintenance of the patent. The Board would in such a situation not consider itself bound by any reasoning of the first instance even though the only appeal were that of the patentee.

V. No response was made by either of the parties.

### **Reasons for the Decision**

1. For a party to be adversely affected within the meaning of Article 107 EPC, the first instance must have refused some request of the party appealing.
2. Here the appellant (opponent) had requested that the patent be revoked, and this was the order made by the Opposition Division. Accordingly, no request of the appellant was refused, so he was not adversely affected.

3. That the Opposition Division also indicated in its decision that it would have considered some claims allowable contrary to the submissions of the appellant is irrelevant, because this part of the decision is not part of the reasoning supporting the order actually made by the Opposition Division, but rather an obiter dictum commenting on a hypothetical case, on which a decision was not necessary because the patentee had made no corresponding request before the Opposition Division.
  
4. Accordingly as the appellant does not meet the requirement of Article 107 EPC that he be adversely affected by the decision under appeal, the appeal must be rejected as inadmissible pursuant to Rule 65(1) EPC.

## **Order**

### **For these reasons it is decided that:**

The appeal is rejected as inadmissible.

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey