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D E C I S I O N
of 18 September 2002

Case Number: T 0653/99 - 3.3.4

Application Number: 90915320.7

Publication Number: 0495852

IPC: C12N 5/10

Language of the proceedings: EN

Title of invention:
Modified Biological Material

Patentee:
IMUTRAN LIMITED

Opponent:
Nextran, Inc.

Headword:
Modified biological material/IMUTRAN LTD.

Relevant legal provisions:
EPC Art. 83, 100(b)
EPC R. 56, 55, 67

Keyword:
"Partial admissibility of an opposition - no"
"Remittal to the first instance for complete re-examination -
yes"
"Substantial procedural violation - yes"

Decisions cited:
T 0222/85, T 0016/87, T 0182/89, T 0204/91, T 0682/91,
T 0065/00, J 0006/79, J 0021/98

Catchword:

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Case Number: T 0653/99 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 18 September 2002

Appellant: Nextran, Inc.
(Opponent) 303 College Road East, Ste B
Princeton, New Jersey 08540-6605 (US)

Representative: Bassett, Richard
Eric Potter Clarkson
Park View House
58 The Ropewalk
Nottingham NG1 5DD (GB)

Respondent: IMUTRAN LIMITED
(Proprietor of the patent) 21 Holborn Viaduct
London EC1A 2DY (GB)

Representative: Sheard, Andrew
P.O. Box 521
Berkhamsted
Hertfordshire HP4 1YP (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 27 April 1999
rejecting the opposition filed against European
patent No. 0 495 852 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. L. Davison-Brunel
Members: R. E. Gramaglia
V. Di Cerbo

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Opposition Division to maintain as granted the European patent No. 0 495 852 with the title "Modified biological material".

Granted claims 1 and 18 read as follows:

"1. A graftable animal cell or tissue of a donor species; wherein the cell or tissue is associated with one or more homologous complement restriction factors which can be used in a recipient species to prevent the complete activation of complement, and wherein the donor species is a discordant species with respect to the recipient species."

"18. The use of an animal cell or tissue derived from a donor species and of one or more homologous complement restriction factors (HCRFs) which can be used in a recipient species to prevent the complete activation of complement; wherein the donor species is a discordant species with respect to the recipient species; in the preparation of tissue graftable into the recipient species without hyperacute rejection."

Claims 2 to 17 related to further features of the cell or tissue of claim 1. Claims 19 and 20 related to further features of the use of claim 18.

- II. The Opposition Division came to the conclusion that the arguments put forward by the Appellant (Opponent) under Article 100(b) EPC (lack of sufficient disclosure; Article 83 EPC) did not comply with the requirements of Rule 55(c) EPC and, thus, that the opposition was

partially inadmissible (ie as far as it was based on said ground). With reference to the grounds under Article 100(a) EPC, the Opposition Division decided that the subject-matter of the granted claims was novel and inventive.

III. The Appellant lodged an appeal against the above decision, paid the appeal fee and submitted a statement of grounds of appeal.

IV. Oral proceedings were held on 18 September 2002.

V. The Appellant's arguments in writing and during oral proceedings which are relevant to the present decision can be summarized as follows:

- With reference to the admissibility of the opposition under Article 100(b) EPC, the case law of the Boards of appeal (T 212/97 of 8 June 1999 and T 65/00 of 10 October 2001) established that there was not any basis in the EPC for the concept of partial admissibility of oppositions. Hence, the Opposition Division was wrong not to have assessed the opposition under Article 100(b) on its merits.

- Moreover, the finding of the Opposition Division that the objection under Article 83 EPC had not been properly substantiated was not correct. Indeed, three technical reasons had been given. Thus, the facts of the present case were distinctly different from those dealt with in decision T 16/87 (OJ EPO 1992, 212) where the Opponents expressed doubts that the invention was sufficiently disclosed in the description part of

the patent, yet did not put forward any technical submissions relating to why what was described could not be put into practice. The herein provided arguments were sufficient to satisfy the requirements for an adequate substantiation of a ground of appeal as defined in decision T 222/85 (OJ EPO 1988, 128).

- The case should be remitted to the first instance for examination not only of sufficiency of disclosure but also of the other grounds under which the patent in suit had been opposed. Indeed, the Opposition Division may finally decide that there is sufficiency of disclosure in relation to a set of claims different from the granted one and this would leave open the questions of novelty and inventive step in relation to this new set of claims.
- The decision of the Opposition Division in respect of the admissibility of the opposition under Article 83 EPC amounted to a substantial procedural violation that merited reimbursement of the appeal fee.

VI. The Respondent (Patentee) answered essentially as follows:

- In earlier decision T 182/89 (OJ EPO 1991, 391), the then competent Board held that a mere statement by the Opponents that the results described in the patent in suit could not be repeated was inadequate to discharge the burden of proof which lay upon them and that, if this insufficiency of disclosure had been the only

ground for opposition, there would have been good reasons for rejecting the notice of opposition as inadmissible. This conclusion was directly relevant to the present case and, therefore, the Opposition Division had been right in refusing to consider Article 83 EPC as a ground for the appeal.

- It was clear to all that the Opposition Division had simply expressed itself in an awkward manner when qualifying the opposition under Article 100(b) EPC as inadmissible. What they really meant was that the reasons given for lack of sufficient disclosure were not adequately substantiated. It was a fact that the Appellant had only provided mere hints on a number of possible attacks against sufficiency of disclosure and that the case on insufficiency had not been made out in such a way that the Patentee could be in a position to respond.

- In decision T 16/87 (see supra), the necessity for the Opponent of furnishing the results of tests showing that the invention could not be reproduced was emphasized. Decision T 222/85 (supra) set as a condition for an adequate substantiation that the contents of the notice of opposition be sufficient for the Opponent's case to be properly understood **on an objective basis**, this latter criteria implying that it should be understandable not only for the Patentee but also for the Opposition Division and for the public. In case T 204/ 91 (of 22 June 1992), it was found that "the patentee and the Opposition Division had to be put in a

position of understanding clearly the nature of the objection submitted as well as the evidence and arguments in its support". As none of these conditions were fulfilled here, it must be concluded that the Opposition Division made the correct decision on admissibility.

- If the Board did not agree to this, the case had to be remitted to the first instance for a further examination of sufficiency of disclosure. Other grounds of opposition could not be considered as they had already been decided upon. Even if sufficiency of disclosure was accepted in relation to another set of claims than the granted one, the scope of these new claims could not be wider than that of the granted claims and, therefore, the decision already reached that the requirements of Articles 54 and 56 EPC were fulfilled had to apply.

- The Opposition Division had committed no substantial procedural violation but simply made an error of judgment in considering that the arguments given by the Appellants against sufficiency of disclosure were insufficient.

VII. The Appellant requested that the decision under appeal be set aside and that the European patent be revoked.

In the alternative, that the case be remitted to the first instance for the examination of the ground of opposition under Article 83 EPC and that in case of any change of claims the examination of the patentability requirements be continued.

The reimbursement of the appeal fee was also requested.

The Respondent requested that the appeal be dismissed and that the patent be maintained.

In the alternative, it was requested to remit the case to the first instance for examination only under Article 83 EPC and that the request for the reimbursement of the appeal fee be rejected.

Reasons for the Decision

Rule 56 EPC, admissibility of the opposition

1. In its decision of 27 April 1999, the Opposition Division found that the Appellant's argumentation with regard to lack of sufficient disclosure did not comply with the requirements of Rule 55(c) EPC because he had only expressed doubts that the invention could not be carried out, without providing the results of tests in this respect (point 4 of the decision). The Opposition Division concluded therefrom that the opposition was **partly inadmissible** ie that it was inadmissible insofar as the ground of appeal under Article 100(b) EPC was concerned.

2. In the European Patent Convention, the admissibility of an opposition is governed by Rule 56 EPC, "Rejection of the notice of opposition as inadmissible", which rule states in paragraph (1):

"(1) If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, and

Rule 55, sub-paragraph (c), or does not provide sufficient identification of the patent against which opposition has been filed, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period."

It is clear from the heading of Rule 56 EPC as well as from its wording that the concept of "inadmissibility" is only applicable to the notice of opposition as a whole. And, indeed, this is confirmed by the case law: in decision T 212/97 (supra, point 3.1 of the decision), it is stated that an opposition must fulfill, amongst other requirements, those of Rule 55(c) EPC in that it must contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments; **the fulfilment of this latter requirement in respect of one of the grounds of opposition being enough to render admissible the opposition as a whole.** In decision T 65/00 (supra), it is once more emphasized that *"nowhere in the EPC is there any basis for the concept of partial admissibility of oppositions."*

3. In the present case, it was never argued that the grounds for opposition under Article 100(a) EPC were not adequately substantiated and it is also the Board's opinion that they were. It is, therefore, concluded that the opposition as a whole is admissible.

4. It is clear from the Minutes of the oral proceedings before the Opposition Division (points 4.1 to 4.3) that the admissibility of the opposition under Rule 55(c) EPC was the only matter which was discussed at the oral

proceedings in relation to Article 100(b) EPC and that the Opponents were given no opportunity to develop the arguments with respect of Article 83 EPC which they had presented in writing (points 9.1 to 9.3 of the notice of opposition). For this reason, it must be concluded that the Opposition Division did not decide the issue of sufficiency of disclosure on its merits. Therefore, the case must be sent back to the first instance for this assessment to be carried out.

Remittal to the first instance

5. Sufficiency of disclosure is a preliminary essential step in the assessment of patentability insofar as it would be purposeless to assess the novelty and inventive step of a claimed subject-matter which could not be reproduced on the basis of the information given in the patent specification. Consequently, the issues of novelty and inventive step of a claimed subject-matter should only be assessed once this subject-matter has been found reproducible.

6. In the present case, the subject-matter in relation to which sufficiency of disclosure is achieved will be decided by the Opposition Division upon return of the case to the first instance (see point 3, supra). From their decision depends the very existence of a potentially patentable set of claims. It is the novelty and inventive step of this set of claims which need to be investigated in order to reach any conclusion on patentability.

7. In this respect, the Respondents argued that the Opposition Division had no right to reconsider the novelty and inventive step of the claimed subject-

matter as it has already reached a decision in this respect. They also argued that the subject-matter of any subsequent set of claims in relation to which sufficiency of disclosure is accepted would necessarily have the same or a narrower scope than that of the granted set of claims and, that, therefore, the decision already reached on novelty and inventive step would still apply.

8. This position cannot be shared for the reasons already given under points 4 and 5 above. Indeed since no assessment on sufficiency of disclosure was made, a new assessment of the Opposition Division on novelty and inventive step cannot be excluded.

Substantial procedural violation

9. According to decision J 6/79 (OJ EPO 1980, 225), the expression "substantial violation" is to be understood as meaning that the Rules of Procedure have not been applied in the manner prescribed by the EPC. The further case law (see for example, J 21/98, OJ EPO 2000, 406 and T 682/91 of 22 September 1992) points out that a procedural violation could not be considered substantial if it did not play a decisive part in the decision or if it did not adversely affect anyone.
10. In the present case, the decision by the Opposition Division that the opposition was partly inadmissible means that Rule 56 EPC was not correctly applied. It had as a consequence that the Appellant was adversely affected since no discussion was allowed on sufficiency of disclosure. Moreover, the overall procedure was significantly lengthened as the Board of Appeal could not decide on all issues which may otherwise have been

pending in front of it. For these reasons, the Board concludes that a substantial procedural violation did occur which, in accordance to Rule 67 EPC, justifies the reimbursement of the appeal fee.

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 with the order to consider all grounds of opposition originally submitted;
3. The request for reimbursement of the appeal fee is granted.

The Registrar:

The Chairwoman:

P. Cremona

F. Davison-Brunel