



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Große
Beschwerdekammer

Enlarged
Board of Appeal

Grande
Chambre de recours

Internal distribution code:

- (A) [] Publication in OJ
(B) [X] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 15 July 2008**

Case Number: R 0001/08

Appeal number: T 1344/05 - 3.3.02

Application Number: 97600009.1

Publication Number: 0916347

Language of the proceedings: EN

Title of invention:
-

Petitioner:
Uni-Pharma Kleon Tsetis A.B.E.E.

Other parties:
BIOSPRAY SA
HELP S.A.

Headword:
-

Relevant legal provisions (EPC 2000):
EPC Art. 112a, 113;
EPC R. 104, 106 and 107

Keyword:
"Petition for review - clearly not allowable"

Decisions cited:
G 0006/95

Catchword:
-



Case Number: R 0001/08

D E C I S I O N
of the Enlarged Board of Appeal
of 15 July 2008

Petitioner: Uni-Pharma Kleon Tsetis A.B.E.E.
(Proprietor of the patent) Farmakeftika Ergastiria
14th Klm. Ethnikis Odou 1
Athinou-Lamias
GR-145 64 Kifissia (GR)

Representative: Vossius & Partner
Siebertstraße 4
D-81675 München (DE)

Other party: BIOSPRAY SA
(Opponent 01) Pharmaceutical Industry
39, Favierou Street
GR-104 38 Athens (GR)

Other party: HELP S.A.
(Opponent 02) Pharmaceuticals
10, Valaoritou Street
GR-144 52 Metamorphosis - Athens (GR)

Decision under review: **Decision of the Technical Board of Appeal
3.3.02 of the European Patent Office of
17 December 2007.**

Composition of the Enlarged Board of appeal pursuant to Rule 109(2)a):

Chairman: P. Messerli
Members: J.-P. Seitz
U. Kinkeldey

Summary of Facts and Submissions

I. European patent No 0916347 was granted to Uni-Pharma Kleon Tsetis A.B.E.E., hereafter referred to as the Proprietor, on 19 February 2003.

II. Notices of opposition were respectively filed on 6 November 2003 and 10 November 2003 by BIOSPRAY SA and HELP SA, hereafter Opponent I and Opponent II.

The patent was opposed under Article 100(a) and 100(c) EPC.

III. In its decision notified on 17 August 2005, the Opposition Division rejected the oppositions.

Concerning the objection under Article 100(c) EPC, it was held that the notice of opposition of Opponent II contained no arguments to substantiate the objection, thus this objection was to be disregarded.

The Opposition Division decided that the subject matter of the patent in suit met the requirements of Articles 52(1), 54 and 56 EPC 1973 having regard to the prior art cited by the opponents.

On 17 October 2005, Opponent I filed a notice of appeal against the above decision, requesting it be set aside. A reasoned statement of the grounds of appeal was filed on 20 October 2005.

The Proprietor-Respondent replied with submissions received at the EPO on 23 January 2006.

On 30 July 2007, Board of Appeal 3.3.02 issued a summons to attend oral proceedings on 17 December 2007, together with a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal.

The Appellant-Opponent I informed the Board of Appeal by letter received at the Office on 12 November 2007 that he would not attend the oral proceedings.

In a letter received on 16 November 2007 a newly appointed professional representative, acting on behalf of the Proprietor-Respondent, filed a new main request corresponding to the claims as granted, with a correction of a clerical error in claim 5, and an auxiliary request in which claim 1 consisted of a combination of granted claims 1 and 2, together with further arguments and documents in support of the auxiliary request.

- IV. Oral proceedings took place before the Board of Appeal on 17 December 2007 in the absence of the Appellant-Opponent I.

Having heard the Proprietor-Respondent's submissions with respect to both requests on file, i.e. a main and one auxiliary request, the Board of Appeal closed the debate for deliberation, after which it announced the decision that the patent was revoked.

The reasons for the decision were notified to the parties by registered letter dated 24 January 2008, which pursuant to Rule 126 EPC was deemed to have been delivered on 3 February 2008.

V. The Proprietor-Respondent filed a petition for review of this decision on 3 April 2008 on the grounds of:

- Article 112a(2)c) EPC that fundamental violations of Article 113 EPC had occurred.

- Article 112a(2)d) EPC that a fundamental procedural defect, as defined in the Implementing Regulations to the said provisions, had occurred in the appeal proceedings; this defect arising from the lack of reasoning with respect to the auxiliary request in the decision for which the review is sought.

He requests that the decision be set aside and the proceedings be reopened before the Board of Appeal.

VI. In order to support his request under Article 112a(2)c) EPC the Proprietor-Respondent argues as follows:

Having opened the oral proceedings, which the Appellant-Opponent I did not attend, the Board of Appeal asked the representative of the Proprietor-Respondent to present his case with respect to inventive step of the claimed subject matter.

After hearing the representative's arguments concerning the main request, which were submitted in accordance with the written submissions and the reasoning given by the first instance, the Board then drew attention to a statement in one of the expert opinions submitted by the Appellant-Opponent I and - after the Proprietor-Respondent's reply that such an opinion could not

constitute prior art - to a statement in the patent in suit that benzylic alcohol was "already used as a solvent for parenteral administration of drugs".

Thereafter the Board invited the Proprietor-Respondent to present his case with respect to the auxiliary request. Neither before nor after said submissions did the Board give any opinion or raise an objection with regard to the inventive step of the subject matter claimed in the auxiliary request.

The Board then closed the debate and after deliberation announced the decision that the patent was revoked.

However, in the written procedure the non-attending Appellant-Opponent I had not raised any objection against the subject matter of either request. In addition, the Board of Appeal had not expressed any objections or opinions in respect of the auxiliary request in either the written procedure or the oral proceedings. Therefore, the Proprietor-Respondent was not given the opportunity to reply to the negative approach of the Board of Appeal in its assessment of the merits of the auxiliary request.

Hence, the Proprietor-Respondent was absolutely surprised by the refusal of the auxiliary request by the Board of Appeal, which had never previously objected to it, and by the revocation of the patent.

Indeed, the first time the Proprietor-Respondent became aware of the basis for the Board's decision against the inventive step of the Auxiliary request was from the written decision. In that respect, the Proprietor-

Respondent refers to paragraph 3.3 of the notified decision, and argues that neither these reasons, nor any other, for finding a lack of inventive step were ever raised, or were the subject of discussion during the oral proceedings.

The Board of Appeal should have dealt with each request separately and after having admitted the auxiliary request into the proceeding, should have informed the Proprietor-Respondent of its objections against the inventive step of the subject matter claimed in the auxiliary request. As no objections had been raised before, the Proprietor-Respondent's right to be heard pursuant to the provisions of Article 113 EPC had been fundamentally violated. Because the Proprietor-Respondent only became aware of the reasons for the Board of Appeal's refusal of the auxiliary request when he received them in writing, the Proprietor-Respondent's representative was in no position to raise an objection in respect of the procedural defect during the oral proceedings under Rule 106 EPC.

A further fundamental procedural defect was seen in the fact that the decision of the Board of Appeal was not reasoned with respect to the auxiliary request. A legal basis for such a review on this point could be found in the provisions of Rule 111 EPC, which required that decisions of the European Patent Office open to appeal should be reasoned. In view of the provisions of Article 112a EPC establishing the possibility of a review of decisions of Boards of Appeal, the requirements of Rule 111 EPC should also apply *mutatis mutandis* to the decisions of the Boards of Appeal.

In the case in suit, a reader of the written decision would be unable to identify any reasoning that could be used as the basis for the conclusion that a feature that had never before been proposed in the relevant technical context should be considered obvious.

VII. The Proprietor-Respondent also alleges a third procedural violation concerning the decision of the Board of Appeal under Article 112a(2)d).

During the oral proceedings the Proprietor-Respondent, who attended in the absence of Appellant-Opponent I, relied on an advantage arising from a technical feature in the claim in order to support his arguments in favour of inventive step of the subject matter claimed in his main request.

The Board, however, refused to consider this argument on the ground that *"the advantages were raised for the first time during the oral proceedings in the absence of the appellant, with the result that the alleged effect cannot be taken into account for the assessment of inventive step"*. This would be tantamount to an extension or prolongation of the rights of a voluntarily absent party, and the decision of the Enlarged Board of Appeal G 4/92 should not be read in this sense.

The Proprietor-Respondent in a final general statement summarises the grounds underlying his complaint, and stresses that it is hard for a patent proprietor having prevailed in examination and in first instance opposition proceedings to be defeated for the first time at the appeal stage where no other legal remedy

exists, all the more so when he was not in a position to counter objections he had never been confronted with before.

Reasons for the decision

1. Admissibility of the petition for review, formal requirements.

1.1 In accordance with the provision of Article 112a(4) EPC, the petition was filed on 3 April 2008, that is within two months of notification of the decision of the Board of Appeal which was deemed to have been effected on 3 February 2008.

The prescribed fee was duly paid on the same day.

The requirements of Rule 107 EPC in respect of the content of the petition for review have been fulfilled. The Proprietor-Respondent will in the following be referred to as "the Petitioner".

1.2 The Petitioner raised no objection regarding procedural defects during the oral proceedings held on 17 December 2007 before the Board of Appeal. As to why it was unable to raise objections in respect of the complaint of procedural defects during the oral proceedings, the Petitioner makes the following points:

i) that the representative was surprised when the Board, after deliberation, directly pronounced its decision to revoke the patent implying a decision on the auxiliary request;

ii) the written decision is alleged to be based on grounds and arguments which the patent proprietor was not aware of; and

iii) hence, that the alleged harmful event took place after deliberation. At that time, the debates were closed and the Petitioner was no longer entitled to file any submissions or objections.

The Enlarged Board of Appeal accepts the conclusion that the Petitioner was unable to raise the objections during the oral proceedings and, therefore, the provision of Rule 106 EPC *in fine* applies.

1.3 The petition is based first on the grounds that fundamental violations of Article 113 EPC occurred (Article 112a(2)c) EPC), and that second a further fundamental procedural defect (Article 112a(2)d) EPC together with Rule 104 EPC) affected the decision for which review is sought.

1.4 Finally, the Petitioner is adversely affected by the decision of the Board of Appeal revoking its patent.

1.5 From the above it follows that the petition for review is admissible.

2. Allowability of the petition for review.

2.1 Article 112a(3) EPC provides that a petition for review shall not have suspensive effect. Article 112a EPC was introduced as a result of the revision of the European Patent Convention, usually referred to as "EPC 2000".

As the *travaux préparatoires* for the EPC 2000 make clear, "...the petition for review is an extraordinary legal remedy the filing of which does not affect the force of *res judicata* of the decision under attack", (MR/2/00 of 13 October 2000, Explanatory Remarks to Article 112a EPC, point 11). The extraordinary nature of this legal remedy means that the provisions of Article 112a EPC are to be applied in a strictly-limited fashion. This is again clear from the *travaux préparatoires*:

"That a final court decision should be respected in defence of the principle of legal certainty is of the utmost importance for an effective legal system. Thus, decisions of the boards of appeal must remain final decisions.

However, under certain circumstances many legal systems offer a possibility to review final decisions of a court which are *res judicata*. It is acknowledged that even a final court decision must be set aside if maintaining it without further review would be intolerable. Under the continental legal systems, extraordinary legal remedies exist which make it possible to set aside even final judicial decisions...Common to all these procedures is that they are subject to very strict rules.

The purpose of the present proposal [the draft of Article 112a EPC] is to create a comparable, strictly-limited possibility to apply for a further review of decisions of the boards of appeal of the EPO" (CA/PL 17/00 of 27 March 2000, point 5).

"Under no circumstances should the petition for review be a means to review the application of substantive law. A review of the application of substantive law would mean adding a third instance to the procedure before the EPO...", (CA/PL 17/00 of 27 March 2000, point 11).

The Board therefore considers that Article 112a EPC provides an exceptional means of redress, which provisions have to be applied strictly.

Thus, it is not the purpose of Article 112a EPC that a case be decided upon by a third instance, but rather, it provides the right for a judicial review founded on a limited number of grounds that have been exhaustively defined by the legislator (Article 112a(2) EPC in conjunction with Rule 104 EPC).

- 2.2 The petition is mainly based on an alleged fundamental violation of Article 113 EPC in respect of the auxiliary request as dealt with by the Board of Appeal during the oral proceedings and in its written decision.

The auxiliary request was filed in writing by the Petitioner (who was then the Proprietor-Respondent) on 16 November 2007 i.e. one month before the oral proceedings.

No legal conclusion in favour of the Petitioner can be deduced from the fact that the auxiliary request was neither commented upon or objected to by Appellant-Opponent I who did not attend oral proceedings, nor by the Board of Appeal. The absence of any objections to a request, particularly in "*inter partes*" opposition

proceedings, obviously cannot by virtue of this fact alone render it allowable.

In the case in suit the Petitioner acknowledges that the Board of Appeal "asked the representative to provide his argument with respect to the inventive step of the subject-matter of the Auxiliary Request" (see petition page 3) and that the Board raised no objection with regard to the admissibility of said request. It is in such a case not convincing when the attending party claims to have been taken by surprise; on the contrary, it was made aware of the Board's intention to deal with the merits of the auxiliary request.

Although having in that respect no competence "*ratione legis*" to review the substantive assessments of inventiveness by the Board of Appeal, the present Board is, however, satisfied that the statements brought forward in writing by the then Proprietor-Respondent in order to support his auxiliary request (see letter dated 16 November 2007) have been duly considered by the Board of Appeal (see also point 3.1).

3. As to the first ground of the petition, Article 112a (2) (c) EPC (fundamental violation of Article 113 EPC), to succeed under this head a petitioner has to establish firstly that the decision under review is based on an assessment or on reasoning relating to grounds or evidence which the adversely affected party was not aware of and had no opportunity to comment upon, and secondly that a causal link exists between this procedural defect and the final decision, otherwise the alleged defect could not be considered decisive and hence not fundamental.

3.1 In the present case, the arguments brought forward by the Petitioner are not convincing for the following reasons:

- the reasoning given by the Board of Appeal in respect of the auxiliary request is directly related to the arguments put forward in writing by the Proprietor-Respondent, and hence is based on "grounds or evidence" on which the party concerned had the opportunity to comment,
- no provision of the EPC requires that a Board of Appeal must provide a party with all foreseeable arguments in favour or against a request in advance (see G 6/95, OJ EPO 1996, point 5 i.f., page 657).

In fact, when dealing with the claims of the auxiliary request the Board of Appeal sought to assess the contribution made by the new limiting feature to subject-matter that lacked so far an inventive step. Such a classical approach cannot be considered surprising.

Thus, in the present case no fundamental violation of the right to be heard under Article 113 EPC has taken place.

4. As to the second ground of the petition, based on Article 112a (2) (d) on insufficiency of reasons with respect to the auxiliary request, the Enlarged Board of Appeal leaves open the question whether Article 112a(2) EPC or Rule 104 EPC foresee at all the

possibility of a review based on this point of law and can only note that the Petitioner acknowledges that the decision under review is reasoned (see petition, point 4, page 5, paragraph 1: "The reasoning is contradictory").

Therefore, the present Board does not intend to enter into a review of the merits of the decision i.e. the substantive assessments of inventiveness, as this belongs to the final and exclusive competence of the Board of Appeal. It is sufficient in the present case to ascertain that the Board of Appeal has decided on all valid requests and not "*infra petita*" and that it gave reasons. The fact that the Petitioner does not agree with them is not relevant in this context.

5. As to the third allegation (see section VII), the refusal of the Board of Appeal to consider an argument, this ground cannot be allowed for the following reasons:

- the passage in the Board's decision referred to by the Petitioner concerns the main request only;
- even if the present Board assumed that "*mutatis mutandis*" it could also be applied to the auxiliary request, the argument is not convincing, because the relevant reasoning in the decision under review (point 2.3.6 of the reasons) does not imply that the alleged effect was not considered only owing to the absence of the other party. In fact, a sensible reading of the sentence concerned indicates that the adverbial phrase "with the result" does not refer only to the antecedent "absence of appellant" but also to the other

propositions preceding that part of the sentence which also belong to the reasoning in that respect, including *inter alia*, the statement that the alleged advantage had not been substantiated.

Order

For these reasons it is decided unanimously that:

The petition for review is clearly not allowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli