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**Datasheet for the decision  
of 2 February 2011**

**Case Number:** T 1349/10 - 3.3.10

**Application Number:** 03747449.1

**Publication Number:** 1501559

**IPC:** A61L 17/04

**Language of the proceedings:** EN

**Title of invention:**

Surgical thread and surgical implant with the same

**Patentee:**

Ethicon GmbH

**Opponent:**

Aesculap AG

**Headword:**

Composition of Opposition Division/ETHICON

**Relevant legal provisions:**

EPC Art. 19(2), 111(1)

EPC R. 103(1)(a)

**Keyword:**

"Chairman of Opposition division having participated in  
examination proceedings"

"Relevance of parties' position to defective composition of  
Opposition Division (no)"

"Substantial procedural violation (yes) - Remittal (yes) -  
Reimbursement of appeal fee (yes)"

**Decisions cited:**

T 0251/88, T 0939/91, T 0382/92, T 0476/95, T 0838/02



Case Number: T 1349/10 - 3.3.10

**DECISION**  
of the Technical Board of Appeal 3.3.10  
of 2 February 2011

**Appellant 1:** Aesculap AG  
(Opponent) Am Aesculap-Platz  
78532 Tuttlingen/Donau (DE)

**Representative:** Patentanwälte  
Ruff, Wilhelm, Beier, Dauster & Partner  
Kronenstrasse 30  
70174 Stuttgart (DE)

**Appellant 2:** Ethicon GmbH  
(Proprietor) Robert-Koch-Strasse 1  
22851 Norderstedt (DE)

**Representative:** Mercer, Christopher Paul  
Carpmaels & Ransford  
One Southampton Row  
London WC1B 5HA (UK)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 7 April 2010  
concerning maintenance of European patent  
no. 1501559 in amended form.

**Composition of the Board:**

**Chairman:** P. Gryczka  
**Members:** J.-C. Schmid  
F. Blumer

## Summary of Facts and Submissions

- I. European patent No. 1 501 559 was granted on the basis of European patent application No. 03747449.1. The mention of the grant of the patent was published on 13 June 2007. The decision to grant said patent was signed, *inter alia*, by Mr M. as second examiner.
- II. Opposition was filed on 13 March 2008. In its interlocutory decision of 7 April 2010, the Opposition Division maintained the patent in amended form. Mr M. was presiding the Opposition Division and signed said interlocutory decision as Chairman.
- III. On 21 May 2010, the Opponent (Appellant 1) filed a notice of appeal and paid the appeal fee. On 15 June 2010, the Proprietor (Appellant 2) filed a notice of appeal and paid the appeal fee. The statements setting out the grounds of appeal were filed on 6 August 2010 and on 17 August 2010, respectively.
- IV. Appellant 1 requested that the decision under appeal be set aside and that the patent be revoked. Appellant 2 requested that the decision under appeal be set aside and that the patent be maintained as granted, or, subsidiarily, that the patent be maintained on the basis of any of auxiliary requests 1 to 4 as filed with letter of 17 August 2010. Both appellants requested oral proceedings as an auxiliary measure.
- V. In a communication posted on 5 November 2010, the Board observed that the composition of the Opposition Division did not satisfy the requirements of Article 19(2) EPC since one of the members of the Examining Division which granted the patent-in-suit was

also the Chairman of the Opposition Division. The Board indicated that it intended to remit the case to the department of first instance and to reimburse the appeal fee because the faulty constitution of the Opposition Division was a substantial procedural violation.

- VI. In their letters of 17 November 2010 and 22 November 2010, respectively, the appellants stated that they did not maintain their request for oral proceedings should the Board remit the case to the department of first instance and order the reimbursement of the appeal fee. In addition, Appellant 1 requested that any possible future oral proceedings before the Opposition Division be held in Munich, not in The Hague. This was contested by Appellant 2 who, furthermore, in its letter dated 11 January 2011 requested oral proceedings before the Opposition Division after remittal as an auxiliary request.

### **Reasons for the Decision**

1. The appeals are admissible.
2. Under Article 9(2) EPC, "[a]n Opposition Division shall consist of three technically qualified examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for the grant of the European patent may not be the Chairman." (emphasis added)

3. In the present case, the Chairman of the Opposition Division had taken part in the proceedings for the grant of the opposed patent when he signed Form 2035.4 (dated 14 December 2006) which established the text of the patent to be granted. For this reason, the composition of the Opposition Division violated Article 19(2), second sentence, EPC.
4. Violations of Article 19(2) EPC are considered to be substantial procedural violations which led to a remittal of the case under Article 111(1) EPC and to the reimbursement of the appeal fee in several cases (see decisions T 251/88, T 939/91, T 382/92, T 476/95, T 838/02, none of them published in the OJ EPO).
5. The Board is aware that in two of the cases mentioned above (T 251/88 and T 838/02), the boards asked the appellant or all parties whether they invoked the procedural violation before they decided on the remittal. In both cases, the patent had been revoked by the Opposition Division. In the judgment of this Board, violations of Article 19(2) EPC should lead to a remittal regardless of the parties' position at least in situations where third parties are affected by the outcome of the defective first instance proceedings, like in the present case where the patent was maintained in the opposition proceedings.
6. The decision under appeal therefore has to be set aside and the case has to be remitted to the department of first instance.
7. The requests of Appellant 1 with regard to the location of possible oral proceedings before the Opposition

Division after remittal of the case and the auxiliary request of Appellant 2 for oral proceedings relate to issues that have to be decided by the Opposition Division and should therefore be addressed to the Opposition Division.

**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 appeal fees are reimbursed.

The registrar:

The chairman:

C. Rodríguez Rodríguez

P. Gryczka