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D E C I S I O N
of 1 April 2004

Case Number: T 0796/02 - 3.3.8

Application Number: 82304513.3

Publication Number: 0073657

IPC: C12N 15/81

Language of the proceedings: EN

Title of invention:

Preparation of hepatitis B surface antigen in yeast

Patentee:

GENENTECH, INC.

Opponents:

Akzo Pharma B.V.
Pasteur Merieux Serums et Vaccins
Institut Pasteur

Headword:

Hepatitis B antigen/GENENTECH

Relevant legal provisions:

EPC Art. 111(1), 111(2)

Keyword:

"Decision re appeals - contravene ratio decidendi (no)"
"Late submitted requests (yes)"
"Abuse of procedure (yes)"

Decisions cited:

G 0001/97, J 0006/98, T 0406/86, T 0319/91, T 0845/93,
T 0609/94, T 0382/97

Catchword:

It amounts to an abuse of procedure to withdraw a request with broader claims in proceedings before the board of appeal, in order to avoid that a negative decision be taken on it by the board, but then to re-introduce those broader claims before the opposition division, having obtained remittal of the case for further prosecution on the basis of much more limited claims.



Case Number: T 0796/02 - 3.3.8

D E C I S I O N
of the Technical Board of Appeal 3.3.8
of 1 April 2004

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
15 May 2002 concerning maintenance of European
patent No. 0073657 in amended form.

Composition of the Board:

Chairman: L. Galligani
Members: P. Julia
M. B. Günzel

Summary of Facts and Submissions

- I. The European patent No. 0 073 657 with the title "Preparation of hepatitis B surface antigen in yeast" was opposed under Articles 100(a) and 100(b) EPC for lack of novelty (Article 54 EPC), lack of inventive step (Article 56 EPC) and insufficiency of disclosure (Article 83 EPC). The opposition division decided on 21 July 1993 to revoke the patent on the grounds of lack of inventive step.
- II. The patentee lodged an appeal against said decision. In response to a communication accompanying the summons to oral proceedings the appellant filed a main request and five auxiliary requests. In the course of oral proceedings and after discussion of the requests on file the appellant withdrew all previous requests and filed a main request which was found by the then competent board of appeal to comply with Articles 84, 123(2)(3) and 54 EPC (cf. T 845/93 of 26 June 1996). Since the said request contained a novel technical feature whose contribution to inventive step had never been considered by the first instance, the board decided to remit the case to the opposition division under Article 111(1) EPC for further discussion on Article 56 EPC.
- III. In its interlocutory decision of 15 May 2002, the opposition division decided that a second auxiliary request filed on 10 October 2001, which corresponded to the request on which the board of appeal had decided in case T 845/93 (*supra*), fulfilled the requirements of Article 56 EPC. The patent was maintained in amended form on the basis of this second request (Article 102(3))

EPC). The main request and the first auxiliary request also filed on 10 October 2001 were considered to be in conflict with the ratio decidendi of T 845/93 (*supra*) and thus, they were considered not to be allowable under Article 111(2) EPC.

IV. Claim 1 of the **second auxiliary request** of the decision under appeal, corresponding to claim 1 of the request underlying decision T 845/93 (*supra*), read as follows:

"1. A method of producing hepatitis B surface antigen in particle form suitable for use in conferring immunogenicity to hepatitis B virus in a susceptible human which comprises:

- a) providing a DNA transfer vector capable of replication and phenotypic selection in yeast host strains;
- b) providing a DNA fragment comprising a promoter compatible with a yeast host strain;
- c) providing a DNA fragment encoding hepatitis B surface antigen and lacking any sequence encoding HBsAg precursor sequence;
- d) assembling the fragments of steps a), b) and c) to form a replicable expression vector wherein said sequence of step c) is under control of said promoter, with appropriate translational start and stop signals such that it is expressible to produce mature hepatitis B surface antigen;

e) transforming a yeast strain with the vector of step d);

f) allowing the yeast transformant to grow until said hepatitis B surface antigen is produced therein; and

g) lysing the yeast cells **with a glass bead suspension** and recovering therefrom said hepatitis B surface antigen in discrete particle form." (emphasis added)

This method also corresponded to the method of claim 8 as granted, wherein, however, step (g) in **claim 8 as granted** read as follows:

"g) recovering said hepatitis B surface antigen in discrete particle form."

V. Claim 1 of the main request and the first auxiliary request forming the basis of the decision under appeal were the same as claim 1 underlying decision T 845/93 (*supra*) except for step (g) which read in the **main request**:

"g) lysing the yeast cells so as to allow recovery of hepatitis B surface antigen in discrete particle form.",

and in the **first auxiliary request**:

"g) breaking open the yeast cells so as to allow recovery of hepatitis B surface antigen in discrete particle form, and recovering therefrom said hepatitis B surface antigen in discrete particle form."

Claims 2 and 4 were common to all requests - main request, first and second auxiliary requests - and they were all specific embodiments of the corresponding claim 1.

- VI. An appeal was lodged by the patentee (appellant) against the interlocutory decision of the opposition division. None of the three opponents (respondents) replied to the statement of grounds for appeal.
- VII. Oral proceedings were summoned. In a communication annexed to the summons, the board expressed the preliminary, non-binding opinion that the main request and the first auxiliary request did not contravene the ratio decidendi of decision T 845/93 (*supra*), but they were late filed and the appellant had failed to provide good reasons that justified their introduction into the proceedings at such a late stage.
- VIII. In reply to said communication, the appellant withdrew its request for oral proceedings and submitted further comments so as to justify the introduction of the main request and the first auxiliary request into the proceedings. None of the respondents replied to the communication of the board and to the appellant's submissions.
- IX. Oral proceedings took place on 1 April 2004 in the absence of the parties.

X. The appellant's arguments, insofar as they are relevant to the present decision, may be summarized as follows:

According to the established case law of the boards of appeal, *inter alia* decision T 319/91 of 8 December 1992 and the ensuing decision T 609/94 of 27 February 1997, an order of a board of appeal to continue the opposition procedure on the basis of a specific request could not prevent the patentee from pursuing claims of different scope and wording to the specified request provided that the claims proposed did not contravene any points decided by the board of appeal, i.e. the patentee was not limited to the wording of a claim found formally admissible and hints relating to issues not decided were non-binding. After remittal to the opposition division from the board of appeal, different facts and claim wordings could be presented and considered by the opposition division, which was bound by the ratio decidendi of the board's decision only in so far as the facts were the same.

In decision T 845/93 (*supra*) the claims of the then main request were found to comply with Articles 123(2)(3) and 84 EPC. However, it was not decided on any of the withdrawn requests nor on the inventive step of the main request. There was no decision on the relevance of the feature of lysis by glass beads. The board only hinted at the importance of this feature but this hint was only non-binding as the board did not decide that, in order to be admissible, the claim had to include this feature. Therefore, claims omitting this feature were not necessarily in conflict with the ratio decidendi of decision T 845/93 (*supra*). The opposition division was not restricted to

consideration of a set of claims having the exact wording and scope of the remitted main request. Rather, that main request was a starting point and amendments should in principle be acceptable provided that they were not in conflict with the ratio decidendi of T 845/93 (*supra*). Therefore, claims amended to include the lysis feature but without mention of the glass bead suspension were not in conflict with the ratio decidendi of T 845/93 (*supra*).

There was evidence of well-established practice that a patentee should have the opportunity to defend the claims at two instances or levels of jurisdiction. In the present case, the patent had been revoked on 21 July 1993 by the opposition division because the product claims lacked inventive step. However, the opposition division had not made any adverse finding in respect of the method claims. These method claims were considered for the first time at the hearing before the board of appeal in case T 845/93 (*supra*), when the patentee withdrew all previous requests comprising the product claims. It was therefore procedurally correct that the then competent board of appeal did not decide on the question of inventive step of the method claims of any of the requests and gave the appellant the right to have these method claims considered at two instances. By refusing now to admit the main and first requests under Article 111(2) EPC, the opposition division had deprived the patentee of the right to have these claims considered even at the first instance. No decision had ever been taken on the inventive step of the method claims presented in the main and first request filed in the present case.

XI. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of either the main request or the first auxiliary request both filed on 10 October 2001 or that the case be remitted to the opposition division for further consideration of these requests.

Reasons for the Decision

Article 111(2) EPC (Ratio decidendi)

1. According to Article 111(2) EPC "*If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, **in so far as the facts are the same.***" (emphasis added). Thus, in line with the established jurisprudence of the boards of appeal (cf. "Case Law of the Boards of Appeal of the European Patent Office", 4th edition 2001, VII.D.10.2.2, pages 537 to 538), and in particular with the case law referred to by the appellant (cf. Section X *supra*), it has first to be determined what is the ratio decidendi of the board of appeal's previous decision T 845/93 (*supra*) and then whether the facts in the present case are the same as in the case of decision T 845/93 (*supra*).
2. Decision T 845/93 (*supra*) is only concerned with the specific feature "*lysing the yeast cells with a glass bead suspension*", which is found to have a basis in the application as filed (Article 123(2) EPC), to restrict the scope of the claim compared to the scope of the corresponding granted claim (Article 123(3) EPC) and to

cause no lack of clarity (Article 84 EPC) (cf. points 1 to 4 of the Reasons for the Decision). Novelty is said not to be disputed (Article 54 EPC) (cf. point 5 of the Reasons). In point 6 of the Reasons for the Decision, this novel technical feature, which in the patentee's view renders the claims inventive, is said to be of some significance. It is stated that, in these circumstances the request is allowed into the proceedings. However, it is added that, as inventive step in relation to a claim with that feature has not been considered by the first instance, the board exercises its discretionary power under Article 111(1) EPC and remits the case to the opposition division for further prosecution. Thus, apart from the decision with regard to Articles 123(2)(3) and 84 EPC for said specific feature, no other decision has been taken in case T 845/93 (*supra*).

3. The **main and first auxiliary requests** forming the basis of the decision under appeal do not comprise the specific feature "*lysing the yeast cells with a glass bead suspension*" put forward in case T 845/93 (*supra*) but a generalisation thereof (cf. Section V *supra*). Such a generalisation of this specific feature is not found in the claims under consideration in case T 845/93 nor is there any reference in the said decision to such a generalisation or, for the purpose, to any equivalent feature. Thus, the factual situation in the present case and in the case T 845/93 (*supra*) is different and the generalisation made in the main request and in the first auxiliary request does not contravene any decision taken in case T 845/93.

4. It follows from the foregoing that the main request and the first auxiliary request do not contravene Article 111(2) EPC.

Late filed requests - Abuse of procedure

5. It is the established case law of the boards of appeal that the patentee's right to file amendments in the course of proceedings is not unlimited in time (cf. "Case law" supra, VII.C.10.1.3, pages 485 and 486). It is in particular within the discretion of either the opposition division or of the board of appeal to refuse such amendments if they are submitted late in the proceedings, e.g. when the examination of the opposition or appeal is already substantially complete and the patentee fails to provide good reasons for such late filing (cf *inter alia* T 406/86 of 2 March 1988, OJ EPO 1989, 302; T 382/97 of 28 September 2000).
6. Already in the **first proceedings** before the opposition division the appellant had ample time and opportunity to consider how he could appropriately define the claimed subject-matter. In fact, as a reply to the notice of opposition, the patentee filed in **1992** a new main request, wherein step (c) of the method of claim 8 as granted was already amended. It was the patentee's own choice to pursue in these first proceedings before the opposition division requests comprising both product and method claims. Nothing prevented the patentee from pursuing a request comprising only method claims - with appropriate further amendments - if he had so wished.

7. In the **first appeal proceedings** the patentee introduced the feature "*lysing the yeast cells and recovering therefrom*" in the method claims of its first and third auxiliary requests. This feature corresponds in substance to feature (g) of the present main request. However, as can be derived from decision T 845/93, VII. of the facts and submissions, after discussion of the requests on file, these requests were not maintained by the appellant but were replaced by the narrower claims of the new main request underlying decision T 845/93, limiting feature (g) to lysing the yeast cells with a glass bead suspension. The appellant has argued that in order to "*... avoid prejudicing the (likely) referral back to the OD, by allowing the Board to express a decided view on broader claims (protein lysis) rather than just the narrower claims (glass bead lysis) ... I took the step of withdrawing those broader claims, hoping that the OD would consider themselves free to admit them if the Board referred the case back with the narrower claims.*" (cf. page 3, first paragraph, appellant's letter of 20 February 2004).
8. Thus, requests comprising the above, more generally defined feature (g) had indeed already been put forward in the proceedings of the first appeal but the appellant had then chosen to withdraw them for **tactical reasons** because it assumed that maintaining the requests containing the broadly defined feature (g) could prejudice a remittal. By withholding such broader requests the then competent board was deprived of the opportunity to decide thereon. Thus, as a direct result of the patentee's own tactical choice, the matter of the appeal proceedings was limited from the broader version of the claims (now reintroduced as main request)

to a much more restricted subject-matter by limiting feature (g) of the method claims to lysis with glass bead suspension (cf. Sections IV and V *supra*). At the same time it is also apparent from the appellant's submission that it withdrew the broader requests with the intention to reintroduce them in the proceedings before the opposition division after remittal.

9. Nevertheless, it was only with the submissions of 10 October 2001 in preparation for the oral proceedings of 11 December 2001 in the **second proceedings** before the opposition division, that the appellant filed the present main request thereby seeking to reintroduce a method claim with a broadly defined feature (g) corresponding in substance to feature (g) of the requests withdrawn in the first proceedings before the then competent board of appeal. Feature (g) of claim 1 of the first auxiliary request now on file which was also filed with the letter of 10 October 2001 before the opposition division is more limited in scope than feature (g) of the main request but it is also still considerably broader in scope than feature (g) of the method claims underlying decision T 845/93 (*supra*).
10. In the appellant's letter of 10 October 2001 under the heading "Reasons for the current claim requests" only inventive step is discussed and as a conclusion the patentee points out that "*Therefore, in striking the appropriate balance between a fair reward to the patentee in consideration of his contribution of the art, I submit that a strict limitation to lysis with glass beads would be unduly narrow*" (cf. page 6, third full paragraph of patentee's letter dated 10 October 2001). Additionally, in its letter of 20 February 2004,

filed in response to the communication of the board informing the appellant of its preliminary view that it tended to regard appellant's main and auxiliary request as late filed and the reintroduction of broader subject-matter abandoned before the board of appeal as amounting to an abuse of proceedings, the appellant submitted that the invention resided in the recovery of the hepatitis B surface antigen by (mechanical) lysis of the yeast cells and that this was not apparent when the patent application was filed but that it only became evident to the patentee at a (not further defined) later point in time (cf. page 2, fourth and fifth full paragraphs of appellant's letter of 20 February 2004).

11. In the circumstances of the present case set out above, this argument cannot be accepted by the board. Firstly, the appellant had ample time from the very beginning of the opposition proceedings to reflect on appropriate claim drafting in order to ensure an adequate scope of protection. Secondly, it is apparent from the appellant's broad version of feature (g) only referring to lysis in general, drafted in the first appeal proceedings before the board of appeal in case T 845/93 (*supra*), that the appellant was very well aware of how a claim ensuring adequate protection could be drafted. Thirdly, as it has also been explained above, the appellant deliberately chose to withdraw these broader method claims directed to lysis in general, in order to avoid an adverse decision being taken on it by the board of appeal, and with the intention to reintroduce them before the opposition division after having obtained a remittal on the basis of much more limited claims.

12. Such behaviour in the proceedings cannot be justified by appealing to a supposed "right to two instances" as the appellant has sought to do in the context of its submissions on the "ratio decidendi" of the previous appeal board's decision. Firstly, there is no absolute "right to two instances" in the sense of a party being in all circumstances entitled to have every aspect of its case examined by two instances (see e.g. J 6/98 of 17 October 2000, point 4 of the reasons, making reference to G 1/97, OJ EPO 2000, 322, point 2a) of the reasons). Secondly, where a patentee waits until the appeal proceedings before proposing amendments which could be suitable to avoid the final revocation of its patent it is his own behaviour which causes him the loss of an instance for the examination of the amended claims. Withdrawing broader requests before the board of appeal in order to avoid a negative decision being taken on them, and then re-introducing them after a remittal having been obtained for more limited subject-matter, is an even less acceptable behaviour by the patentee, not justifiable by any legitimate interest. As the present case shows, the overall length of further opposition and possibly further appeal proceedings after remittal is likely to severely impair the legitimate interests of the other party or parties and of the general public in having some degree of legal certainty about the existence and scope of the European patent within a reasonable time span.
13. In conclusion, the board holds that it amounts to an abuse of procedure to withdraw a request with broader claims in proceedings before the board of appeal, in order to avoid that a negative decision be taken on it

by the board, but then to re-introduce those broader claims before the opposition division, having obtained remittal of the case for further prosecution on the basis of much more limited claims. The re-introduction of both the main and the first auxiliary requests therefore amount to an abuse of procedure and, as a result, they are not to be considered by the board. The second auxiliary request corresponds to the request already maintained by the opposition division in the decision under appeal. So the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani