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**Datasheet for the decision
of 23 March 2009**

Case Number: T 0616/08 - 3.3.04

Application Number: 98935212.5

Publication Number: 1017848

IPC: C12Q 1/68

Language of the proceedings: EN

Title of invention:
Nucleic acid sequence analysis

Patentee:
Medical Biosystems Ltd.

Opponent:
STRAWMAN LIMITED

Headword:
Sequence analysis/MEDICAL BIOSYSTEMS

Relevant legal provisions:
EPC Art. 111(1)
EPC R. 103(1)(a)
RPBA Art. 11

Keyword:
"Transitional provisions of the EPC 2000,
substantial procedural violation - (yes),
remittal - (yes), reimbursement of the appeal fee - (yes)"

Decisions cited:
G 0001/97, J 0005/91, J 0032/95, J 0003/06, J 0010/07,
T 0833/90, T 1366/04

Catchword:
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Case Number: T 0616/08 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 23 March 2009

Appellant: Medical Biosystems Ltd.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24 January 2008
rejecting the opposition filed against European
patent No. 1017848 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chair: U. Kinkeldey
Members: F. Blumer
M. Wieser

Summary of Facts and Submissions

- I. The appeal was lodged by the Patent Proprietor (Appellant) against the decision of the Opposition Division posted on 24 January 2008 concerning European patent No. 1 017 848.

- II. The front sheet of the decision under appeal (EPO form 2330) states that it has been decided to reject the opposition according to Article 101(2) EPC, whereas point (8), on page 4 of the appealed decision reads: "Bearing in mind the arguments presented above, it is decided that the patent should be maintained in amended form based upon AR1."

- III. The Appellant filed a notice of appeal in a letter dated 26 March 2008, received at the EPO on 27 March 2008, in which he requested "... that the decision of the Opposition Division to refuse the Main Request is set aside and that the patent be maintained on the basis of the Main Request."

- IV. On 31 March 2008, the Formalities Officer of the Opposition Division contacted the Appellant's Representative by telephone and informed him that there was a discrepancy between the text of the decision and the decision indicated on EPO form 2330. The Representative was further informed "...that no amended description relating to the claims of auxiliary request 1 had either been submitted nor agreed" and that his notice of appeal had been forwarded to the Board of Appeal.

- V. The Appellant and the Opponent (Respondent) were informed in a letter dated 3 April 2008 of the commencement of proceedings before the Board of Appeal.
- VI. The Respondent, in a letter dated 15 April 2008, requested that the decision of the Opposition Division be corrected according to Rule 140 EPC because it contained an obvious mistake. The correction should take place before the substance of the appeal was considered by the Board of Appeal.
- VII. In a letter dated 23 May 2008, the Appellant submitted the grounds for appeal. As a preliminary point he remarked that he considered that the appealed decision, namely that the opposition had been rejected, to contain an obvious mistake and that it was the intention of the Opposition Division to maintain the patent on the basis of auxiliary request 1. His submissions (the grounds for appeal) were based on this understanding.

The Appellant requested the Board to set aside the decision under appeal and to maintain the patent on the basis of the main request. Oral proceedings were requested as an auxiliary measure.

- VIII. The Board expressed its preliminary opinion in a communication dated 23 September 2008.
- IX. In a letter dated 2 October 2008, the Respondent requested the Board to remit the case to the department of first instance for further prosecution.

The Appellant requested the Board in a letter dated 7 November 2008 to set aside the decision under appeal,

to reimburse the appeal fee and to remit the case to the department of first instance for further prosecution.

Reasons for the decision

Substantial procedural violation and remittal to the department of first instance - Article 111(1) EPC and Article 11 of the Rules of Procedure of the Boards of Appeal

1. The front sheet of the decision under appeal (EPO form 2330) states that it has been decided to reject the opposition according to Article 101(2) EPC, whereas point (8), on page 4 reads: "Bearing in mind the arguments presented above, it is decided that the patent should be maintained in amended form based upon AR1."
2. Besides this inconsistency, the Board notes a further shortcoming in the decision under appeal.

In point (3.1) of the decision, it was decided that the patent did not disclose the invention according to claim 1 of the main request in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 83 EPC). The reason for this was that claim 1 of the main request was considered to miss an essential feature of the invention, which made it impossible to carry out the claimed method over the entire scope covered by the claim.

However, this essential technical feature, namely that the nucleotides used contained a blocking group at their 3' end, was contained in claim 1 of auxiliary request 1. Consequently, the Opposition Division decided that the

requirements of Article 83 EPC were met by this request (see point (3.2) of the decision).

Nevertheless, the critical feature is still indicated in paragraph [0010] of the granted patent as being purely optional.

The decision under appeal does not contain any comment with regard to the description that should be maintained together with the claims of auxiliary request 1. The only version of the description on file, the description as granted, is not in line with the subject-matter of the claims of auxiliary request 1.

3. The decision under appeal contains obvious mistakes. As a result of the contradiction between the cover sheet and the reasoning (see point (1) above) and of the unclear situation concerning the description (see point (2) above) partly there exists a confusing situation as to which is adversely affected by the decision and thus entitled to appeal.

In a situation where it is unclear whether the Appellant is adversely affected, the Board has to decide in favour of the admissibility of the appeal (see T 833/90 of 19 May 1994, point (1)).

4. The obvious mistakes, which cause the decision under appeal to be contradictory and legally obscure, are considered to represent substantial procedural violations.

As foreseen in cases where substantial procedural violations are apparent in the first instance

proceedings, the Board decides to remit the case to the department of first instance for further prosecution (Article 111(1) EPC and Article 11 of the Rules of Procedure of the Boards of Appeal).

Reimbursement of the appeal fee - Applicability of Rule 67 EPC 1973 or Rule 103(1)(a) EPC 2000

5. Under Article 1 Nos. 1-82 of the Act revising the EPC of 29 November 2000 ("Revision Act"), the EPC 1973 has been extensively revised through the amendment of 72 Articles, the deletion of 17 Articles and the insertion of 7 new Articles. Under the heading "Transitional Provisions", Article 7(1) Revision Act provides as follows: *"The revised version of the Convention shall apply to all European patent applications filed after its entry into force, as well as to all patents granted in respect of such applications. It shall not apply to European patents already granted at the time of its entry into force, or to European patent applications pending at that time, unless otherwise decided by the Administrative Council of the European Patent Organisation"*. Article 7(2) authorised the Administrative Council to take a decision under Article 7(1) no later than 30 June 2001. Under Article 3 Revision Act, the Administrative Council was furthermore authorised to draw up, at the proposal of the President of the European Patent Office, a new text of the European Patent Convention. The new wording of the provisions of the Convention should, in particular, be aligned in the three official languages (see the explanatory remarks to the new text of the EPC in OJ EPO Special Edition No. 4/2001, 54). Both the new text adopted under Article 3 Revision Act and the decision of

the Administrative Council on transitional provisions taken under Article 7(2) Revision Act should become an integral part of the Revision Act (Article 3(2), 7(2) Revision Act).

6. Article 7(2) Revision Act was implemented by the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the European Patent Convention of 29 November 2000 ("Transitional Provisions", OJ EPO Special Edition No. 1/2003, 203). In the document submitted to the Administrative Council together with the proposed Transitional Provisions, the basic principle underlying the proposed provisions is summarised as follows: *"These transitional arrangements are designed to ensure that, after the entry into force of the revised version of the EPC, **the provisions applied in proceedings before the European Patent Office are as uniform as possible, and that the provisions will quickly take effect in practice. The use of different versions of the EPC over a prolonged period is to be avoided.** This is equally important to the Office and to users of the European patent system"* (CA/25/01, para. 5, emphasis added by the Board).

7. The Transitional Provisions (as issued under Article 7 Revision Act) only refer to Articles of the EPC which have been amended or newly introduced through the Revision Act (see the introduction of Article 1 Transitional Provisions: *"... the following transitional provisions shall apply to the **amended and new** provisions of the European Patent Convention specified below"*, emphasis added by the Board). The Transitional Provisions list a number of EPC 2000 Articles which

apply to European patent applications pending at the time of the entry into force of the EPC 2000 and to European patents already granted at that time, or for which special rules apply (Article 1 Nos. 1-6). In the published "explanatory remarks", other application- or patent-related Articles amended under the Revision Act are listed which, under Article 7(1), first sentence, Revision Act, only apply to European patent applications filed after the cut-off date (explanatory remarks, No. 16 indent 2, OJ EPO Special Edition No. 1/2003, 204, 207). As a result there is clarity with respect to all EPC 2000 Articles referred to in Article 1 Revision Act. They are either (i) specifically referred to in Article 1 Transitional Provisions as being applicable to applications filed before the entry into force of the EPC 2000, or (ii) they are (*e contrario*) applicable only to applications filed after the entry into force of the EPC 2000 or (iii) they are purely organisational and institutional provisions which are applicable upon entry into force of the EPC 2000 (explanatory remarks, No. 16 indent 3, OJ EPO Special Edition No. 1/2003, 204, 208). On the other hand, neither the Transitional Provisions nor the explanatory remarks refer to any EPC Article which has not been referred to in Article 1 Revision Act (see also the table on the transitional provisions of the EPC 2000 in OJ EPO Special Edition No. 1/2007, 211). The limited scope of the Transitional Provisions (addressing only EPC Articles amended or added under Article 1 Revision Act) does not, in the Board's view, allow any direct conclusions to be drawn with respect to the applicability of any Articles of the EPC 2000 not referred to in Article 1 Revision Act in the Board's view (see below point (12)).

8. Together with the decision on the Transitional Provisions, the Administrative Council decided to adopt the "new text of the European Patent Convention" as prepared under Article 3 Revision Act (see above point (5)). The alignment of the text under Article 3 Revision Act affected the wording of the vast majority of all Articles of the EPC 2000 in one or more language versions, including Articles introduced or amended through Article 1 Revision Act (see the synoptic presentation in document CA/26/01). Said decision to adopt the new text entered into force upon entry into force of the EPC 2000 (Decision of the Administrative Council of 28 June 2001 adopting the new text of the European Patent Convention, OJ EPO Special Edition No. 4/2001, 55, Article 2). The decision of the Administrative Council does not include further transitional provisions. However, the link between the entry into force of the aligned text of the EPC 2000 and the entry into force of the EPC 2000 can only mean that the aligned text is applicable to the extent that the respective provisions of the EPC 2000 are applicable. In the Board's view, no conclusions can be drawn from the alignment of the EPC 2000 under Article 3 Revision Act for the resolution of transitional law issues. If an Article of the EPC 2000 applies, the aligned version applies. If an Article of the EPC 1973 applies, any alignments made under Article 3 Revision Act are not to be considered.
9. For EPC Articles that have not been amended through Article 1 Revision Act (i.e. that which have only been aligned under Article 3 Revision Act or that have not been amended at all), transitional provisions may appear to be unnecessary as no material changes to such

Articles were intended. However, even for such Articles it may be relevant whether the EPC 1973 version or the EPC 2000 version applies. On the one hand, there must be certainty about the relevant wording of any applied provision, as the precise wording is the basis of any interpretation. On the other hand, Rules of the Implementing Regulations may have changed which implement unchanged Articles of the EPC. In such cases, the applicability of the revised or new Rules may depend on the applicability of the relevant Article(s) of the revised Convention (see below point (13)). The latter effect was probably not foreseeable when the Transitional Provisions were implemented in 2001 as the transitional provision related to the Implementing Regulations was enacted in 2006 only (see below point (13)).

10. For the EPC Articles not referred to in Article 1 Revision Act (i.e. the Articles which have only been aligned under Article 3 Revision Act or which have not been amended at all), it is not clear whether Article 7 ("Transitional Provisions"), including the authorisation of the Administrative Council to issue transitional provisions, is applicable at all, as Article 7(1) Revision Act refers to the *"revised version of the Convention"*. If Article 7(1) Revision Act was meant to refer to revised Articles only, there would be no transitional provisions for the other Articles and no authorisation for the Administrative Council to issue such provisions. In the absence of transitional provisions, the revised text would apply in accordance with the general rule of Article 8 Revision Act, under which *"[t]he revised text of the European Patent Convention"* entered into force on 13 December 2007.

However, the Board tends to interpret the reference to the "*revised version of the Convention*" in Article 7(1) Revision Act as a reference to the entire EPC 2000. According to this interpretation, any issues related to the application of the old or the revised version of any EPC Article are governed by Article 7 Revision Act exclusively (for the functions of Articles 7 and 8 Revision Act see also U. Joos, GRUR Int. 2008, 662, section II).

11. The Transitional Provisions as issued by the Administrative Council under Article 7(2) Revision Act only apply "*to the **amended and new provisions** of the European Patent Convention **specified below***" (introduction to Article 1 Transitional Provisions, emphasis added by the Board). It is unclear whether the Administrative Council considered itself authorised to issue transitional provisions for the EPC Articles which have only been aligned under Article 3 Revision Act or which have not been revised at all. It is also unclear whether the Administrative Council saw any need for such transitional provisions. What is clear, however, is that the Transitional Provisions issued by the Administrative Council do not refer to the Articles not referred to in Article 1 Revision Act (see above point (7)).

12. According to the literal wording of Article 7(1) Transitional Provisions, the revised version of all EPC Articles not mentioned in the Transitional Provisions issued under Article 7(2) would not apply to applications filed before the cut-off date - regardless of whether or not such Articles were amended under Article 1 Revision Act. The Legal Board of Appeal in its decision J 10/07 (OJ EPO 2008, 567) concluded from said

provisions, *inter alia*, that Articles 107 and 111 EPC 1973 should be applied in connection with applications filed before the cut-off date (see points (1.1) and (6)). The continued application of all EPC 1973 Articles which have not been addressed in the Transitional Provisions, on the other hand, appears not to be in line with the legislators' objectives that the revised provisions should quickly take effect in practice and that the use of different versions of the EPC over a prolonged period should be avoided (see above point (6)). There appear to be conflicts between the literal wording of the legal provisions and the manifest intent of the legislator at least with respect to the EPC Articles not referred to in Article 1 Revision Act. For all EPC Articles mentioned in Article 1 Revision Act, the legislators have explained their understanding of the Transitional Provisions (see above point (7); OJ EPO Special Edition No. 1/2003, 204). Any EPC Article amended under Article 1 Revision Act but not listed in the Transitional Provisions has to be applied in the 1973 version unless it is of a purely institutional or organisational nature (see above point (7)). For the EPC Articles not addressed in Article 1 Revision Act, the situation is different. These Articles are not addressed in the Transitional Provisions (see above point (7)), even though, in the Board's view, the Administrative Council was authorised to consider these Articles in any decision taken under Article 7(2) Revision Act (see above point (10)). The reasons why said EPC Articles were not addressed in the Transitional Provisions, and even excluded from their scope, are unclear (see above point (11)). Any assumption that the drafters of the Transitional Provisions intended to rely on the general rule of Article 7(1), second sentence, Transitional

Provisions would be in clear conflict with the expressed intent of the same legislators that the revised provisions should quickly take effect and that the use of different versions of the EPC over a prolonged period should be avoided (see above point (6)). Such assumption would also imply that the drafters of the Transitional Provisions, by calling for the early application of as many EPC 2000 Articles as possible where these Articles were addressed in Article 1 Revision Act and by avoiding the early application of all other EPC 2000 Articles, accepted inconsistencies within the transitional rules (while the parties to the Revision Act presumably expected consistent transitional provisions for the entire EPC 2000 to be issued under Article 7 Revision Act). In the Board's view, no certain conclusions can be drawn from the Revision Act and the Transitional Provisions with respect to the applicability of EPC 2000 Articles that have not been revised under Article 1 Revision Act in proceedings related to patent applications filed before the entry into force of the EPC 2000. The Legal Board of Appeal in its decision J 10/07 (OJ EPO 2008, 567) chose, with regard to specific EPC Articles not referred to in Article 1 Revision Act, to apply the strict literal meaning of Article 7(1) Revision Act (see above point (12), second sentence). For the reasons set out above, this Board considers that, to the extent that it is relevant whether the old or the new version of any Article not mentioned in Article 1 Revision Act is applicable in proceedings related to European patent applications filed before the cut-off date, and in the absence of any specific provision, there may exist a "gap in the law" or "*lacuna*" ("*Gesetzeslücke*") which must be closed by case law, considering the existing legislation and the

manifest intent of the legislators, and aiming at a reasonable result which is equitable for all parties concerned (G 1/97, OJ EPO 2000, 322, point 3b, J 5/91, OJ EPO 1993, 657, point 5.4; J 32/95, OJ EPO 1999, 713, point 2.4).

13. Under the "Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000" (OJ EPO Special Edition 1/2007, 89), the text of the Implementing Regulations to the EPC 2000 was adopted. According to Article 2 of said decision, "*[t]he Implementing Regulations to the EPC 2000 shall apply to all European patent applications, European patents, decisions of departments of the European Patent Office and international applications, **in so far as the foregoing are subject to the provisions of the EPC 2000***" (emphasis added by the Board). This single transitional provision for the Implementing Regulations apparently means that any Rule (or part of a Rule) of the EPC 2000 is applicable if the Article or Articles of the EPC 2000 addressing the same subject-matter is/are applicable or which is/are further implemented by the relevant Rule (or provision within a Rule). To determine whether the old or the new version of any provision of the Implementing Regulations is applicable, such provision first needs to be attributed to the pertinent Article(s) of the Convention (see J 10/07, OJ EPO 2008, 567, point 1.3; J 3/06 of 17 December 2007 (to be published), point 3).

14. For the reimbursement of the appeal fee in the present case, either Rule 67 EPC 1973 or Rule 103 EPC 2000 is applicable. These Rules further implement the provisions

on appeals proceedings in Articles 106 to 111 EPC. Of these provisions, Articles 106, 108 and 110 EPC 2000 (all of them revised under Article 1 Revision Act) are mentioned in Article 1 No. 1 Transitional Provisions as being applicable to European patent applications pending at the time of their entry into force and to European patents already granted at that time. The decision under appeal was notified and the appeal was filed after the entry into force of the EPC 2000 (in contrast to the facts underlying J 10/07, OJ EPO 2008, 567). In view of the Transitional Provisions and taking into account the principle that any procedural steps should be governed by the law valid at the point in time when the procedural step is taken or due to be taken (*tempus regit actum*; see, for example, T 1366/04 of 16 April 2008), Articles 106, 108 and 110 EPC 2000 apply to appeal proceedings initiated after the entry into force of the EPC 2000 even if the underlying patent application was filed before that date.

15. The other Articles related to appeal proceedings (i.e. Articles 107, 109 and 111) are not mentioned in the Transitional Provisions. All of these Articles have been aligned under Article 3 Revision Act but not revised under Article 1 Revision Act. Nothing indicates that the legislators intended to provide for parallel application of Articles 106, 108 and 110 EPC 2000 on the one hand and Articles 107, 109 and 111 EPC 1973 on the other hand in the course of the same appeals proceedings. On the contrary, it appears that the authors of the Transitional Provisions, going through the Articles revised under Article 1 Revision Act, decided for all such Articles related to appeal proceedings (i.e. Articles 106, 108 and 110) that the new version should

be used in cases related to applications filed before the cut-off date.

16. To the extent that it is relevant whether the aligned or the original version of a Rule applies and since various (amended and renumbered) Rules of the Implementing Regulations may be viewed as implementing provisions of Articles 107, 109 and 111 (in particular, Rules 100 to 103 EPC 2000), there is a gap in the law which needs to be closed by case law as long as the legislator is not active (see above point (12)). In view of the purpose of the Transitional Provisions (namely, to avoid the use of different versions of the EPC over a prolonged period, see above point (6)) and taking into account the fact that nothing indicates any intention to use new and old versions of Articles covering appeal proceedings in parallel, the Board will apply Articles 107, 109 and 111 EPC 2000 (in the version aligned under Article 3 Revision Act, see above point 8) where Articles 106, 108 and 110 EPC 2000 are applicable.
17. Thus, if Articles 106 to 111 EPC 2000 are applicable in appeal proceedings related to applications filed before the entry into force of the EPC 2000, Rule 103 EPC is applicable for the reimbursement of appeal fees, regardless of whether the Rule on the reimbursement of appeal fees is attributed to Article 108, 109 or 111 EPC. The application of Rule 103(1)(a) EPC 2000 would, in the present case, lead to the same result as the application of Rule 67 EPC 1973.
18. The appeal fee will therefore be reimbursed as a consequence of the substantial procedural violations described above (points (1) to (4)).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The appeal fee is reimbursed.
3. The case is remitted to the department of first instance for further prosecution.

Registrar:

Chair:

P. Cremona

U. Kinkeldey