BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [X] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen
(D) [ ] No distribution

D E C I S I O N
of 17 June 2004

Case Number: T 0015/01 - 3.3.4

Application Number: 92913710.7

Publication Number: 0587780

IPC: A61K 39/12

Language of the proceedings: EN

Title of invention:
Causative agent of the mystery swine disease, vaccine compositions and diagnostic kits

Patentee:
Stichting Dienst Landbouwkundig Onderzoek

Opponents:
Cyanamid Iberica
Akzo Nobel N.V.

Headword:
Mystery Swine Disease/SDLO

Relevant legal provisions:
EPC Art. 54, 56, 76(1), 83, 87(1), 88, 100, 107, 112, 123(2), (3), 139(2), 167(2), (5)
EPC R. 20, 57a, 61, 64(a), 65(2), 87, 88, 90(1), 101(7)
PCT Art. 8(2)
Paris Convention Articles 4F, 4G

Keyword:
"Admissibility of appeal (yes) - party status of universal successor of original patentee (yes) - correction of wrong designation of appellant (allowed)"
"Allowability of amendments: new set of claims for ES/GR (yes)"
"Broadening of scope of protection (no)"
"Priority (yes) - doctrine of exhaustion of priority (no)"
"Novelty and inventive step (yes)"

Decisions cited:
G 0002/88, G 0003/93, G 0007/93, G 0002/98, G 0002/02, T 0522/94, T 0353/95, T 0001/97, T 0461/97, T 0097/98, T 0656/98, T 0814/98, T 0460/99, T 0998/99, T 0715/01

Headnote:
1. The same priority right may be validly claimed in more than one European patent application; there is no exhaustion of priority rights (see points 25 to 41 of the reasons).

2. Rule 20(3) EPC does not apply in the context of universal successions in law. The universal successor of a patent applicant or patentee automatically acquires party status in proceedings pending before the European Patent Office (see points 4 to 12 of the reasons).

3. Neither Rule 57a nor Article 123(3) EPC is infringed for the sole reason that a patent proprietor files a separate set of claims for a specific contracting state in opposition proceedings in order to take into account that, due to a reservation made under Article 167(2)(a) EPC, product claims as granted would be considered invalid in this state (see points 17 to 21 of the reasons).

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0015/01 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 17 June 2004

Appellant I: (Proprietor of the patent)
Stichting Dienst Landbouwkundig Onderzoek
Costerweg 50
NL-6701 BH Wageningen (NL)

Representative:
Renes, J.
Vereenigde
Postbus 87930
NL-2508 DH Den Haag (NL)

Appellant II: (Opponent 01)
Cyanamid Iberica
Cristobal Bordiu 35
E-28013 Madrid (ES)

Representative:
von Menges, A.
Uexküll & Stolberg
Patentanwälte
Beselerstrasse 4
D-22607 Hamburg (DE)

Respondent: (Opponent 02)
Akzo Nobel N.V.
P.O. Box 9300
NL-6800 SB Arnhem (NL)

Representative:
Van Gent, Marieke
INTERVET INTERNATIONAL B.V.
Wim de Korverstraat 35
NL-5831 AA Boxmeer (NL)

Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 16 October 2000 concerning maintenance of European patent No. 0587780 in amended form.

Composition of the Board:

Chairwoman: U. M. Kinkeldey
Members: R. E. Gramaglia
R. Moufang

Summary of Facts and Submissions

I. European patent No. 0587780 is derived from EURO-PCT application PCT/NL92/00096 (European application No. 92913710.7) filed on 5 June 1992 in the name of Stichting Centraal Diergeneeskundig Instituut. It claims priorities from EP 91201398 of 6 June 1991 (document (D47)) and EP 92200781 of 18 March 1992 (document (D48)). The patent relates to the Lelystad Agent causative of the Mystery Swine Disease (MSD) and was granted on the basis of 26 claims for contracting states AT, BE, CH, DE, DK, ES, FR, GB, GR, IT, LI, LU, MC, NL and SE, of which claims 1, 2, 6, 10, 14, 15, 23 and 26 read as follows:

"1. Composition of matter comprising isolated Lelystad Agent which is the causative agent of Mystery Swine Disease, said Lelystad Agent essentially corresponding to the isolate Lelystad Agent (CDI-NL-2.91) deposited 5 June 1991 with the Institut Pasteur, Paris, France, deposit number I-1102.

2. Composition of matter according to claim 1 which comprises killed isolated Lelystad Agent.

6. Composition of matter comprising isolated or synthetic protein, (poly)peptide, or nucleic acid derived from Lelystad Agent as defined in claim 1.

10. Composition of matter comprising a (poly)peptide having an amino acid sequence derived from a protein of Lelystad Agent as defined in claim 1, the (poly)peptide being produced by a cell capable of producing it due to genetic engineering with appropriate recombinant DNA.

14. Vaccine composition for vaccinating animals, in particular mammals, more in particular pigs or swines, to protect them against Mystery Swine Disease, comprising Lelystad Agent as defined in claim 1, and a suitable carrier or adjuvant.

15. Vaccine composition according to claim 14 which comprises killed Lelystad Agent.

23. Diagnostic kit for detecting an antibody which specifically recognizes Lelystad Agent as defined in claim 1 in a sample, in particular a biological sample such as blood or blood serum, sputum, saliva, or tissue, derived from an animal, in particular a mammal, more in particular a pig or swine, comprising an antigenic part or component of Lelystad Agent, and suitable detection means of an antibody detection assay.

26. A process for diagnosing whether an animal, in particular a mammal, more in particular a pig or swine, is contaminated with the causative agent of Mystery Swine Disease, comprising preparing a sample, in particular a biological sample such as blood or blood serum, sputum, saliva, or tissue, derived from the animal, and examining whether it contains Lelystad Agent nucleic acid, Lelystad Agent antigen, or antibody specifically recognizing Lelystad Agent, said Lelystad Agent being as defined in claim 1."

II. Notices of opposition were filed by opponents 01 and 02, both requesting the revocation of the European patent on the grounds of Article 100(a) and (b) EPC. In its

interlocutory decision posted on 16 October 2000, the opposition division maintained the patent on the basis of the sole claim of the auxiliary request then on file:

"1. Composition of matter comprising isolated Lelystad Agent which is the causative agent of Mystery Swine Disease, said Lelystad Agent essentially corresponding to the isolate Lelystad Agent (CDI-NL-2.91) deposited 5 June 1991 with the Institut Pasteur, Paris, France, deposit number I-1102."

During the opposition proceedings, the patentee, which had already changed its name in 1994 to "Stichting Instituut voor Veehouderij en Diergezondheid" and in 1995 to "Stichting Instituut voor Dierhouderij en Diergezondheid", was merged in 1998 into Stichting Dienst Landbouwkundig Onderzoek. The EPO was not informed of any of these changes.

III. Two appeals were filed against the decision of the opposition division. The first was said to be filed on behalf of Stichting Centraal Diergeneeskundig Instituut, the second was filed by opponent 01 (appellant II). By fax received on 15 June 2004, the patentee requested that its change into Stichting Dienst Landbouwkundig Onderzoek (appellant I) be recorded, paid the registration fee and submitted a statement from Freerk Volders, deputy civil-law notary in Rotterdam, of 11 June 2004 as evidence of the above-mentioned merger.

IV. Oral proceedings were held on 17 June 2004 and were attended by both appellants. The respondent (opponent 02) was absent as previously announced. During the oral proceedings appellant I filed a new main request.

Appellant I furthermore requested that the name of the appealing party in the notice of appeal and the statement setting out the grounds of appeal be corrected to "Stichting Dienst Landbouwkundig Onderzoek".

Claims 1 to 6 of the new main request for contracting states AT, BE, CH, DE, DK, FR, GB, IT, LI, LU, MC, NL and SE read as follows:

"1. Composition of matter comprising isolated Lelystad Agent which is the causative agent of Mystery Swine Disease, said Lelystad Agent essentially corresponding to the isolate Lelystad Agent (CDI-NL-2.91) deposited 5 June 1991 with the Institut Pasteur, Paris, France, deposit number I-1102.

2. Composition of matter according to claim 1, which comprises killed isolated Lelystad Agent.

3. Composition of matter comprising an isolated component of Lelystad Agent as defined in claim 1, wherein said isolated component is a Lelystad Agent-specific protein, polypeptide or peptide.

4. Vaccine composition for vaccinating animals, in particular mammals, more in particular pigs or swines, to protect them against Mystery Swine Disease, comprising Lelystad Agent as defined in claim 1 and a suitable carrier or adjuvant, which comprises killed Lelystad Agent.

5. Diagnostic kit for detecting an antibody, which specifically recognizes Lelystad Agent as defined in

claim 1 in a sample, in particular a biological sample such as blood or blood serum, sputum, saliva, or tissue, derived from an animal, in particular a mammal, more in particular a pig or swine, comprising an antigenic component of Lelystad Agent, and suitable detection means of an antibody detection assay.

6. A process for diagnosing whether an animal, in particular a mammal, more in particular a pig or swine, is contaminated with the causative agent of Mystery Swine Disease, comprising preparing a sample, in particular a biological sample such as blood or blood serum, sputum, saliva, or tissue, derived from the animal, and examining whether it contains Lelystad Agent nucleic acid, Lelystad Agent antigen, or antibody specifically recognizing Lelystad Agent, said Lelystad Agent being as defined in claim 1."

Claims 1 to 6 for contracting states ES and GR read as follows:

"1. A method for producing a composition of matter comprising isolated Lelystad Agent which is the causative agent of Mystery Swine Disease, said Lelystad Agent essentially corresponding to the isolate Lelystad Agent (CDI-NL-2.91) deposited 5 June 1991 with the Institut Pasteur, Paris, France, deposit number I-1102, comprising isolating said Lelystad Agent from a sample taken from affected piglets or affected sows or experimentally infected SPF pigs, or from cells inoculated with said sample.

2. A method according to claim 1, further comprising killing said Lelystad Agent.

3. A method for producing a composition of matter comprising an isolated component of Lelystad Agent as defined in claim 1, wherein said isolated component is a Lelystad Agent-specific protein, polypeptide or peptide, comprising producing said protein by recombinant DNA techniques or producing said peptide by peptide synthesis techniques.

4. A method for producing a vaccine composition for vaccinating animals, in particular mammals, more in particular pigs or swines, to protect them against Mystery Swine Disease, comprising providing Lelystad Agent which is the causative agent of Mystery Swine Disease, said Lelystad Agent essentially corresponding to the isolate Lelystad Agent (CDI-NL-2.91) deposited 5 June 1991 with the Institut Pasteur, Paris, France, deposit number I-1102 and mixing said Lelystad Agent with a suitable carrier or adjuvant, further comprising the step of killing said Lelystad Agent.

5. A method for producing a diagnostic kit for detecting an antibody which specifically recognizes Lelystad Agent as defined in claim 1 in a sample, in particular a biological sample such as blood or blood serum, sputum, saliva, or tissue, derived from an animal, in particular a mammal, more in particular a pig or swine, comprising providing an antigenic component of Lelystad Agent, and further providing suitable detection means of an antibody detection assay.

6. A process for diagnosing whether an animal, in particular a mammal, more in particular a pig or swine,

is contaminated with the causative agent of Mystery Swine Disease, comprising preparing a sample, in particular a biological sample such as blood or blood serum, sputum, saliva, or tissue, derived from the animal, and examining whether it contains Lelystad Agent nucleic acid, Lelystad Agent antigen, or antibody specifically recognizing Lelystad Agent, said Lelystad Agent being as defined in claim 1."

V. The following documents are cited in the present decision:

(D1) Collins J.E et al., 71st Conf. Res. Workers in Anim. Dis., Chicago, IL , Abstract No. 2;

(D4) Iglesias G. et al., Veterinary Bulletin, Vol. 60, Abstract 1541, pages 255-256 (1990);

(D6) Wensvoort G. et al., Veterinary Quarterly, Vol. 1, pages 121-143 (July 1991);

(D7) McCullough S.J. et al. in "The new pig disease", Chapter 9 of the Report on the Seminar/Workshop held in Brussels on 29-30 April 1991;

(D8) Ohlinger V.F. et al., Tierärztl. Umschau, Vol. 46, page 703-708 (1991);

(D9) Wensvoort G. et al., Vet. Microbiol., Vol. 33, pages 185-193 (1992);

(D22) GB-A-2 282 811;

(D23) EP-B-0610250;

(D24) Terpstra C. et al. in "The new pig disease : A report", Seminar/Workshop held in Brussels on 29-30 April 1991, pages 36-45;

(D30) Murphy B.R. et al. in "Fields Virology", Second Edition, Raven Press, New York, pages 469-502 (1990);

(D36) WO-A-93/07898

(D45) Legal opinion provided by Klaas Bisschop dated 12 May 2004;

(D47) Priority document EP 91201398 of 6 June 1991;

(D48) Priority document EP 92200781 of 18 March 1992.

VI. The submissions by appellant I (patentee), in so far as they are relevant to the present decision, can be summarised as follows:

Admissibility of the appeal by appellant I

– The main requirements for filing an appeal were that a party had to be adversely affected by the decision under appeal and to be unambiguously identifiable. Both requirements were fulfilled in the present case. Under Dutch law, after a merger, the acquiring entity may continue pending proceedings and file an appeal under the name of the merged entity.

Rule 57a EPC

- The filing of separate claims for ES/GR was justified on the grounds that a number of claims as granted might be ineffective in Spain and Greece since the reservations made by both contracting states under Article 167(2)(a) EPC were still in force on the date of filing the application.

- The term "specific" in claim 3 (including ES/GR) had been introduced to avoid possible problems under Article 54 EPC.

Article 123(3) EPC

- Amending the product-type claims to method-type claims for ES/GR did not extend the protection conferred by the granted claims.

Article 123(2) EPC

- The wording "comprising isolating said Lelystad Agent from a sample taken from affected piglets or affected sows or experimentally infected SPF pigs, or from cells inoculated with said sample" in claim 1 for ES/GR found a basis on page 24, lines 7 to 25, of the PCT application as filed.

Article 83 EPC

- The patent in suit taught how to prepare the killed vaccines by conventional techniques (see page 6, lines 28-33).

– Example 3 of document (D36) which was appellant II's own application (see eg page 33, line 1, to page 35, line 20) showed the efficacy of killed vaccines obtained as suggested in the patent in suit.

Article 87(4) EPC (Priority)

– The claims were entitled to the filing date of the first priority document (P1)(= document (D47)). The doctrine of exhaustion of priority rights should not be applied.

Novelty

– The "myxo-like" particles of document (D24) could not be equated with the claimed Lelystad Agent since said "myxo-like particles", having a size of 130-200 nm as observed by EM (see page 41, lines 14-16), did not even remotely resemble the Lelystad Agent, said Agent being at least three times smaller, having a size of 45-55 nm as observed by EM (see patent in suit, page 13, lines 8-11). That other viruses could infect lung alveolar macrophages was shown by document (D4), relating to the Aujeszky's disease virus.

– As for document (D7), which was based on the work already described in document (Dl), no micro-organism was found. These documents related to homogenates containing a great many viruses and bacteria. Apparently, no substantial further progress was made by the authors of documents (Dl)

and (D7), again illustrating the difficulties in finding the causative agent of MSD. Consequently, there was no teaching whatsoever in documents (D1) and (D7) that was novelty-destroying to claim 1, as homogenates of viruses were not within the scope of present claim 1 (cf the feature "isolated").

– Documents (D6), (D8) and (D9) did not represent prior art because the claims were entitled to the filing date of the first priority document (P1).

Inventive step

– Document (D24) alone provided the skilled person with no guidance on how to solve the problem of finding the causative agent of MSD. It taught (see page 43, third paragraph, lines 1-3) that a wide variety of micro-organisms could be isolated from cases of MSD, without any pointer that some of them were **the** likely candidate and the Lelystad Agent was not among the ones identified. It was admitted by the authors of this document that the results "were just as inconclusive" as those of others (see page 44, second paragraph).

– Combining document (D24) with common general knowledge or with document (Dl) would not have provided any more guidance than that given in document (D24) alone.

– The main teaching that a skilled person wishing to find the causative agent of MSD could learn from document (D7) was that the authors of this

document preferred not to filter their homogenates to reproduce the clinical signs of MSD, as filtering abolished the possibility of reproducing the clinical signs of the disease. Consequently, the skilled person would conclude from the experimental results of document (D7) that most likely bacteria, or even larger micro-organisms, in the unfiltered homogenate were necessary for reproducing the prominent clinical signs of MSD in experimental infections. Thinking that bacteria were essential, the skilled person would have used technologies from bacteriology and would not have found the agent looked for.

– Documents (D6), (D8) and (D9) did not represent prior art because the claims were entitled to the filing date of the first priority document (P1).

VII. The submissions in writing and during oral proceedings by appellant II (opponent 01), in so far as they are relevant to the present decision, are summarised as follows:

Admissibility of the appeal by appellant I

– The appeal filed by appellant I had to be rejected as inadmissible.

– The notice of appeal of appellant I was filed on behalf of Stichting Centraal Diergeneeskundig Instituut. After September 1998, there was no longer a legal entity by the name of Stichting Centraal Diergeneeskundig Instituut. A non-existing legal entity could not validly file

an appeal. Under Dutch law, an entity which had ceased to exist due to a merger was not allowed to file an appeal in its name. The appeal thus failed to comply with the requirements of Article 108 and Rule 64 EPC.

– It followed from decision T 656/98 (OJ EPO 2003, 385) that it was not allowed retroactively to change the identity of an appellant.

Rule 57a and Article 123(3) EPC

– The filing of a separate set of claims for ES and GR was neither justified under Rule 57a EPC nor acceptable under Article 123(3) EPC as it broadened the scope of protection conferred by the granted claims.

Article 123(2) EPC

– The wording "comprising isolating said Lelystad Agent from a sample taken from affected piglets or affected sows or experimentally infected SPF pigs, or from cells inoculated with said sample" in claim 1 for ES/GR represented an impermissible generalisation from a specific example in the application as filed.

Article 83 EPC

– The disclosure of the patent was insufficient for obtaining an inactivated (killed) Lelystad Agent vaccine according to claim 4, as there was no

evidence in the patent of successful immunisation of the subject to be protected.

Article 87(4) EPC (Priority)

– The priority of the earlier priority document (D47) was already claimed in the later priority document (D48). Therefore, according to the most recent case law embracing the doctrine of exhaustion of priority (see decision T 998/99 of 15 September 2003), none of the claims was entitled to the filing date of the first priority document (P1), with the consequence that intermediate documents (D6), (D8) and (D9) were prior art.

Article 54 EPC (Novelty)

– Owing to the wording "essentially corresponding to", claim 1 covered not only the isolate specifically deposited by the patentee but also any other isolates which were immunologically cross-reactive or which comprised a DNA sequence hybridising to the deposited Lelystad Agent.

– Documents (D1) and (D7) taught that the symptoms of MSD could be observed upon infecting pigs with filtered homogenates. These filtrates comprised, of necessity, the claimed virus.

– Claim 1 lacked novelty in view of the "myxo-like" virus isolated according to document (D24) from the lung macrophages of pigs infected with MSD. Not only did both the patent in suit and document (D24) use exactly the same method for isolation of

the causative agent of MSD (compare section 2 of "Methods" on page 38 and the paragraph "Virus and mycoplasma isolation" on page 41 of document (D24) with the method described in the patent in suit for the isolation of the Lelystad Agent, see page 11, lines 44 to 47; page 11, lines 55 to 58; page 12, lines 16 to 20; see also pages 14 and 15 of priority document (D47)), but the Lelystad Agent also had the same characteristic of the "myxo-like" virus isolated according to document (D24).

– Therefore the method used for isolation of the causative agent of MSD in document (D24) and in the patent in suit could only yield the same virus, be it named "Lelystad Agent" or "myxo-like virus". This was shown by document (D23), a post-published document taken as expert opinion, wherein others isolated the same virus (named "PRRS virus") by applying the same isolation method of document (D24)

– Claim 1 lacked novelty in view of documents (D6) and (D9) describing the successful isolation and characterisation of LV, and of document (D8), disclosing a repetition of the same experiments as in document (D6).

Article 56 EPC (Inventive step)

– None of the isolates described in document (D24) was known to cause symptoms attributable to MSD except for the "myxo-like" isolate that was observed to cause cytopathic effects on lung

macrophages, ie cells known to be affected by the disease. On the basis of document (D24), the person skilled in the art would have inevitably concluded that the new "myxo-like" virus was most likely the causative agent of MSD. To test this hypothesis, the new "myxo-virus" could have been used in the experimental infection method that had been part of the common general knowledge for years (see eg document (D1)). That test would have shown that the clinical signs of the disease could be reproduced upon experimental infection using the isolate.

– Other teams were able to reproduce the teaching of document (D24) and easily isolate the virus responsible for MSD (see eg documents (D6) and (D8)).

– Since the claims were not entitled to the filing date of the first priority document (D47), documents (D6), (D8) and (D9) were prior art and rendered the subject-matter of the claims obvious.

VIII. Appellant I (patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the new main request filed during oral proceedings.

Appellant II (opponent 01) requested that the appeal of appellant I be rejected as inadmissible, the decision under appeal be set aside and patent No. 0587780 be revoked.

Reasons for the decision

Party status of Stichting Dienst Landbouwkundig Onderzoek (SDLO) and admissibility of appeal by appellant I

1. The admissibility of the appeal of appellant I has been called into question by appellant II with the argument that the appeal was filed on 14 December 2000 on behalf of a legal entity which had already ceased to exist in 1998 due to a merger. Since this issue was raised only at a rather late stage of the appeal proceedings, appellant I objected to its introduction into the present proceedings. However, admissibility issues can and have to be examined at every stage of the appeal procedure. According to established case law, the admissibility of an opposition must be checked *ex officio* in every phase of the opposition and ensuing appeal proceedings (T 522/94, point 3, OJ EPO 1998, 421). The same principles apply *a fortiori* to the examination of the admissibility of an appeal. Appellant I's procedural objection against the late introduction of the issue cannot therefore succeed.

2. According to Article 107 EPC, an appeal may only be filed by an adversely affected party to the proceedings. The board thus has to determine, first, who the relevant party was when the appeal was filed and, secondly, whether the appeal was filed on behalf of that party.

3. The application leading to the patent in suit was filed by the Dutch foundation Stichting Centraal Diergeneeskundig Instituut. As convincingly evidenced by the declaration of deputy civil-law notary Volders

of 11 June 2004, this legal entity changed its name in 1994, ie before the grant of the patent, into "Stichting Instituut voor Veehouderij en Diergezondheid" and, by a further deed of amendment executed on 19 September 1995, into "Stichting Instituut voor Dierhouderij en Diergezondheid" (SIDD). Thus, when on 15 November 1995 both notices of opposition were filed and the opposition proceedings started, SIDD was the proprietor of the patent and hence party to the proceedings. In this respect it does not matter that the proprietor did not inform the EPO or the opponents of its new name. Several earlier board of appeal decisions have held that, as long as the identity of a legal person is not at issue, the use of a previous and therefore incorrect name, although being unfortunate, does not have the consequence that the party status is to be denied or that the respective procedural acts have to be regarded as invalid (see eg T 1/97 of 30 March 1999, point 1; T 461/97 of 26 October 1999, point 1).

4. In September 1998, ie during the opposition proceedings before the first-instance department, a merger took place between SIDD and another Dutch foundation, Stichting Dienst Landbouwkundig Onderzoek (SDLO). As evidenced by the declaration of deputy civil-law notary Volders, SDLO was the acquiring foundation and SIDD the disappearing foundation pursuant to the deed of merger. As a consequence, SDLO became, as of 4 September 1998, the successor in universal title of SIDD and thus, as a matter of substantive law, proprietor of the patent in suit. However, SDLO failed to inform the EPO of these circumstances for more than five years after they had happened. Only when appellant II, with its letter of

12 May 2004, drew the attention of the board to the merger, did appellant I request that the change be recorded, pay the appropriate fee and produce documentary proof with its fax letter of 15 June 2004. Therefore, the question arises whether SDLO acquired the party status of proprietor in the present proceedings only at the date on which the request for recording the change was filed or already "automatically" at the date on which the merger took place.

5. According to Rule 20(1) EPC, the transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. According to Rule 20(3) EPC, the transfer has effect vis-à-vis the EPO only when and to the extent that the necessary documents have been produced. Rule 20 EPC applies *mutatis mutandis* to any transfer of the European patent made during the opposition proceedings (see Rule 61 EPC).

6. In its decision T 656/98 (OJ EPO 2003, 385) the present board, in a different composition, dealt with the impact of Rule 20(3) EPC on the party status of proprietor in opposition proceedings. In that case the patentee, which was a company, had assigned its patent to another company (transferee) during opposition proceedings. Without requesting the assignment to be recorded under Rule 20 EPC, the transferee had then filed an appeal against the decision of the opposition division. The board considered the appeal inadmissible and held that, for a transferee of a patent to be entitled to appeal, the requirements of Rule 20 EPC

(request for recording the transfer, filing of documentary evidence and payment of fee) had to be complied with before expiry of the period for appeal. The term "party" in Article 107 had to be interpreted as being confined to the parties of record and their duly recorded successors, including those who have completed all the formalities necessary to be recognised as the legal successors (see points 1.1 and 1.2). In view of Rule 20(3) EPC, later registration of the transfer was not considered to validate the appeal retroactively.

7. The factual situation before the board in decision T 656/98 and in the present case is not the same. In that decision, the appellant had claimed to have acquired the patent through an assignment by the patentee on record. Here, SDLO is, due to a merger, the universal successor in law of the original patentee. This difference is important for the following reasons:

8. Rule 20 EPC is concerned with the registering of transfers (in the French version: "transferts", in the German version: "Rechtsübergänge") of patent applications and, in view of Rule 61 EPC, of patents. Thus its wording, at least in the English and French versions, does not unambiguously embrace cases where the patent application or the patent becomes vested in the new proprietor other than by transfer, ie in particular where the change of proprietor status is caused by universal succession of law. Decision T 656/98 (see point 9) implicitly acknowledged that such latter cases might have to be treated in a different way.

9. If Rule 20(3) EPC were to be applied in the context of universal successions, procedurally undesirable consequences would ensue. On the one hand, the successor in law would acquire party status only after fulfilling the requirements set out in Rule 20(1) and (2) EPC. On the other hand, the applicant or proprietor on record who ceases to exist automatically loses party status. Under the procedural law of the EPC, a person who does not exist any more cannot remain party to the proceedings (see T 353/95 of 25 July 2000, point 2). Both parties have put forward arguments concerning the issue as to whether under Dutch civil procedural law an appeal may be filed on behalf of a party which had ceased to exist due to a merger. However, the board considers this issue to be only of limited relevance to the present proceedings: While it is true that the status of a legal person as such has to be determined by the applicable national law, the issue whether a non-existing person can remain a party to the proceedings before the EPO is to be determined autonomously by the procedural law of the EPC.

10. It follows from the above that the application of Rule 20(3) EPC in cases of universal succession would lead to a procedural "vacancy" with respect to the applicant or proprietor for a certain period of time. Such a vacancy would not only amount to a rather unfortunate procedural situation in itself, but would also be difficult to reconcile with other provisions of the EPC:

11. Pursuant to Rule 90(1)(a) EPC, proceedings before the EPO are interrupted, *inter alia,* in the event of the death of the patent applicant or proprietor. However,

to the extent that these events do not affect the authorisation of a representative appointed under Article 134 EPC, proceedings are interrupted only on application by such representative. In this context, Rule 101(7) EPC provides that, subject to any provisions to the contrary contained therein, an authorisation does not terminate vis-à-vis the EPO upon the death of the person who gave it.

It follows from these provisions - which, in the view of the board, are applicable by analogy to situations where a legal person ceases to exist due to a merger - that the legislator has contemplated the procedural consequences of universal succession in law for the applicant or proprietor during patent grant or opposition proceedings. The legislative mechanism provided by Rules 90(1)(a) and 101(7) EPC makes it possible that under these circumstances the proceedings can continue without interruption: although the applicant or patentee on record ceases to exist and thereby loses his party status, the authorisation of the representative does not terminate so that the latter now immediately represents the successor in law and can validly act in the proceedings. This legislative mechanism would be seriously undermined if Rule 20(3) EPC were to be applied in the context of universal successions.

12. The board concludes that, when an applicant or patentee ceases to exist, his universal successor in law immediately and automatically acquires the party status in proceedings pending before the EPO. Since SDLO was, as of 4 September 1998, the successor in universal title of SIDD, it automatically became party to the

opposition proceedings on that date. No interruption of the proceedings occurred (Rule 90(1)(a), second sentence, and Rule 101(7) EPC). Since the opposition division was not informed of the change, it continued to use the old name of the legal predecessor of SDLO as designation of the proprietor. So did the representatives. This, however, only amounts to a wrong designation of the true party; it does not have the consequence that procedural acts which occurred after the change were made on behalf of or against a legal person who had ceased to exist. Thus, SDLO was the true party to the proceedings when the appealed decision was given and was adversely affected by it.

13. It follows from the above that the appeal of appellant I can only be considered admissible if it was filed by SDLO. In the notice of appeal and the grounds of appeal, the name of the appellant was indicated as Stichting Centraal Diergeneeskundig Instituut. Thus, the appellant was designated by the old name of the predecessor of SDLO that had already wrongly been used during opposition proceedings before the first-instance department as the name of the proprietor.

14. According to the established case law of the boards of appeal, a wrong designation of the appellant in the notice of appeal or in the grounds of appeal may be corrected either under Rule 65(2) EPC (see T 97/98, OJ EPO 2002, 183, point 1.3; T 715/01 of 24 September 2002, points 1-11) or under Rule 88 EPC (see T 814/98 of 8 November 2000, point 1; T 460/99 of 30 August 2001, point 1). In decision T 97/98, the then competent board considered that there was also a deficiency in the indication of the name and address of the appellant

within the meaning of Rule 65(2) in conjunction with Rule 64(a) EPC when incorrect indications had been made. The view was expressed that nothing in the said rules allowed them to be applied only to certain kinds of deficiencies and as a matter of principle not when the correction of a wrong indication led to a different person to the one originally expressly named in the appeal having to be regarded as the appellant. It was stated that what was required under Rules 64(a) and 65(2) EPC was that there was indeed a deficiency, ie that the indication was wrong, so that the correction only expressed what was intended when the appeal was filed.

15. In the present case, the board is convinced that it was the intention of the representative of appellant I to file the notice of appeal and the grounds of appeal on behalf of that person who had party status as proprietor during the opposition and who was adversely affected by the appealed decision. The use of the old name of the legal predecessor of SDLO amounted to an objectively incorrect designation of the proprietor which, however, can be easily explained by the fact that the same incorrect designation was already used in the opposition proceedings before the first-instance department and in the appealed decision itself. Under these circumstances, the requested correction of the name of appellant I in the notice of appeal and in the grounds of appeal can be allowed. To decide otherwise would not only be overly formalistic, but would also undermine the procedural mechanism provided for in Rule 90(1)(a), second sentence, and Rule 101(7) EPC. As shown above, this mechanism ensures that in cases of universal succession a representative may continue to

act in proceedings pending before the EPO. The mechanism works even if the representative does not yet know the identity of the successor in law (who in the event of death of a natural person may be uncertain for a considerable period of time) and even if the representative is not informed about the fact itself that a succession in law has occurred. Thereby procedural efficiency is also increased in so far as a representative does not need to ascertain himself every time before acting in the proceedings whether or not a succession in law has occurred. This mechanism would be seriously damaged if a representative who designates the appellant by the name of the applicant or patentee on record who has already ceased to exist rather than by the name of the successor in law could not correct this objectively wrong designation.

16. The board concludes that the requested correction is to be allowed. Thus, the appeal of appellant I was filed on behalf of SDLO which was adversely affected by the appealed decision. Therefore, the appeal of appellant I is admissible.

Rule 57a EPC

17. The main request of appellant I contains a separate set of claims for ES/GR. Appellant II has argued that for this reason the request does not comply with Rule 57a EPC.

18. Rule 57a EPC provides that, without prejudice to Rule 87 EPC, the description, claims and drawings may be amended in opposition proceedings, provided that the amendments are occasioned by grounds for opposition

specified in Article 100 EPC, even if the respective ground has not been invoked by the opponent. Appellant I has justified the filing of separate claims for ES/GR with the argument that a number of claims as granted might be ineffective in Spain and Greece since the reservations made by both contracting states under Article 167(2)(a) EPC were still in force at the date of filing the application. In fact, the application leading to the patent in suit was filed on 5 June 1992, while the respective reservations only ceased to have effect after 7 October 1992. It follows from Article 167(5) EPC that the reservations apply to European patent applications filed during the period in which the reservations have effect and that the effect of the reservations continues for the term of the patent.

19. The possible invalidity of a European patent in a contracting state is as such not a ground for opposition under Article 100 EPC. However, Rule 57a EPC is not limited to grounds of opposition *strictu sensu*. This follows from its explicit reference to Rule 87 EPC. According to the latter provision, a European patent may contain a separate set of claims for a contracting state *inter alia* where a prior national right under Article 139(2) EPC exists. Thus, although such prior national rights are not contained in the state of the art under Article 54(3) EPC and cannot support a ground for opposition under Article 100(a) in connection with Article 54 EPC, the applicant or proprietor may take them into account by means of a separate set of claims for the respective state.

20. The EPC does not contain an explicit provision for the corresponding situation where an applicant or proprietor wishes to take into account the reservation made by an EPC contracting state under Article 167(2)(a) EPC. Nevertheless, it has been the established practice of the EPO from the very beginning to accept the filing of separate sets of claims for such contracting states (see Announcement, OJ EPO 1979, 289, in respect of Austria, and Legal Advice No. 9/81, OJ EPO 1981, 68, No. 9). This practice was confirmed by the Enlarged Board of Appeal in its decision G 7/93 (OJ EPO 1994, 775), in which it dealt with the question of whether amendments can be allowed at a very late stage of the examination procedure. In point 2.5 of the reasons, the following was stated: "Nevertheless, in the Enlarged Board's view, a clear example of an exceptional case when it may be appropriate to allow amendment, is when the applicant requests separate sets of claims to be substituted in respect of designated States that have made reservations under Article 167(2) EPC. In such a case no further substantive examination of the case may be required, and **any short delay caused by making the necessary amendments is then of little weight, compared to the importance to the applicant of obtaining a valid patent in such designated States.**" (emphasis added)

21. The general purpose of Rule 57a EPC is to allow amendments only where they are made to overcome an objection against the validity of the European patent. If follows from the reference to Rule 87 EPC that, within the framework of the centralised opposition procedure before the EPO, amendments are also to be allowed where the patentee intends to overcome a possible ground of invalidity which only exists in

respect of a particular contracting state. Thus, Rule 57a EPC is not infringed by the formulation of a separate set of claims for a contracting state in which, due to a reservation made under Article 167(2)(a) EPC, certain product claims as granted would be considered invalid or ineffective. The same view is expressed in the Guidelines for Examination in the EPO (see point D-VII, 4.4). The board therefore concludes that the main request complies with Rule 57a EPC.

Article 123(3) EPC

22. Appellant II has argued that the filing of a separate set of claims for ES/GR would infringe Article 123(3) EPC since the product claims as granted were ineffective in Spain and Greece in view of the reservations made under Article 167(2)(a) EPC.

According to Article 123(3) EPC, the claims of a European patent may not be amended during opposition proceedings in such a way as to extend the protection conferred. By means of the separate set of claims, appellant I has amended several product claims as granted to method claims for contracting states ES and GR. Generally, a change from a product claim to a method claim for the production or the use of the product does not extend protection (see G 2/88, OJ EPO 1990, 93, point 5). The argument of appellant II that competitors could expect the product claims to be held invalid and non-enforceable in contracting states ES and GR is of no relevance in the context of Article 123(3) EPC since the comparison between the claims as granted and the claims as amended always has to be made without considering the possible invalidity

of the claims as granted. The board therefore concludes that the main request complies with Article 123(3) EPC.

Article 123(2) EPC

23. The wording "comprising isolating said Lelystad Agent from a sample taken from affected piglets or affected sows or experimentally infected SPF pigs, or from cells inoculated with said sample" in claim 1 for ES/GR has a basis on page 5, lines 5-8 and lines 30-31; page 12, lines 13-31; page 13, lines 22-32; page 14, lines 13-15; page 22, line 23, to page 24, line 25, of the PCT application as filed. All these passages will be taken by the skilled person as general instructions for isolating the Lelystad Agent from various samples. Therefore, no case of added subject-matter has been made out for claim 1 for designated states ES and GR.

Article 83 EPC

24. The disclosure of the patent, in appellant II's view, is insufficient for obtaining an inactivated (killed) Lelystad Agent vaccine according to claim 4.

However, the patent in suit teaches how to prepare the killed Lelystad Agent by conventional techniques (see eg page 6, lines 28-33).

That the claimed killed vaccines are able to confer sufficient protection or at least some degree of active immunity is shown by Example 3 of document (D36) which is appellant II's own application (see eg page 33, line 1, to page 35, line 20). These killed vaccines are also made by conventional techniques as described in

the patent in suit.

Therefore, the subject-matter of claim 4 is sufficiently disclosed and, thus, it does not violate the requirements of Article 83 EPC.

Article 87(1) EPC - priority

25. The patent in suit is derived from Euro-PCT application PCT/NL92/00096 in which a first priority of 6 June 1991 was claimed in respect of European application No. 91201398. According to Article 8(2)(a) PCT, the conditions for, and the effect of, any priority claim declared in an international patent application are as provided in Article 4 of the Paris Convention for the Protection of Industrial Property (Stockholm Act). However, since the Paris Convention does not address the issue of so-called "internal priorities" (see below point 26), the above principle is subject to the provisions of subparagraph (b) of Article 8(2) PCT which, in its second sentence, states the following: "Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, ... the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State". The term "national application" also includes applications for regional patents and the term "national law" is to be construed, where a regional application or regional patent is involved, as a reference to the respective regional treaty (see Article 2(vi) and (x) PCT). Thus, in the present case, where a Euro-PCT application claims the priority of a European patent application, the conditions for, and

the effect of, the priority claim are governed by Articles 87 to 89 EPC.

26. According to the basic rule contained in Article 87(1) EPC, a person who has duly filed in or for any State party to the Paris Convention, an application for a patent shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority. In view of its broad wording and in view of Article 87(2) EPC, which recognises applications under the EPC as giving rise to a priority right, the provision also applies where the priority claim is to a previous national application filed in a designated EPC contracting state or to a previous European application (cf Guidelines for Examination in the EPO, C-V, 1.3; BGH GRUR 1982, 31 = OJ EPO 1982, 66, point II 3). The European legislator has thus adopted a priority system which also recognises "internal priorities" and thereby extends beyond the minimum standards of the Paris Convention which only regulates "external" priorities.

27. Appellant II has contested the validity of the first priority claim of the patent in suit. It argues that the priority right was exhausted at the filing date of Euro-PCT application PCT/NL92/00096 (5 June 1992), since the same priority had already been claimed in European patent application No. 92200781 filed on 18 March 1992, ie in that application from which the patent in suit claims a second priority.

28. The argument of Appellant II is based on the "doctrine of exhaustion of priority rights", namely on the legal proposition that a priority right which has been

claimed in a patent application is thereafter exhausted and cannot be claimed any more in a later patent application in or for the same territory. Although some support for this doctrine may be found in national case law (cf Cour de Montpellier of 20 December 1966, Ann. 1967, 7 ff. = GRUR Int. 1969, 198) and in the legal literature (*Mathély,* Le nouveau droit français des brevets d'invention, 1991, p. 597 ff.; *Mousseron,* Traité des brevets, 1984, p. 327; *Wieczorek,* Die Unionspriorität im Patentrecht, 1975, p. 183 ff.), it cannot be considered to be unanimously or even widely recognised. Most legal commentators, in so far as they address the doctrine at all, express clear reservations against it (cf eg *Busse,* Patentgesetz, 6th ed. 2003, § 41, point 23 with further references; *Goebel,* GRUR 1988, 243, 244; *Gramm,* GRUR 1980, 954, 957; *Ruhl,* Unionspriorität, 2000, p. 96; *Schulte,* Patentgesetz mit EPÜ, 6th ed. 2001, § 40, point 19).

29. Until very recently, the doctrine of exhaustion of priority rights has, to the knowledge of the board, never been applied or explicitly addressed in the practice of the examining or opposition divisions of the EPO or in the case law of the boards of appeal. The Guidelines for Examination in the EPO do not mention the issue at all in their passages relating to priority (A-III, 6, and C-V). However, in decision T 998/99 of 15 September 2003 (point 3.1 of the reasons), the competent board of appeal considered the doctrine to be applicable and held that it was not allowable to claim priority from a first filing for more than one application in the same state and in respect of the same invention. The decision has caused controversial reactions, as shown in the legal literature (cf eg

contra: Bremi/Liebetanz, Mitt. 2004, 148 ff.; *pro: Vigand,* Prop.ind. 2004, 16).

30. As acknowledged by the board in T 998/99, the EPC is silent on whether or not it is possible to claim the same priority for more than one application filed for the same state. Pursuant to Article 87(1) EPC, the priority right is enjoyed for the purpose of filing a European patent application in respect of the same invention (in the German version: "für die Anmeldung derselben Erfindung zum europäischen Patent", in the French version: "pour effectuer le dépôt d'une demande de brevet européen pour la même invention"). With respect to the issue of exhaustion of priority, this wording appears to be open to different interpretations. The board therefore has to consider which interpretation fits better into the priority system of the EPC as a whole, taking duly into account the interests involved.

31. Articles 87 to 89 EPC provide a complete, self-contained code of rules on claiming priority for the purpose of filing a European patent application (G 3/93, OJ EPO 1995, 18, point 4; G 2/98, OJ EPO 2001, 413, point 3; G 2/02, OJ EPO 2004, 483, point 3.1). Since the EPC constitutes, according to its preamble, a special agreement within the meaning of Article 19 of the Paris Convention, these rules are not intended to contravene the basic priority principles of the Paris Convention.

32. The right of priority is generally regarded as one of the cornerstones of the Paris Convention and was already incorporated in the original text of 1883 (cf

Bodenhausen, Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967, 1969, Article 4, Section A(1), point (a); *Ladas,* Patents, Trademarks, and Related Rights, Vol. I, 1975, p. 456). Its basic purpose is to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality in patent law.

33. In the course of the revisions of the Paris Convention, several amendments were made to its priority provisions in order to enhance their flexibility and thereby ameliorate the legal position of patent applicants. It was considered that overly strict solutions would hardly be in accord with the spirit of the Union treaty which is aimed at fostering and encouraging inventive genius (cf *Actes de la Conférence réunie à Washington du 15 mai au 2 juin 1911,* Berne 1911, p. 45). In particular, the Paris Convention in its present version (Stockholm Act) explicitly recognises the possibility of claiming multiple and partial priorities (cf Article 4F) and guarantees the right to divide patent applications while preserving the benefit of the right of priority also for the divisional application (cf Article 4G Paris Convention). The same principles are reflected in the corresponding provisions of the EPC, ie Articles 76(1), second sentence, and 88(2) and (3).

34. In the light of the above, the board disagrees with the view expressed in decision T 998/99 (point 3.1), according to which the international priority provisions contained in the Paris Convention have to be

regarded as a body of exceptional rules which should be interpreted strictly. Rather, they have to be construed in a manner which ensures that the general purpose they serve, namely to assist the applicant in obtaining international protection for his invention, is fulfilled as far as possible. The same holds true *a fortiori* for the self-contained priority system of the EPC which has to be compatible with the standards set by the Paris Convention in the sense that it should not give less protection, but which is not generally prevented from going beyond these standards in favour of the applicant. This is illustrated *inter alia* by the recognition of internal priorities under the EPC (cf above, point 26), a circumstance which also has a bearing on the solution of the present issue (cf below, point 38).

35. In order to ascertain whether a practical need exists for allowing applicants to claim the same priority right in more than one European patent application, the board considers it appropriate to examine more closely the circumstances under which the issue may arise. The following types of situation can be identified:

36. First, an applicant may split up the subject-matter of the priority application between two subsequent European applications, eg in order to avoid a non-unity objection in the European examining procedure. If, in such a case, the applicant were only entitled to rely on the priority in his first subsequent application, he would lose the priority for that part of the subject-matter contained in the second subsequent application. This stands in clear contrast to the result the applicant would have achieved if he had at first filed

a European application containing the whole subject-matter of the priority application and later a divisional application containing only a part of the subject-matter. Since both Article 4G Paris Convention and Article 76(1), second sentence, EPC explicitly recognise that a divisional application enjoys not only the filing date of the parent application but also the benefit of any right to priority (cf above, point 33), both the parent application and the divisional application would then validly claim the priority right. The board does not see any convincing reason for not allowing the applicant to achieve the same result by immediately dividing the subject-matter of the priority application between two separate European applications both claiming the priority right for the respective part of the subject-matter. This speaks against the application of the doctrine of exhaustion in such cases of "divided priority". Even in decision T 998/99 the then competent board expressly reserved its position on the issue of divided priorities (cf point 3.1. of the reasons).

37. Secondly, it may occur that a patent applicant who has claimed a priority right realises before the expiry of the priority period that his application suffers from a major deficiency. If the applicant is allowed to rely on the same priority in a second European application, he could still remedy the situation by a second filing, it being understood that the deficient application will then normally be withdrawn or abandoned through non-action. However, if the doctrine of exhaustion had to apply, this means of redress would cease to exist.

38. Thirdly, and most importantly, technological development is characterised by a process of innovation and research which does not usually come to a halt when a first application is filed. Therefore, patent applicants may wish to combine the originally disclosed subject-matter with further improvements and additional embodiments developed during the priority period within one and the same application. The patent system of the EPC encourages such a filing strategy through the recognition of internal priorities: an applicant may file a second European application disclosing both the subject-matter of a first European application (for which he may claim and enjoy priority) and newly found related subject-matter. There may also be good reasons, in particular in technology fields where the pace of innovation is fast, to repeat this strategy more than once and to file a third or even further European application within the priority period, always claiming the priority of all the previous applications. It is difficult to see why the EPC should, on the one hand, encourage such a "combination strategy" - if the applicant makes use of it only once - by the recognition of internal priorities and, on the other hand, restrict it - if the applicant makes use of it twice or more - by the doctrine of exhaustion.

39. It might be argued that notwithstanding the above considerations the doctrine of exhaustion of priority rights should be applied on the ground that it serves the function of preventing double-patenting. However, a closer analysis reveals that the doctrine is not an appropriate legal instrument for achieving this purpose. On the one hand, the possibility of double-patenting may also arise in situations where no priorities are

claimed or where legal provisions such as Article 76(1), second sentence, EPC prevent the application of the doctrine of exhaustion of priority. On the other hand, the doctrine is detrimental to patent applicants even in situations where no risk of double-patenting exists, eg because only one application is still pending and the other application or applications have already been withdrawn or are deemed to be withdrawn.

40. Although none of the parties has sought to refer the issue of exhaustion of priority rights to the Enlarged Board of Appeal, the board has considered whether it should do so of its own motion pursuant to Article 112(1)(a) EPC. However, such a referral should only be made if it is **required** for ensuring uniform application of the law or for settling an important point of law. As already stated above (point 29), the board is not aware that the doctrine of exhaustion of priority rights has ever been applied or explicitly addressed in the first-instance practice of the EPO or, with the exception of decision T 998/99, in the case law of the boards of appeal. Under these circumstances, a decision of the Enlarged Board is, for the time being, not necessary for the purposes set out in Article 112 EPC.

41. The board concludes that the priority system of the EPC allows patent applicants to claim and enjoy the same priority right in more than one European application. The doctrine of exhaustion of priority rights is to be rejected. Thus, the patent in suit is entitled to the first priority claimed. It follows that documents (D6), (D8) and (D9) do not represent prior art under Article 54(2) EPC.

Novelty

Document (D24)

42. Appellant II argues that the method used for isolation of the causative agent of MSD in document (D24) and in the patent in suit could only yield the same virus, be it named "Lelystad agent" or "myxo-like virus". However, the "myxo-like" particles of document (D24) have a size of 130-200 nm as observed by EM (see page 41, lines 14-16), whereas the claimed Lelystad Agent is at least three times smaller, ie it has a size of 45-55 nm as observed by EM (see patent in suit, page 13, lines 8-11). Moreover, the claimed Lelystad Agent belongs to the genus of Arteviridae (see document (D22), page 3, lines 15-16), ie a genus different from Myxoviridae.

43. It is true that both methods (document (D24) and the patent in suit) use lung macrophages of pigs suffering from MSD as a virus source. However, the fact that both the "myxo-like" virus of document (D24) and the claimed Lelystad Agent have a trophism for lung macrophages cannot be seen as proof of identity between the two viruses, as many viruses infect lung macrophages, eg the Aujeszky's disease virus referred to in document (D4), which induces a completely different clinical symptomatology. Finally, post-published document (D6), taken as expert opinion, shows that many virus isolates from pigs suffering from MSD were able to infect macrophages, but only one (ie the claimed Lelystad Agent) was sensitive to chloroform (cf page 125, under "Virus isolation"). This shows that the skilled person applying the method of document (D24) would not

necessarily arrive at a virus falling under the definition of claim 1 at issue, contrary to appellant II's position.

Documents (D1) and (D7)

44. The authors of these documents demonstrated that some signs (eg microscopic lesions) of MSD could be observed upon infecting pigs with the filtered homogenates. However, it was only with the unfiltered homogenate (comprising micro-organisms much larger than viruses such as bacteria) that the complete pathological situation of MSD, including respiratory disease and reproductive failure could be produced (see document (D7), pages 47, under 2, and Fig. 5). These documents thus merely show that the whole clinical symptomatology of MSD could be reproduced upon experimental infections with homogenates containing a great many micro-organisms. They do not teach the skilled person how to identify and isolate the causative agent of MSD. However, a critical feature of claim 1 at issue is that the virus should be arrived at in an isolated form (see section IV supra). Therefore, documents (D1) and (D7) do not affect the novelty of claim 1 at issue.

45. Consequently, claim 1 and all claims of the new main request, including those for contracting states ES and GR, relying on the isolated Lelystad virus, fulfil the requirements of Article 54(1) EPC.

Inventive step

46. In view of the board's finding under point 41 supra, the prior art to be considered is represented by (D24),

(D7) and (D1). Appellant II argues that the skilled person wishing to find the causative agent of MSD would arrive at the claimed subject-matter in an obvious manner departing from documents (D24), (D7) and (D1) taken alone or in combination. Document (D24) teaches (see page 43, third paragraph, lines 1-3) that a plethora of micro-organisms (listed under the heading "Virus and mycoplasma isolation") could be isolated from cases of MSD: porcine Enterovirus serotype 7 (PEV), Encephalomyocarditis virus (EMCV), "myxo-like" particles of 130-200 nm diameter, Mycoplasma hyosynoviae, Acholeplasma laidlawii and probably Mycoplasma hyopneumoniae. The Lelystad Agent is not among the aetiologies identified. There is also no pointer that some of them, let alone the "myxo-like" virus, is the likely candidate for the cause of the disease. Rather, the "myxo-like" virus would have been excluded by the person skilled in the art as a candidate causing MSD on the basis of the disappointing seroconversion data. Moreover, the authors of this document admit that the results "were just as inconclusive" as those of others (see page 44, second paragraph). Therefore, document (D24) provided the skilled person with no guidance on how to solve the problem of finding the causative agent of MSD.

47. The board is of the opinion that the skilled person would agree to the above negative conclusion arrived at by the authors of document (D24). But even if, for the sake of argument only, the skilled person concluded that the new "myxo-like" virus was the most likely causative agent of MSD, as appellant II argues, there is no evidence before the board that the whole clinical symptomatology of MSD could be induced upon

experimental infection using the "myxo-like" isolate. Moreover, as emphasised in point 43 supra, the skilled person entering the "myxo-like" route would not necessarily arrive at something falling under the definition of claim 1.

48. Departing from document (Dl) or combining the teaching of document (D24) with that of document (Dl) would not provide the guidance towards the claimed Lelystad Agent missing in document (D24), as the skilled person was presented, on the one hand, with a list of a great many MSD aetiologies, wherein the Agent in question was glaring by its absence (document (D24)), and, on the other hand, with the homogenates of document (D1), including no fewer micro-organisms.

49. If the skilled person looking for the causative agent of MSD came across document (D7), he was taught that the authors of this document had to refrain from filtering their homogenates to reproduce the clinical signs of MSD. As already highlighted (see point 43 supra), filtering abolished the possibility of reproducing the complete pathological frame of MSD, including respiratory disease and reproductive failure (see document (D7), pages 47, under "2", and Fig. 5). The skilled person, aware of the fact that bacteria do not pass through the filters of 0.45, 0.22 or 0.1 µm pore diameter referred to on page 47, second paragraph, of document (D7), would conclude from the experimental results of document (D7) that bacteria, or even larger micro-organisms, in the unfiltered homogenate were perhaps necessary to reproduce the prominent clinical signs of MSD experimental infections. Thinking that bacteria were essential, the skilled person would have

used technologies from bacteriology and would have missed the filterable (see patent in suit, page 13, lines 2-4) causative agent of MSD.

50. It is argued by appellant II that others (see eg document (D6) or (D8)) were able to reproduce the teaching of document (D24) and easily isolate the virus responsible for MSD. However, this position of appellant II is not convincing since document (D24) does not anticipate any critical feature of the virus looked for, such as its buoyant density of 1.19 g/cm^3 in CsCl or its sensitivity to chloroform treatment (see document (D6), page 125), the knowledge of which could indeed have greatly facilitated the isolation of the Lelystad Agent. In fact, the authors of document (D8) rely *inter alia* on these features (known to them from reference "14", ie document (D6)) to isolate the virus (see document (D8), page 707, end of the central column). The board must conclude that finding this Agent in the light of the information derivable from document (D24) required more than routine work.

51. In conclusion, the subject-matter of claim 1 cannot be derived in an obvious manner from the prior art. This conclusion has to be extended to all the claims of the new main request, including those for contracting states ES and GR, since they all rely on the inventive Lelystad Agent of claim 1.

Order

For these reasons it is decided that:

1. The appeal of appellant I is admissible.

2. The decision under appeal is set aside.

3. The case is remitted to the first instance with the order to maintain the patent on the basis of the claims of the new main request filed during oral proceedings, and a description to be adapted.

The Registrar: The Chairwoman:

P. Cremona U. M. Kinkeldey