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D E C I S I O N
of 13 November 2001

Case Number: T 0615/96 - 3.3.2

Application Number: 85903545.3

Publication Number: 0185759

IPC: A61K 31/56

Language of the proceedings: EN

Title of invention:

Electrolyte solutions and (in vivo) use thereof

Patentee:

BTG INTERNATIONAL LIMITED

Opponent:

Fresenius AG

Headword:

Electrolyte/BTG

Relevant legal provisions:

EPC Art. 107

Keyword:

"Appellant (Opponent) made Appellant's (Patentee) request its own"

Decisions cited:

G 0007/91, G 0008/91, G 0009/91, G 0010/91

Catchword:

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Case Number: T 0615/96 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 13 November 2001

Appellant: Fresenius AG
(Opponent) D-61343 Bad Homburg v.d. Höhe (DE)

Representative: Luderschmidt, Schüler & Partner GbR
Patentanwälte
Postfach 3929
D-65029 Wiesbaden (DE)

Respondent: BTG INTERNATIONAL LIMITED
(Proprietor of the patent) 10 Fleet Place
London EC4M 7SB (GB)

Representative: W.P. THOMPSON & CO.
Eastcheap House
Central Approach
Letchworth
Hertfordshire SG6 3DS (GB)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 3 May 1996
concerning maintenance of European patent
No. 0 185 759 in amended form.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: U. Oswald
S. U. Hoffmann

Summary of Facts and Submissions

- I. European patent No. 0 185 759 with the application No. 85 903 545.3 and based on the international application No. PCT/US85/01202 was granted on the basis of 23 claims.
- II. Opposition was filed against the granted patent by the Appellant (Opponent) on the grounds of lack of novelty and lack of inventive step under Article 100(a) EPC. More particularly the statement of grounds of appeal filed on 17 August 1993 contains an attack of lack of novelty of independent claims 1 and 19 to 23 and a final request to revoke the patent in suit (see page 7, last three paragraphs).
- III. By its interlocutory decision of 3 May 1996 the Opposition Division maintained the patent in amended form under Article 102(3) EPC on the basis of the fifth auxiliary request filed during the oral proceedings of 10 May 1995.

Since the subject-matter of the claims of the fifth auxiliary request related to solutions containing obligatorily only one of the couples lactate/pyruvate (couple A2) or d-betahydroxybutyrate/acetoacetate (couple A3), the Opposition Division concluded that this request was restricted to subject-matter not objected to by the Opponent. Moreover, in the Opposition Division's view, the Opponent did not produce facts or arguments in the light of which the patentability of the said restricted subject-matter could be questioned on a prima facie basis.

- IV. Both the Appellant (Patentee) and the Appellant

(Opponent) filed an appeal against the said decision.

V. In the course of the written proceedings the Appellant (Patentee) filed several requests, namely a main request seeking maintenance of the patent with the claims as granted and eleven auxiliary requests containing amended sets of claims.

VI. Oral proceedings took place on 13 November 2001.

At the beginning of the oral proceedings the Appellant (Patentee) withdrew all previous requests and filed a new main request and 2 auxiliary requests each containing an amended claim 1 comprising couples A2 and/or A3 of claim 1 as maintained in amended form.

Since the scope of the opposition was restricted to an attack on only couple A1 (bicarbonate-dissolved carbon dioxide) of the three alternative couples A1, A2 and A3 encompassed by the granted claim 1, in fact couple A1, and since the patent was maintained on the basis of an amended claim 1 containing obligatorily only the couples A2 and/or A3, the Appellant (Patentee) took the view that, as regards decisions G 9/91 and G 10/91 of the Enlarged Board of Appeal, the Appellant (Opponent) was not adversely affected within the meaning of Article 107 EPC by the decision of the Opposition Division and accordingly contested the admissibility of the Appellant's (Opponent) appeal.

VII. In response the Appellant (Opponent) argued inter alia that the notice of opposition only specified that the opposition was directed essentially (im wesentlichen) but not exclusively to the said couple A1. Since the patent was opposed in its entirety and since the

subject matter of claim 1 as granted represented an indivisible unit the Appellant (Opponent) felt in any case be adversely affected by the decision of the Opposition Division.

- VIII. After deliberation on the aspect of admissibility of the Appellant's (Opponent) appeal, the Board informed the parties that the Appellant's (Opponent) appeal was admissible but left open the question of whether the facts and arguments against the said couples A2 and A3, brought forward for the first time at the appeal stage by the Appellant (Opponent), should be admitted in the proceedings because of their late filing.
- IX. After discussing formal and substantial aspects of the patentability of the subject matter of the said requests filed at the beginning of the oral proceedings, the Appellant (Patentee) indicated its intention to file a new sole request which would replace all previous requests.

Having regard to the large number of requests already presented, the Board consented to a further and last opportunity to modify the claims.

Subsequently the Appellant (Patentee) filed a sole request and explained that this request should be acceptable since the claimed subject was restricted to solutions comprising only couple A3 as an obligatory feature.

The opponent declared that he did not see any problem with the maintenance of the patent on the basis of this restricted request.

- X. The Appellant (Opponent) and the Appellant (Patentee) filed the same request to the effect that the European Patent be maintained on the basis of the sole request received during the oral proceedings.

- XI. After the Board announced its decision at the end of the oral proceedings but before its reasoned written decision was sent to the parties, the Appellant (Patentee) filed a letter dated 22 November 2001, confirming each of the requests filed during the oral proceedings.

Reasons for the Decision

- 1. Both parties appealed against the decision of the Opposition Division.
 - 1.1 The Appellant's (Patentee) appeal is admissible. This was not contested by the Appellant (Opponent).
 - 1.2 The admissibility of the appeal by the Appellant (Opponent), however, was challenged by the Appellant (Patentee) who argued in essence that the Appellant (Opponent) was not adversely affected by the decision of the Opposition Division.
 - 1.2.1 A party is adversely affected within the meaning of Article 107 EPC if the decision fails to meet that party's requests.

Having regard to the content of the reasoned statement of grounds of opposition, the Board can only conclude that the Appellant (Opponent) filed the opposition in order to have the contested patent revoked in its

entirety.

Accordingly, by maintaining the patent in amended form, the decision of the opposition division unquestionably did not fully meet the Appellant's (Opponent) request at the opposition stage, namely to revoke the patent in its entirety.

For that reason alone the Appellant's (Opponent) appeal is admissible.

2. At the end of the oral proceedings the Appellant (Patentee) withdrew all previous requests and filed a sole request containing a set of claims 1 to 11.

With the claims of the sole request the Appellant (Patentee) has merely cancelled one of the two claimed alternatives of the amended patent as maintained by the Opposition Division, keeping the remaining subject-matter unchanged.

Independent claim 1 of this sole request reads as follows:

"A physiologically compatible aqueous salt solution for mammalian administration which (a) maintains a normal plasma milliequivalent ratio of sodium cations to chloride anions in a normal range, and (b) maintains normal plasma and cellular pH and maintains normal cellular co-factor ratios, said solution containing no plasma proteins and comprising water which has dissolved therein:

the following near equilibrium couple in the quantity indicated:

from 0.1 to 465 millimoles per litre of a couple mixture consisting of d-betahydroxybutyrate anions and acetoacetate anions wherein the milliequivalent ratio of said d-betahydroxybutyrate to acetoacetate ranges from 6:1 to 0.5:1.

- (B) from 1 to 2400 millimoles per litre of sodium cations
- (C) sufficient millimoles per litre of chloride anions to produce a milliequivalent ratio of sodium cations to chloride anions in the range from 1.24 to 1.6
- (D) optionally from 0 to 2400 millimoles per litre of at least one osmotically active substance
- (E) optionally at least one of the following additional cations in a respective quantity as indicated:

cations	quantity (in millimoles per litre)
potassium+	up to 90
calcium++	up to 60
magnesium++	up to 15

- (F) optionally up to 25 millimoles per litre of sigma inorganic phosphate,
- (G) optionally up to 2 millimoles per litre of sigma inorganic sulfate,

the relationship between said water and all solutes in said water being such that the solution has:

- (1) an osmolarity ranging from 260 to 5000 milliosmoles;
- (2) a pH in the range from 5 to 9; and
- (3) the charges of all cations equal the charges of all anions.

3. The Appellant (Opponent) made the Appellant's (Patentee) request its own.

3.1 As regards the Appellant (Patentee), a request consisting of claims proposed by it and agreed by the Opponent self-evidently brings its appeal to an end.

3.2 As regards the Appellant (Opponent), its consent to those claims as its only request can only mean that there is no remaining subject-matter of those claims which would give rise to continue the appeal.

4. Following decisions G 7/91 and G 8/91 (OJ 1993, 346 and 356) as to the effect of withdrawal of an appeal, the Board comes to the conclusion that by withdrawal of an appeal, conditional on the patent in suit being restricted as it is in the present case, the Board is deprived of its discretionary power to examine the substantive merits with respect to the remaining, limited subject-matter claimed by the Appellant (Patentee) and consented to by the Appellant (Opponent).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside

2. The case is remitted to the first instance with the order to maintain the patent on the basis of claims 1 to 11 of the request named "sole request" filed at the oral proceedings on 13 November 2001 and the description to be adapted thereto.

The Registrar:

The Chairman:

A. Townend

P. A. M. Lançon