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**Datasheet for the decision  
of 26 September 2011**

**Case Number:** T 0534/08 - 3.3.01

**Application Number:** 99905995.9

**Publication Number:** 1056767

**IPC:** C07J 9/00

**Language of the proceedings:** EN

**Title of invention:**

Method for the preparation of phytosterols from tall oil pitch

**Patentee:**

Forbes Medi-Tech Inc.

**Opponent:**

Raisio Nutrition Ltd.

**Headword:**

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**Relevant legal provisions:**

EPC Art. 111(2)

EPC R. 103(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Transfer of opponent status (yes): evidence for transfer of business area sufficient"

"Decision reasoned (no): summary of Party's submission does not constitute reasoning proper to the Opposition Division"

"Substantial procedural violation (yes)"

"Reimbursement of appeal fee (yes)"

"Remittal for further prosecution"

**Decisions cited:**

T 0278/00, T 1366/05

**Catchword:**

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Case Number: T 0534/08 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 26 September 2011

**Appellant:** Forbes Medi-Tech Inc.  
(Patent Proprietor) Suite 200, 750 West Pender Street  
Vancouver, British Columbia V6C 2T8 (CA)

**Representative:** Tollett, Ian  
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**Respondents:** Raisio Nutrition Ltd.  
(Opponent) Raisonkaari 55  
FIN-21200 Raisio (FI)

**Representative:** Kirsch, Susan Edith  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 14 January 2008  
revoking European patent No. 1056767 pursuant  
to Article 102(1), (3) EPC 1973.

**Composition of the Board:**

**Chairman:** P. Ranguis  
**Members:** G. Seufert  
L. Bühler

## Summary of Facts and Submissions

- I. The Appellant (Patent Proprietor) filed an appeal against the decision of the Opposition Division dated 14 January 2008 revoking European patent No. 1 056 767.
- II. Opposition was filed by the Respondent (Opponent), who requested revocation of the patent in suit in its entirety on the ground of lack of inventive step (Article 100(a) EPC).
- III. After having been summoned to oral proceedings by the Opposition Division, the Respondent with letter of 2 October 2007 requested that a new ground for opposition under Article 100(c) EPC be admitted into the proceedings, as the Appellant's main request allegedly contained amendments made during the examination of the application which contravened Articles 100(c) and 123(2) EPC. In addition, the Respondent asserted that there were amendments made during the opposition proceedings which did not comply with Article 123(2) EPC either. In this letter the Respondent referred to the following amendments:
- a) amendments made to claim 1 of the main request during examination of the application, namely:
- (1) the amendment in step (b) from "removing light ends from said modified pitch by evaporation..." to "distilling said modified pitch in a first evaporator to remove light ends" (emphasis added by the Respondent), which the Respondent considered to be an impermissible generalisation as the first evaporator

was mentioned in the application as filed in combination with a certain pressure and temperature.

(2) the amendment in step (c) from "evaporating said bottom fraction to produce a light phase distillate" to "distilling only said bottom fraction (14) in a second evaporator (15) to produce a light phase distillate" (emphasis added by the Respondent), which the Respondent did not consider to be supported, because the second evaporator in the application as filed was a specific ultra low pressure wiped film evaporator and there was no support for the term "only".

(3) the amendment in step (d) "dissolving only said light phase distillate..."; according to the Respondent the term "only" had no clear basis in the application as filed.

Further objections of unsupported amendments made during the examination of the application were raised against claims 15, 16 and 18.

b) The amendment made during the opposition proceedings in claim 1 of the main request concerned the expression "treated to remove water", which according to the Respondent was not supported by claim 6, which was said to be the basis for the amendment and which stated that the neutralized pitch was heated. Apart from heating the pitch to remove water, no other way of treatment was said to be supported by the application as filed.

Further objections of unsupported amendments made during the opposition proceedings were raised against claims 7, 8, 11, 13 and 18.

The Respondent also raised objections under Rule 80 EPC against amendments made in claims 1, 7-9, 11-13 and 18 of the main request. With letter of 2 November 2007 the Respondent also requested admission of the ground for opposition under Article 100(b) EPC into the proceedings.

- IV. With letter of 4 December 2007 the Appellant filed first and second auxiliary requests without providing further comments as to the substantive issues.
- V. Oral proceedings before the Opposition Division were held on 7 December 2007. According to the minutes, the Opposition Division apparently decided to admit the ground for opposition under Article 100(c) EPC (see minutes, point 2, last paragraph) which had been objected to by the Appellant as late filed with reference to certain decisions of the Boards of Appeal (T 1002/92 and T 339/92 as far as can be understood from the minutes). From points 3 and 4 of the minutes it is apparent that the issue of compliance with Article 123(2) and (3) EPC was discussed for the main, first and second auxiliary requests. After this discussion, the Appellant asked to file a third auxiliary request and the oral proceedings were interrupted for 30 minutes to allow the Appellant to draft its request (point 5 of the minutes), which was discussed for its compliance with Article 123(2) and (3) EPC (point 6 of the minutes). The minutes mentioned certain decisions cited by the Appellant, but otherwise did not contain any arguments provided by either party.

- VI. The Opposition Division found that
- the main request did not comply with Article 123(2) EPC
  - the first and second auxiliary requests did not comply with Article 123(2) and (3) EPC and
  - the third auxiliary request did not comply with Article 123(3) EPC.
- VII. The decision under appeal comprised in part II "Reasons for the decision" under point 1 "Main request" a section headed "Article 123(2) (Article 100(c) EPC)", which consisted of four paragraphs. The first paragraph (1) confirmed the Respondent's request and indicated that the Respondent repeated its arguments provided with letter dated 2 December 2007. The second paragraph (2) represented a short summary of the Appellant's arguments apparently as presented during oral proceedings. It referred to those parts of the application as filed where according to the Appellant support for the amendments in step (a) "saponification in water solution of an alkali metal base", the amendment "heated" to "treated" and the amendment "only" was to be found. Furthermore, with regard to replacing the expression "removing by evaporation" and "evaporating" by the word "distilling", the Appellant referred to decision G 1/93, according to which "an added feature merely excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not to be considered as subject-matter which extended beyond the content of the application as filed in the meaning of Art. 123(2) EPC". Furthermore, the Appellant considered that the expressions "removing by evaporation" and "distilling" were alternatives for the person skilled in the art. In

support for its arguments the Appellant cited decisions T 201/83 and T 582/91. The third paragraph (1.2) summarised the Respondent's reply, which consisted of a reference to the specific second evaporator and a statement "that the process had to be taken as a whole and the introduction of the term "only" made a selection of part of the process". The fourth and last paragraph (1.3) under this section represented the finding of the Opposition Division, which was worded as follows:

"1.3 The Opposition Division taking into account the arguments of both parties considered that the proposed amendments "removing by evaporation" to "distilling", "heating" to "treating" and the introduction of the term "only" contravene Art. 123(2) EPC."

Point 2 of the "Reasons" dealt with the first and second auxiliary requests and consisted of four paragraphs. Paragraph 2.1 and 2.2 referred to the amendments made by the Appellant. The third paragraph (2.3) comprised the statement that the "Opponent objected both requests under Article 123(3) and provided the same argumentation as in written, since the proposed amendments extended the protection conferred by the Patent". The last paragraph (2.4) justified the finding of the Opposition Division, which was worded as follows:

"2.4 The Opposition Division taking into account the arguments of both parties considered that the proposed amendments "distilling" to "removing by evaporation" and the deletion of "only" contravene article 123(3),



and the amendment "heating" to "treating" contravenes Art. 123(2) EPC."

The third and last point of the "Reasons" refers to the third auxiliary request. It consisted of two paragraphs (3.1 and 3.2). The first paragraph referred to the amendments made by the Appellant. The second point stated that the Respondent objected to the proposed amendments under Article 123(3) EPC. This statement is followed by the finding of the Opposition Division having the following wording:

"The Opposition Division considered that the proposed amendments "distilling" to "removing by evaporation" to "evaporating" and "treating" to "heating" and the deletion of "only" contravene article 123(3)."

The decision under appeal did not provide reasons for the Oppositions Division's decision to admit the late-filed ground for opposition and the late filed third auxiliary request.

VIII. With the statement of grounds of appeal the Appellant filed an amended main request, which still contained in claim 1 all those features which the Opposition Division decided did not comply with Article 123(2) and (3) EPC. In addition to the substantive issues addressed in the statement of grounds of appeal, the Appellant put forward that there was a substantial procedural violation by the Opposition Division, as the decision under appeal was not adequately reasoned as required by Rule 111(2) EPC. According to the Appellant, paragraphs 1.3, 2.4 and 3.2 were merely statements of the Opposition Division that certain specific terms

- contravened Article 123(2) EPC. Additionally, no reasons were provided as to why the late-filed ground for opposition under Article 100(c) was considered admissible.
- IX. With letter of 26 November 2009 the EPO was informed that the Respondent (Raisio Benecol Oy, parallel English name Raisio Benecol Ltd.) had demerged into Raisionkaaren teollisuuspuisto Oy and Intervalli Oy. Intervalli Oy was renamed Ravintoraisio Oy, whose parallel English name is Raisio Nutrition Ltd. Extracts from the relevant supporting documentation were provided. The other party received copies of the filed letter and documents. The parties were informed of the change in name of the opponent by a communication of the EPO dated 15 December 2009.
- X. In a communication pursuant to Article 110 and Rule 100(2) EPC, the Board informed the parties that it might come to the conclusion that the contested decision was inadequately reasoned contrary to the requirements of Rule 111(2) EPC which constituted a substantial procedural violation warranting remittal to the department of first instance and reimbursement of the appeal fee. The parties were asked whether under these circumstances they maintained their requests for oral proceedings.
- XI. With letter of 17 March 2011 the Appellant agreed with the preliminary opinion of the Board to reimburse the appeal fee and remit the case to the department of first instance and declared that it did not request oral proceedings in respect of this particular issue.

- XII. With letter dated 5 April 2011 the Respondent agreed with the preliminary opinion of the Board that the contested decision may be considered as inadequately reasoned and with "the preliminary opinion of the Board to remit the case to the first instance in order that the Opposition Division be requested to rectify the decision dated 14th January 2008, such that full reasons are provided with respect to why the Opposition Division came to the conclusion that the Patent does not meet the requirement of Article 100(c) EPC." Subject to remittal for such a rectification the Respondent withdrew its request for oral proceedings.
- XIII. In reply to the Respondent's letter, the Appellant with letter dated 26 April 2011 considered such a course of action, namely the retrospective provision of the reasons for the decision under appeal without reopening the debate, as a violation of its rights under Article 113(1) EPC.
- XIV. On 11 May 2011 the Board summoned the parties to oral proceedings having understood that the Respondent intended to maintain its request for oral proceedings if the Board did not order rectification of the contested decision. In a communication accompanying the summons, the Board informed the parties that if it came to the conclusion that a substantial procedural violation had occurred, the impugned decision would have to be set aside as a whole and the case would be remitted to the department of first instance for further prosecution. It would be for the first instance to decide how to continue the proceedings.

- XV. In reply to the summons the Respondent withdrew its request for oral proceedings subject to the Board remitting the case to the department of first instance.
- XVI. In reply to the summons the Appellant confirmed that it did not request oral proceedings on this issue and that, on the condition that nothing else is decided, it would not attend oral proceedings.
- XVII. On 5 August 2011 the oral proceedings were cancelled.
- XVIII. The Appellant requested that the decision under appeal be set aside, that the case be remitted to the department of first instance for further considerations of the ground for opposition under Article 100(a) EPC of the main request filed with the statement of grounds of appeal, and that the appeal fee be reimbursed.
- XIX. The Respondent requested that the appeal be dismissed or, should any of the Appellant's requests meet the requirements of Article 123(2) EPC, that the case be remitted to the department of first instance for the consideration of the grounds for opposition under Article 100(a) and (b) EPC.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Transfer of opponent status
  - 2.1 According to established case law, a transfer of the procedural status of opponent is accepted if it is

related to the transfer of the business assets in the interests of which the opposition was filed.

- 2.2 In the present case, evidence of the transfer of assets was submitted with letter dated 26 November 2009 (see point IX above). According to the demerger plan of 24 August 2007, the company Raisio Benecol Oy demerged into the companies Raisionkaeren teollisuuspuisto Oy and Intervalli Oy. Extracts from the Trade Register of the Patent and Registration Board of Finland (certified translation into English) regarding the company Raisio Benecol Oy provide evidence that its parallel English name was Raisio Benecol Ltd, in whose name the opposition was filed. It is apparent from the demerger plan that the operative business and intangible rights, such as logos and patents of the demerging company, i.e. Raisio Benecol Ltd., were to be transferred to the company Intervalli Oy (page 4, point 12.3 of the demerger plan). The second company Raisionkaeren teollisuuspuisto Oy received assets supporting the real estate service operations explicitly excluding patents. Extracts from the Trade Register of the Patent and Registration Board of Finland regarding the company Ravintoraisio Oy demonstrate that the implementation of the demerger was registered on 31 December 2007 (page 4 of the extract) and that the company Intervalli Oy has changed its name to Ravintoraisio Oy (page 5 of the extracts), whose parallel English name is Raisio Nutrition Ltd (page 1 of the extract). Accordingly, the Board considers that the extent and the validity of the transfer of assets from Raisio Benecol Ltd. to Raisio Nutrition Ltd. has been sufficiently established by the documents on file. The Board thus finds that Raisio Nutrition Ltd. has

effectively acquired the status of Opponent and Respondent. No objection was raised by the Appellant in this respect.

3. Rule 111(2) EPC

3.1 Rule 111(2) EPC stipulates that decisions of the European Patent Office which are open to appeal shall be reasoned. The purpose of this requirement is to enable the party or parties and, if an appeal is filed, the Board of Appeal to examine whether a decision taken by a department of first instance was justified or not. It is the established jurisprudence of the Boards of Appeal that, in order for a decision to be reasoned, it must contain, in logical sequence, those arguments which justify the decision. The conclusion drawn from the facts and evidence must be made clear. Therefore, all the facts, evidence and arguments which are essential to the decision must be discussed in detail (see T 278/00 OJ EPO 2003, 546, point 2 of the reasons).

3.2 It is clear from the written decision that the Opposition Division did not allow the Appellant's requests, because it considered that the main request and first and second auxiliary requests contained subject matter extending beyond the application as originally filed (Article 100(c) and 123(2) EPC) and that all three auxiliary requests extended the protection conferred by the patent as granted (Article 123(3) EPC). Thus, a reasoned decision in the present case must

a) clearly identify the amendments made starting from the application as filed, and provide reasons why these amendments, based on the Opposition Division's own

considerations, change the subject-matter in such a way that it cannot be considered as properly supported by the application as filed and why the facts, evidence and arguments brought forward by the Appellant, as the losing party, were invalid and its arguments unconvincing; and

b) identify the scope of protection of the patent in suit and the scope of protection of the Appellant's auxiliary requests and, by comparing both, provide reasons why there is subject-matter which is covered by these requests but not by the patent as granted.

3.3 In point 1, headed "Main Request", under the section "Article 123(2) (Article 100(c) EPC)", the paragraphs 1, 2 and 1.2 merely refer to the submissions of both parties. Paragraph 1 mentions that the Respondent repeated its arguments provided with letter dated 2 October 2007, a summary of which was provided in the section "Facts and submissions". Paragraphs 2 and 1.2 summarise the Appellant's submissions and the Respondent's reply and therefore, like the summary of the Respondent's written arguments, rather belongs in the section "Facts and submissions" of the written decision. None of these paragraphs reflect the Opposition Division's own considerations and findings. Accordingly, these paragraphs cannot be considered as a reasoning of the decision taken by the Opposition Division. The mere summary of a party's submission is not *per se* a reasoning proper to the deciding body (see T 1366/05, point 5 of the reasons for the decision).

The last paragraph, namely paragraph 1.3, merely consists of the statement that "the Opposition Division taking into account the arguments of both parties

considered that the proposed amendments "removing by evaporation" to "distilling", "heating" to "treating" and the introduction of the term "only" contravened Article 123(2) EPC". It does not provide any reasoning at all as to why the Opposition Division had come to this "conclusion". In particular, this paragraph fails to indicate why the parts of the application as originally filed provided by the Appellant could not support the amendments or why its arguments, which were backed up by case law, were not considered convincing. Furthermore, from the wording of the statement in point 1.3 of the written decision it is not even clear whether or not the Opposition Division entirely adopted the Respondent's arguments, or whether or not it had its own objections. The Respondent based its arguments against step (b) on an impermissible generalisation regarding the first evaporator (see point III a) above). However, the statement of the Opposition Division could also be understood as pointing in the direction that the expressions "removing by evaporation" and "distilling" were not equivalent, without however providing any reasons for this.

- 3.4 In point 2, headed "1<sup>st</sup> and 2<sup>nd</sup> Auxiliary requests", the first two paragraphs (2.1 and 2.2) refer to the amendments made to each request. Paragraph 2.3 states that the "Opponent objected to both requests under Article 123(3) EPC and provided the same argumentation as in written, since the proposed amendments extended the protection conferred by the Patent". The last paragraph, i.e. paragraph 2.4, again consists of the mere statement that "the Opposition Division taking into account the arguments of both parties considered that the proposed amendments "distilling" to "removing



by evaporation" and the deletion of "only" contravene article 123(3), and the amendment "heating" to "treating" contravenes Art. 123(2) EPC". It does not provide any reasoning at all for its findings. Moreover, the Board observes that, contrary to the Opposition Division's statement, no arguments concerning compliance with Article 123(3) EPC were provided by any of the parties during the written procedure. The minutes indicate that this issue was discussed. However, no arguments from either party are mentioned in the minutes. Neither are these arguments provided anywhere in the written decision. The Board is therefore left entirely in the dark as to how the Opposition Division came to its negative finding regarding Article 123(3) EPC.

3.5 In point 3 headed "3<sup>nd</sup> Auxiliary request" the first paragraph 3.1 refers to amendments made in the third auxiliary request. The second paragraph (3.2) merely states that the Respondent objected to the amendments under Article 123(3) EPC. This paragraph is followed by the findings of the Opposition Division that "the proposed amendments "distilling" to "removing by evaporation" to "evaporating" and "treating" to "heating" and the deletion of "only" contravene article 123(3)". Again no reasons are provided for the Opposition Division's findings. Moreover, the Board observes that in the context of the third auxiliary request the Opposition Division apparently also considered the amendment "distilling" to "evaporating" to contravene Article 123(3) EPC. This amendment is also present in the first and second auxiliary requests. However, there the Opposition Division, according to

its findings, apparently did not consider it to contravene Article 123(3) EPC.

- 3.6 Due to the above deficiencies of the decision under appeal, the reasons for the revocation of the patent in suit are opaque. The Board is left in the dark as to how the first instance came to its negative conclusion in respect of the claimed subject-matter. The Board therefore concludes that the decision under appeal is not reasoned within the meaning of Rule 111(2) EPC.
- 3.7 The failure to provide a reasoned decision amounts to a substantial procedural violation requiring the decision under appeal to be set aside and the case to be remitted to the department of first instance. The appeal is thus deemed to be allowable, and the Board considers it equitable by reason of that substantial procedural violation to reimburse the appeal fee in the present case (Rule 103(1) EPC).
- 3.8 None of the parties requested oral proceedings, subject to the case being remitted to the department of first instance. Accordingly, oral proceedings are not necessary.

**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 request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis