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D E C I S I O N
of 3 March 2003

Case Number: T 0165/99 - 3.3.8

Application Number: 91202591.3

Publication Number: 0480519

IPC: C07H 3/04

Language of the proceedings: EN

Title of invention:
Solid lactulose

Patentee:
DUPHAR INTERNATIONAL RESEARCH B.V.

Opponent:
INALCO S.P.A.

Headword:
Crystalline lactulose/DUPHAR

Relevant legal provisions:
EPC Art. 83, 111, 114

Keyword:
"Admission of a late ground of opposition on appeal (yes) -
wrong discretion exercised by opposition division"
"Main request - disclosure - sufficiency - (no)"
"Remittal to the first instance - (no)"

Decisions cited:
G 0010/91, G 0001/95, T 0133/87, T 0986/93, T 0557/94,
T 0644/96

Catchword:
-



Case Number: T 0165/99 - 3.3.8

D E C I S I O N
of the Technical Board of Appeal 3.3.8
of 3 March 2003

Appellant:
(Opponent)

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Respondent:
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 27 November 1998
rejecting the opposition filed against European
patent No. 0 480 519 pursuant to Article 102(2)
EPC.**

Composition of the Board:

Chairman: L. Galligani
Members: P. Julia
M. B. Günzel

Summary of Facts and Submissions

I. An appeal was lodged by the opponent against the decision of the opposition division which rejected the opposition against the European patent 0 480 519 having the title "Solid lactulose". Claim 1 as granted read as follows:

"1. Method for the preparation of water-free crystalline lactulose by reduction of the water content by evaporation of an aqueous lactulose solution or lactulose suspension, optionally in the presence of seed crystals, characterized in that the reduction by evaporation is carried out simultaneously with continuous mixing and is continued until the total of the material is converted into a powder."

Claims 2 and 3 were dependent on claim 1 and defined specific conditions of the reduction by evaporation.

II. The patent was opposed on the grounds of lack of novelty and inventive step (Article 100(a) EPC). Document EP 0 318 630 (D1) was cited as anticipating the claimed method (Article 54 EPC), whereas the combination of document D1 with document Kirk-Othmer "Encyclopedia of Chemical Technology", 3rd edition, 1979, Vol. 7, pages 268 to 269 (D2), was considered by the opponent to prejudice the inventive step (Article 56 EPC). In the context of inventive step, reference was made by the opponent to the technical contribution of the patent in suit and to several disadvantages of the method of claim 1 which, in its view, resulted in a yellow product not suitable for pharmaceutical use.

- III. In a reply to the notice of opposition, the patentee argued on the novelty and the inventive step of the patent in suit. No comments were made on the alleged technical disadvantages referred to by the opponent because, in its view, there was no requirement in the EPC for the presence of any technical advantage. The lack of technical progress or advantages was not a valid ground of opposition.
- IV. In the summons to the oral proceedings, the opposition division gave a preliminary, non-binding opinion on novelty and inventive step. In respect of the alleged unsuitability of the product, the opposition division explicitly indicated that the quality of the starting material could possibly be the origin of lack of reproducibility of the desired results and that the burden of proof was on the opponent. A specific protocol with all relevant experimental parameters should be provided sufficiently early to the opposition division and the proprietor. The opposition division set the final date of 3 months before the date set for oral proceedings for making written submissions according to Rule 71a EPC and for filing appropriate comparative experiments.
- V. In preparation for the oral proceedings, the opponent referred to unsuccessful efforts to obtain the drying equipment mentioned in the patent in suit or similar equipments and concluded therefrom that the drying equipment mentioned in the patent in suit no longer existed. Relying essentially on the evidence cited in the notice of opposition, the yellow colour of the product obtained was said to be due to the presence of a substantial amount of unknown degradation substances. The opponent also filed a report of a technical expert

(Prof. Dr van Rosmalen) comparing the properties of different products, one of them allegedly having been produced by the method of the contested patent.

- VI. By letter dated 24 September 1998 the patentee, replying both to the preliminary opinion of the opposition division and to the comments of the opponent, filed several documents as evidence for the existence of the drying equipment indicated in the contested patent at the filing date of the patent in suit (faxes of 19 March 1990 and 9 April 1990 respectively between P. Lais (Riniker AG) and H. Pluim (Duphar) dealing with and confirming the use of the drying equipment MZA 100 for crystallisation experiments) and supplied information concerning a suitable alternative drying equipment comparable to the Riniker MZA 100 mentioned in the patent in suit (fax of Glatt-Inox of 8 September 1998 and documentation Glatt-INOX dryers). The patentee referred to Article 114 EPC, to the decision G 10/91 of the Enlarged Board of Appeal (OJ EPO 1993, 420), and objected to the introduction of the ground of opposition under Articles 100(b), 83 EPC.
- VII. At the oral proceedings held before the opposition division on 10 November 1998, the opponent filed comparative experiments performed with a "mini laboratory pilot plant" set up by the opponent, comprising a drying equipment different from but allegedly comparable to the one used in the patent in suit. The opponent indicated that this had been done due to the impossibility to verify the patent in suit with the machine indicated by the patentee. According to the minutes of the oral proceedings, the opposition division indicated at the beginning of the proceedings that any arguments presented by the opponent relating

to an alleged lack of sufficient disclosure and/or reproducibility were not admitted in the proceedings, failing the patentee's agreement, as the ground of opposition was not filed within the nine-month time limit prescribed for opposition. In the reasons for its decision the opposition division repeated this and, moreover, considered that the comparative experiments did not prima facie prejudice the patent in suit and disregarded them. Novelty and inventive step were acknowledged and the opposition was rejected pursuant to Article 102(2) EPC.

VIII. In the statement of grounds of appeal the appellant (opponent) referred both to lack of inventive step and of reproducibility and filed two additional comparative experiments, which were carried out using the alternative drying equipment indicated by the patentee (cf Section VI), as further technical evidence for supporting the objection of lack of reproducibility (attachment X1).

IX. In a reply to the statement of grounds of appeal and concerning the objection of lack of reproducibility, the respondent (patentee) filed experimental evidence corresponding to the example of the contested patent and three further experimental tests (appendix 5 of respondent's letter of 13 July 1999: "Report on experiments on the crystallisation of lactulose with the aid of Riniker MZA 100, prepared by K.D. Gessellschaft für Abwassertechnik with attached opinion of the firm Riniker AG of Rapperswill, Switzerland" dated 1 March 1990). Additional documents were filed for demonstrating that document D1 was not enabling (appendix 1: "Decision of the Opposition Division of the EPO to revoke EP 0318630", appendix 2: "Jeffrey et

al., Carbohydrate Research 1992, Vol. 226, pages 29 to 42"; appendix 3: "Decision T 644/96 of 15 May 1999" and Appendix 4: "EP 0375046").

- X. The appellant replied to the respondent's submissions arguing against inventive step of the contested patent and commenting on the respondent's technical evidence. Reference was also made to the comparative experiments filed with the statement of grounds of appeal.

- XI. The board issued an official communication pursuant to Article 11 of the rules of the procedure of the boards of appeal with a provisional, preliminary opinion on the issues to be discussed, in particular on the issue under Articles 100(b), 83 EPC.

- XII. In reply to the board's communication, the appellant further pleaded for the consideration of this ground of opposition by the board. Among other arguments, the appellant referred to the fact that disregarding evidence under Articles 100(b), 83 EPC as a new ground of opposition because the patentee did not consent to its introduction into the proceedings was a prerogative of appeal proceedings **not** of opposition proceedings and, thus, the opposition division had committed a substantial procedural violation. Moreover, the appellant submitted that the discretion left to the opposition division by Article 114 EPC should have been applied in a more balanced manner.

- XIII. With reference to the decisions of the Enlarged Board of Appeal G 10/91 (supra) and G 1/95 (OJ EPO 1996, 615), the respondent in its letter of reply dated 29 January 2003 objected to the introduction of the said ground of opposition.

XIV. Oral proceedings before the board of appeal were held on 3 March 2003. With respect to the ground of opposition under Articles 100(b), 83 EPC, the board decided, after hearing the pleadings of the parties, to consider it.

XV. The appellant (opponent) requested that the decision under appeal be set aside and that European patent No. 0 480 519 be revoked.

As a main request the respondent (patentee) requested that the appeal be dismissed. As auxiliary request, should the board come to the conclusion that the patent in suit lacked sufficient disclosure, the respondent requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution.

Reasons for the Decision

Admissibility of considering the ground of opposition of Articles 100(b), 83 EPC at the appeal stage.

1. The appellant's opposition was - at least expressly - originally only based on lack of novelty and inventive step. Further arguments presented by the appellant in the course of proceedings and an experimental protocol filed at the oral proceedings were disregarded by the opposition division on the ground that an alleged lack of sufficient disclosure and/or reproducibility of the subject matter of the patent could not be admitted, at this stage of proceedings, without the patentee's agreement, which had not been given.

2. According to opinion G 10/91, OJ 1993, 408 and 420, Headnote III., fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee. As it can be derived from the Enlarged Board of Appeal's argumentation in point 18. of the reasons, the term "fresh ground of opposition" means a ground which is relied upon for the first time in appeal proceedings (T 986/93, OJ 1993, 215, point 2.3 of the reasons), which is not the case here.

3. Where a belatedly submitted ground of opposition had been disregarded by the opposition division pursuant to Article 114(2) EPC, the board of appeal is at least not barred from considering such ground if it is of the opinion that the opposition division exercised its discretion wrongly in this respect, T 986/93 (supra), Headnote. The procedural decision of an opposition division to disregard submissions forms an essential element of its decision-making process and as such belongs to the issues subject to review when the final decision of the opposition division is challenged on its merits, T 986/93, point 2.4 of the reasons.

4. In the present case the opposition division exercised its discretion wrongly:
 - (i) In point 10. of its communication accompanying the summons to oral proceedings the opposition division made remarks about a possible origin of the lack of reproducibility of the desired results alleged by the appellant and pointed out that the burden of proof lay with the appellant. The communication then went on to say that a specific protocol indicating all relevant experimental parameters should be provided to the

opposition division and the proprietor 3 months prior to the oral proceedings.

- (ii) In response to the appellant's submission that its enquiries about the machine mentioned in the only example of the patent in suit had revealed that the said machine no longer existed and that it was impossible to verify the results obtained by the patentee with laboratory equipments, the respondent indicated, by letter dated 24 September 1998, a firm where a machine was available which was in its view comparable to the machine mentioned in the patent in suit.

- (iii) According to point 3 of the minutes of the oral proceedings held before the opposition division on 10 November 1998, the Chairman opened the discussion on the case by indicating that any arguments presented by the opponent relating to an alleged lack of sufficient disclosure and/or reproducibility of the subject matter of the patent, although potentially significant by themselves, could not be admitted at this stage of proceedings without the patentee's agreement and would therefore be dismissed, since the ground for opposition was not filed within the nine-month time limit prescribed for opposition. The further documents produced by the opponent relevant to this point, ie also the experimental protocol filed during the oral proceedings (D5), were excluded from consideration.

5. As it is apparent therefrom, at the oral proceedings the opposition division did not even let the appellant speak on the issue of whether or not the ground of

opposition of Articles 100(b), 83 EPC and the experiments submitted in the oral proceedings were still to be considered. All this, although the opposition division had itself invited the appellant to provide such data, and, furthermore, in spite of the fact that the appellant could hardly have produced the experimental results much earlier than it actually did after having unsuccessfully tried to use the machine indicated by the respondent. It is true that point 10. of the opposition division's communication does not expressly mention Articles 100(b), 83 EPC or the ground of insufficiency. However, nevertheless, the appellant had good reasons to believe that asking for the said data was considered by the opposition division to be relevant under an issue different from novelty and inventive step because the latter issues had already been dealt with in points 8 and 9 of the opposition division's communication.

6. By opening the discussion in the oral proceedings with the above cited statement that any arguments relating to an alleged lack of sufficient disclosure and/or reproducibility including the documentation D5 could not be admitted at this stage of proceedings without the patentee's agreement, and by not even letting the appellant speak on the issue, the opposition division has not only violated the appellant's right to be heard, but made also a legally incorrect statement. According to G 10/91 (supra), consent of the patentee is not as such a requirement for considering a new ground of opposition before the opposition division. The opposition division's incorrect approach is repeated under point 5.2 of the reasons for the appealed decision, where the opposition division sets out that the issue of whether or not the patent

provided sufficient information for carrying out the invention did not constitute a ground for opposition within the nine-month time limit and should therefore not be allowed to be introduced. Although at another place in the reasons for the decision, in point 2, in an unclear context, the opposition division points out that the "lately filed documents" (these including D5) did not appear "prima facie" to prejudice the patent in suit, this aspect is not addressed at all or referred to under the said point 5.2 of the reasons dealing with the late ground of opposition.

7. It is to be concluded therefrom that the decision of the opposition division not to consider the ground of insufficient disclosure and the experimental evidence filed therefor in the oral proceedings and to not even let the appellant speak on the issue was essentially based on its erroneous view that considering such ground was subject to the consent of the patentee. Because the opposition division exercised its discretion wrongly when excluding the appellant's submissions from consideration from the outset, after having itself expressly asked for further evidence, the present board is not barred from considering the issue of insufficiency of disclosure.

Article 83 EPC

8. According to Articles 100(b), 83 EPC, the claimed invention must be disclosed in the European patent and in the European patent application in a manner sufficiently **clear** and **complete** that it can be put into practice by the person skilled in the art without undue burden taking into consideration also common general knowledge. These requirements refer to the European

patent and the European patent application taken as a whole, ie taken the complete technical information or content disclosed therein.

Technical information or content of the patent in suit

9. The method of claim 1 as granted comprises the following technical features: (i) reduction of the water content by evaporation, (ii) which is carried out simultaneously with (iii) continuous mixing and (iv) is continued until the total of the material (aqueous lactulose solution or suspension) is converted into a powder. The resulting product is water-free crystalline lactulose (column 2, lines 46 to 47). The claimed method is worded in general terms without any specific limitation (starting material, conditions of mixing and evaporation). Moreover, by the presence of an optional feature, the claim embraces two possible embodiments, a first one covering a method carried out in the presence of seed crystals and a second embodiment covering a method without seed crystals.

10. The description provides more detailed technical information. In particular, it states that the evaporation should **preferably** take place under reduced pressure (less than 100-200 mbar) (column 2, lines 16 to 19), the temperature should be maintained below the decomposition temperature of the lactulose (**preferably** not exceed 70-80°C) (column 2, lines 34 to 37) and the lactulose content based on total dry substance should **preferably** be at least 80-95% (column 2, lines 24 to 26). It is indicated that, due to the dramatic increase of the viscosity at the onset of the crystallization process, "*a very powerful mixing equipment is required*" (column 2, lines 38 to 41). The reduction by

evaporation and simultaneous mixing is continued until the total of the material is converted into powder, **preferably** until the water content is less than 1% by weight (column 2, lines 42 to 45). Specific conditions for the embodiment with seed crystals are also disclosed (column 2, lines 22 to 34). The resulting crystalline lactulose powder is said to consist completely of water-free non-hygroscopic lactulose suitable for pharmaceutical purposes (column 2, lines 9 to 10 and 46 to 50).

11. The teaching of the description is exemplified by a single example, wherein the starting material (50 kg lactulose syrup, 65.3% by weight) is initially concentrated (100 min) in a drying equipment MZA 100 (Riniker) at reduced pressure (< 0.2 bar) and low temperature (< 60°C) until a concentration of about 85% by weight. The concentrated solution is seeded (2.4 kg of crystalline lactulose) and further concentrated by evaporation (65-70°C, 40 min). The final product is described as a white powder with 0.8% water content (column 2, line 56 to column 3, line 7).

*The experimental evidence provided by the **appellant***

12. The appellant has provided experimental evidence to show that the claimed invention could not be reproduced without undue burden.
13. The experimental evidence provided by the appellant during the oral proceedings before the opposition division relied on three trials performed with starting materials and under operating conditions of the drying equipment falling under those mentioned in the patent in suit, namely (i) the temperature of the circulating

fluid thermostatic bath was about 65°C, (ii) the vacuum was lower than 50 mbar and (iii) the reduction by evaporation took place with simultaneous mixing (choppers welded on the stirrer's paddels). With operating times (80 to 120 min) similar to those of the contested patent, none of the three trials could be, however, completed due to technical problems related to the powerful mixing required. The final products were identified as viscous and sticky masses different from the expected crystalline powder of the patent in suit.

14. Further experimental evidence was provided in the statement of the grounds of appeal (attachment X1), wherein the drying equipment used (Glatt-Inox IUT 100) was the one identified by the respondent as having essentially the same technical characteristics as the one used in the contested patent (MZA 100, Riniker) (cf Section VI). The starting material (70.6 kg lactulose 98.1% and 74.3 kg lactulose 87.6%) and the operating conditions (temperature < 77-78°C and pressure < 30 mbar) were, in both trials of this evidence, falling under those disclosed in the contested patent and the behaviour of the most important parameters (time, temperature, pressure, water evaporated) was described in detail for the complete process. Whereas no seed crystals were used in the first trial, seed crystals were added in the second trial. Both trials referred to a powerful mixing (10 rpm stirrer and 500 rpm chopper) and they were ended after observing no more changes in the morphology of the product (first trial) or after considering the slowness of water evaporation (second trial) with final times (215 and 195 min) longer than the one shown in the contested patent. A small amount (0.5%) of crystalline lactulose powder was obtained in the first trial, whereas,

however, the greater part of the material was a spongy sticky mass (first trial) or only aggregates, spherules and blocks (second trial). Contrary to the patent in suit, the crystalline powder was hygroscopic and none of the samples analysed had a content of water lower than 1%.

15. Considering this experimental evidence, there is no apparent reason for the failure to obtain water-free crystalline lactulose. As possible reasons for this failure, the respondent has identified several technical problems, in particular in relation to (i) the suitability of the drying equipment and mixing conditions used, (ii) the amount and quality of the starting material, (iii) the temperature of the sample and (iv) the general optimisation of operating parameters, in particular, (v) the presence of seed crystals. However, none of these reasons casts serious doubts on the validity and the conclusiveness of the experimental evidence provided by the appellant as the operating conditions were within the framework of those provided by the description of the patent specification.
16. In order to fulfil the requirements of Article 83 EPC, all the essential features required for carrying out the invention and achieving the desired effect must be clearly identified as such in the patent as a whole. For the purpose of reproducibility, it is not possible to rely on the presence of further essential features which have not been clearly identified as such in the patent as a whole.
- (i) Apart from the reference to "*a very powerful mixing equipment*" (column 2, lines 38 to 41) and

to the drying equipment MZA 100 (column 2, lines 57 to 58) which no longer exists, there is no further information in the patent in suit concerning the specific technical characteristics required for the drying equipment or the operating conditions (cf items 9 to 11 supra). Thus, there is no reason to doubt that the drying equipment used by the appellant in the above referred experimental evidence could indeed provide a "very powerful mixing" as required (certainly not for the drying equipment Glatt-Inox IUT 100; cf Section VI). Moreover, the operating conditions employed in this evidence were essentially in line with those used in the experiments made by the respondent before the filing date of its patent application (cf items 17 and 17.i infra).

- (ii) There is only one reference in the patent in suit to the amount of starting material used (50 kg). However, a specific amount is neither claimed nor it is identified as being an essential feature of the claimed process and the patent in suit is completely silent regarding any effects of changing or altering the amount of starting material.
- (iii) The quality of the starting material used in the appellant's experimental evidence (77.6% to 85.5%, 98.1% and 87.6%) was within the range indicated in the patent in suit (80-95%; column 2, lines 19 to 21) and exemplified therein too (initial solution of 65.3% which is concentrated to 85% before seeding).

- (iv) As required by the patent in suit (column 2, lines 34 to 37), the temperature of the product never exceeded the decomposition temperature of the lactulose (70 to 80°C). Whereas in one case, the product temperature (temperature of the syrup inside the dryer) was close to the highest given value (77 to 78°C), in the other case it was certainly lower (65°C, the temperature of the "circulating fluid thermostatic bath").
- (v) Articles 100(b), 83 EPC do not require to disclose the "best mode" of carrying out the invention. Improvements or an optimisation of the exemplified subject-matter are considered to be within the normal ability of the person skilled in the art. However, the reproducibility required by Article 83 EPC must not place an undue burden on the skilled person and thus, it cannot be made **completely** dependent on the selection and/or optimisation of different parameters or values for which no guidance is given in the patent in suit. To transform a complete failure as in the present case (no lactulose crystals with the claimed property of being non-hygroscopic, see item 14 supra) into a significant success (complete production of powder and significant production of non-hygroscopic lactulose crystals) as required to be obtained by the claimed method would require more than mere improvements and it cannot be seen as a matter of routine optimisation. In this case, it places an undue burden on the skilled person.
- (vi) In this respect, the presence of seed crystals possibly improves the method. However, this

presence is only disclosed (and claimed) as an optional feature and not as a mandatory one. Moreover, seed crystals were used in one trial of the experimental evidence but without any apparent success. Admittedly, the crystal concentration used did not fall within the preferred range indicated in the patent in suit (1 to 5%) but it was still within the range disclosed therein (at least 1%) (column 2, lines 32 to 34).

*The counter-experimental evidence provided by the **respondent***

17. The respondent has provided experimental evidence (appendix 5) comprising four trials (cf Section IX). Said evidence, which is dated 1 March 1990, relates to the experimental work made before the filing of a patent application. The first and second trials correspond indeed to the method exemplified in the patent in suit, whereas the third and fourth trials concern similar methods except for the continuous introduction of lactulose syrup (third trial) or for the production of hygroscopic crystalline lactulose (fourth trial). It is now undisputed that the drying equipment Riniker MZA 100 mentioned in the patent in suit and used by the respondent for the said experimental work is no longer available. It may, however, remain undecided what the legal consequences thereof might be as regards the issue of reproducibility in view of the conclusions reached under items 18 to 20 *infra*. In view of the trials made by the respondent, the board also notes that:

- (i) The operating conditions of the drying-equipment MZA 100 (Riniker), in particular the speeds of

the stirrer (10 to 20 rpm) and chopper (300 to 1300 rpm) as well as the value of the vacuum (20 to 600 mbar), were similar to the ones used in the experimental evidence provided by the appellant (20 rpm for the stirrer and < 50 mbar or 10 rpm for the stirrer, 500 rpm for the chopper and < 30 mbar).

- (ii) All trials refer to strong mixing with the resulting equipment overloading and the associated technical problems, which were, however, in all cases successfully overcome by the following modifications and changes: the speed of both the stirrer and the chopper was significantly increased during seeding, whereas the vacuum was progressively reduced before seeding (in order to increase the temperature of the product) and it was significantly increased after seeding.
- (iii) All trials were carried out using seed crystals and there is no technical evidence showing the successful preparation of water-free crystalline lactulose in the absence of seed crystals.

Board's final considerations

- 18. The technical teaching disclosed in the patent in suit is by far less complete than the one provided in the respondent's experimental evidence (appendix 5). In particular, the operating conditions (item 17.i supra) as well as the modifications required after seeding, more particularly the changes in speed and vacuum (item 17.ii supra), are certainly essential for a successful achievement of the expected result. In fact, these

modifications and changes are the only apparent reason for the appellant's failure. However, none of them is clearly disclosed in the contested patent and the skilled person could not be expected to achieve them without undue burden. The respondent has obviously decided not to include the more detailed experimental evidence of appendix 5 in the description of the patent application.

19. Moreover, there is no technical evidence on file (apart from appellant's failed trial, item 14 supra) showing the preparation of water-free crystalline lactulose without using seed crystals, which are, however, only claimed as being optional. In the absence of this evidence, there are substantial doubts that this embodiment can be carried out with the technical information of the patent in suit.

20. Moreover, there is also evidence on file (cf Section IX, Appendixes 1 to 3) showing that aqueous lactulose crystals were not available earlier than 1992, ie two years after the priority date of the patent in suit. In the absence of any information in the patent in suit (or in the submitted experimental evidence) concerning the source, properties and availability of these seed crystals, there are substantial doubts that this particular embodiment can be reproduced without undue burden.

21. Therefore, the board concludes that the requirements of Article 83 EPC are not fulfilled by the patent in suit.

Remittal to the first instance

22. As an auxiliary request, should the board come to the conclusion that the patent in suit lacked sufficient disclosure, the respondent has requested that the decision under appeal be set aside and the case be remitted to the opposition division for further prosecution.
23. According to Article 111(1), second sentence, EPC it is within the board's discretion either to decide the case itself or to remit it for further prosecution to the department who has taken the appealed decision. In the latter alternative according to Article 111(2), first sentence, EPC the opposition division shall be bound by the ratio decidendi of the board, insofar as the facts are the same. Therefore, to remit the case to the opposition division, as the respondent has requested, if the board has come to the conclusion that the patent in suit lacks sufficient disclosure would make no sense because the opposition division could not then decide differently. However, even if said request, in conjunction with the respondent's objection against considering the ground of opposition of Articles 100(b), 83 EPC in appeal proceedings, was interpreted to mean that the board should not consider this issue at all but instead remit the case to the opposition division for consideration of this ground of opposition, the board would not have found such remittal justified, for the following reasons.
24. As has been explained above, the ground of opposition of Articles 100(b), 83 EPC has not been raised for the first time in appeal proceedings. Moreover, although in a different context, the opposition division had indeed

already dealt with the experimental data filed by the appellant in the oral proceedings and had formed an opinion on them by declaring that they did not appear prima facie to be relevant. Therefore, the additional experiments filed with the grounds of appeal did not introduce entirely new facts. They were intended to reinforce the line of arguments unsuccessfully presented before the opposition division and they can therefore be regarded as a response to the rejection of the appellant's submissions by the opposition division. They do not create a fresh case. The further experimental data have been presented with the grounds of appeal, ie with letter dated 26 March 1999. The respondent had thus almost four years time to consider them and to react to them. It has been acknowledged in the jurisprudence of the boards of appeal that there is no absolute right of a party to have every aspect of a case examined in two instances (T 133/87 of 23 June 1988, point 2. of the reasons), even if as a consequence the patent is revoked for the first time by the board of appeal (T 557/94 of 12 December 1996, point 1.3 of the reasons). Other criteria, eg the general interest that proceedings are brought to a close within an appropriate period of time, have also to be taken into account by the board when deciding whether or not to remit a case. The filing date of the patent is 4 October 1991. Opposition and appeal proceedings have lasted six years. A possible consequence of remittal, possibly ensuing further appeal proceedings on the issue of reproducibility, could be that a final decision on the validity of the patent would be not taken before the expiry of the patent. The board has therefore decided not to remit the case but to decide on it itself.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani