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D E C I S I O N
of 1 December 1994

Case Number: T 0731/93 - 3.3.1

Application Number: 84106343.1

Publication Number: 0131147

IPC: C07D 499/68

Language of the proceedings: EN

Title of invention:
Crystalline amoxicillin salt

Patentee:
BEECHAM GROUP PLC

Opponent:
Gist-Brocades N.V.

Headword:
Further oral proceedings/BEECHAM

Relevant legal provisions:
EPC Art. 116(1), 111(1)

Keyword:
"Request for further oral proceedings refused, despite change
in the "subject" of the proceedings - substantial procedural
violation"
"Remittal without consideration of the case on its merits"

Decisions cited:

Catchword:



Case Number: T 0731/93 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 1 December 1994

Appellant:
(Proprietor of the patent) BEECHAM GROUP PLC
Beecham House
Great West Road
Brentford
Middlesex TW8 9BD (GB)

Representative:
Tyrrell, Arthur William Russell, Dr.
SmithKline Beecham plc
Corporate Intellectual Property
SB House
Great West Road
Brentford, Middlesex TW8 9BD (GB)

Respondent:
(Opponent) Gist-brocades N.V.
Wateringseweg 1
NL-2611 XT Delft (NL)

Representative:
Visser-Luirink, Gesina (NL)
Gist-brocades N.V.
Patents and Trademarks Department
Wateringseweg 1
P.O. Box 1
NL-2600 MA Delft (NL)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 3 June 1993 revoking
European patent No. 0 131 147 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: A. I. A. Jahn
Members: R. K. Spangenberg
J. A. Stephens-Ofner

Summary of Facts and Submissions

I. An opposition to the grant of European patent No. 0 131 147 had been launched, requesting the revocation of the patent for want of sufficiency (Article 100(b) and Article 83 EPC). The technical support for this opposition consisted of experimental evidence designed to show that it was impossible to prepare the compounds as claimed in the patent. The Patentee filed experimental evidence in rebuttal of the Opponent's evidence.

II. On 3 May 1991 the Opposition Division issued an invitation to oral proceedings and at the same time expressed its opinion that the Opponent had provided sufficient experimental evidence to cast serious doubts upon the validity of the patent. A summons to oral proceedings was then issued on 4 June 1991, which summons also invited the production of further experimental evidence by the Patentee.

On 22 August and 2 September 1991 the Patentee did file further experimental evidence, together with a new set of claims by way of auxiliary request. The Opponent objected to the submittal of this late-filed evidence and indicated his inability to deal with it in the time available. On 18 September 1991 oral proceedings were held, in the course of which the Opposition Division considered this late-filed evidence to be highly relevant, and gave the Opponent eight weeks to submit evidence in rebuttal. Since no decision could be reached on the substantive issue, i.e. the sufficiency of the patent, during the course of those oral proceedings, the Opposition Division expressed its intention to continue the procedure in writing, a course of action with which both parties concurred.

III. On 3 December 1991 the Opponent reported his repeated failure to carry out the invention as claimed in Claim 1. On 10 March 1992 the Patentee put forward a number of technical suggestions in order to secure success. Both parties went on to file further submissions, with the Opponent requesting further oral proceedings in case the patent were maintained partially or in its entirety, and the Patentee requesting oral proceedings in case the patent in suit were to be revoked. Both requests were expressly maintained after the Opposition Division had informed the parties of its intention not to appoint further oral proceedings.

By a written decision issued 3 June 1993, the Opposition Division revoked the patent for want of sufficiency under Articles 100(b) and 83 EPC, stating in paragraph 2 of the Reasons for the Decision as follows:

"The parties if unsuccessful applied for further oral proceedings. The Opposition Division stressed already the point at the end of the oral proceedings held on 18 September 1991 that the procedure will be resumed in writing after the Opponent replied to the Patentee's late-filed submission. After having had several possibilities to react on the present case, it is not expected that further relevant evidence can be produced during another oral proceedings; it is therefore considered that the case is ready for decision."

IV. An appeal against the above decision was filed on 5 August 1993 and the appropriate fee was paid at the same date. A statement of grounds of appeal was received on 4 October 1993.

In that statement the Appellant (the Patentee) submitted inter alia that the decision under appeal was made in contravention of Article 116 EPC. He requested oral

proceedings in the event that the Board intended to refuse the appeal or require any amendment of the granted patent. In reply, the Respondent (the Opponent) argued that the patentee was not entitled to further oral proceedings and that the Opposition Division did have discretion to decide the case without appointing further oral proceedings. He requested oral proceedings in the event that the Board intended to maintain the patent.

By a communication issued by the Board on 27 May 1994 both parties were advised that the Board was minded to remit the case to the Opposition Division with the order to appoint and to hold oral proceedings, and were accordingly asked to confirm the maintenance of their requests for oral proceedings in the appeal. In reply, the Appellant reiterated his request, whilst the Respondent also implicitly stood by his earlier request and asked that the costs of any oral proceedings arising in the present case should be borne by the Appellant. On 12 July 1994 the Appellant filed further submissions and arguments, directed at the issue of insufficiency under Article 83 EPC. By a further communication attached to the summons to oral proceedings dated 5 September 1994 the Board informed the parties that these proceedings would be confined to deciding the legal issue under Article 116(1) PCT.

- V. Accordingly, the oral proceedings held on 1 December 1994 were confined to the issue of whether or not the Opposition Division had been right in law to refuse both parties' requests for further oral proceedings, which requests superseded their earlier consent to the continuation of the proceedings in writing, and to issue instead its written decision revoking the patent.

In the course of the oral proceedings the Appellant submitted that the experimental evidence, and the arguments that had been produced by both parties on its basis after the oral proceedings held on 18 September 1991, had materially altered the case on insufficiency, which therefore needed to be dealt with orally. Indeed, so he pointed out, the very fact that a decision could be and was issued on 3 June 1993, whereas it could not on 18 September 1991, provided all the confirmation that one could wish for, that the weight and balance of the experimental evidence as a whole had altered substantially between the two dates. The term "subject of the proceedings" in the English text of Article 116 (1) EPC could not, so he argued, be restricted to the patent as such, for such a construction would make the Opposition Division's discretionary power to refuse requests for further oral proceedings "redundant".

The Respondent did not demur to the above submission, but argued that, as a matter of law, aside from **new** items of **prior art** or **fresh grounds** of objection, the "subject of the proceedings" within the meaning of Article 116(1) EPC remained the same even if new arguments and/or evidence had been introduced into the case, as had happened here. His reply to the Board's question of why, in that case, he had asked for further oral proceedings, was simply that requests for oral proceedings were purely routine and therefore automatic steps in his organisation. This request, therefore, did not detract from the credibility of his submission that the subject of the proceedings, on his interpretation, had remained the same, so that the Opposition Division correctly exercised its discretionary power to refuse both parties' requests for further oral proceedings.

Both parties made further submissions relating to the issue of the apportionment of costs, during which the Respondent explained that his submissions to this effect should be regarded as relating only to oral proceedings on remittal and not to those in this appeal.

VI. At the end of the oral proceedings the Appellant requested that the case be remitted to the Opposition Division for further prosecution by way of oral proceedings.

The Respondent requested that the case should not be remitted to the Opposition Division but should instead be heard by the Board of Appeal. He also requested that all the costs of any further oral proceedings before the Opposition Division be borne by the Patentee.

After deliberation, the Board's decision to allow the Appellant's request and to refund the appeal fee was announced.

Reasons for the Decision

1. The appeal is admissible.
2. The right of parties to oral proceedings in examination, opposition as well as appeal proceedings is enshrined in Article 116 EPC, according to which "oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. However, the European Patent Office may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same".

It is the established case law of the Boards of Appeal that a party who requests oral proceedings is, in principle, entitled to such proceedings **as of right**. Therefore, considerations such as the speedy conduct of the proceedings, equity or procedural economy cannot take precedence over a party's right to oral proceedings. In addition, it is not the purpose of oral proceedings to afford an opportunity of adducing further evidence, but rather to decide a case on the basis of facts and evidence submitted well before such oral proceedings. Therefore, the consideration upon which the Opposition Division had expressed its refusal to appoint additional oral proceedings is not in accordance with the requirements of Article 116 EPC.

3. Whilst it is true that the second sentence of Article 116(1) EPC does give the European Patent Office the discretionary power to reject a request for further oral proceedings before the same department, it does so only "where the parties and the **subject** of the proceedings are the same". Both the German and the French texts of the second sentence of Article 116(1) refer not to the rather vague term "subject" of the proceedings but to the facts or the **subject-matter** of the oral proceedings "... wenn die Parteien und der dem Verfahren zugrundeliegende **Sachverhalt** unverändert geblieben sind", "... devant une même instance pour autant que le parties ainsi que **les faits** de la cause soient les mêmes". Thus the Board accepts the Appellant's submission that, whatever the term "subject" may mean, it cannot be restricted to the patent as such for that will, in any single set of proceedings, always remain the same.
4. The Respondent's submission that the subject of the proceedings remained the same within the meaning of Article 116(1) EPC, even if fresh evidence and/or

arguments had been introduced, cannot be accepted either without qualification: in some cases, in particular where only new arguments have been presented, this may turn on to be the case, not so in others, e.g. where, as in the present case, also fresh evidence has been submitted. In any case, once fresh evidence has been admitted into the proceedings, the "subject" of such proceedings, as construed by reference to the text of Article 116(1) EPC in all three official languages, can no longer be the same.

5. In the present case, therefore, the Board accepts the Appellant's submission that the experimental evidence and arguments submitted after the oral proceedings held on 18 September 1991 amounted to a substantial change of the "subject" of the proceedings. In the Board's judgment, and again in agreement with the Appellant's submission, this must follow inevitably from the fact that the Opposition Division was unable to reach a decision at the end of the first oral proceedings, whilst it could and did issue a reasoned decision after having considered the written evidence and submissions filed later on.

6. Accordingly, the Opposition Division was wrong in law to refuse the parties' requests for further oral proceedings and to issue its written decision on the sole basis of the prior written submissions. In consequence of the course of action taken by the Opposition Division, the case had not yet been fully considered by the first instance. It is therefore not appropriate for the Board to continue with the appeal proceedings and consider the case on its merits, contrary to the Appellant's express request. Instead, the case is to be remitted to the Opposition Division for further prosecution by way of appointing the

requested further oral proceedings to consider the case on the basis of all the available evidence, including both parties' written submissions to date.

7. Furthermore, since the infringement of Article 116(1) constitutes a substantial procedural violation under Rule 67 EPC, and since this procedural violation is the cause of the present remittal without any decision by the Board of the merits of the case, the refund of the appeal fee is fully justified.

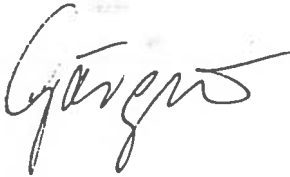
8. Having regard to the Respondent's request to the Board for a decision on the apportionment of the costs of any oral proceedings to be held before the Opposition Division, the Board is not satisfied that this matter has been sufficiently explored during the present appeal proceedings to enable a final decision to be taken under Article 111(1) EPC. Further explanation by the parties will clearly be necessary, but, in the light of its previously communicated intention to confine the oral proceedings held on 1 December 1994 strictly to the legal issue arising from Article 116 EPC, the Board has decided to refrain from pressing the parties for a complete explanation of the detailed reasons for their respective actions in filing evidence and responding, or failing to respond, to it. In addition, in the Board's judgment, it is only in exceptional circumstances, e. g. in manifest cases of abuse, appropriate to decide on the apportionment of costs which may be incurred **in the future**. Therefore, it is left to the Opposition Division to decide that matter pursuant to Article 104(1) and (2) EPC.

Order

For the above reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to appoint and to hold oral proceedings on the basis of all the available evidence.
3. The appeal fee is refunded.

The Registrar:



The Chairman:

