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D E C I S I O N
of 7 March 2001

Case Number: T 0899/98 - 3.3.2

Application Number: 87905672.9

Publication Number: 0357598

IPC: A01N 57/00

Language of the proceedings: EN

Title of invention:

Stable, shippable, peroxy-containing microbicide

Patentee:

MINNTECH CORPORATION

Opponent:

Henkel Kommanditgesellschaft auf Aktien
Solvay Interlox Ltd.

Headword:

Shippable microbicide/MINNTECH

Relevant legal provisions:

EPC Art. 113(1), 99(1), 111
EPC R. 67, 68(2), 55(c)

Keyword:

"Procedural violation - yes - decision of first instance
defect as to lack of reasoning for a ground of opposition"

Decisions cited:

G 0009/91, T 0274/95

Catchword:

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D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 7 March 2001

Appellant: Henkel
(Opponent) Kommanditgesellschaft auf Aktien
TFP/Patentabteilung
D-40191 Düsseldorf (DE)

Opponent: Solvay Interox Ltd.
Baronet Works, Baronet Road
Warrington, Cheshire, WA4, 6HB (GB)

Representative: Vande Gucht, Anne
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Respondent: MINNTECH CORPORATION
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Minnneapolis, MN 55447 (US)

Representative: Bass, John Henton
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 16 July 1998
concerning maintenance of European patent
No. 0 357 598 in amended form.

Composition of the Board:

Chairman: C. Germinario
Members: U. Oswald
S. U. Hoffmann

Summary of Facts and Submissions

- I. European patent No. 357 598, based on the international application published under publication number WO 88/08667 (application No. PCT/US87/01147) was granted on the basis of 18 claims.
- II. Oppositions were filed against the granted patent by the Appellant (Opponent 01) and Opponent 02 on the grounds of lack of novelty and inventive step under Article 100(a) EPC and additionally by Opponent 02 for lack of sufficiency of disclosure of the invention under Article 100(b) EPC.

Regarding the objections under Article 100 (b) EPC Opponent 02 argued inter alia that the invention was insufficiently described since the ranges given for the components were so broad as to encompass compositions which were not storage stable. This was clearly confirmed by Table 1 of the patent in suit, from which it could be derived that none of the components of the claimed solution were indeed stable. For instance, the peracetic acid composition increases 63% between the first and the last analysis. Even the analysis after 60 days, which corresponds most closely to the composition of claim 7, undergoes a peracetic acid concentration increase of almost 8% during the remainder of the storage period (see in particular the notice of opposition, filed on 7 December 1994, page 9, last paragraph and page 10).

- III. With the interlocutory decision posted on 16 July 1998 the Opposition Division maintained the patent under Article 102(3) EPC on the basis of an amended set of 8 claims filed as auxiliary request during the oral

proceedings held on 20 October 1997, of which the sole independent claim reads:

"1. A stable, shippable solution for use as a microbicide, comprising:

- (a) 1% by weight hydrogen peroxide;
- (b) acid consisting of a mixture by weight of 0.08% peracetic acid and 5% acetic acid;
- (c) the remainder of 100% by weight water."

The Opposition Division held that the amended claims fulfilled the requirements of Article 123(2) and (3) EPC, Article 84 EPC as well as Articles 54 EPC and 56 EPC.

The Opposition Division recognised an inventive step in particular in view of the effects achieved by the claimed solutions.

- IV. The Appellant (Opponent 01) lodged an appeal against this decision.
- V. The sole action of the Opponent 02 in the appeal procedure was to inform the Board and the other Parties that he will not participate at the oral proceedings scheduled for 7 March 2001.
- VI. Oral proceedings took place on 7 March 2001.

At the beginning of the oral proceedings the Chairman drew the party's attention to the fact that the patent was also opposed under Article 100(b) EPC. Although the

Opposition Division had not considered this ground of opposition in its decision, this ground proved to be particularly relevant in view of the amended claim 1 which was directed to a defined specific microbicide solution, for which any possible variations in percent-amount of the different components was excluded by the very wording of the claim.

- VII. On this point the Respondent argued that the claimed solution was a stable commercial product already sold under different trade names. He tried to prove this by producing a set of documents concerning one of those products named "Actril Cold Sterilant".
- VIII. On the other hand, the Appellant argued that example 1 of the patent in suit showed that even after a storage period of sixty days the claimed solution did not reach the equilibrium state and that, because of their instability, each of the compositions as set out in table 1 of example 1 was outside the scope of claim 1.
- Moreover, the Appellant contested that the commercial products referred to by the Respondent necessarily corresponded to those described in the patent in suit.
- IX. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.

The Respondent requested (main request) that the appeal be dismissed and that the patent be maintained as accepted by the Opposition Division and as auxiliary request that the case be remitted to the first instance.

Reasons for the Decision

1. The appeal is admissible.
2. The subject matter of amended claim 1 of the patent in suit as maintained by the Opposition Division is restricted to a specific composition which is in fact the composition of claim 7 as granted.

The currently claimed microbicide solution is defined by one specific composition comprising 1% by weight hydrogen peroxide, 0.08% by weight peracetic acid, 5% acetic acid and the remainder of 100% water.

Stability is cited as a characterising feature of the claimed subject matter and the solution is further characterised by the amounts of its components without leaving any possibility of variation (due to e.g. instability).

The alleged stability of the claimed subject matter is shown, according to the Respondent, in table 1 of example 1 of the patent.

3. In the Board's view the arguments brought forward by the Opponent are indeed pertinent in many respects. In fact, on the basis of the results of the stability tests as indicated in table 1 of example 1, it appears that stability as a consequence of an equilibrium state was achieved neither within 60 days of storage as alleged, nor thereafter. It is evident that even after 193 days the hydrogen peroxide content in the solution is still decreasing while the peracetic acid content rises.

Provided that an equilibrium state could be achieved, yet example 1 does not indicate the necessary time for achieving it after mixing the different components nor does it mention whether the amount of the components as claimed is the amount of the starting materials before mixing or the amount observed after a defined period of time after the initial mixing, possibly at the equilibrium.

4. Under these circumstances, the question of whether the invention as defined in amended claim 1, is described in a manner sufficiently clear and complete for it to be carried out by the skilled person, should have been considered by the Opposition Division and still needs to be considered by the Board.

5. This does not amount to the introduction of a fresh ground of opposition since Opponent 2 produced substantive written arguments during the opposition proceedings concerning this ground of opposition (see *inter alia* the notice of opposition filed on 7 December 1994, page 9, last paragraph and page 10).

Accordingly the Board can only conclude that the requirements of Article 99 (1) EPC and Rule 55 (c) EPC regarding the ground for opposition under Article 100(b) are met (see T 274/95, OJ 1997/3, 99).

6. In spite of this, the decision under appeal lacks any substantial reasoning as regards the grounds for opposition of insufficiency of disclosure of the invention.

7. Therefore, in the Board's judgment the failure of the Opposition Division to consider in the decision-making

process a ground for opposition, which could have strongly influenced the outcome of the decision, constitutes a substantial procedural violation.

8. On the other hand, if the Opposition Division has indeed considered this ground of opposition and has concluded that it did not prejudice the maintenance of the European patent in amended form, then it should have produced substantial arguments explaining the reasons of its decision according to Rule 68(2) EPC.

Failure to explain these reasons amounts to a procedural violation since one party was deprived of its legitimate right to challenge the reasoning on which the decision was based, which is the purpose of the proceedings before the Boards of Appeal (Article 113 EPC) (see decision of the Enlarged Board G 9/91, OJ 93, 408, paragraph 18).

9. Article 111 EPC and Article 10 RPBA (Rules of Procedure of the Boards of Appeal) provides that a Board shall remit the case to the first instance, if a fundamental deficiency is apparent in the first instance proceedings.
10. In view of the substantial procedural violation the Board considers that the reimbursement of the appeal fee is clearly equitable (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. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

A. Townend

C. Germinario