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D E C I S I O N
of 8 May 1998

Case Number: T 0425/97 - 3.3.2

Application Number: 86309899.2

Publication Number: 0249667

IPC: A61K 33/00

Language of the proceedings: EN

Title of invention:

Fluid therapy with L-lactate and/or pyruvate anions

Patentee:

British Technology Group Limited

Opponent:

Fresenius AG

Headword:

Cardiac Reperfusion/VEECH

Relevant legal provisions:

EPC Art. 113(1), (2)
EPC R. 67, 68(1), 89

Keyword:

"Decision notified in writing different to the decision given orally at the oral proceedings"
"Correction under Rule 89 EPC (no) - change in substance"
"Procedural violation (yes) - reimbursement of appeal fee"

Decisions cited:

G 0008/95, T 0666/90, T 0647/93, T 0552/97

Catchword:

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Case Number: T 0425/97 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 8 May 1998

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

Representative: Luderschmidt, Schüler & Partner GbR
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Appellant II: British Technology Group Limited
(Proprietor of the patent) 10 Fleet Place
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Representative: Ackroyd, Robert
W. P. Thompson & Co.
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Hertfordshire SG6 3DS (GB)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 5 February
1997 concerning maintenance of European patent
No. 0 249 667 in amended form.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: C. Germinario
R. E. Teschemacher

Summary of Facts and Submissions

I. European Patent No. 0 249 667 was granted in response to European patent application No. 86 309 899.2. Notice of opposition was filed by the appellant I, requesting revocation of the patent in its entirety.

II. During the written proceedings, the appellant II (patentee) had filed a main request and a first auxiliary request on 21 August 1995 and subsequently, a second and a third auxiliary requests by fax dated 22 October 1996.

Oral proceedings were held on 24 October 1996.

The minutes dispatched on 19 December 1996 state the following: the main request and the first and second auxiliary requests were rejected on different grounds. The second auxiliary request was thus modified and resulted in the new third and fourth auxiliary requests, which, both were rejected for lack of novelty. Then, the original third auxiliary request of 22 October 1996 was modified and resulted in the fifth and sixth auxiliary requests, which both were rejected for lack of novelty. Then, such fifth auxiliary request was further modified to give the seventh auxiliary request, which comprised a single claim and which was held by the opposition division to meet the requirements of the EPC.

III. Referring to the discussion on the patentability of auxiliary request seven, the minutes indicate, on

page 4, third paragraph, that the subject-matter of the single claim concerns the use of a solution for **cardiac reperfusion** (emphasis added). A complete text of the maintained claim was not enclosed to the minutes.

The decision was then pronounced that the patent was maintained in amended form on the basis of auxiliary request seven.

- IV. The interlocutory decision under Article 106(3) EPC with the text of the claim on which the decision was based was dispatched on 5 February 1997. The minutes of the oral proceedings were also enclosed. However, this version of the minutes was different from the previous one of 19 December 1996, in that the subject matter of the single claim was said, on page 4, third paragraph, to concern the use of a solution for **peritoneal dialysis** (emphasis added). The decision and the text of the enclosed claim were in agreement with this new version.

In its decision the opposition division held that the subject-matter of the claim had to be regarded as novel since none of the cited documents disclosed the use of the composition in question for the preparation of a medicament for peritoneal dialysis and that it was not obvious for a person skilled in the art to modify the Hartman solution of E6 ... and to use it for peritoneal dialysis (see decision page 6).

- V. In a note from the opposition division concerning a consultation by telephone on 8 April 1997, it is stated that appellant II drew the opposition division's

attention to an *obvious error* in the second version of the minutes and in the decision.

This consultation was followed, on 9 April 1997, by the dispatch by telefax of a revised version of the "Facts and submissions" and the "Reasons" of the decision of 5 February 1997 and a revised form of the minutes, both confirmed by post on 14 April 1997. A new term for appeal was not set. In a short accompanying communication, the opposition division informed the parties that the correction was made according to Rule 89 EPC, and had "*become necessary because auxiliary request 7 and 8 obviously had been confounded*". No trace of said auxiliary request 8 is however to be found in the foregoing history of the case.

In the corrected form of the decision, any reference to "peritoneal dialysis" was replaced by "cardiac reperfusion" and a completely fresh text of the valid claim was enclosed. The minutes were corrected accordingly.

VI. With letter received on 10 April 1997, thus crossing the dispatch of the revised decision, appellant I lodged an appeal against the opposition division's decision in the first version and paid the appeal fee. At the same time he submitted the statement setting out the grounds of appeal.

Appellant I submitted as unique ground of appeal the inconsistency existing between the written decision, in particular the document on which the decision had been

taken as indicated in form 2339.411.93, and the form of the patent held as patentable by the opposition division at the oral proceedings. He requested that the decision be set aside because of the evident procedural violation and the appeal fee be reimbursed. Revocation of the patent in its entirety was also requested, however without any further substantiation.

On 11 April 1997, appellant II lodged an appeal against the decision already in revised form. He paid the appeal fee and requested cancellation of the decision in its revised version.

In his statement setting out the grounds of appeal, he attacks the decision under appeal for substantive reasons, and requests maintenance of the patent in the form of the main request or of any one of the first to ninth auxiliary requests.

VII. With communication pursuant to Article 110(2) EPC, the Board informed the parties of its intention to remit the case to the opposition division for formal reasons.

No objection was raised against this course of action and the requests for oral proceedings before the board were withdrawn by the both parties.

Reasons for the Decision

1. *Admissibility*

An appeal has been lodged by appellant I (opponent) against the opposition division's decision in the original version (5 February 1997). Appellant I was adversely affected by this decision because the patent was maintained contrary to his request (Article 107 EPC), and he gave a reason why the decision should be set aside (Article 108 EPC). The correction of the decision did not remove the appellant's cause of complaint. Therefore, the appeal meets all the requirements of Articles 107, 108 and Rule 64 EPC and is admissible.

A second appeal has been lodged by appellant II (patentee) not against the decision in its original form but against the decision as subsequently corrected.

Since in its decision, regardless whether in the original or revised version, the opposition division rejected the patentee's main request and a number of auxiliary requests, appellant II was in any case adversely affected. Therefore the requirements of Article 107 EPC are met.

As to the statement setting out the grounds of appeal, the Board notes that the appellant has requested *inter alia* the maintenance of the patent according to the main request or to the second to sixth auxiliary requests all rejected by the opposition division with decision in both version. Therefore the appellant's arguments, submitted accordingly, substantiate the appeal against the interlocutory decision, regardless whether in the original or revised version. Hence the

formal requirements of Article 108 and Rule 64 EPC are met and the appeal is admissible.

2. *The decision under appeal, as dispatched on 5 February 1997*

2.1 Article 113(2) EPC

At the oral proceedings, the opposition division maintained the patent in the form of the seventh auxiliary request, which had been filed by appellant II during the same proceedings after rejection of all the previous requests. However, the fair and complete text of the single claim according to the maintained patent was not included in the minutes dispatched by the opposition division on 19 December 1996.

From the minutes of the oral proceedings and from the foregoing history of the file, it may be derived that the single claim according to the seventh auxiliary request corresponds to claim 1 of the third auxiliary request filed on 22 October 1996, and is directed to the use of a solution comprising water having dissolved therein the given components in the given quantities for the manufacture of a medicament **for cardiac reperfusion**.

However the text of the single claim attached to the decision issued by the opposition division on 5 February 1997 was different from the text apparently held as patentable at the oral proceedings, in relation to many essential features of the claim, and, first of all, with regard to the therapeutic application of the

medicament, now said to be **peritoneal dialysis**.

From the original minutes of oral proceedings, from the history of the case, from the submissions of the parties and from the correction made by the opposition division, it becomes evident that a request consisting of one single claim directed to the use of a specific solution for the manufacture of a medicament for peritoneal dialysis, was never filed by appellant II.

The Board therefore concludes that the opposition division took a decision upon the patent in suit on the basis of a text which was neither submitted nor agreed by appellant II. This involves an infringement of Article 113(2) EPC and must be considered as a substantial procedural violation (see T 666/90 of 28 February 1994; T 647/93 OJ EPO 1995, 132; T 552/97 of 4 November 1997).

- 2.2. Moreover, Rule 68(1) EPC sets out that "Where oral proceedings are held before the EPO, the decision may be given orally. Subsequently the decision in writing shall be notified to the parties". The Rule unambiguously refers, in its two parts, to the **same** decision given orally firstly, and notified in writing later. Therefore, in the Board's judgement, any substantive deviation, as in the present case, of the decision notified in writing from the decision taken at the oral proceedings and given orally amounts to a further procedural violation (T 666/90 supra).

3. *The decision under appeal as corrected - Rule 89 EPC*

After first dispatch of the decision on 5 February 1997, the opposition division corrected the decision, the text on which the decision was based and the minutes of the oral proceedings. It based this correction on Rule 89 EPC.

Rule 89 EPC lays down that "In decisions of the EPO, only linguistic errors, errors of transcription and obvious mistakes may be corrected". The Enlarged Board of Appeal in G 08/95 (OJ EPO 1996, 481, Reasons 3.3) dealt with the scope of Rule 89, stating that the difference between an appeal against a decision and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed. This means that it can be within the scope of Rule 89 EPC to correct the text of the patent if it is not and cannot be in the form corresponding to the intention of the deciding instance (T 850/95 OJ EPO 1997, 152, Reason 3 for the grant procedure).

In the present case, the intention of the opposition division apparently changed between the oral proceedings and the issuance of the written decision in its original version. The relevant point of time for determining the applicability of Rule 89 EPC is the date when the written decision was taken and issued because it is the decision in its written form which is subject to appeal. The modifications introduced by the opposition division in the revised form of the decision after intervention of appellant II, do however not correspond to the intention on the basis of which the

written decision, dispatched on 5 February 1997, was taken.

In fact, the definition of the claimed use for **peritoneal dialysis** cannot be the result of a clerical error or similar obvious mistake. This is proved by the fact that the decision specifically addresses, in the discussion of novelty and inventive step of claimed subject matter, to the use of the medicament (comprising the aqueous solution) just for **peritoneal dialysis**. Moreover, the text of the minutes of the oral proceedings attached to the decision was not the original one, but was also modified to bring it into agreement with the decision. Hence, it appears that when giving the original written decision the division intended to decide on the basis of the claim relating to peritoneal dialysis.

The claim on which the revised version of the decision is based is substantially different from the non-revised one: the quantity of the components in the aqueous solution, the therapeutic application of the medicament and the conditions defining and limiting the scope of the protection are all different. Moreover, the very reasons for the decision have been substantially modified, not only in replacing "peritoneal dialysis" for "cardiac reperfusion" in the paragraphs dealing with the novelty and the inventive step of the claimed subject-matter, but also in rewording the underlying technical problem. In summary, the amendments later introduced into the decision dispatched on 5 February 1997 were made intentionally.

For these reasons, the original decision of 5 February 1997 could not be revised under Rule 89 EPC since the modifications introduced would change not only the form but its very substance.

4. In view of the procedural violations, the Board comes to the conclusion that the decision under appeal must be set aside and considers it appropriate to make use of its powers under Article 111(1) EPC to remit the case to the first instance for further prosecution on the basis of a valid and clear text of the patent on which the parties concerned have had an opportunity to present their comments pursuant to Article 113(1) EPC.

Furthermore, in view of the procedural violations (points 2 and 3), the Board also orders that the appeal fee be reimbursed to both parties, under Rule 67 EPC.

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 for further prosecution.
3. The appeal fees shall be reimbursed.

The Registrar: The Chairman:

P. Martorana P. A. M. Lançon