

Internal distribution code:

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

**Datasheet for the decision
of 29 March 2007**

Case Number: T 0537/05 - 3.3.03

Application Number: 95901252.7

Publication Number: 0739368

IPC: C08G 63/08

Language of the proceedings: EN

Title of invention:

Biodegradable copolymers and plastic articles comprising
biodegradable copolymers

Patent Proprietor:

THE PROCTER & GAMBLE COMPANY

Opponent:

Metabolix, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 106(1), 107, 118

EPC R. 67, 68(2)

Keyword:

"Admissibility of appeal by Patent Proprietor (yes)"

"Substantial procedural violation (yes)"

"Remittal (yes)"

Decisions cited:

T 0390/86, T 0506/91, T 0838/92, T 0528/93, T 0552/97,

T 0613/97, T 0722/97

Catchword:

-



Case Number: T 0537/05 - 3.3.03

D E C I S I O N
of the Technical Board of Appeal 3.3.03
of 29 March 2007

Appellant I: Metabolix, Inc.
(Opponent) 21 Erie Street
Cambridge, MA 02139 (US)

Representative: Stevens, Ian Edward
Eric Potter Clarkson LLP
Parkview House
58 The Ropewalk
Nottingham NG1 5DD (GB)

Appellant II: THE PROCTER & GAMBLE COMPANY
(Patent Proprietor) One Procter & Gamble Plaza
Cincinnati, OH 45202 (US)

Representative: Canonici, Jean-Jacques
NV Procter & Gamble Services Company SA
Temselaan 100
B-1853 Strombeek-Bever (BE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office dated
20 January 2005 and posted 3 March 2005
concerning maintenance of European patent
No. 0739368 in amended form.

Composition of the Board:

Chairman: R. Young
Members: C. Idez
H. Preglau

Summary of Facts and Submissions

- I. The grant of the European patent No. 0 739 368 in the name of The Procter & Gamble Company, Inc., in respect of European patent application No. 95 901 252.7 filed on 15 November 1994 and claiming US priorities of 28 January 1994 and 15 September 1994 (US 187969 and US 306349) was announced on 26 February 2003 (Bulletin 2003/09).
- II. A Notice of Opposition was filed against the patent by Metabolix, Inc. on 26 November 2003, on the grounds of Article 100(a) EPC (lack of novelty and lack of inventive step) and of Article 100(c) EPC (extension of subject-matter).
- III. By a decision announced orally on 20 January 2005 and issued in writing on 3 March 2005 the Opposition Division held that the grounds of opposition raised by the Opponent did not prejudice the maintenance of the patent in amended form on the basis of Claims 1 to 11 submitted at the oral proceedings as main request.
- IV. Notices of Appeal were filed:
 - (i) on 25 April 2005 by Appellant I (Opponent) followed by the payment of the prescribed fee on 28 April 2005; and
 - (ii) on 29 April 2005 by Appellant II (Patent Proprietor) with simultaneous payment of the prescribed fee.

- V. With its Statement of Grounds of Appeal filed on 1 July 2005, Appellant II submitted a new main request and 5 auxiliary requests. It also presented arguments concerning novelty and inventive step of the subject-matter of these requests.
- VI. In its Statement of Grounds of Appeal filed on 5 July 2005, Appellant I contested the admissibility of the appeal filed by the Patent Proprietor. The arguments presented in that respect may be summarized as follows:
- (i.1) The patent in suit had been maintained on the basis of the main request of the Patent Proprietor.
- (i.2) Thus, the Patent Proprietor was not a party adversely affected by the decision within the meaning of Article 107 EPC.
- (i.3) Consequently, its appeal should be ruled inadmissible.
- VII. In its letter dated 5 January 2006, Appellant I essentially argued that the main request, the first and second auxiliary requests submitted by the Patent Proprietor with its Statement of Grounds of Appeal which were broader than the request allowed by the Opposition Division were inadmissible, since the appeal of the Patent Proprietor was not admissible.
- VIII. In its letter dated 19 January 2006, Appellant II presented arguments concerning the admissibility of its appeal which may be summarized as follows:

(i.1) During the oral proceedings, the Opposition Division had taken decisions with regard to novelty and inventive step of the main request (cf. Minutes of the Oral Proceedings, pages 3 and 4).

(i.2) The Patent Proprietor had changed his requests only after these decisions were issued by the Opposition Division.

(i.3) The Opposition Division had decided on the allowability of subject matter in the original Main Request and thereby adversely affected the Patent Proprietor.

(i.4) The case in suit substantially differed from the cases in T 528/93 of 23 October 1996 and T 613/97 of 26 May 1998 (neither published in OJ EPO), wherein the Opposition Division had failed to reach adversely affecting decisions, since in these cases the Patent Proprietor had withdrawn its main request and had replaced it by a new main request before the Opposition Division had issued a decision concerning the initial request.

(i.5) Thus, the Patent Proprietor was adversely affected by the Opposition Division's decision to maintain the Patent in amended form.

(i.6) The way the Opposition Division had conducted the Opposition Oral Proceedings had led to a series of decisions by the Opposition Division on separate Claims of the Main Request, rather than to a decision on the Patent Proprietor's initial Main Request as a whole.

(i.7) A final decision on the Patent Proprietor's initial Main Request as submitted at the beginning of the Opposition Oral Proceedings could never be reached.

(i.8) The way the Opposition Division had conducted the Opposition Oral Proceedings was contrary to the good faith principle as applied by the EPO. Reference was made to decision T 506/91 of 3 April 1992 (not published in OJ EPO).

(i.9) Consequently, the appeal should be decided to be admissible by the Board based on the principle of good faith or the Board should examine the facts and the Patent Proprietor's requests (Requests as submitted with the Grounds of Appeal) on its own motion under Article 114(1) EPC.

IX. Oral proceedings took place before the Board on 29 March 2007.

At the oral proceedings the discussion essentially focussed on the question of the admissibility of the appeal by the Patent Proprietor in the light of the submissions made by the Parties concerning the actual course of the oral proceedings before the Opposition Division.

(i) These submissions may be summarized as follows:

(i.1) Both Parties agreed that the minutes of the oral proceedings correctly reflected the essentials of these oral proceedings.

(i.2) It was confirmed by both Parties that the Patent Proprietor had withdrawn at the beginning of the oral proceedings the main request and the first auxiliary request submitted with letter of 6 January 2005 (cf. Minutes, page 1, Point 1).

(i.3) Both Parties also indicated that the Patent Proprietor had then requested the maintenance of its patent in its granted version (cf. Minutes, page 1, Point 1), and that this was hence its only request remaining when the Opposition Division started with the assessment of novelty and inventive step of the claims as granted (cf. Minutes, page 1, Point 1).

(i.4) Although this was not reflected in the minutes, the Patent Proprietor indicated that after a break the Opposition Division gave the decision that the subject-matter of Claim 1 as granted did not meet the requirements of Article 56 EPC, and that, following the announcement of this decision, it invited the Patent Proprietor to file further requests.

(i.5) The Opponent confirmed that this break had taken place, and that after having announced its decision concerning Claim 1 as granted, the Opposition Division invited the Patent Proprietor to file further requests, although, as submitted by the Opponent at the oral proceedings before the Board, the patent could have been revoked at that stage.

(i.6) Both Parties confirmed that afterwards the Patent Proprietor withdrew its previous main request (maintenance of the patent as granted) and filed a new main request and a new auxiliary request (cf. also page 4, Point 3 of the minutes).

(i.7) Both Parties confirmed that the oral proceedings had continued on the basis of this new main request, which was later withdrawn (cf. page 5 Point 4 of the minutes) and replaced by the auxiliary request, which was further amended by deletion of its Claim 10 (cf. page 5, Point 5 of the Minutes).

(i.8) Both Parties confirmed that this "amended" auxiliary request was further submitted as main request by the Patent Proprietor (cf. page 5, Point 6 of the minutes).

(ii) Concerning the admissibility of the appeal made by the Patent Proprietor, while the Parties relied on their previous arguments presented in the written phase of the appeal, they made additional submissions which may be summarized as follows:

(ii.1) By Appellant I:

(ii.1.1) Even if the word "decision" appeared at several times in the minutes of the oral proceedings, these "decisions" did not amount to appealable decisions. Reference was made to the "decision" of the Patent Proprietor to withdraw the main request as recorded at Point 4 of the minutes of the oral proceedings.

(ii.1.2) Furthermore, these intermediate "decisions" were not reasoned.

(ii.1.3) The minutes of the oral proceedings did not represent an appealable decision. Reference was made to the decision T 838/92 of 10 January 1995 (not published in OJ EPO).

(ii.1.4) The only appealable decision under Article 106(1) EPC was the final decision of the Opposition Division.

(ii.1.5) Since the main request of the Patent Proprietor had been granted by the Opposition Division, it was not affected by the decision of the Opposition Division.

(ii.1.6) No undue pressure had been put by the Opposition Division on the Patent Proprietor to withdraw requests. The Patent Proprietor had not even raised this point in its Statement of Grounds of Appeal.

(ii.2) By Appellant II:

(ii.2.1) Article 107 (1) EPC referred to any party affected by a decision, and not only by the final decision.

(ii.2.2) The aim of the minutes of the oral proceedings was to show what had happened at the oral proceedings.

(ii.2.3) From the minutes of the oral proceedings it was clear that the Opposition Division had indeed taken decision which adversely affected the Patent Proprietor (cf. page 4, lines 11 to 12; 23 to 24).

(ii.2.4) The argument, that pressure had been put on the Patent Proprietor by the Opposition Division to modify its requests had been mentioned in the response to the Statement of Grounds of the Opponent in which the admissibility of the appeal of the Patent Proprietor had been challenged.

X. Appellant I requested that the appeal of the Patent Proprietor be rejected as inadmissible, that the decision under appeal be set aside and the patent be revoked.

Appellant II requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request as submitted with the letter dated 1 July 2005, or in the alternative on the basis of one of the auxiliary requests 1 to 5 as submitted with the letter dated 1 July 2005.

Reasons for the Decision

1. *Admissibility of the appeal filed by the Patent Proprietor*

1.1 According to Article 107 EPC any party to proceedings adversely affected by a decision may appeal and,

according to established case law, a party is adversely affected if the decision does not accede to his main request or to auxiliary requests preceding the allowed auxiliary request.

1.2 In the present case, although the decision of the Opposition Division maintaining the patent in suit is presented as being based on the final main request submitted by the Patent Proprietor at the oral proceedings before the Opposition Division (cf. written decision, page 3, Point 10), the Patent Proprietor has nevertheless argued that it is entitled to appeal since, in its view, in the course of the oral proceedings, the Opposition Division had taken interlocutory decisions, for example on inventive step of the subject-matter of Claim 1 as granted, which adversely affected the Patent Proprietor's position and would therefore allow an appeal.

1.3 Under these circumstances, and in view of the considerations made in the decision T 390/86 (OJ EPO, 1989, 030) according to which an Opposition Division is not precluded from giving interlocutory decisions on substantive issues before deciding to maintain the patent in amended form, and may during the course of an opposition make a (final) interlocutory decision, either orally or in writing that the main claim, for example, of the opposed patent cannot be maintained (cf. Reasons for the decision, point 3.1), the question of the admissibility of the appeal by the Patent Proprietor boils down hence to the question (a) as to whether the Opposition Division had effectively taken such decision, and, if question (a) can be positively

answered, to the question (b) as to whether the Patent Proprietor was adversely affected by such a decision.

- 1.4 In that context, the Board firstly notes that the minutes of the oral proceedings before the Opposition Division) contain at the end of Point 2 entitled "Claims as granted" the following statement (cf. minutes, page 4, lines 11 to 12):
"OD decided that the subject-matter of claim 1 does not meet the requirements of Art. 56 EPC."
- 1.5 While there can be no doubt that the abbreviation "OD" refers to the Opposition Division as a whole (cf. Minutes, page 1, line 4), it must, in the Board's view, further be clarified (i) whether, at that moment of the oral proceedings, the Opposition Division has expressed its mere opinion that Claim 1 as granted was not allowable, or (ii) whether the Opposition Division has given a substantive oral decision to reject Claim 1 as granted.
- 1.6 While both procedures (i) and (ii) referred to above in paragraph 1.5 comply with the procedural framework set out in the EPC for opposition proceedings, their legal consequences are however fundamentally different as shown below:
 - 1.6.1 In the present case, as can be deduced from the minutes of the oral proceedings (Point 1) and as confirmed by both Parties at the oral proceedings before the Board (cf. Points IX (i.2) and (i.3) above), the only valid request of the Patent Proprietor at that moment of the opposition proceedings was the maintenance of the patent as granted.

1.6.2 Consequently, should the Opposition Division have followed procedure (ii) referred above in paragraph 1.5, it should in accordance with the principles of unity of the European patent (Article 118 EPC), have revoked the patent in suit in its entirety due to the non-compliance of granted Claim 1 with the requirements of Article 56 EPC and would hence have had no power to continue the examination of the opposition on further requests presented by the Patent Proprietor after the announcement of this decision, but should the Opposition Division have followed procedure (i), it would have been still empowered to ask the Patent Proprietor whether it intended to file further requests and to continue the examination of the opposition on that basis.

1.7 In order to establish which actually was the procedure chosen by the Opposition Division at the oral proceedings before the Opposition Division, the Board deems it appropriate to supplement the minutes of the oral proceedings drafted by the Opposition Division by the submissions made by the Parties at the oral proceedings before the Board in respect of what happened at the oral proceedings before the Opposition Division.

1.7.1 In that respect, the Board firstly notes that both Parties have acknowledged that the minutes of the oral proceedings correctly reflect the course of that oral proceedings (cf. Point IX (i.1) above).

- 1.7.2 The Board further notes that both Parties have concurred with the characterization of the announcement made by the Opposition Division (cf. Points IX (i.3) and (i.4) above) as a decision and that both Parties have confirmed that the further requests referred to under Point 3 of the minutes have been submitted after the announcement of that decision (cf. Points IX (i.4), (i.5) and (i.6) above).
- 1.8 It hence follows from the above that the Board sees no reason to deprive the wording "decision" used by the Opposition Division in respect of the non compliance with Article 56 EPC of Claim 1 as granted of its true meaning and hence of its legal implications, or, therefore, to consider that the Opposition Division has given a mere opinion on the non compliance of Claim 1 as granted with the requirements of the EPC (cf. in contrast decision T 722/97 of 11 January 1999 (not published in OJ EPO; Reasons point 4)).
- 1.9 Consequently, the Board comes to the conclusion that the question (a) set out in paragraph 1.3 above must be positively answered.
- 1.10 Since the Opposition Division had taken a decision concerning the non compliance of Claim 1 as granted with the requirements of the EPC, and since the only valid request on file at the moment of the announcement of this decision was the maintenance of the patent as granted, the direct consequence of this decision of the Opposition Division, as set above in paragraph 1.6.2, was the revocation of patent in suit.

- 1.11 The revocation of the patent in suit evidently implies that question (b) set out in paragraph 1.3 above must also be answered positively, and that, consequently, the Patent Proprietor is hence entitled to appeal.
- 1.12 It further implies that all actions carried out by the Opposition Division after the revocation of the patent in suit were *ultra vires* and thus are of no legal effect.
- 1.13 Under these circumstances, there is no need for the Board to deal either with the arguments presented by the Patent Proprietor in view of the decisions T 528/93, T 613/97 and T 506/91 in its letter dated 19 January 2006 or by the Opponent in view of the decision T 838/92 (cf. Point IX (ii.1.3) above).

2. *Procedural violations*

- 2.1 Independently of the fact that all the actions carried out by the Opposition Division after the revocation of the patent in suit already amount to substantial procedural violations, the Board also notes that the reasons for rejecting the main request based on the claims as granted have not been set out in the written decision of Opposition Division contrary to Rule 68(2) EPC.
- 2.2 In accordance with established practice of the boards of appeal, the present Board considers this default to constitute a further substantial procedural violation.

- 2.3 These substantial procedural violations justify setting aside the decision of the Opposition Division and the remittal of the case to the first instance.
3. Since the appeal of the Patent Proprietor is successful to the extent that the decision under appeal is to be set aside and since, in view of the foregoing, reimbursement of the appeal fee is equitable because of the substantial procedural violations, the appeal fee should be reimbursed to the Patent Proprietor (Rule 67 EPC).
4. The reimbursement of the appeal fee of the Opponent shall also be ordered, since the decision of the Opposition Division to maintain the patent in amended form, which caused the Opponent to file its appeal, resulted from the substantial procedural violation committed by the Opposition Division to continue the opposition proceedings after the revocation of the patent (cf. also T 552/97 of 4 November 1997 (not published in OJ EPO); Reasons, point 6).

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 on the basis of the patent as granted.
3. Reimbursement of both appeal fees is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young