

Internal distribution code:

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

**Datasheet for the decision
of 19 February 2009**

Case Number: T 1077/06 - 3.3.04

Application Number: 95923651.4

Publication Number: 0796269

IPC: C07K 1/34

Language of the proceedings: EN

Title of invention:

Filtration method for removing viruses from virus-contaminated aqueous solutions

Patentee:

Octapharma AG

Opponents:

- 01: NHS Blood and Transplant (Gwaed a Thrawsblaniadau'r GIG)
02: Stichting Sanquin Bloedvoorziening
03: Laboratoire Français du Fractionnement et des
Biotechnologies
04: CSL Behring GmbH

Headword:

Filtration method/OCTAPHARMA

Relevant legal provisions:

EPC Art. 111(1), 113(1)
EPC R. 103(1)(a)

Keyword:

"Substantial procedural violation (yes)"
"Remittal to the department of first instance (yes)"
"Reimbursement of the appeal fee (yes)"

Decisions cited:

T 0133/87, T 0125/91, T 0892/92, T 0594/00, T 0416/07,
J 0020/85, J 0003/90

Catchword:

-



Case Number: T 1077/06 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 19 February 2009

Appellant:
(Patent Proprietor)

Octapharma AG
Seidenstrasse 2
CH-8853 Lachen (CH)

Representative:

Meyers, Hans-Wilhelm
Patentanwälte
von Kreisler-Selting-Werner
Postfach 10 22 41
D-50462 Köln (DE)

Respondent I:
(Opponent 01)

NHS Blood and Transplant (Gwaed a
Thrawsblaniadau'r GIG)
Oak House
Reeds Crescent
Watford WD24 4QN (GB)

Representative:

Beacham, Annabel Rose
Frank B. Dehn & Co.
St Bride's House
10 Sailsbury Square
London EC4Y 8JD (GB)

Respondent II:
(Opponent 02)

Stichting Sanquin Bloedvoorziening
Plesmanlaan 125
NL-1066 CX Amsterdam (NL)

Representative:

Ebner von Eschenbach, Jennifer
Vereenigde
P.O. Box 87930
NL-2508 DH Den Haag (NL)

Respondent III:
(Opponent 03)

Laboratoire Français du Fractionnement et des
Biotechnologies (Groupement d'Intérêt public)
3, avenue des Tropiques
ZA de Courtaboeuf
F-91940 Les Ulis (FR)

Representative:

Pochart, François
Cabinet Hirsch
58, Avenue Marceau
F-75008 Paris (FR)

Respondent IV: CSL Behring GmbH
(Opponent 04) Emil-von-Behring-Strasse 76
D-35041 Marburg (DE)

Representative: Binsack, Beate
CSL Behring GmbH
Patents & Licences
Postfach 1230
D-35002 Marburg (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 May 2006
revoking European patent No. 0796269 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chair: U. Kinkeldey
Members: M. Wieser
D. S. Rogers

Summary of Facts and Submissions

- I. The appeal was lodged by the Patent Proprietor (Appellant) against the decision of the Opposition Division, whereby the European patent No. 0 796 269 was revoked in accordance with Article 102(1) EPC 1973.
- II. The Patent had been opposed by Opponents 01 to 04 (Respondents I to IV) under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC) and under Article 100(b) EPC on the ground of insufficient disclosure (Article 83 EPC).
- III. The following documents are referred to in this decision:
- (E31) WO 90/15 613
- (E32) Advances in Applied Microbiology, vol.30, 1984, pages 133 to 168
- (E33) Bitton, G., et al., Adsorption of Viruses to Surfaces, John Wiley & Sons, New York, 1980, pages 331 to 374
- (E34) PNAS USA, vol.78(2), 1981, pages 1229 to 1232
- (E35) Applied and Environmental Microbiology, vol.35(6), 1978, pages 1084 to 1094
- (E36) Haurowitz, F., The Chemistry and Function of Proteins, Academic Press, New York and London, 1963, page 203

- (E37) Schultze, H.E., et al., Molecular Biology of Human Proteins, Elsevier Publishing, 1966, pages 182, 183, 222 and 223
- (E38) Fields, B.N., et al., Virology, Lippincott-Raven, Philadelphia - New York, 1996, vol.2, page 2182
- (E39) Applied and Environmental Microbiology, vol.45(2), 1983, pages 526 to 531
- (E46) "Research report Product Development", filed by Opponent 02 (Respondent II) with letter dated 12 October 2004
- (E47) "Research report Product Development", filed by Opponent 02 (Respondent II) with letter dated 25 January 2006

IV. In the written procedure before the Opposition Division the Appellant requested not to admit documents (E31) to (E39) and (E46) into the procedure, all filed by the Respondents after expiry of the time limit of Article 99(1) EPC and Rule 55(c) EPC (1973) (see Appellant's letters dated 6 May 2005, page 2, first paragraph).

In a communication posted on 23 September 2005, annexed to the summons to attend oral proceedings, the Opposition Division stated that these documents appeared to be *prima facie* relevant and seemed therefore to be admissible into the proceedings. They further stated that "[t]he admissibility of the new evidence will be further discussed at the oral proceedings."

A further document, (E47), was filed by Respondent II with letter dated 25 January 2006.

V. At the oral proceedings held on 28 March 2006, the Opposition Division decided to admit documents (E31) to (E39), (E46) and (E47) into the procedure (see point (I) of the appealed decision). They also decided that none of Appellant's requests met the requirements of the EPC.

VI. The Board of Appeal issued a communication posted on 5 September 2008.

Oral proceedings before the Board took place on 19 February 2009 in absence of the Appellant, who informed the Board in a letter dated 19 January 2009 that he would not attend the oral proceedings.

VII. The Appellant requested, by letter dated 19 January 2009, that the decision under appeal be set aside and the case be remitted to the department of first instance for further prosecution.

The Respondents I to IV requested that the appeal be dismissed.

VIII. The submissions by the Appellant as far as they are relevant to the present decision may be summarized as follows:

The Opposition Division, at the oral proceedings before it, had made a substantial procedural violation by announcing that documents (E31) to (E39), (E46) and (E47) were allowed into the procedure, without, at the oral proceedings, hearing the parties on this issue.

Thus, the Appellant's right to be heard according to Article 113(1) EPC had been violated.

Because of this substantial procedural violation the case had to be remitted to the department of first instance for further prosecution (Article 111(1) EPC).

IX. The submissions by the Respondents as far as they are relevant to the present decision may be summarized as follows:

New evidence had been filed during the opposition procedure in response to Appellant's arguments and to the preliminary opinion expressed by the Opposition Division. The Appellant's right to be heard had not been violated in the procedure before the Opposition Division. He had plenty of time and opportunities to present his arguments during the written procedure. Also at the oral proceedings before the Opposition Division he did not react immediately after the Chair announced the decision to allow the newly filed evidence into the procedure, but only at a later stage. The only document, of the eleven documents in question, that had been mentioned in the appealed decision was document (E31). The decision was not tainted by the disclosure in the other ten documents.

Remittal to the department of first instance for further prosecution would only delay the procedure and prolong the period of legal uncertainty. According to Article 11 of the Rules of Procedure of the Board of Appeal, a Board should not remit a case to the department of first instance if special reasons presented themselves for doing otherwise. The special

reasons present in the underlying case were the following:

The age of the patent (claimed priority date 1994) meant that the matter should be dealt with speedily to avoid the situation that the patent expired before the EPO delivered a final decision.

Even if documents were submitted only in the appeal procedure, the Board had the discretion to allow these documents into the procedure and to decide the case without remitting it to the department of first instance. This Board, in a similar situation, in decision T 416/07 of 27 March 2008, decided not to remit a case to the department of first instance but to decide itself.

The Appellant, who had no absolute right to have each and every point heard by two instances, had abandoned his right to be heard by not appearing at the oral proceedings before the Board of Appeal.

Reasons for the Decision

1. Against the grant of the patent in suit four oppositions were filed. The four Opponents cited in their respective notices of opposition thirty documents, (E1) to (E30), which were presented in a consolidated list submitted by the Patent Proprietor as annex to a letter dated 6 November 2003.
2. With additional submissions Opponents 01, 02 and 03 filed nine additional documents. The Patent Proprietor

added these documents to the already existing list as documents (E31) to (E39) and provided an updated list with his letter dated 6 May 2005. In addition, Opponent 02 with letter of 12 October 2004 filed a first "Research report Product Development", referred to as document (E46) (see section (III) above).

3. On page 2 of his letter of 6 May 2005 the Patent Proprietor argued:

"Documents E31 to E39 and the test results submitted by opponent 02 were filed too late, because there were not filed within the opposition period. It is requested not to admit these documents and test results into the opposition proceedings."

This passage is followed by a statement of why the Opposition Division should allow this request.

With the same letter the Patent Proprietor filed four additional documents ((E40) to (E43)). Document (E44) was cited by Opponent 04 in its note of Opposition (23 October 2002) and was subsequently referred to in the proceedings by this number.

4. In a communication posted on 23 September 2005, annexed to the summons to attend oral proceedings, the Opposition Division informed the parties that they considered the newly filed documents to be *prima facie* relevant and therefore to be admissible into the proceedings. However, they continued that "[t]he admissibility of the new evidence will be further discussed at the oral proceedings."

5. Oral proceedings were scheduled for 28 to 29 March 2006. The date for the parties to make final submissions in preparation for the oral proceedings was set to be no later than two months before this date.

6. With letter dated 25 January 2006 Opponent 02 filed a second "Research report Product Development", referred to as document (E47) (see section (III) above).

With letter dated 27 January 2006 the Patent Proprietor filed a new document (E45).

7. According to the minutes of the oral proceedings before the Opposition Division, page 1, fifth paragraph, at the oral proceedings the Chair announced "...that all citations E1 through E27, E29 through E41 and E44, and all the experimental evidence provided by O II were admitted into the proceedings as they were regarded *prima facie* as particularly relevant (pursuant to Article 114)(1) EPC."

The minutes do not indicate that the parties were heard on this issue before the Chair announced this decision.

8. After the announcement the Chair summarized the parties' requests. The Patent Proprietor's request not to admit documents (E31) to (E39) and (E46) (see Patent Proprietor's letter of 6 May 2005) was not mentioned. The minutes state that all parties confirmed their requests (see minutes, page 1, paragraphs 6 to 9).

Only after the Opposition Division had decided that Patent proprietor's main request before it contravened the requirements of Rule 57a EPC (1973), did the Patent

Proprietor protest against the admittance of the late filed documents. The discussion was focussed on the admittance of Opponent 02's second "Research report Product Development" (E47).

The last two sentences on page 2, second paragraph of point (2) of the minutes read: "The admission of the experimental data of 25.01.2006 thus was not considered as a procedural violation by the O.D. but only as its prerogative under Art. 114 EPC. The Patentee was informed of his right to appeal to a higher instance."

9. The decision under appeal deals in point (I) with the "admissibility of documents E31-E43, E45 and technical evidence of 25.01.06 by OII".

In point (I)(1) of its decision the Opposition Division deals with Patent Proprietor's arguments submitted with his letter dated 6 May 2005.

In point (I)(2) of its decision the Opposition Division comments on the arguments submitted by the Patent Proprietor at the oral proceedings **after** the decision was announced by the Chair that E1 through E27, E29 through E41 and E44, and all the experimental evidence provided by O II were admitted into the proceedings.

In point (I)(3) of its decision the Opposition Division expresses its surprise that the Patent Proprietor objected to the admittance of Opponent 02's second "Research report Product Development" (25 January 2006) at such a late stage of the procedure, as this would have been possible earlier, firstly directly after the filing of this document and secondly at the oral

proceedings when the Chair summarised the parties' requests. Finally it is remarked that the document has "not been considered for the present decision."

A reasonable interpretation of this part of the decision is that the parties were not heard by the Opposition Division on this issue at the oral proceedings **before** the Chair announced the decision to admit, among others, documents (E31) to (E39), E(46) and E(47) into the procedure.

10. According to Article 113(1) EPC the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

This provision is a guarantee for the parties that proceedings before the EPO will be conducted openly and fairly (cf decisions J 20/85, OJ EPO 1987, 102, point (4) and J 3/90, OJ EPO 1991, 550, point (11)). The right to be heard is intended to ensure that the parties to proceedings are not taken by surprise by grounds mentioned in an adverse decision (cf decision T 892/92, OJ EPO 1994, 664, point (2.1)).

The parties may present their comments either in writing, or orally during oral proceedings. The express right to oral proceedings is enshrined in Article 116 EPC.

11. The minutes of the oral proceedings before the Opposition Division do not contain an indication that the parties were heard on the issue of whether or not documents (E31) to (E39), (E46) and (E47) should be

allowed into the procedure. According to the minutes, the Chair of the Opposition Division announced at the very beginning of the oral proceedings that documents (E1) to E27), (E29) to (E41), (E44), (E46) and (E47) were admitted into the proceedings.

12. The Board at the oral proceedings asked the parties for their recollections of whether or not the parties at the oral proceedings before the Opposition Division were heard on the issue of allowing documents (E31) to (E39), (E46) and (E47) into the procedure. Those parties, respectively their representatives who were present at the oral proceedings before the Opposition division, namely Opponents 01 and 03 (Respondents I and III) confirmed that the parties were not heard before the Chair made the announcement to allow the documents in question into the procedure.
13. Contrary to the argument presented by the Respondents it was not necessary for the Appellant to file a renewed request at the oral proceedings before the Opposition Division not to admit the documents, as this request was made in writing on 6 May 2005.
14. Respondents' argument, that a party's right to be heard is satisfied if said party, which had requested oral proceedings according to Article 116 EPC, has had the opportunity to argue in writing, cannot be followed by the Board.

If this interpretation of Article 113(1) EPC were to be followed, the parties' right to oral proceedings safeguarded by Article 116 EPC would be redundant, with the unacceptable consequence that an Opposition

Division or a Board of Appeal with regard to a controversial issue discussed during written procedure, would be entitled to give a decision on this issue right at the beginning of oral proceedings without hearing the parties (see decision T 594/00 of 6 May 2004, point (4)).

15. Moreover, the Respondents emphasised that only one of the documents in question, namely (E31), was actually referred to in the decision under appeal. Thus the decision is not therefore tainted by the disclosure in the remaining ten documents concerned.

The Board does not agree that the actual number of documents which have been referred to in the appealed decision is a factor which has decisive weight in a decision as to whether or not the Appellant's right to be heard has been violated.

16. As a consequence, the decision under appeal is based on grounds and evidence on which the Appellant has not had an opportunity to present his comments during the oral proceedings and thus contravenes the requirements of Article 113(1) EPC.
17. According to Article 11 of the Rules of Procedure of the Boards of Appeal, "[a] Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless **special reasons** present themselves for doing otherwise" (emphasis added by the Board).

When deciding whether or not to remit the case according to Article 111(1) EPC the Board examined if such **special reasons** exist in the present case.

18. According to the case law of the Boards of Appeal the violation of the principle of the right to be heard is considered as a fundamental deficiency in proceedings (see decision T 125/91 of 3 February 1992).

It is, however, also acknowledged that there is no absolute right of a party to have every aspect of a case examined in two instances (decision T 133/87 of 23 June 1988, point (2)). 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.

19. The Respondents argued that, considering the aspect of procedural efficiency, it was within the discretion of the Board, even if new evidence was submitted during the appeal procedure, to allow it into the procedure and to decide the case without remitting it to the department of first instance.

Attention was directed to decision T 416/07 of 27 March 2008 points (9) to (11), where this Board in a different composition, for reasons of procedural efficiency, had decided not to remit a case to the department of first instance but to decide itself.

In the case underlying decision T 416/07, the Board had to decide whether or not several documents submitted by the Appellant/Opponent after expiry of the time limit according to Article 99(1) EPC, should be admitted into

the procedure. Two of these documents had been filed at the oral proceedings before the department of first instance and had not been admitted into the procedure by the Opposition Division. The remaining documents had been filed with Appellant's/Opponent's grounds for appeal. The Appellant/Opponent had requested that the case be remitted to the department of first instance should all these documents not be admitted into the procedure.

The Board decided to admit the two documents submitted by the Appellant/Opponent at the oral proceedings before the Opposition Division (decision T 416/07, points (2) to (3)), but not to admit the documents submitted with its grounds for appeal (decision T 416/07, points (5) to (7)). Finally the Board decided, for reasons of procedural efficiency, not to remit the case to the department of first instance (decision T 416/07, points (9) to (11)).

As is apparent from the above the factual and procedural situation underlying decision T 416/07 is different and therefore the Board does not consider it to be relevant for the present case.

20. Since the Appellant whose right to be heard has been violated requests the remittal of the case to the first instance, in the specific situation of the present case this request has precedence over apprehensions regarding an undue delay of the procedure (see decision T 594/00, supra, point (9) of the reasons).
21. The Respondents argue that remittal to the first instance for further consideration of the question of

admissibility of documents (E31) to (E39), (E46) and (E47) would be of no practical use and would only delay the procedure and prolong the period of legal uncertainty, as the Appellant has already made its arguments in writing, which have already been dealt with by the Opposition Division in the decision under appeal and which have been found to be insufficient to make a case for the non-admission of these documents.

However, the reasoning for this decision was given in writing after the oral proceedings and is based on grounds and evidence on which the Appellant did not have an opportunity to present his comments in accordance with Article 113(1) EPC as they were not given the opportunity **at the oral proceedings** to address this issue. Thus, any argument the Appellant wanted to present in this respect at the oral proceedings, which it considered to be pertinent for the decision, could not be made, and is therefore neither dealt with nor mentioned in the decision under appeal. One cannot know if, and to which degree, the Appellant's arguments, if allowed, might have influenced the decision taken by the Opposition Division. Since the Appellant's right to be heard has been violated by the Opposition Division, being an authority of the first instance, this violation cannot be repaired by hearing the Appellants on this issue before an authority of the second instance, but only by remitting the case to the first instance (see decision T 594/00, supra, point (10) of the reasons).

This situation is not therefore one which lends itself to the application of the principle that there is no

absolute right to a party to be heard at two instances (see decision T 133/87, supra).

22. The Respondents moreover argued that the Appellant has abandoned his right to be heard by not attending the oral proceedings before the Board.

The Board cannot identify a legal basis in the EPC from which it could be concluded that a party, appealing against a decision of a department of first instance, which had been taken in violation of its right to be heard, when it does not appear at oral proceedings before the department of second instance has retrospectively abandoned its right to be heard before the department of first instance.

23. The Board concludes that there are **no special reasons** in the sense of Article 11 of the Rules of Procedure of the Boards of Appeal not to remit the case. It is emphasised that the precise and correct definition of those documents which belong to the state of the art is of utmost importance for the realization of a legally correct and reliable procedure before the departments of all instances of the EPO. Therefore, the case is remitted to the first instance for further prosecution (Article 111(1) EPC).

24. The appeal is deemed to be allowable so that this prerequisite of Rule 103(1)(a) EPC is also fulfilled. The Board considers it to be equitable by reason of the substantial procedural violation incurred to reimburse the appeal fee (Rule 103(1)(a) EPC).

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 Chair:

P. Cremona

U. Kinkeldey