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D E C I S I O N
of 14 October 2002

Case Number: T 0854/02 - 3.3.2

Application Number: 93401978.7

Publication Number: 0584001

IPC: A61K 31/335

Language of the proceedings: EN

Title of invention:

Use of taxol for the manufacture of a medicament for the
treatment of cancer

Patentee:

BRISTOL-MYERS SQUIBB COMPANY

Opponent:

NaPro BioTherapeutics Inc
Boehringer Ingelheim GmbH
BAKER NORTON PHARMACEUTICALS, INC,

Headword:

Use of taxol/BRISTOL-MYERS SQUIBB

Relevant legal provisions:

EPC Art. 107, 108

Keyword:

"Not adversely affected opponent - appeal inadmissible"

Decisions cited:

J 0016/94, J 0027/94

Catchword:

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Case Number: T 0854/02 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 14 October 2002

Appellant: NaPro BioTherapeutics Inc
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Parties as of right:
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(Opponent IV) Boehringer Ingelheim GmbH
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Representative: -

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 May 2002
revoking European patent No. 0 584 001 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: M. Ortega-Plaza
S. U. Hoffmann
G. F. E. Rampold
C. Rennie-Smith

Summary of Facts and Submissions

I. By its decision of 22 May 2002, the Opposition Division revoked the European patent No. 0 584 001 (based on application No. 93 401 978.7) under Article 102(1) EPC.

The Opposition Division took the view that the patent in suit did not meet the requirements of Articles 52(1) and 54(1) EPC. It expressed the further view, as *obiter dictum*, that the contested patent lacked an inventive step (Article 56 EPC).

II. On 1 August 2002 Opponent III filed a document headed "Notice of Requests" by fax and paid the appeal fee. This document contained a series of requests to be considered "on appeal by the patentee, should there be one". This was followed by a number of requests:

1. The decision in that it revokes the opposed patent on the ground of lack of novelty should be upheld so that the opposed patent shall stand revoked.

2. The decision so far as it finds the subject-matter of the opposed patent to lack an inventive step should be upheld with the effect that the opposed patent shall stand revoked so far as it does not stand revoked in accordance with the request made in paragraph 1 above.

3. In the case that neither of the requests set forth in paragraphs 1 and 2 above are allowed, the opposed patent should be revoked on one or more of the following grounds, namely that:

3.1 The opposed patent is invalid in that it fails to

comply with Article 123(2) EPC.

3.2 The opposed patent is invalid in that it fails to comply with Article 83 EPC.

3.3 The opposed patent is invalid in that it fails to comply with Article 52(2) EPC.

3.4 The opposed patent is invalid in that it fails to comply with Article 52(4) EPC.

There were also four further requests of a procedural nature - for oral proceedings unless the Board confirms revocation of, or revokes, the opposed patent on written submissions; for simultaneous translation at such oral proceedings; for cross-examination of witnesses; and for accelerated proceedings.

III. The same document then also stated that, "For the avoidance of all doubt, in the event that OIII is held to be adversely affected by the decision (and thus has *locus* to appeal), insofar as the decision finds for the patentee under any one or more of Articles 123(2), 83, 52(2) and 52(4) EPC, this "Notice of Requests" stands also as a Notice of Appeal against the decision insofar as it decides for the patentee under such Article(s) and if and so far as the decision is adverse to OIII. OIII's request on such appeal would be cancellation and setting aside of the decision to this extent, whilst preserving the decision so far it decides that the opposed patent lacks novelty and inventive step and is revoked".

IV. The proprietor of the revoked patent did not file an appeal.

In a letter of 2 October 2002 the proprietor requested that the appeal be rejected as inadmissible and that there be an apportionment of costs in its favour.

Reasons for the decision

1. In this decision the Board will for convenience refer to OIII as "the appellant" although, in its guise as a "Notice of Requests", the document contemplates OIII as a prospective respondent.
2. As a so-called "Notice of Requests", the appellant's document is of no effect for the following reasons.
 - 2.1 First, by prefacing its list of requests with the words "on appeal by the patentee, should there be one", the appellant clearly makes its requests conditional on an appeal being filed by the patentee. Not only has that condition not been fulfilled, since no such appeal has been filed within the permitted time, but, since an appeal cannot be filed as an auxiliary request and procedural declarations by parties may not be made conditionally (see J 16/94, OJ EPO 1997, 331 and J 27/94, OJ EPO, 1995, 831), it follows that mere conditional requests outside any pending proceedings cannot be entertained.
 - 2.2 Second, the appellant's requests amount to an anticipatory cross-appeal but, as is well-known, cross-appeals are not possible before the Boards of Appeal (save in the sense that appeals may be filed by parties on both sides of opposition proceedings which end in an interlocutory decision to maintain a patent in amended form). Cross-appeals, such as exist in some other legal systems, in the sense of appeals only filed in reaction to and within a specified time after another party's

appeal, are not possible. Any adversely affected party wishing to appeal must do so within the prescribed time limit of two months (Articles 107 and 108 EPC).

3. The appellant also designates the document it has filed as a Notice of Appeal. The appeal is inadmissible for the following reasons.

3.1 First, although the notice of appeal has been filed in due time and the appeal fee has been paid (Article 108 EPC), the provision of Article 107 EPC, which limits the right to appeal to parties adversely affected by a decision, is not satisfied. In the present case the decision subject to appeal is the decision of the Opposition Division to revoke the patent in suit under Article 102(1) EPC. Thus the decision was in favour of the appellant who, therefore, was not adversely affected. The appellant tacitly acknowledges this by its words "in the event that OIII is held to be adversely affected by the decision (and thus has *locus* to appeal)" - the appellant is not adversely affected and thus has no *locus* to appeal. Further, if by those words the appellant sought to file a conditional appeal, such an appeal is *per se* inadmissible (see the cases cited in paragraph 2.1 above). An appellant cannot make the filing of a Notice of Appeal conditional on the assessment of an admissibility requirement which can only be made by the Board after the Notice of Appeal has actually been filed. To do so would be tantamount to asking the Board whether or not an appeal is possible - the Board cannot give advice or opinions to parties, it can only make decisions on appeals once filed.

- 3.2 Second, it appears that the appellant does not really seek to challenge the decision of the Opposition Division (i.e. revocation of the patent) but the reasons within the decision. In particular, the appellant wishes to see the patent found invalid under Articles 123(2), 83, 52 (2) and 52(4) EPC, in addition to Articles 52(1) and 54(1) EPC. In doing so the appellant misunderstands the nature and purpose of opposition appeal proceedings which are not to re-examine a patent but to decide whether or not a first instance decision is correct. Oppositions challenge patents, appeals challenge decisions.
4. Accordingly, the Board has no alternative but to dismiss the present appeal as inadmissible. It is therefore unnecessary to consider the appellant's individual requests including that for oral proceedings which, in any event, was only made in the ineffective "Notice of Requests".
5. There is no request by the appellant for reimbursement of the appeal fee and indeed such a request would be inconsistent with the requests it seeks to make. However, for the avoidance of doubt, the Board emphasises that its decision is that the appeal is inadmissible and not that the appeal is deemed not to have been filed (see "Case Law of the Boards of Appeal of the European Patent Office", 4th ed. 2001, page 552, section 15.1, 5th paragraph). Accordingly, no question of reimbursement of the appeal fee can arise.
6. The Board has no need to consider the proprietor's request for an apportionment of costs since, the appeal being inadmissible *ab initio*, the conditions for such an apportionment (namely the taking of evidence or oral

proceedings) cannot, however those conditions might be interpreted, apply in the present case.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

A. Townend

P. A. M. Lançon