

Publication in the Official Journal Yes / No

File Number: T 205/89 - 3.2.2  
Application No.: 80 106 114.4  
Publication No.: 0 026 940  
Title of invention: Syringe and gasket therefor.

Classification: A61M 5/315

D E C I S I O N  
of 21 August 1991

Proprietor of the patent: Terumo Corporation  
Opponents: 01: West Pharmarubber Ltd  
02: Becton, Dickinson and Company

Headword:

EPC Rule 84

Keyword: "Request for extension of time limits - omitted consideration of same - substantial procedural violation"

Headnote



Case Number : T 205/89 - 3.2.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.2  
of 21 August 1991

**Appellant :**  
(Proprietor of the patent)                      Terumo Corporation  
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**Respondents :**                                      West Pharmarubber Ltd  
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**Representative :**                                      Schmitt & Maucher  
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**Decision under appeal :**

**Decision of Opposition Division of the European  
Patent Office of 12 January 1989 revoking  
European patent No. 0 026 940 pursuant to Article  
102(1) EPC.**

**Composition of the Board :**

**Chairman :** G. Szabo  
**Members :** C. Gérardin  
L. Mancini

## Summary of Facts and Submissions

- I. The mention of the grant of the patent No. 26 940 in respect of European patent application No. 80 106 114.4 filed on 8 October 1980 was published on 23 May 1984.
- II. Two Notices of Opposition were filed on 15 February 1985 and 19 February 1985, respectively, against the grant of the patent on the grounds of lack of novelty and inventive step (Article 100(a) EPC) as well as insufficient disclosure within the meaning of Article 100(b) EPC.
- III. In the course of opposition proceedings the Proprietor of the patent was invited by a Communication dated 26 May 1988 to file observations within a period of 3 months on the written statements by Opponent 2 submitted on 7 January 1988 and 28 March 1988.

By letter of 16 August 1988 the Proprietor of the patent requested that the term of filing a reply be extended by 2 months, thus to a total of 5 months to 26 October 1988. This extension of the time limit was duly granted by a communication dated 25 August 1988.

- IV. On 12 January 1989 the Opposition Division issued the decision of revocation of the patent for non-compliance with the requirements of Article 100(b) EPC.

The opposition file shows that a substantive reply was submitted by the Proprietor of the patent on 4 January 1989 together with an amended Claim 1, but only reached the file after the above decision had been issued.

- V. The Proprietor of the patent (Appellant) thereafter filed a Notice of Appeal on 10 March 1989 and paid the prescribed fee at the same time.

In the Statement of Grounds of Appeal filed on 11 April 1989 the Appellant (a) first put forward that the amended Claim 1 and the substantive arguments submitted on 4 January 1989 had not been considered in the decision issued on 12 January 1989, and (b) further referred to his letter dated 17 October 1988, wherein it was requested that the term for filing a reply to the communication of 26 May 1988 be further extended by 2 months, i.e. to a total of 7 months. For both reasons the Opposition Division was not entitled to issue an adverse decision.

V. On 26 September 1989 Respondent 2 (Opponent 2) filed a Counterstatement of Appeal wherein the previous objections under Article 100(a) and (b) EPC were maintained against the wording of Claim 1 as filed on 4 January 1989.

VI. The Appellant requested that the decision under appeal be rescinded, the patent be maintained on the basis of Claim 1 filed on 4 January 1989 as well as the reimbursement of the appeal fee.

The Respondent requested that the appeal be dismissed.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In the Board's interpretation, the Respondent's request to dismiss the appeal can only concern the factual issues raised by the Appellant in the Statement of Grounds of Appeal. This clearly appears from the introduction of the Respondent's counterstatement, wherein it is explicitly specified that no useful comment could be made on the

circumstances whereby the reply of 4 January 1989 was not considered by the Opposition Division in the decision issued on 12 January 1989. Since the present decision shall only deal with the factual aspects of the procedure which led to the decision of revocation of the patent in suit, the conditional request for oral proceedings in Respondent's counterstatement does not have to be considered essential.

3. In support of his argument that a further extension of time limit had been requested on 17 October 1988, the Appellant filed a copy of the form 1037 whereon the signs M17.10.88 resulting from the perforation of the original document appear quite legibly. According to prevailing practice by Formalities Officers the form 1037 is normally filled out and sent by a party together with subsequently filed items for patent applications or patents, but never itself incorporated in the official file. The printed text on this form shows that the latter is in fact an acknowledgement of receipt at the EPO on which the various items are identified in three columns; whilst the application or patent number and name of the Applicant or Patentee are indicated on the first two columns, the third is reserved to specify the nature of the items, which can be a substantive reply, a cheque together with the amount thereof, or the translation of granted claims into the other two official languages.
  
4. In the present case, the patent in suit is identified on the form 1037 by the number of the corresponding original application and the name of the Appellant; the nature of the item is specified as a "request for extension of term". There is thus no doubt that a proper request in that sense was actually filed on 17 October 1988, but not dealt with by the Formalities Section by incorporating it

in the official file, as done with the first request of 16 August 1988 and by informing the Appellant that the extension of time limit pursuant to Rule 84 EPC had been granted, as shown in form 2091 of 25 August 1988, or, as the case may be, rejected. In the absence of any reaction from the Office in due time before the expiry of the existing term on 26 October 1988, the Appellant could assume that this implied the extension to 26 December 1988, i.e. until the 6 January 1989 including the compulsory 10 days' grace.

It follows that, under these circumstances, the issuance of the decision of revocation of the patent in suit was not due to a procedural violation of the Opposition Division, which could reasonably assume that no further submissions would be filed by the Appellant, but to an oversight of the Formalities Section, whereby the Appellant's request has been left unanswered and without due handling.

5. In the Board's judgment, the failure by the Formalities Section to deal properly with the Appellant's request of 17 October 1988 which caused the revocation of the patent in suit, amounts to a substantial procedural violation on its part; the reimbursement of the appeal fee under Rule 67 EPC is thus regarded as equitable.

#### Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.

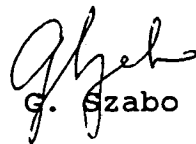
2. The case is remitted to the Opposition Division for further prosecution with inclusion of Claim 1 filed on 4 January 1989.
3. The appeal fee shall be reimbursed to the Appellant.

The Registrar:



N. Maslin

The Chairman:



G. Szabo

CG

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