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D E C I S I O N
of 9 October 2000

Case Number: T 0736/95 - 3.3.4

Application Number: 83901979.1

Publication Number: 0108128

IPC: C07K 13/00

Language of the proceedings: EN

Title of invention:

(Met-1,des-Cys1,des-Tyr2,des-Cys3) human gamma interferon and a DNA sequence encoding it

Patentee:

AMGEN INC.

Opponent:

Boehringer Ingelheim GmbH

Headword:

Fresh ground of opposition/AMGEN INC.

Relevant legal provisions:

EPC Art. 99(1), 100(a)(b)(c), 114(1), 102(3)
EPC R. 55(c), 66(1)

Keyword:

"Admissibility of fresh ground of opposition - relevance"
"Obligation of opposition division to examine fresh ground of opposition for relevance"
"Remittal to first instance for further prosecution - yes"
"Referral to Enlarged Board of Appeal - no"

Decisions cited:

G 0010/91, G 0001/95, T 0922/94

Headnote:

From the Enlarged Board of Appeal case law, decisions G 10/91 and G 1/95 in particular, and the Guidelines for the examination in the EPO follows that the aim of the patent prosecution to avoid invalid patents comes to the foreground as far as proceedings before the first instance are concerned. By adding that the Enlarged Board of Appeal did not see any reason to change the practice of the first instance, it indicated that the first instance at least needs to examine whether a fresh ground is relevant. Therefore, before declaring it inadmissible, the opposition division should have examined under Article 114(1) EPC whether the ground raised under Article 100(c) EPC could prejudice the maintenance of the patent.



Case Number: T 0736/95 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 9 October 2000

Appellant: Boehringer Ingelheim GmbH
(Opponent) D-55216 Ingelheim (DE)

Representative: Armitage, Ian Michael
MEWBURN ELLIS
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Respondent: AMGEN INC.
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Representative: Brown, John
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 10 July 1995
rejecting the opposition filed against European
patent No. 0 108 128 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: C. Holtz
R. E. Gramaglia

Summary of Facts and Submissions

- I. The opposition raised by the appellant against European patent No. 0 108 128 was rejected by the decision under appeal. The grounds of opposition referred to in the notice of opposition were lack of novelty and inventive step, Article 100(a) EPC, and sufficiency of disclosure, Article 100(b) EPC. In the proceedings before the opposition division, the appellant also raised the ground under Article 100(c) EPC that the subject-matter of the European patent extended beyond the content of the application as filed. This latter ground was not admitted by the opposition division into the proceedings.
- II. The appellant requested that the decision under appeal be set aside and that the patent be revoked.
- III. The respondent requested that the appeal be dismissed.
- IV. In the oral proceedings held before the board, the admissibility of the ground under Article 100(c) EPC raised by the appellant was discussed. The parties argued with respect to this question essentially as follows:

The appellant:

Although this ground had not been mentioned in the notice of opposition, it was raised about 18 months later and about 16 months before the oral proceedings before the opposition division took place. The opposition division and the respondent therefore had ample time to consider it. The opposition division should have admitted this ground as highly relevant. In

fact, it did so by examining this issue under the heading of novelty in the context of the claim to priority, on pages 5 to 7 in the decision under appeal. This meant that in the appeal no new legal or factual situation would arise which would go against the essence of decisions G 10/91, OJ EPO 1993, 420, and G 1/95, OJ EPO 1996, 615, if this ground were admitted into the proceedings. The facts on which the Enlarged Board of Appeal decisions were based were not related to the particular facts of the present case, where a highly relevant ground had been rejected as inadmissible in the opposition proceedings. Therefore, there would be reason to refer a question to the Enlarged Board of Appeal. Decision T 922/94 of 30 October 1997 concerned a situation similar to the one in the present case, where the ground under Article 100(c) EPC had not been mentioned in the notice of opposition, but the opposition division had in fact discussed this ground in its reasons. The board of appeal decided to admit this ground in the appeal proceedings, since it would not raise any new factual or legal situation. If in the present case the board would not be prepared to examine and decide this issue itself, either the case could be remitted to the first instance for examination of this matter or a question could be referred to the Enlarged Board of Appeal.

The respondent:

Decisions G 10/91 and G 1/95 limited the room for new grounds strictly, in the sense that a fresh ground for opposition was not admissible unless the patentee agreed to its being admitted into the proceedings, which in the present case it did not do. A fresh ground for opposition not included in the notice of opposition

could otherwise only be examined on appeal if it had been introduced by the opposition division itself in the opposition proceedings. The respondent would not be against a referral of a question to the Enlarged Board of Appeal or a remittal to the first instance for examination of the fresh ground raised under Article 100(c) EPC. However, under decision G 1/95 this ground was not open for the board to examine.

Reasons for the Decision

1. The appeal is admissible.

2. The ground referred to by the appellant under Article 100(c) EPC was not raised in the notice of opposition. The question therefore arises whether it can at all be examined under Article 114(1) EPC and the case law of the Enlarged Board of Appeal, in particular decisions G 10/91 and G 1/95 interpreting this provision. Decision T 922/94 seems less relevant, since in that case the opposition division had recognised and admitted the late filed ground referring to Article 123(2) EPC as relevant. As a consequence, the board of appeal considered that this ground had been part of the legal framework of the opposition and that its admittance into the appeal proceedings would not raise any new legal issue, and decided to examine it. Further, Article 102(3) EPC in conjunction with Article 66(1) EPC conferred wide powers on the boards to consider all possible objections, pleaded or not pleaded, arising from amendments made to the claims originally filed. In contrast, in the present case the new ground was rejected as inadmissible. Another distinction in comparison to the situation in T 922/94

is that no amendments have been made in the present case to the claims as granted.

3. Decision G 10/91, point 16 of the reasons, discussed the framework of the examination by the opposition division with regard to grounds not mentioned in the notice of opposition. The Enlarged Board of Appeal did not consider that there was sufficient justification for changing the practice of examination of fresh grounds under Article 114(1) EPC in examination or opposition proceedings. The aim of this practice was obviously to prevent that invalid European patents were maintained. It concluded that an opposition division may therefore of its own motion introduce such a ground or consider it, if raised by the opponent after the expiry of the time limit laid down in Article 99(1) EPC. The Enlarged Board of Appeal stated, however, that this should only take place in cases where, prima facie, there were clear reasons to believe that such grounds were relevant and would in whole or in part prejudice the maintenance of the European patent.

4. In view of the cited passage, the argument of the respondent that the Enlarged Board of Appeal strictly limits an opposition to the extent indicated in the notice of opposition in accordance with Rule 55(c) EPC would seem to be pertinent only for appeal proceedings. The procedural decision under Article 114(1) EPC by the opposition division in the present case not to admit the fresh ground was taken without giving the parties any indication that it had considered it to be less pertinent. While it is true that decision G 10/91 refers to the opposition division as having a discretion to decide whether to admit new grounds ("may of its own motion ... or consider such a ground raised

by the opponent"), according to the Guidelines for the examination in the EPO, Part D, Chapter V, 2.2, grounds which, prima facie, may in whole or in part prejudice the maintenance of the European patent should generally be examined by the opposition division, while taking account of the interests of procedural expediency. In this context, the Guidelines refer to decision G 10/91. According to Part E, Chapter VI, 1.1, referring to Article 114(1) EPC, the competent department must comply with this Article during all proceedings before it, and examine whether there are facts and evidence on file which, prima facie, may prejudice the maintenance of the patent. The Guidelines were also cited by the Enlarged Board of Appeal in decision G 10/91.

5. From the Enlarged Board of Appeal case law, decisions G 10/91 and G 1/95 in particular, and the Guidelines for the examination in the EPO follows that the aim of the patent prosecution to avoid invalid patents comes to the foreground as far as proceedings before the first instance are concerned. By saying that it did not see any reason to change the practice of the first instance, the Enlarged Board of Appeal indicated that the first instance at least needs to examine whether a fresh ground is relevant. Therefore, before declaring it inadmissible, the opposition division should have examined under Article 114(1) EPC whether the ground raised under Article 100(c) EPC could prejudice the maintenance of the patent. Since it did not do so, but based its refusal to admit this ground only on the fact that it had been raised late, the opposition division deprived the appellant of the opportunity to have the relevance of this ground, and thus its admissibility, examined on appeal.

6. In view of decision G 10/91 and the Guidelines quoted above, the board does not find it necessary to refer any question to the Enlarged Board of Appeal, but considers it appropriate to remit the case for further prosecution by the opposition division. This examination shall have to deal with the question whether the ground raised by the appellant under Article 123(2) EPC (Article 100(c) EPC) would prejudice the maintenance of the patent and any further issue which may arise as a result of the answer to that question.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairwoman:

U. Bultmann

U. Kinkeldey