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**D E C I S I O N**  
**of 17 August 1999**

**Case Number:** T 0862/98 - 3.4.2  
**Application Number:** 87116861.3  
**Publication Number:** 0268237  
**IPC:** G01N 1/10, G01N 35/00, G01F 11/02

**Language of the proceedings:** EN

**Title of invention:**

Apparatus and process for reagent fluid dispensing and printing

**Patentee:**

Abbott Laboratories

**Opponent:**

Roche Diagnostics GmbH

**Headword:**

Apparatus for fluid dispersing/ABBOTT LABORATORIES

**Relevant legal provisions:**

EPC Art. 102(3), 106(3), 111(1), 113(1), 116(1)  
EPC R. 67, 68(2)

**Keyword:**

"Unclear situation of the file: substantive oral decision or intention announced"  
"Infringement of Rule 68(2) EPC: substantial procedural violation"  
"Change in composition of Opposition Division: obligation to offer new oral proceedings"

**Decisions cited:**

T 0234/86 T 0390/86, T 0234/87, T 0209/88

**Catchword:**

Changes in the composition of an Opposition Division after oral proceedings should be generally avoided also in cases where no final substantive decision has been given orally. Where this is not possible, new oral proceedings must in general be offered to the parties under such circumstances (see the analogous regulation of Article 7(1) of the Rules of Procedure of the Boards of Appeal). Such offers may be foregone in exceptional cases, in particular if the final decision given by a differently composed Opposition Division is not substantially based on findings arrived at during the oral proceedings but on fresh facts and arguments communicated to the parties in the resumed written proceedings (see point 2.3 of the reasons).



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Boards of Appeal

Chambres de recours

Case Number: T 0862/98 - 3.4.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.4.2**  
**of 17 August 1999**

**Appellant:** Abbott Laboratories  
(Proprietor of the patent) One Abbott Park Road  
Abbott Park  
Illinois 60064-3500 (US)

**Representative:** Modiano, Guido, Dr.-Ing.  
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20123 Milano (IT)

**Respondent:** Roche Diagnostics GmbH  
(Opponent) - Patentabteilung -  
68298 Mannheim (DE)

**Representative:** -

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 3 July 1998  
revoking European patent No. 0 268 237 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** S. V. Steinbrener  
B. J. Schachenmann

## Summary of Facts and Submissions

- I. The appellant (proprietor of the patent) lodged an appeal against the decision of the Opposition Division revoking European patent No. 0 268 237.

An opposition against the patent as a whole had been filed by the respondent (opponent) and based on Article 100(a) EPC since the subject matter of the patent in suit allegedly lacked novelty and/or inventive step.

- II. As can be seen from the minutes of oral proceedings arranged before the first instance, the Opposition Division held that the grounds for opposition mentioned in Article 100(a) EPC prejudiced the maintenance of the patent in accordance with the main request of the patent proprietor, i.e. the patent as granted, and announced its intention to maintain the patent in amended form on the basis of a set of claims in accordance with the proprietor's auxiliary request. The patent proprietor was given a period within which to adapt the description to the amended claims.

- III. Against the amended description filed in due time after the oral proceedings, objections under Article 84 EPC were raised by the opponent referring to inconsistencies between the description and claims.

In a communication pursuant to Article 101(2) EPC dated 21 November 1997, the Opposition Division requested the patent proprietor to make further amendments to the description within a period of two months, otherwise the patent would be revoked in accordance with

Guidelines D-VI, 7.2.1.

Without any reaction of the patent proprietor to this communication being discernible from the file, the patent was eventually revoked by the impugned decision of the Opposition Division handed over to the EPO postal service on 3 July 1998. The revocation was based on Article 102(1) EPC for reasons of inconsistent terminology used in the amended claims of the auxiliary request and the description adapted thereto, and signed by an Opposition Division different from that before whom the oral proceedings had taken place, the second member having been replaced after the oral proceedings.

IV. In the statement of grounds of appeal, the appellant requested that the decision of the Opposition Division be set aside and that the patent in suit be maintained in its granted form (main request) or - alternatively - in amended form on the basis of first and second auxiliary requests, respectively. In case rejection of the patentee's main request was envisaged by the Board of Appeal, oral proceedings pursuant to Article 116 EPC were requested.

V. In a communication dated 1 December 1998, the Board took the provisional view that the impugned decision lacked the reasoning required by Rule 68(2) EPC since the appellant's main request apparently had never been withdrawn before the first instance. Furthermore, the point was raised whether the change in the composition of the Opposition Division would have required the arrangement of new oral proceedings in the present case. Because of the substantial procedural violations, the Board envisaged an immediate remittal of the case to the department of first instance for further

prosecution and a reimbursement of the appeal fee.

- VI. In a reply to said communication, the appellant agreed with the Board's intention to remit the case to the Opposition Division since it wanted "to appeal the decision to reject the main claims as well".

The respondent did not file any substantive observations.

### **Reasons for the Decision**

1. *Admissibility of Appeal*

The appeal complies with the provisions mentioned in Rule 65 EPC and is therefore admissible.

2. *Substantial procedural violations*

2.1 Unclear situation of the file

- 2.1.1 According to Form 2009.2 of the minutes of the oral proceedings before the department of first instance dated 10 April 1997, the Opposition Division informed the parties of its "intention" to maintain the contested patent as amended on the basis of the so-called "amended auxiliary request" and to give the patent proprietor a period of two months to adapt the description to the amended claims. Although the part of the Form relating to possible decisions is left empty, the box "Brief grounds for the decision" is marked with a cross and reasons for the patentability of the

amended auxiliary request are given. In the typed annexes to said Form, the paragraph dealing with the above "intention" is headed "Decision" (see point G. at page 6).

Furthermore, the first paragraph at page 3 of the impugned decision reiterates the Division's finding that it considered the subject matter of the independent claims of the amended auxiliary request both novel and inventive with respect to the available prior art, and "decided" pursuant to Article 102(3) EPC to maintain the patent as amended.

2.1.2 Having regard to the proprietor's main request, the subject matter of claim 1 as granted was not considered inventive over the available prior art at said oral proceedings (see point D.3.4 at page 4 of the annexes).

There is no indication in the minutes that an interim substantive decision has been given orally on the main request, nor that the main request had been withdrawn by the patent proprietor at the oral proceedings as a reaction to the Division's negative assessment of patentability. Rather, it must be concluded from the consistent terminology "main request" and "auxiliary request" used throughout the minutes (see in particular points A., E. and G. of the annexes) that both requests were maintained.

This fact is confirmed by the impugned decision also consistently referring to main and amended auxiliary requests (see points I.3. and I.4. at pages 2 and 3).

Finally, the appellant directed its appeal against the



Division's "decision" to revoke the patent in suit for "lack of inventive step" and referred in this context to point D.3.4 of the above annexes to the minutes not allowing claim 1 of the main request for this reason (see the notice of appeal and point 1 of the statement of grounds of appeal). This was again confirmed by the appellant's reply to the Board's communication, underlining the appellant's interest in appealing the rejection of the main request as well.

2.1.3 Thus, whereas the evidence available from the file leads to the conclusion that both main and amended auxiliary requests were maintained by the proprietor at the end of the oral proceedings before the first instance, it remains unclear

(i) whether, at the moment, the Opposition Division considered the main request not allowable and "merely" expressed its intention to maintain the patent on the basis of the amended auxiliary request as soon as an amended description would have been filed, or

(ii) whether the Opposition Division gave an interim substantive oral decision to reject the main request and to maintain the patent on the basis of the amended claims according to the auxiliary request, without any approved text of the specification.

2.1.4 Although, in these circumstances, procedure (i) is the one recommended in the Guidelines for Examination in the EPO (see D-VI, 7.2.1 and 7.2.2) and, accordingly, provided on Form 2009.2, procedure (ii) has also been

found to be within the power of the Opposition Division (see decision T 390/86, OJ EPO 1989, 30; in particular point 4, first paragraph of the reasons).

Therefore, in principle, both procedures comply with the procedural framework set out in the EPC for opposition proceedings. However, it goes without saying that it should be clearly apparent from the file which procedure has actually been adopted since the legal consequences are fundamentally different. In particular, in contrast to procedure (i) the Opposition Division has no power to continue examination of the opposition in relation to issues which were subject of a substantive oral decision given in accordance with procedure (ii) (see T 390/86, supra; point 4, last paragraph of the reasons).

The present conduct of the procedure before the first instance is therefore deficient in that the situation of the file is unclear in relation to important procedural matters.

## 2.2 Infringement of Rule 68(2) EPC

2.2.1 Whether procedure (i) is followed or procedure (ii), the written decision will in most cases be an interlocutory decision open to appeal, under Article 106(3) EPC to the effect that the amended patent and the invention to which it relates meet the requirements of the Convention. If based on an auxiliary request, this interlocutory decision must set out reasons for not allowing the main request but allowing the auxiliary request in order to comply with Rule 68(2) EPC (see T 390/86, supra; last paragraph of

point 2 of the reasons). Of course, the same requirements have to be met if it eventually turns out that - due to some deficiencies which have not been removed - none of the existing requests is allowable (see decision T 234/86, OJ EPO 1989, 79; in particular points 5.6 to 5.10 of the reasons).

- 2.2.2 This means in the present case that - irrespective of whether a substantive oral decision was given or not - pursuant to Rule 68(2) EPC the reasons for rejecting the main request should have been set out in writing in the impugned decision as well.

In accordance with established practice of the boards of appeal, the present Board considers this default to constitute a substantial procedural violation justifying a reimbursement of the appeal fee (see T 234/86, supra; Headnote IV.).

2.3 Change in composition of the Opposition Division

- 2.3.1 In the present case, the composition of the Opposition Division was changed after the oral proceedings in that the minutes and the impugned decision are signed by different second members.

In accordance with the jurisprudence of the boards of appeal (see e.g. T 390/86, supra; Headnote IV.(a) and (b); and T 243/87, not published in OJ EPO; point 3 of the reasons), such a change in the composition of the Opposition Division is to be considered to be a substantial procedural violation resulting in invalidity of the decision, if procedure (ii) has been adopted.

2.3.2 Decision T 243/87 (supra) refers to the argument that even if only one member of the opposition division is replaced after oral proceedings, there is no guarantee that the reasoned decision written later on correctly reflects the views of all three members which participated at the oral proceedings. Such a change introduces a considerable risk of influencing the final written decision by the new member on one hand, who on the other hand will not be aware of what really happened in the course of the oral proceedings.

As best can be seen from the present case, this risk exists with any change in the composition of the opposition division between oral proceedings and issue of a final decision.

In view of the fact that oral proceedings are a fundamental expression of the right to be heard pursuant to Article 113(1) EPC (see e.g. decision T 209/88, not published in OJ EPO; point 4.3 of the reasons), any findings at oral proceedings relevant to the final decision should be made in the presence and with the involvement of those members giving the final decision also in cases where no substantive oral decision is pronounced, i.e. where procedure (i) is followed.

Therefore, in the Board's opinion such changes in composition should be generally avoided, and if this is not possible, new oral proceedings must in general be offered to the parties if the composition of the department of first instance is changed after the oral proceedings before a final decision has been issued (see the analogous regulation of Article 7(1) of the

Rules of Procedure of the Boards of Appeal). Such offers may be foregone in exceptional cases, in particular if the final decision given by a differently composed opposition division is not substantially based on findings arrived at during the oral proceedings but on fresh facts and arguments communicated to the parties in the resumed written proceedings (under which circumstances however requests for further oral proceedings under Article 116(1), second sentence EPC may not be rejected if the subject of the proceedings has changed). Since there will not be too many cases where new oral proceedings actually have to be arranged for this reason, the aspect of procedural economy is of secondary importance.

In the present case, if procedure (i) was followed, then the impugned decision was, in fact, substantially based on findings resulting from the oral proceedings so that new oral proceedings should have been offered to the parties in the light of the above arguments.

3. *Remittal of the case to the first instance and reimbursement of the appeal fee*

3.1 In view of the above procedural violations and in order to allow a correct decision on the appellant's requests before two instances, the Board without any comment as to the merits of the impugned decision makes use of its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution.

Due to the change in the Division's composition and the unclear result of the oral proceedings, new oral proceedings will have to be offered to the parties by

the first instance.

3.2 Under the circumstances of the present case, the Board considers the requirements of Rule 67 EPC to be met and, accordingly, the appeal fee shall be reimbursed.

4. *Request for oral proceedings*

In view of the remittal to the first instance without any substantive decision on the appellant's main and auxiliary requests, the request for oral proceedings in case rejection of the appellant's main request is envisaged by the Board of Appeal can be disregarded.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

P. Martorana

E. Turrini