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**Datasheet for the decision  
of 18 January 2011**

**Case Number:** T 1421/05 - 3.3.09

**Application Number:** 91903945.3

**Publication Number:** 0515460

**IPC:** A23L 1/054

**Language of the proceedings:** EN

**Title of invention:**

Docosahexaenoic acid, methods for its production and compounds containing the same

**Patentee:**

MARTEK BIOSCIENCES CORPORATION

**Opponents:**

OmegaTech, Inc.  
Sanofi-Aventis Deutschland GmbH  
Monsanto Company  
Nagase Biochemicals, Ltd.

**Headword:**

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**Relevant legal provisions:**

EPC Art. 56, 83, 84, 112(2), 114(2)

**Relevant legal provisions (EPC 1973):**

EPC R. 26(2)(c), 64(a), 65(2), 88, 90(1)(a), 101(7).  
RPBA Art. 13(1)

**Keyword:**

"Inter-partes transfer of opposition (no)"  
"Transfer of opposition status to universal successor (yes)"  
"Correction of name of appellant (yes)"  
"Admissibility of appeal (yes)"  
"Party entitled to resile from position previously taken in  
opposition proceedings (no)"  
"Issue decided in first appeal res judicata (yes)"  
"Amendments of party's case in appeal proceedings (no)"  
"Inventive step (yes)"

**Decisions cited:**

G 0004/88, G 0009/91, G 0010/91, G 0003/97, G 0002/04.  
T 0234/86, T 0301/87, T 0934/91, T 0951/91, T 0201/92,  
T 0525/94, T 0353/95, T 0670/95, T 0019/97, T 0298/97,  
T 1137/97, T 1204/97, T 0097/98, T 0814/98, T 0656/98,  
T 0460/99, T 0952/99, T 0446/00, T 1091/00, T 0015/01,  
T 0136/01, T 0520/01, T 0715/01, T 0413/02, T 0956/03,  
T 0006/05, T 0425/05, T 0724/05, T 1324/06, T 0157/07,  
T 0762/07

**Headnote:**

1. Where the business assets in relation to which an opposition was filed have been transferred and at the same time the transferor has contractually agreed to transfer the opposition to the transferee, the status of opponent remains with the transferor in the absence of there being filed with the Office (a) evidence sufficiently evidencing the transfer and (b) a request to recognise the transfer of opponent status (point 3.3).

2. Where in such a case the transferor subsequently ceases to exist but has a universal successor, the status of opponent is capable of passing to that successor (point 4.7).

3. The mere possibility of abuse (in the sense of G 3/97) arising out of such events does not prevent opponent status passing in this way; it is for the proprietor to prove relevant acts of abuse (point 5).

4. An appeal filed by mistake in the name of an opponent who no longer exists but who has a universal successor, and which was obviously intended to be filed on behalf of the person who is the actual opponent and who was prejudiced by the decision, namely the universal successor, is admissible; if necessary the notice of appeal and statement of grounds of appeal may be corrected to record the name of the true appellant/opponent (points 6 and 7).

5. It is not in accordance with normal procedural efficiency and principles of fairness to allow a party to re-open questions relating to the formal allowability of a claim and to attempt to raise a new issue which it had had the opportunity to raise and which it should have raised at an earlier stage of the proceedings, and in doing so to resile from its previous position (point 13.11).



Case Number: T 1421/05 - 3.3.09

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.09  
of 18 January 2011

**Appellant:** Sanofi-Aventis Deutschland GmbH  
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**Respondent:** MARTEK BIOSCIENCES CORPORATION  
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**Party as of right:** Nagase Biochemicals, Ltd.  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
5 September 2005 concerning maintenance of  
European patent No. 0515460 in amended form.

**Composition of the Board:**

**Chairman:** W. Sieber  
**Members:** W. Ehrenreich  
K. Garnett

## Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 515 460 in respect of European application No. 91 903 945.3, filed on 4 February 1991 as international application No. PCT/US91/00733 in the name of Martek Corporation, was announced on 22 April 1998 in Bulletin 1998/17. The patent was granted with 22 claims. Claim 1 read as follows:

"A single cell-edible oil characterised in that docosahexaenoic acid (DHA) makes up at least 15% of the oil by weight, preferably at least 20%, more preferably at least 30% and most preferably at least 35%."

Claims 2 and 3 were dependent claims. Claim 4 and dependent Claims 5 to 12 were directed to a method for producing a single cell-edible oil containing at least 20% DHA by weight. Claim 13 and dependent Claims 14 to 18 concerned various food products containing the single cell edible oil according to Claims 1 to 3 or produced by the method of Claims 4 to 12. Claims 19 to 22 were use claims.

II. Four notices of opposition were filed against the patent, namely by:

Opponent I: Omega Tech, Inc. ;  
Opponent II: Aventis Research and Technologies GmbH & Co. KG (hereinafter: "Aventis R&T");  
Opponent III: Monsanto Company;  
Opponent IV: Nagase Biochemicals, Ltd.

The oppositions were based on Article 100(a) EPC (lack of novelty and lack of inventive step) and on Article 100(b) EPC (insufficiency of disclosure).

III. The following documents were *inter alia* cited during the opposition proceedings:

D4 Biochimica et Biophysica Acta, 316, 56-65, 1973;  
D10 WO-A 89/00606.

IV. In the course of the opposition/appeal proceedings Opponents I and III withdrew their oppositions.

V. With its decision announced orally on 12 October 2000 and issued in writing on 30 October 2000 the Opposition Division revoked the patent. The Opposition Division held that the oil extract described in D4 anticipated the subject-matter of the product of Claim 1 of the granted claims and of the other then requests.

VI. An appeal (the "First Appeal") against this decision was filed by the proprietor on 13 October 2000. In the oral proceedings before the Board held on 2 July 2002 the proprietor filed sets of claims as bases for a new main request and Auxiliary Requests 1 and 2. The claims according to the main request and Auxiliary Request 1 consisted of an independent product Claim 1, an independent process Claim 5 and dependent Claims 2 to 4 and 6 to 14. Claim 1 of the main request read as follows:

"1. A single cell, edible oil wherein  
docosahexaenoic acid (DHA) makes up at least 35%

of the oil by weight, said oil being obtainable from a unicellular organism by hexane extraction."

Claim 5 of the main request read as follows:

"5. A method of producing a single cell-edible oil wherein DHA makes up at least 20% of said oil by weight by cultivating a microorganism capable of producing said oil in a fermentor to achieve a cell density of at least 10 grams biomass per liter of a nutrient solution, harvesting the biomass and recovering said oil from the biomass, wherein the microorganism is a dinoflagellate and the microorganism is induced to produce said oil at a concentration of at least 1.5 grams per liter of nutrient solution by imposition of a stationary phase."

As regards Auxiliary Request 1, the only difference was that in Claim 1 the word "directly" was introduced before the word "obtainable".

VII. In the Board's decision in the First Appeal dated 2 July 2002 (T 1091/00):

(a) The Board rejected the main request. The Board held that the provisions of Articles 123(2), 123(3) and 100(b) EPC were complied with but that the subject-matter of Claim 1 lacked novelty over the disclosure in D10.

(b) The Board accepted the introduction of the word "directly" into Claim 1 of Auxiliary Request 1

under Articles 123(2) and (3) EPC (point 3.1 of the decision).

- (c) As to novelty (point 3.2 of the decision), the Board held that the introduction of the word "directly" was a clear restriction of the claimed oil to the effect that the amount of 35% DHA must already be present in the extracted neutral lipid fraction of the unicellular organism. Novelty of the oil claimed in Claim 1 over D4 and D10 was acknowledged because the highest DHA content in the neutral triglyceride fraction shown in Figure 7 of D4 amounted to about 30% and D10 only described the total lipid fraction, which was a mixture containing both polar and neutral lipids.
- (d) The Board also acknowledged novelty of the process according to Claim 5 of Auxiliary Request 1.

It was held that the maximum biomass reached under the growth conditions of D4 and D10 was lower than the minimum biomass of 10 g/L required in Claim 5. This in particular emerged from the second Declaration by Dr. David J. Kyle (hereinafter: D57), showing that the maximum biomass reached under the growth conditions of documents D4 and D10 were 2.35 g/L and 3 g/L, respectively.

- (e) Under point 4 of the decision the Board stated that the rejection of the main request and the Board's findings in relation to the first auxiliary request under Articles 123(2), 123(3), 83 and 54 EPC were *res judicata*.



(f) The final decision of the Board was to set aside the appealed decision and to remit the case to the Opposition Division for further prosecution. The essential reasons for remittal were given in point 4, where it was said that the Opposition Division had based its decision on the grounds of lack of novelty but had left out the issue of inventive step, which, however, was an essential substantive issue in the present case.

VIII. In the subsequent continued opposition proceedings the proprietor filed, with the letter dated 3 June 2005, sets of claims as bases for a new main request and Auxiliary Requests 1 to 6. The claims according to the main request corresponded to the claims according to Auxiliary Request 1, on the basis of which remittal of the case to the Opposition Division had been ordered. With the same letter further documents, *inter alia* GB-A 2 098 065, later renumbered to D65a, were filed by the patent proprietor.

IX. Opponent II maintained its earlier objections as to lack of inventive step and submitted additional documents. With its letter dated 27 June 2005 Opponent II raised for the first time an objection under Article 84 (lack of clarity) against Claim 1 of the proprietor's main request.

X. With its decision announced at the end of the oral proceedings on 4 August 2005 and issued in writing on 5 September 2005, the Opposition Division found that the claims according to the main request met the requirements of the EPC. The decision in particular dealt with the following issues:

(a) Admissibility of the Article 84 objection

The Opposition Division did not admit the objection under Article 84 into the proceedings. It held that the Board in the First Appeal had implicitly decided on clarity because otherwise the Board could not have taken a decision on novelty.

(b) Inventive step

- (i) The Opposition Division considered D10 representative of the closest prior art.
- (ii) Concerning the edible oil claimed in Claim 1, the Opposition Division held that a skilled person would not learn from the disclosure in D10 per se that an oil with 35% DHA could be obtained. Furthermore, he would not have been motivated to investigate whether the oil produced by the microorganisms according to the teaching in D10 contained DHA predominantly in the neutral or the polar lipid fraction.
- (iii) As to the process according to Claim 5, the Opposition Division held that the achieved cell density of at least 10 grams biomass per litre was considerably higher than that disclosed in D4 and that a skilled person could not foresee the influence of the increased biomass density on the fatty acid composition of the oil.

- XI. On 4 November 2005 Opponent II (hereinafter: the Appellant) filed an appeal against the decision of the Opposition Division and paid the prescribed fee on the same day. The statement of the grounds of appeal was filed on 5 January 2006. The Appellant maintained its position that the claimed subject-matter lacked an inventive step and also reiterated its objections under Article 84 EPC.
- XII. In its reply dated 24 July 2006 the patent proprietor (hereinafter: the Respondent) defended the requests which had been before the Opposition Division (i.e. main request and auxiliary requests 1 to 6).
- XIII. With its letter dated 29 December 2006 the Appellant for the first time raised an objection under Article 83 EPC as regards Claim 1 of the main request.
- XIV. With the summons dated 27 August 2008 oral proceedings were scheduled for 31 March 2009.
- XV. With its letter dated 16 December 2008 the Appellant provided further, detailed arguments as to lack of inventive step of the claimed subject-matter and cited the new document:

D79 JP S63-90598.

With respect to Claim 1 of the main request, the Appellant in particular argued that the claimed oil was obvious when starting from any one of the following documents as closest prior art:

D79 edible oils containing up to 33% DHA extracted with hexane from tuna or bonito heads;

D65a DHA-enriched oil preparations, for instance in the form of triglyceride mixtures containing 85% DHA;

D10: edible oil extracted from *C. cohnii*.

The Appellant argued further that the process of Claim 5 of the main request was obvious from D4.

XVI. By a letter dated and sent on 30 March 2009, i.e. one day before the scheduled oral proceedings, the Respondent raised for the first time the issue that the appeal was inadmissible. It said that although the appeal had been filed in the name of Aventis R&T, this company had ceased to exist in 2003. Further, that in 2000 the opposition and the business interests in respect of which the opposition had been filed had in any event been transferred by Aventis R&T to another company, Axiva GmbH (hereafter "Axiva"). These business assets had then in July 2002 been transferred from Axiva to Nutrinova, the food ingredients business of Celanese Ventures GmbH from which company the relevant business was subsequently acquired by Lonza Ltd in December 2005. Evidence in support of these allegations was filed.

XVII. This issue was briefly discussed at the oral proceedings which took place on 31 March 2009, during which the Appellant filed various documents in response to those of the Respondent's. At the conclusion of the

hearing, the Board ordered the proceedings to be continued in writing to enable evidence and submissions to be filed in accordance with a timetable set by the Board.

The parties duly filed such material as follows:

29 May 2009: Submissions and evidence (Z2 - Z16) from the Appellant, including a request (Z1) for correction of the name of the Appellant to Sanofi-Aventis Deutschland GmbH (hereafter: "Sanofi-Aventis").

21 August 2009: Evidence and submissions from the Respondent in response.

Subsequently, further, essentially repetitive, exchanges were filed by the parties.

XVIII. On 24 March 2010 the Board sent the parties a communication together with a summons to oral proceedings on 7 and 8 July 2010, indicating its provisional opinion on the admissibility issue, as well as on other procedural and substantive aspects of the appeal. The Appellant filed a response to this communication on 6 May 2010 and the Respondent on 7 June 2010.

XIX. The oral proceedings which took place on 7 and 8 July 2010 took the following course:

(a) The admissibility of appeal and correction of the name of the Appellant to Sanofi-Aventis were discussed. After interruption of the debate, the

Board indicated its conclusion that the appeal was admissible and the name of the Appellant would be corrected as requested.

(b) The admissibility of the Appellant's objections under Articles 83 and 84 EPC was discussed. After interruption of the debate, the Board indicated its conclusion that the Article 84 and Article 83 objections would not be admitted into the proceedings.

(c) Inventive step of the subject-matter according to Claim 1 of the main request was discussed in particular in respect of the following documents and/or combinations thereof, namely D4, D10, D65a and D79.

After a discussion on admissibility of the late-filed document D79, it was admitted into the proceedings.

(d) Towards the end of the first day of the oral proceedings the Appellant presented objections of lack of inventive step based on a combination of D4 as closest prior art with D65a. The Respondent did not at that stage object to this line of argument being advanced.

(e) When the proceedings were resumed on 8 July 2010, the Board indicated that, as regards the attack based on D4 as closest prior art in combination with D65a, Claim 1 appeared to the Board not to be based on an inventive step since a combination of neutral lipids as obtained in accordance with

Table 1 of D4 with a DHA concentrate obtained according to D65a seemed to lead to a product according to Claim 1. Of all the inventive step attacks made by the Appellant, this was the only one which appeared to the Board to be likely to succeed. However, the Board was concerned that the arguments of the parties had not been sufficiently directed to this issue, which was now seen by the Board as being crucial. The Board therefore wished to give the parties, particularly the Respondent, the opportunity to address the Board further on the point.

- (f) Further submissions on this issue were then presented. The Respondent's main position was that D65a, and not D4, was to be considered as closest prior art.
- (g) After interruption of the debate, the Board indicated its conclusion that the subject matter of Claim 1 of the main request was not inventive over a combination of D4 taken as the closest prior art and combining it with D65a.
- (h) The Respondent then for the first time raised the objection that the Appellant's submissions concerning lack of an inventive step based on a combination of D4 with D65a represented a completely new line of argument which had been advanced for the first time on the late afternoon of the previous day. As the Respondent had had no opportunity to deal extensively with this argument or to provide evidence that a combination of D4 with D65a would not lead to the oil of Claim 1, it

was argued that a decision adverse to the Respondent at this stage of the proceedings would violate its right to be heard, contrary to Article 113(1) EPC. The Respondent thus requested adjournment of the oral proceedings.

- (i) After interruption of the oral proceedings and deliberation the Board ordered the proceedings to be continued in writing, each party being at liberty to file evidence relating to the following issue, namely:

"Whether a combination of (a) neutral lipids as obtained in accordance with table 1 of D4 and (b) a DHA concentrate obtained in accordance with D65a would lead to a product according to claim 1 of the respondent's main request ... ."

Such evidence was to be limited to that of one expert from each side and to be filed in accordance with an agreed timetable.

XX. With the summons dated 18 July 2010 new oral proceedings were scheduled for 18 and 19 January 2011. Meanwhile each party filed evidence and submissions pursuant to the above order.

XXI. On 18 January 2011 further oral proceedings were held. At the start of the oral proceedings, the Board indicated that notwithstanding the evidence and submissions which had been filed pursuant to the order made on 8 July 2010, the Board first wished to hear argument on the question whether a skilled person,



taking D4 as the closest prior art, would have considered combining neutral lipids as obtained in accordance with Table 1 of D4 with a DHA concentrate obtained in accordance with D65a in order to solve the objective problem. The Board would then, if necessary, hear argument on whether such a combination would in fact lead to a product according to Claim 1. The proceedings then took the following course:

- (a) The parties made submissions as to whether the Appellant's inventive step argument based on D4 as closest prior art combined with D65a was a new argument and thus an amendment to the Appellant's case which should not be admitted into the proceedings under Article 13 of the Rules of Procedure of the Boards of Appeal (hereafter: "RPBOA"). After an interruption of the proceedings the Board announced that this argument was to be considered as already part of the proceedings.
- (b) The parties made submissions as to whether a skilled person would have combined D4 with D65a in order to arrive at the oil according to Claim 1 of the main request (inventive step). After deliberation the Board indicated its conclusion that the skilled person would not have done so.
- (c) In the event it was therefore not necessary to hear the parties on the issue of whether combining neutral lipids as obtained in accordance with Table 1 of D4 with a DHA concentrate obtained in accordance with D65a would in fact lead to a product according to Claim 1.

- (d) The parties made submissions on inventive step of the process claimed in Claim 5 of the main request starting from D4 as the closest prior art.

XXII. The Respondent's arguments concerning admissibility of the appeal may be summarized as follows:

- (a) The opposition had been filed by Aventis R&T. Its interest in the opposition had subsequently been transferred to Axiva as a result of an agreement between these two parties dated 14 April 2000 (hereafter: "the Technology Transfer Agreement"), and Axiva's interest had been subsequently transferred through a series of companies to Lonza Ltd. This had resulted in a transfer of the opposition since it is not possible to transfer the business assets in relation to which an opposition has been filed without also transferring the opposition. Oppositions and their underlying business assets are inseparable: see G 4/88 (OJ EPO 1989, 480) and G 2/04 (OJ EPO 2005, 549).
- (b) If, contrary to this submission, evidence of the Technology Transfer Agreement had to be filed before a transfer of the opposition could be acknowledged as having taken place, such evidence was present in the Office's file in the separate opposition proceedings against the patent EP 0443861. Axiva had requested transfer of that opposition in September 2000 and in August 2004 had filed a copy of the Technology Transfer Agreement. The Office therefore had constructive

knowledge that the present opposition had been transferred to Axiva.

- (c) As shown by the relevant company register, Aventis R&T was subsequently dissolved, and had ceased to exist on 31 May 2003. Even if the opposition had not already been transferred to Axiva as above, and even if, as alleged by the Appellant, Aventis R&T had a universal successor in the shape of Aventis Research & Technologies Verwaltungs GmbH, it was not legally possible for the status of opponent to be acquired by a universal successor: the requirements for a transfer of party status are very different for an opponent than for an proprietor.
- (d) But even if this were possible, it was not legally possible for such a successor to acquire the status of opponent from a company which had already divested itself of its interest in the opposition. Since an appeal could only have been validly filed in the name of an entity which owned the relevant business assets and which had the status of opponent at the time when the appeal was filed, the appeal filed in the name of Aventis R&T was inadmissible.
- (e) T 1324/06 showed that an appeal filed by an opponent which had already transferred the relevant business assets to a third party might be inadmissible.
- (f) Alternatively, T 136/01 showed that in a case where an appeal was filed by an opponent which had

previously transferred the business assets in relation to which the opposition had been filed, it was necessary to show that the opponent still existed.

- (g) Although G 3/97 (OJ EPO 1999, 245: the "straw-man" case) envisaged circumstances where an opposition might be filed by a person acting on behalf of a third party, this principle did not apply following the transfer of a pending opposition.
- (h) Even if G 3/97 applied following a transfer of a pending opposition, it did not apply to a case where the opponent had ceased to exist before an appeal is filed. Even a "straw man" must be a real person or company.
- (i) The present case was concerned with a distinction between a legal fact and a legal fiction. The legal fact here was that the person aggrieved (i.e., adversely affected - see Article 107 EPC) by the decision was Nutrinova (the food ingredients business of Celanese Ventures GmbH, to which company the relevant business assets had been transferred in July 2002). The legal fiction is that there is such a thing as "party status", this being something for which there is no basis in the EPC and which is merely an administrative convenience for the EPO. The persons named in the proceedings from which an appeal may be filed enjoy "party status", even if there has been a transfer from that party. This legal fiction enables the EPO to administer appeal proceedings without investigating whether there has been a

change in the legal fact situation. This implies that "party status" is inextricably linked to the name of the party. If this "party status" can be transferred, then it must have been transferred in the present case by the Technology Transfer Agreement, and the appeal is inadmissible. If it cannot be transferred, then it cannot be transferred by universal succession and the appeal is again inadmissible.

- (j) It is no answer to this argument that it means that the right to file an appeal can thereby be irretrievably lost. There is no absurdity in rights being lost where a company does not take steps to preserve them. Aventis R&T could have preserved the right by registering the transfer to Axiva, but had chosen not to do so, and was thereby at risk.
- (k) Even if it were possible in such a case for a universal successor to acquire the status of opponent, evidence must be filed with the Office to establish the succession before an appeal could be validly filed by such a successor: see T 6/05 and T 956/03. This did not happen in the present case. Since no evidence was filed, the right had disappeared.
- (l) T 656/98 was also relied on in this respect: for a transferee of a patent to be entitled to appeal, the necessary documents must be filed first.
- (m) If the argument of the Appellant were correct, it would mean that the Office would be left with two

different parties who could claim opponent status: a transferee of the assets in relation to which the opposition had been filed and a universal successor of the original opponent. This was intolerable.

- (n) The name of the Appellant could not be corrected to Sanofi-Aventis (as universal successor of Aventis R&T). The notice of appeal and statement of grounds of appeal should each have been filed in the name of the entity that owned the relevant business assets at the time of filing, namely Axiva or its successor Lonza Ltd respectively. Since it was accepted by the Appellant that it was never the intention to file in the names of either of these two companies, it was not possible to correct the name of the Appellant to one of these companies either.
  
- (o) T 97/98 (OJ EPO 2002, 183) shows that it is possible to correct the name of an appellant if the correction only expressed what was intended when filing the appeal. However, there was no evidence in the present case that there was any intention to file an appeal in the name of Sanofi-Aventis, as opposed to Aventis R&T. Indeed, the reverse was the case. The evidence and submissions of the Appellant dated 29 May 2009 (Section B.II.2.2) showed that it was the intention to file the appeal in the name of Aventis R&T, not in the name of any possible successor company. The assertion by the relevant representatives that they "would have" filed an appeal in the name of Sanofi-Aventis had they known of the succession

had not been sufficiently established by the evidence and in any event such evidence could not be tested by the Respondent.

- (p) The declaration which had been filed by Sanofi-Aventis dealt with the history of the company, but there was no letter from Sanofi-Aventis actually expressing any interest in the proceedings.
- (q) Even if it had been the intention to file an appeal in the name of Sanofi-Aventis, this intention was an error of law. Only an error of fact can be corrected (T 656/98, Point 5 of the Reasons).
- (r) Correction of the name to Sanofi-Aventis would enable the opposition to be separated from the underlying business assets, so circumventing the requirements of G 4/88 and G 2/04.
- (s) A correction should also not be allowed in this case because it would have serious procedural consequences. The evidence now showed that the defendants in the infringement proceedings in the German national courts brought by the Respondent against Lonza Ltd and Nutrinova had in fact been conducting the opposition proceedings in the name of, and hiding behind, Aventis R&T. The defendants in these national proceedings had not availed themselves of the opportunity to be joined under Article 105 EPC, presumably because they were already in charge of the opposition. This had disadvantaged the Respondent, for example by preventing it from highlighting the contradictory

arguments on the construction of the claims put forward by the defendants/Appellant in the national and the EPO appeal proceedings respectively or using their submissions in one set of proceedings in the other. Their interpretation of the claims had varied. This conduct amounted to an abuse, therefore taking the case outside what was permissible under G 3/97.

- (t) Even if there was no, or no sufficient abuse in this case, the mere possibility of such abuse was sufficient to take this case outside G 3/97. The Appellant could deny things in these proceedings which the defendants had accepted in the national proceedings, and *vice versa*.

XXIII. As regards the admissibility of the appeal, the Appellant argued as follows:

- (a) Under the terms of the Technology Transfer agreement, the opposition and the assets in relation to which the opposition had been filed had never been fully transferred by Aventis R&T to Axiva, with the effect that any application to have a transfer of the opposition registered would have failed. For reasons which will become apparent, it is not necessary to set out the Appellant's very detailed arguments on this issue.
- (b) Even if the opposition and the assets in relation to which the opposition had been filed had been fully transferred by Aventis R&T to Axiva, the status of opponent remained with the original opponent until the change had been registered by



the Office in response to a valid request coupled with the requisite evidence. Here, no such request had ever been made because the relevant parties had made a conscious and deliberate decision to continue the opposition in the name of Aventis R&T, not least because of the Office's strict approach to transfers of oppositions and doubts about whether the Technology Transfer Agreement was sufficient to do so.

- (c) Following the dissolution of Aventis R&T, its status of opponent had become vested first in Aventis Research & Technologies Verwaltungs GmbH and then later in Sanofi-Aventis, each as universal successor to the previous company.
- (d) Although the conduct of the opposition, and the filing of the notice of appeal and the statement of grounds of appeal, had all been done in the name of Aventis R&T and not Sanofi-Aventis, this had been a simple oversight. It had been intended to take all these steps on behalf of the actual opponent.
- (e) As to the steps taken in the appeal proceedings in the name of Aventis R&T, the name of the Appellant could be corrected to Sanofi-Aventis.
- (f) A more detailed discussion of the Appellant's arguments is contained, below, in the Reasons.

XXIV. The Appellant's arguments regarding the objection under Article 84 EPC were as follows:

- (a) In the First Appeal, the Board had specifically stated what issues were to be regarded as *res judicata* as regards what is now the main request (then the first auxiliary request), and Article 84 EPC was not one of them. The Board was in no position to determine whether the term "directly" was clear; nor was the Appellant in a position to dispute the point, given that the request was only filed during the oral proceedings. Indeed, the lack of any explicit reference in the decision to Article 84 EPC indicates that the Board in the First Appeal saw this issue as problematic. The point was therefore open to argument following remittal of the case to the Opposition Division.
- (b) The term "directly" had in fact led to a lack of clarity in Claim 1 of the main request.

XXV. The Respondent's arguments regarding the objection under Article 84 EPC were as follows:

- (a) The objection under Article 84 EPC was *res judicata* because the Board in the First Appeal did not say that this was an issue which remained to be discussed in the proceedings. Implicitly the Board had obviously considered the question in the ordinary way and decided that there was no valid objection.

(b) Further, the Board did in fact decide that the claim was clear. It could not have decided that the claim was novel if it had not also decided that it was clear.

(c) The Appellant's actions clearly indicated that it also thought that the point had been decided

XXVI. The Appellant's arguments regarding the objection under Article 83 EPC were as follows:

(a) Although the Board in the First Appeal had stated expressly that the rejection of the then main request and its findings in relation to the then first auxiliary request (now the main request) *inter alia* under Article 83 EPC were *res judicata*, it was clear from reading the decision as a whole that the only finding under Article 83 EPC had been in relation to the then main request and that the Board had not considered Article 83 EPC in relation to the then first auxiliary request at all. The point therefore remained open to argument in these proceedings. It was not a fresh ground of opposition

(b) The introduction of the word "directly" into Claim 1 in fact meant that the invention as now claimed was not sufficiently disclosed.

XXVII. The Respondent's arguments regarding the objection under Article 83 EPC were as follows:

(a) The issue was *res judicata* following the decision in the First Appeal.

- (b) Following remittal of the case to the Opposition Division, the issue of Article 83 EPC was also considered as *res judicata* by the Division (see Point VI of the grounds for the decision) and the Appellant had indeed never sought to raise the issue. The Appellant was seeking to reintroduce into the appeal proceedings a ground of opposition which it had effectively withdrawn and which did not form part of the decision on which the appeal was based, contrary to G 9/91 (OJ EPO 1993, 408), G 10/91 (OJ EPO 1993, 420) and T 520/01.
- (c) The objection had been raised for the first time more than one year after the filing of the statement of the grounds of appeal, and thus required an amendment to the Appellant's case (Article 13(1) ROPBA). Allowing such an amendment would considerably increase the complexity and duration of the appeal.

XXVIII. The Appellant's arguments concerning inventive step may be summarized as follows:

- (i) Would a skilled person have combined D4 with D65a in order to arrive at the oil according to Claim 1 of the main request?
- (a) The patent, in its whole context, was concerned with the preparation of edible oils having a high DHA content and therefore meeting certain physiological requirements. As to its technical content the teaching of the patent focussed on the problem of how to cultivate the microorganism C.

cohnii in order to obtain edible oils with a high DHA content. The technical teaching of the patent therefore exclusively related to a process for cultivating microorganisms under conditions which induced the microorganism to produce high amounts of DHA.

- (b) The scope of Claim 1 was not limited to edible oils exclusively produced by single cell microorganisms but also embraced oils from other sources, as long as they had the same composition as a single-cell oil directly obtainable by hexane extraction. In this connection, the product-by-process feature "directly obtainable by hexane extraction", which was as such not detectable at the oil itself, was not limiting and had to be understood such that the oil existed in the form of an essentially neutral lipid fraction, i.e. as triglycerides. Because it was the common general knowledge of a skilled person that edible oils were always triglycerides, D4, which described neutral lipid fractions of single-cell oils, was a suitable starting point for the assessment of inventive step.
  
- (c) It was known from this document that the growing conditions for *C. cohnii* in a saline medium (0.3% NaCl) as indicated in Table 1 led to a triglyceride fraction having a DHA content of about 32%, which was slightly lower than the minimum amount of 35% as claimed in Claim 1.
  
- (d) Because, as stated above, the subject-matter of Claim 1 was not limited to single-cell oils, the

problem to be solved merely had to be seen in the provision of an edible oil having an enhanced DHA-content.

- (e) In order to solve the problem the skilled person would turn to D65a, which described a health food rich in DHA and concentrated and isolated from the oil and fat of aquatic animals. It was further indicated in D65a that the DHA concentrate can be handled in the same way as conventional edible oils and is suitable for being blended with various foodstuffs, for instance other edible oils. Owing to the high purity of the concentrate obtained *inter alia* by solvent extraction or chromatography, impairment of the quality, taste and flavour of the foodstuff by impurities would not occur.
  
- (f) The skilled person would therefore be prompted to blend DHA concentrates obtained according to D65a with the single-cell oils described in D4 in order to enhance their DHA content. Because, as shown in the experiments submitted with the letter dated 8 November 2010, blending of a neutral lipid fraction obtained using the growing conditions of Table 1 of D4 (14°C and with 0.3% NaCl) with the DHA concentrate obtained in Example 4 of D65a led to an oil falling under Claim 1 of the main request, the claimed oil lacked an inventive step.
  
- (ii) Would D79 taken alone or its combination with D65a lead to the oil according to Claim 1 of the main request?

- (a) D79 relates to oils containing considerable amounts of DHA which are suitable as a health food and which are *inter alia* obtainable by hexane extraction from fish heads (page 4, paragraph 2 and page 5, last paragraph). According to Example 2, a hexane-extracted lipid fraction containing 32.5% DHA was obtained. Because of its extraction with the non-polar extraction medium hexane, this fraction existed in the neutral triglyceride form and could be used as edible oil in accordance with Claim 1. The claimed oil differed therefrom merely by its slightly higher minimum DHA content of 35%.
- (b) A skilled person intending to increase the DHA content in the oil of D79 had principally two possibilities which were common in the art:
- increasing the relative DHA portion by removing other (in particular saturated) lipids by winterization (i.e. freezing them out);
  - addition of further DHA, for instance a concentrate as described in Example 3 of D65a with 85% DHA. It should be noted that addition of 10g concentrate according to Example 3 of D65a to 100g oil of Example 2 of D79 would lead to an oil with 36% DHA.
- (iii) Inventive step of the oil of Claim 1, taking D65a alone as closest prior art

Example 6 of D65a discloses an edible oil containing 29.5% DHA which was obtained by hexane extraction from frozen salmon. A skilled person

intending to increase the DHA content of this oil would be motivated to add further DHA, for instance in the form of a concentrate according to Examples 3 or 8 of D65a, with a DHA purity of 85% and 82%, respectively.

- (iv) Would a combination of D10 with D4 lead to the oil according to Claim 1?

It was known from D10 (page 5, first paragraph) that unicellular organisms like *C. cohnii* are suitable sources for preparing oils with a high content of Omega-3 fatty acids, *inter alia* DHA. Example 1 describes one route for preparing such oils including the steps of cultivating the microorganism, harvesting and solvent extraction using methanol/chloroform/water. On page 8 it is pointed out that the Omega-3 fatty acids constitutes 10 to 50% of the total fatty acid fraction, such fatty acids being generally contained in the polar fractions (like phospholipids) and the neutral fractions (like triglycerides). Because a skilled person would be aware of the toxicity of extraction media like chloroform or methanol, as well as of the unsuitability of the polar phospholipids as edible oils, he would consider the neutral triglyceride fraction (e.g. obtainable by extraction with non-polar solvents such as hexane) as a suitable source for a DHA-containing edible oil. In this conjunction he would learn from Figure 7 of D4 that a considerable DHA portion is present in the triglyceride fraction of a unicellular oil derived from *C. cohnii*. In respect of the disclosures in



D10 and D4, an increase of the DHA content up to 35% would be a trivial measure.

- (v) Inventive step of the process claimed in Claim 5 of the main request starting from D4 as the closest prior art.
- (a) The process according to Claim 5 essentially embraced three steps:
  - the cultivation step;
  - the harvesting step;
  - the recovery step.
- (b) D4 was representative of the closest prior art. It described all three steps of Claim 5, the only difference being that - according to the declaration of Dr. Kyle, D57 - the highest reported biomass density of the nutrient solution was 2.85 g/L in the culture labelled "*stationary phase at 4 days*" according to Table 1, instead of 10 g/L as required in Claim 5, leading to an oil concentration of 1.5 g/L nutrient solution.
- (c) Therefore, the problem to be solved by the claimed process was the provision of a nutrient solution leading to a higher lipid content in the recovery step.
- (d) However, as the patent in suit used the same microorganism as in D4, namely *C. cohnii*, and gave no teaching as to which growing conditions had to be applied in order to obtain this enhanced cell

density vis à vis D4, Claim 5 merely expressed a result to be achieved.

- (e) Moreover, it emerged from Table 1 of D4 that extension of the duration of the stationary phase from one day to four days leads to an enhanced cell density and, consequently, to a higher lipid concentration. It would therefore have been obvious for a skilled person to enhance the cell density in the nutrient solution in order to arrive at a higher lipid concentration.

XXIX. The Respondent's arguments as to inventive step were as follows:

- (i) Would a skilled person have combined D4 with D65a in order to arrive at the oil according to Claim 1 of the main request?
  - (a) The patent was concerned with the provision of edible single-cell oils which have enhanced levels of DHA. The oils of the invention lacked unpleasant taste/organoleptic characteristics and fishy odours, and were free from environmental contaminants often found in fish oils. These properties made the oils of the invention particularly suitable as supplements in infant formulas and baby foods. From the patent specification it could be clearly deduced that the teaching underlying the invention related to oils derived from vegetable sources and was directed to avoiding oils derived from fish sources.

- (b) Taking D4 as closest prior art the problem to be solved was to provide a neutral lipid fraction that could be directly obtained from a unicellular organism and that had a high DHA content of at least 35%.
  
- (c) In this context it had to be noted that the manufacture of oils from microbes (vegetarian sources) such as those described in D4 required different techniques from those required for manufacturing fish oil. For this reason, a skilled person intending to enhance the DHA content of the single-cell oil according to D4 would not have combined this document with D65a, which predominantly related to DHA concentrates derived from fish, i.e. an animal source. Consequently, the skilled person would have had no incentive to enhance the DHA content of the vegetarian oil of D4 by mixing it with a DHA concentrate derived from fish.
  
- (d) On the other hand, when starting from D65a as closest prior art, no reason could be seen in taking a fish oil from one of the examples of D65a, which already have a high DHA content within the claimed range, and then to dilute it with a vegetarian oil of D4 with a DHA content below the claimed range in order to reduce the DHA content of the oil of D65a.
  
- (e) For assessing inventive step it was not sufficient to show that the skilled person could have combined D4 with D65a, as argued by the Appellant. Rather, it is necessary to show that a skilled

person would have done it. For the reasons mentioned above, however, this was not the case. The claimed oil was therefore based on an inventive step.

- (ii) Would D79 taken alone or its combination with D65a lead to the oil according to Claim 1 of the main request?
  - (a) Both D79 and D65a relate to oils obtained from fish, which oils could clearly be distinguished from a unicellular oil by their fatty acid profile. The Appellant had not provided any evidence that a fatty acid profile of a unicellular oil as claimed can be obtained from fish oil.
  - (b) Moreover, no evidence had been provided that measures such as winterization necessarily enhanced the DHA portion in the oil. As DHA and saturated fatty acid are present in the same triglyceride molecule, the contrary could be the case.
  - (c) Furthermore, no motivation could be seen for a skilled person to dilute a concentrate from D65a down to the oil according to D79.
- (iii) Inventive step of the oil of Claim 1, taking D65a alone as closest prior art

The concentrates according to Examples 3 and 8 of D65a with such high DHA contents of 85%/82% were artificial products which were not directly obtained by hexane extraction from viable cells

but rather were further purified by chromatography. Therefore, there was no incentive for a skilled person to dilute such artificial concentrates down to the hexane extract obtained in Example 6.

- (iv) Would a combination of D10 with D4 lead to the oil according to Claim 1?
  - (a) D10 did not mention that the unicellular oils are obtainable by extracting the microorganisms with hexane. Furthermore, the passage at page 8 merely relates to the group of Omega-3-fatty acids in general (from which DHA was only one example besides others such as EPA). The further statement that the total fatty acid fraction containing from 10 to 50% of Omega-3 fatty acids was obtained after extraction of the samples harvested from the examples, only related to samples for which methanol/chloroform/water was exclusively used as extraction medium.
  - (b) No conclusion could be therefore drawn from this disclosure as to the amount of the specific Omega-3 fatty acid DHA in the triglyceride fraction directly obtainable by hexane extraction. As D4 disclosed in Figure 7 a maximum DHA-content of about 32% in the triglyceride fraction, a combination of D10 with D4 would not lead to the claimed oil with at least 35% DHA.
- (v) Inventive step of the process claimed in Claim 5 of the main request, starting from D4 as the closest prior art.

- (a) As the Appellant itself stated on page 42 of the grounds of appeal dated 5 January 2006, how to increase the biomass density of the nutrient solution was common knowledge. An increased biomass density, however causes an increase of viscosity of the nutrient medium. Higher viscosity requires higher shear forces for agitating the medium, something which is necessary to achieve adequate oxygenation in order to maximize growth of the microorganism.
- (b) As indicated in column 1 lines 44 to 52 of the patent specification with reference to a publication in 1984, and as also confirmed in points 9 and 10 of Dr. Kyle's declaration D57, it was known that dinoflagellates, such as *C. cohnii*, are shear sensitive and fragile. A skilled person would therefore not have contemplated increasing the biomass density of the nutrient medium above the maximum value of 2.85 g/L achieved in D4 in order to enhance the concentration of the single-cell oil to a value of 1.5 g/L as required in Claim 5.
- (c) The claimed process was therefore inventive also.

XXX. The final requests of the parties were as follows:

- (a) The Appellant requested that:
- (1) The appeal be accepted as admissible;
  - (2) The name of the Appellant be corrected to "Sanofi-Aventis Deutschland GmbH";

(3) The decision under appeal be set aside and the patent be revoked.

(b) The Respondent requested that:

(1) The appeal be rejected as inadmissible;

(2) The Appellant's objections under Articles 83 and 84 EPC be not admitted into the proceedings;

(3) The appeal be dismissed.

(c) Opponent IV took no active part in the appeal and did not file any requests.

## **Reasons for the Decision**

### *Admissibility of the appeal*

1. The Respondent identifies as one of the key questions for the Board as being to decide: if an opponent transfers the business assets in the interests of which the opposition was filed to another company and then ceases to exist, is a later appeal filed in the name of the non-existent company admissible? The answer to this question in the present case is, yes.
  
2. It is easiest to deal with the numerous arguments raised by the Respondent by considering them in relation to the chronological sequence of the relevant events, the three important ones being: (a) the execution of the Technology Transfer Agreement dated 14 April 2000; (b) the dissolution of the original opponent, Aventis R&T, on 31 May 2003; and (c) the

filing of the notice of appeal and statement of grounds of appeal in the name of Aventis R&T on 4 November 2005 and 5 January 2006, respectively.

3. The effect of the Technology Transfer Agreement

3.1 In its written submissions the Respondent argued, relying on G 4/88, that since an opposition is an inseparable part of the assets in relation to which the opposition was filed and cannot be transferred *inter-partes* separately from those assets, this means that when such assets are transferred *inter-partes*, the opposition is *ipso facto* also transferred. This argument was not elaborated on in the course of the oral proceedings and is clearly untenable on the basis of the jurisprudence of the Boards of Appeal. Nevertheless, since the argument pervades many of the proprietor's other arguments, it is appropriate to say something in detail about it here.

3.2 The conclusion which the Respondent seeks to draw from G 4/88 is not correct. There, the Enlarged Board held that an opposition may be transferred or assigned to a third party as part of the opponent's business assets together with the assets in the interests of which the opposition was filed (see the Order of the Enlarged Board). As part of the reasons for this, the Enlarged Board said that where the opposition had been instituted in the interest of the opponent's business:

"... the opposition constitutes an inseparable part of those assets. Therefore, insofar as those assets are transferable or assignable under the applicable national laws, the opposition which is



part of them must also be regarded as *transferable or assignable* in accordance with the principle that an accessory thing when annexed to a principal thing becomes part of the principal thing." (Point 6 of the Reasons, emphasis added).

- 3.3 Despite saying that "the opposition constitutes an inseparable part" of the assets in respect of which it was filed, the Enlarged Board did not say that the opposition was automatically transferred with the business assets; rather, that it was *transferrable*. Indeed, as pointed out in T 19/97 (point 2 of the Reasons) the Enlarged Board did not deal with the procedural requirements for the valid transfer of opponent status; it has been left to subsequent case law to work this out. Such case law makes it clear that where the business assets in relation to which the opposition was filed have been transferred and at the same time the transferor has contractually agreed to transfer the opposition to the transferee, the status of opponent stays with the transferor until (a) evidence has been filed with the Office sufficiently evidencing the transfer and (b) a request has been filed to recognise the transfer of the status of opponent. See T 19/97, Point 5 of the Reasons, and also T 1137/97:

"For the purpose of EPO proceedings, the effective date of the transfer of an opposition must be taken as the date when the transfer has been requested at the EPO and adequate evidence provided. ... [A] transfer of an opposition is something that has to be requested at the EPO

together with supporting evidence before it can take effect." (Point 4 of the reasons).

- 3.4 Until such a request has been made and evidence of the transfer has been provided to the Office, the transferor-opponent continues to have the relevant rights and obligations. See T 670/95 (Point 2 of the Reasons), T 413/02 (Point 3 of the Reasons). In T 6/05 the Board made it clear that in a case where the status as opponent is agreed to be transferred together with the assignment of business assets the party status may either remain with the original opponent or be transferred to the new opponent:

"In the case of transfer by assignment of particular business assets from one (legal) person to another ... the original opponent continues to exist ... [T]he original opponent may continue the opposition proceedings. If the assignee who acquired the particular business assets wishes to become a party to the opposition proceedings, it is justified to grant it party status only at the date when sufficient evidence has been produced, because the original opponent only then loses, as a consequence, its party status." (Point 1.6.4 of the Reasons).

- 3.5 The Respondent seeks to distinguish T 1137/97 and T 670/95 on the basis that they do not deal with the case of an *inter-partes* transfer where the transferor has later ceased to exist. But this point is not relevant to the present stage of the argument, which is only concerned with the effect of an *inter-partes* transfer.

3.6 In T 136/01 a similar argument to that advanced by the Respondent was advanced, also based on the same reading of G 4/88, and was similarly rejected: see Point 1.6 of the Reasons. There, the original opponent was Hoechst AG, on whose behalf an appeal was filed, although the assets in respect of which the opposition had been filed had in the meantime been transferred (as it happens, to Aventis R&T and then to Axiva). The Board said:

"As long as the requested transfer has not been sufficiently substantiated, and has not been accepted by the competent department, the original opponent retains the status of party to the opposition proceedings." (Point 1.4.10 of the Reasons).

3.7 The reason for the above requirement of a request coupled with supporting evidence is procedural certainty: the proprietor and the Office must be in a position to know with certainty who is the person entitled to prosecute the opposition at any particular time. See e.g. T 1137/97 (Point 4 of the Reasons) and T 956/03 (Point 7 of the Reasons).

3.8 The Respondent advanced a rather obscure point based on submissions as to the nature of opponent party status (see Point XXII(i), above). However, the status of opponent is merely a procedural status created by the filing of an opposition. By this act the opponent becomes a party to the proceedings and thus becomes entitled to a bundle of procedural rights (G 3/97, Point 2.1 of the Reasons; G 4/88, Point 2 of the

Reasons), in particular the right to a legal remedy or remedies (T 724/05, Point 5 of the Reasons). The basis on which the status of opponent is obtained and enjoyed is thus a matter of procedural law (G 3/97, Point 2.1 of the Reasons). See also the commentary on Article 99 EPC in Singer/Stauder, 5th edition, 2010, at point 58 (*"Im Gegensatz zum Patentinhaber hat der Einsprechende keine materiellrechtliche, sondern nur eine verfahrensrechtliche Rechtsposition."*) and in Schulte, 8th edition, 2008, para. 59, point 154 (*"... die Stellung als Einsprechender ... [ist] eine jedem Dritten offen stehende prozessuale Möglichkeit."*).

- 3.9 This status, consisting of the right to prosecute an opposition and to the accompanying remedies, is not dependent on any interest, financial or otherwise, in having the patent revoked. Thus the Enlarged Board in G 3/97 made it clear that an opposition may be filed, in the absence of any relevant abuse (as to which see point 5, below), by someone with no financial, commercial or other interest in the opposition:

"... the EPC legislator explicitly designed the opposition procedure as a legal remedy in the public interest which, according to Article 99(1) EPC, is open to "any person". It would be incompatible with this to require that the opponent show an interest, of whatever kind, in invalidating the patent." (Point 3.2.1 of the Reasons).

- 3.9.1 For the same reasons it is not necessary for an opponent to show, subsequent to the filing of the

opposition, any continuing interest, of whatever kind, in invalidating the patent. See T 1204/97:

"Moreover, as a legitimate interest is not a requirement for an opposition to be admissible (G 3/97 and G 4/97, OJ EPO 1999, 245 and 270, points 3.2.1 et seq., see also Singer/Stauder, loc.cit., Article 99, note 17 et seq.), it can also not be required as a condition for being entitled **to continue** an opposition as the legal successor of the original opponent." (Point 1.2 of the Reasons, emphasis added).

3.9.2 Even if the opponent might in some circumstances be considered to be acting on behalf of the transferee, he remains the true opponent. This was established by the Enlarged Board in G 3/97 in the case of an original opponent acting on behalf of a third party (see points 2.1 and 3 of the Reasons). The argument that a person acting on behalf of a third party is not acting in his own name was rejected. The present Board considers that the position is the same following a transfer of relevant business assets by an opponent. There is no objection to this in the absence of additional reasons establishing an abuse.

3.10 Finally, the Respondent argues that the Office had constructive knowledge of the Technology Transfer Agreement because evidence of it had been filed in separate opposition proceedings (against EP 0443861). The suggestion is apparently that a transfer of the present opposition should have been recognised by the Office as from that moment. No case was cited to the Board in support of this novel proposition. However,

first, there is no principle known to the Board under which the Office can be deemed to have notice in one set of proceedings of matters filed in other proceedings. Second, there was in any event no request filed in the present proceedings for transfer of the present opposition.

3.11 It follows that so far as the Office and the parties were concerned, Aventis R&T remained the opponent after the effective date of the Technology Transfer Agreement (apparently 1 January 2000) when, so the Respondent alleges, Aventis R&T assigned to Axiva the relevant business assets, including its interest in the present opposition.

4. The effect of the dissolution of Aventis R&T

4.1 It next needs to be considered what was the effect of the events which took place in 2003. This is summarised in the declaration April 9, 2009, filed by Sanofi-Aventis, and is substantiated by extracts from the relevant company registers, various declarations and also expert evidence of German company law filed on behalf of the Appellant.

4.2 Aventis R&T was originally established as a limited partnership ("*Kommanditgesellschaft*") in 1998 (under the then name of Hoechst Research & Technologies Deutschland GmbH & Co. KG). The partners were (a) Hoechst AG (as the sole limited partner, or *Kommanditistin*) and (b) Hoechst Research & Technology Deutschland Verwaltungs GmbH (as sole general partner). Hoechst Research & Technology Deutschland Verwaltungs GmbH subsequently changed its name to Aventis Research

& Technologies Verwaltungs GmbH. With legal effect from 31 May 2003, Hoechst AG withdrew from the limited partnership ("*ist ausgeschieden*": see the relevant company register, *Handelsregister des Amtsgericht Frankfurt am Main HRA 28517*). This had the effect of dissolving the limited partnership, with the result that Aventis R&T ceased to exist ("*Die Gesellschaft ist aufgelöst. Die Firma ist erloschen.*": see the entry in the same register for 18 June 2003). On Aventis R&T ceasing to exist, Aventis Research & Technologies Verwaltungs GmbH became the universal successor of the limited partnership, so that all the assets of the partnership were transferred by operation of law to this latter company. With effect from 29 August 2003, this company was merged into Aventis Pharma Deutschland GmbH, with the effect that this latter company became the legal successor to all the assets of the former. This latter company subsequently changed its name to Sanofi-Aventis Deutschland GmbH (referred in this decision as Sanofi-Aventis). Thus in 2003, and so before the notice of appeal was filed, Aventis R&T had ceased to exist and Sanofi-Aventis had become the universal successor to Aventis R&T. These facts were not challenged by the Respondent.

- 4.3 Dr Ahrens, a professional representative acting under an authorisation dated 8 March 2001 (see Z16), had been representing Aventis R&T in the opposition proceedings before the company was dissolved. After Aventis R&T's dissolution, the opposition in fact continued to be prosecuted by Dr Ahrens in the name of Aventis R&T. Thus at the hearing before the Opposition Division on 5 September 2005, the "opponent", named as Aventis R&T, was represented by Dr Ahrens and Mr Taormino, of the

firm Hoffmann Eitle (the latter acting under a sub-authorisation given by Dr Ahrens on 6 July 2005). The decision of the Opposition Division was subsequently notified to Dr Ahrens on the same basis.

4.4 The Appellant argues that the effect of these events was that Aventis Research & Technologies Verwaltungs GmbH, and later Sanofi-Aventis, became the person entitled to pursue the opposition as universal successor of Aventis R&T. The fact that the opposition was in fact continued in the name of Aventis R&RT was a mistake.

4.5 The Respondent argues, first, that even if its earlier arguments are wrong, and Aventis R&T retained the status of opponent after the effective date of the Technology Transfer Agreement, opponent status cannot in general be transferred to a universal successor: the principles applicable to the case of a universal successor of a proprietor, such as T 15/01 (OJ EPO 2006, 153), cited by the Appellant, do not apply to the case of an opponent. Secondly, it was argued that even if in general opponent status can be so transferred, it cannot be transferred in a case such as the present one where the "opponent" had previously transferred the relevant business assets: there was nothing left to be transferred to a universal successor. These two arguments are considered in turn.

4.6 No automatic transfer of opposition to universal successor?

4.6.1 The first line of argument was put forward in the Respondent's written submissions but again was not



developed during the oral proceedings, and again is clearly untenable, as demonstrated by many decisions of the Boards of Appeal. Thus in T 956/03 it was said:

"It is well-established that oppositions, while they may not be freely transferred, can be transferred in certain circumstances - from one natural or legal person to another together either with those assets of a business in the interest of which the opposition was commenced or by universal succession to all assets, as for example by merger". (See point 2 of the Reasons, citations omitted).

4.6.2 See also e.g. T 670/95, where it was said:

"Die Stellung als Einsprechender ist nicht rechtsgeschäftlich frei übertragbar ... . Sie geht allerdings bei einer Gesamtrechtsnachfolge (Universalsukzession) auf den Gesamtrechtsnachfolger über, so z. B. im Fall der Eingliederung oder Verschmelzung juristischer Personen ... ." (Point 2 of the Reasons, citations omitted).

4.6.3 T 425/05, cited by the Appellant, and referred to in more detail below (Point 6.10) is to the same effect. See Point 1 of the Reasons.

4.7 No automatic transfer where prior *inter-partes* transfer?

4.7.1 The Board also considers that this argument is not correct. There does not appear to be any justification for the distinction drawn by the Respondent that such

an automatic transfer cannot take place where the opponent has already transferred the assets in the interests of which the opposition was filed. On the above analysis, Aventis R&T had the right to prosecute the opposition in its name immediately before it ceased to exist and there seems no reason why, as a matter of principle, this right could not pass automatically to Sanofi-Aventis as universal successor.

- 4.7.2 As already explained, the status of opponent is purely a procedural status and does not, in the absence of any relevant abuse (as to which see Point 5, below), require the opponent to have a financial or other interest in the prosecution of the opposition (see point 3.9, above). Even where the right to prosecute is completely bare (i.e., where the opponent possesses no other rights) no authority was cited to the Board, whether concerning the position under the EPC or under German national law, to show that such a bare right is of a kind which cannot pass to a universal successor, and the Board can see no reason why it cannot do so.
- 4.7.3 In G 4/88 the Enlarged Board expressly left out of consideration the question whether an opposition could be transmitted or assigned independently of the existence of an interest in instituting the opposition (Point 5 of the Reasons), but noted that transmission of the opposition to the opponent's heirs is acknowledged implicitly in Rule 60(2) EPC 1973 and that the Guidelines for Examination also allowed, by analogy, for the opposition to be transmitted to the opponent's universal successor in law (see Part D, Chapter I.4 of the Guidelines). This has of course since been confirmed by decisions of the Boards of Appeal, e.g.,

those cited in Point 4.6.1, above. In none of the decisions have the Boards held that, in order for transmission to a universal successor to take effect, the opponent must also possess relevant assets which are at the same time transferred to the successor. Of course in none of these cases were the Boards presented with the unusual facts of the present case. However, it should be born in mind that it is not necessary for an opponent to carry on any business at all, whether of a kind related in some way to the subject matter of the patent, or otherwise. See point 3.9, above. There thus seems no good reason why the right to prosecute an opposition should not be capable of passing to the universal successor of an opponent who filed an opposition without having any business assets relating to the opposition. Given this, there also seems no good reason why, in the unusual circumstances of the present case, the right to prosecute an opposition should not be capable of passing to the universal successor of an opponent who did have such assets when the opposition was filed but has since parted with them. There does not appear to be any danger of "trafficking" in the opposition in such circumstances (see T 298/97, Point 6 of the Reasons) and, to the extent that it gives rise to the possibility of abuse, the case law already provides for this (see Point 5, below).

- 4.8 The Respondent accepts that the logical conclusion of its arguments is that (assuming its previous argument that the opposition had already been transferred to Axiva GbmH and then to Lonza Ltd is wrong) when Aventis R&T ceased to exist, the right to prosecute the opposition disappeared, but argues that there is nothing objectionable about this. However, while it is

quite correct that where an opponent has no universal successor the right to opponent status may simply disappear when the opponent ceases to exist (see T 525/94 and T 353/95), here there is a universal successor.

4.9 The "certainty" argument

4.9.1 The Respondent argues that it is intolerable that the right to pursue an opposition could be vested in two different people at the same time, namely the transferee under an *inter-partes* transfer and also the universal successor of the transferor. (It should be noted that this argument, if valid, would apply to *inter-partes* transfer cases generally, not just in the unusual facts of the present case.)

4.9.2 It is of course not in doubt that:

"... clear legal principles are necessary for assessing who may be a party to the proceedings before the EPO ... . At any given time throughout the proceedings, there should be no doubt as to who may validly exercise procedural rights and to whom official actions by the EPO are to be addressed." (G 2/04, point 1.3 of the Reasons).

4.9.3 But on the above analysis it is clear in whom the right is at any time vested, both in the case of an *inter-partes* transfer and in the case of a universal successor. The same is true where both types of transfer are present. There is no question of opponent status being vested in two different persons at the same time. In the case of an *inter-partes* transfer it

has already been pointed out that the requirement of a request coupled with supporting evidence is based precisely on the need for legal certainty (see Point 3.7, above). In the case of a transmission of opposition status to a universal successor, as stated in T 6/05, Point 1.6.4 of the Reasons:

"... there can only be one (legal) person who has rights and obligations, with the consequence that there is necessarily and automatically a continuation of the existing legal status as opponent from the date of the merger. It can thus be established unambiguously and without any legal uncertainty, at any point in time in the proceedings who in fact is the opponent having party status, regardless of the date when sufficient evidence to this effect was filed."

If both types of transfer are present, as here, the position is therefore also clear. The argument of the Respondent, if correct, would have quite the contrary effect; it would create uncertainty.

4.9.4 The Board is not confronted by a situation in which the successor to the business assets in respect of which the opposition was filed and the later universal successor of the original opponent are disputing who has the better right to the status of opponent. This type of problem can be dealt with as and when it arises.

5. Abuse

5.1 The Respondent argues that the transfer of opposition status to Sanofi-Aventis should not be recognised

because it is capable of giving rise to abuse. The Respondent only faintly suggested the existence of actual abuse and in oral proceedings concentrated rather on the possibility of abuse (see Point XXII(s), above). As with the previous argument, the implications of this argument are not limited to the unusual facts of the present case but in fact concern the case of *inter-partes* transfer of opponent status generally.

- 5.2 As already made clear, no financial, commercial or other interest is required as a condition of filing or pursuing an opposition. The Enlarged Board in G 3/97 made it clear in the following passages that the fact that an opponent may be acting on behalf of or at the instance of a third party does not by itself mean that the opposition is inadmissible: there are only limited circumstances in which the filing of an opposition can be regarded as an abuse:

"... acting on behalf of a third party cannot be seen as a circumvention of the law unless further circumstances are involved. The purpose of opposition proceedings alone does not offer sufficient grounds for regarding an opposition on behalf of another person as an abuse of the procedural provisions." (Point 3.2 of the Reasons).

"... the opponent's motives are of no consequence for the EPO, at least as long as no conduct involving an abuse of process arises from additional circumstances." (Point 3.2.2 of the Reasons).

"If, for the purpose of opposition, the opponent does not need to show an interest in the invalidation of the patent, then no harm is done if a third party has an interest in the invalidation of the patent. The question of the internal legal relationship between the opponent and any third parties has, as a matter of principle, no legal significance for external purposes, ie vis-à-vis the EPO and the patent proprietor." (Point 3.2.2 of the Reasons).

- 5.3 The Enlarged Board concluded that where the person named as opponent was acting on behalf of a third party the opposition would be inadmissible only if the involvement of the opponent were to be regarded as circumventing the law by abuse of process. This might arise where the opponent was either (a) acting on behalf of the patent proprietor or (b) acting on behalf of a client in the context of activities which, taken as a whole, were typically associated with professional representatives, but where the opponent did not have the relevant qualifications required by Article 134 EPC: see paragraph 1(c) of the Enlarged Board's order.
- 5.4 The present Board considers that the same considerations must apply to the **continuation** of an opposition or an opposition appeal.
- 5.5 The Respondent did not suggest that the opponent in the present (whoever it might be) case was in fact circumventing the law by abuse of process by either of the above means. While the categories of abusive behaviour were not stated by the Enlarged Board to be limited to the two examples given, the Respondent did

not suggest a third category into which the actions of the Appellant in the present case would fall. As stated by the Enlarged Board, the burden of proof in establishing any abuse falls on the party alleging the abuse (Point 5 of the Reasons).

5.6 The argument is therefore rejected.

6. The filing of notice of appeal and statement of the grounds of appeal.

6.1 The notice of appeal in this case was filed on 4 November 2005 by the firm Hoffmann Eitle, acting by a professional representative. The notice stated: "In the name of, and by authorisation of our client Aventis Research & Technologies GmbH + Co. KG we herewith lodge an appeal ...". In its heading the notice referred *inter alia* to Aventis Research & Technologies GmbH + Co. KG (i.e., Aventis R&T) as "Opponent II". The notice sought *inter alia* reversal of the first instance decision and revocation of the patent. A statement of the grounds of appeal was filed on 5 January 2006 on the same basis by Hoffmann Eitle, again acting by a professional representative. Hoffmann Eitle were acting under a sub-authorisation given by Dr Ahrens on 6 July 2005; their authority to act on behalf of Sanofi-Aventis has been subsequently affirmed by Sanofi-Aventis (see, e.g., the declaration from Sanofi-Aventis dated 1 July 2010 and confirmation of Dr Ahrens' authority dated 14 May 2009: Z8).

6.2 The Respondent argues that an appeal filed by a universal successor of an opponent which has previously transferred away the assets in respect of which the



opposition was filed is inadmissible since the universal successor can have no interest in the proceedings, and thus cannot be prejudiced within the meaning of Article 107 EPC by an order of the Opposition Division. (Again it should be noted that this proposition, if it held good, would apply not just in the special case of an appeal filed by a universal successor of an *inter-partes* transferor, but in the more general case of any appeal filed by an *inter-partes* transferor.) This is largely a repetition of previous arguments, and again the Board does not consider it to be correct. A party is prejudiced by a decision if it does not accede to one of its substantive requests: see e.g., T 234/86 (OJ 1989, 79). This condition was clearly satisfied in the present case. The Board has already explained that it is not necessary that an opponent has a continuing interest, financial or otherwise, in the prosecution of the opposition or appeal (see Point 3.9, above).

- 6.3 T 1324/06 was relied on heavily by the Respondent. There, the proprietor argued that the opponent had no legitimate interest in pursuing the opposition appeal since (so the proprietor alleged) several divisions of the opponent company had been sold. It offered no evidence for this, although it was accepted that the opponent had been declared bankrupt. The Board, after citing G 2/04 to the effect that an *inter-partes* transfer of an opposition requires a concurrent transfer of the material assets, said:

"Since a transfer of material assets by the initial opponent may thus result in its inability to further pursue the opposition or appeal,

allegation of facts that would entail such grave consequences should be proven beyond any reasonable doubt. Yet, all the patentee could offer in this respect was some hearsay evidence about the alleged sale of assets, and the fact that one of documents filed in appeal [sic] did not originate from [the original opponent], but another source. Taken alone or together, these allegations are insufficient to prove beyond reasonable doubt that [the original opponent] should no longer be entitled to pursue the appeal." (Point 1.3 of the reasons)

- 6.4 The Respondent in the present case argues that since it is clear beyond doubt that Aventis R&T had previously transferred all its material assets (something which is disputed by the Appellant), it is no longer able to pursue the opposition or appeal. It is not entirely clear what the Board in T 1324/06 intended by saying that the original opponent might be unable to pursue the opposition or appeal, but the present Board cannot take it as a statement (which in any event would only have been obiter) that if there is evidence of a transfer by an opponent of the relevant assets, the opponent from that point on is no longer entitled to pursue the opposition or an appeal. This would be wholly contrary to the jurisprudence of the Boards of Appeal already discussed relating to when a transfer can be acknowledged (Point 3, above) or the fact that it is not necessary for an opponent to have a continuing financial, commercial or other reason in revoking the patent.

6.5 It might appear that support for the Respondent's argument is also to be found in T 298/97, where the Board said:

"... if the original opponent has transferred the relevant assets to other companies, it no longer possesses the "business" (that is, the economic activity carried on by it - see G 4/88 at paragraph 5) in respect of which the opposition was brought and thus not having, as the party adversely affected by the decision under appeal, filed the Grounds of Appeal, it cannot in law have any further interest in the appeal." (Point 7.5 of the Reasons).

However, this observation should not be taken out of context. The Board was considering a different point, namely, whether both the original opponent and a transferee of the business assets could be appellants. The Board was not concerned with the case of an opponent which had transferred the relevant business assets but had not requested or substantiated a transfer of the opposition. Indeed the Board said later:

"Under Article 99(1) EPC "any person" may oppose a European patent: no commercial or other interest whatsoever need be shown. If the opposition fails, the opponent can as an "adversely affected party" appeal under Article 107 EPC: again, no commercial or other interest is required." (Point 12.2 of the Reasons)

6.6 Reference has already been made by the Board to T 136/01 when rejecting an earlier, similar argument of the Respondent (see Point 3.6, above). Somewhat perversely, the Respondent in fact relies on this decision, particularly sub-paragraphs (c) and (d) of the following passage:

"... it has therefore to be ascertained whether [the original opponent and appellant]:

(a) were a party to the opposition proceedings,

(b) were adversely affected by the impugned decision,

(c) were still enjoying the status of a party at the time the appeal was filed,

(d) have not, subsequently, lost the status of a party to appeal proceedings for any legal or factual reasons." (Point 1.3 of the Reasons)

6.7 The Respondent says that Aventis R&T was not enjoying the status of a party at the time the appeal was filed and had lost the status of a party to appeal proceedings for legal and factual reasons. However, the decisions cited above show that Aventis R&T still enjoyed party status after the effective date of the Technology Transfer Agreement. As already shown, after the date of its dissolution, opponent status automatically became vested in Sanofi-Aventis. This company still enjoyed the status of a party at the time the appeal was filed and had not lost the status of a

party to appeal proceedings for legal or factual reasons.

6.8 Given, then, that an appeal filed by the universal successor of a transferor-opponent is in principle admissible, the question is then whether the present appeal is admissible in the circumstances that the notice of appeal and statement of grounds of appeal were filed in the name of Aventis R&T, the original opponent, a dissolved company, and not in the name of Sanofi-Aventis, the universal successor. Coupled with this question is whether correction of the name of name of the Appellant from Aventis R&T to Sanofi-Aventis should be allowed.

6.9 The Respondent argued in this respect that even if it is possible for a universal successor to acquire the status of opponent, evidence must be filed with the Office to establish the succession before any appeal can be validly filed by such a successor. It was argued that since in the present case no relevant evidence had been filed before the expiry of the appeal period, the right to prosecute the opposition appeal had disappeared. The Respondent relied *inter alia* on T 656/98, which establishes that for a transferee of a patent to be entitled to appeal, the necessary documents must be filed first.

6.10 On one view, the filing of the notice of appeal and the statement of the grounds of appeal in the name of Aventis R&T was in fact completely correct and no correction of the name is required. This conclusion most clearly follows from the decision cited by the Appellant, namely T 425/05 (decided on 23 May 2006;

grounds for the decision published in early July 2006), the facts of which are similar to those of the present case. There, an appeal was filed in the name of an opponent at a time when it had already been dissolved, following its bankruptcy, but having a universal successor. The appeal was filed by the representative who had previously been authorised to act on behalf of the opponent, whose authority had never been rescinded, and whose authority to act on behalf of the successor had subsequently been affirmed (after expiry of the appeal period). The appellant apparently requested correction of the name, citing T 15/01 (see the letter of the appellant dated 21 April 2006 in the public file). The Respondent argued that the mistake in the notice of appeal could not have been a mere clerical error which could be corrected, since the representative could not have been acting on behalf of the successor at a time when he had not yet been authorised (see Point VI of the Facts and Submissions). The Board observed that, after dissolution, the original opponent's assets had passed into the hands of its successor, who had thus succeeded the original company as opponent and therefore also as client of the representative. The Board pointed out that the representative's authorisation to act on behalf of the original opponent had never been contested or rescinded, and its authority to act on behalf of the successor had since been confirmed. The Board therefore considered that the appeal filed by the representative had been implicitly but necessarily ("*implicitelement mais nécessairement*") filed on behalf of the successor. Absurd consequences would follow if the representative's authorisation to act were to be taken as having lapsed at the date when the original opponent

ceased to exist: the notification of the Opposition Division's decision would not have been effective, so that the time for filing an appeal would not yet have started to run. See Point 1.3 of the Reasons. Although the Board noted the request for correction, it merely observed that the identification of the original opponent as appellant had been a clerical error which had in fact since been corrected in the register (see Point 1.3 of the Reasons). The Board did not, however, actually make an order correcting the name of the appellant in the notice of appeal. It is not clear from the public file when the correction took place, but it cannot have been before 21 April 2006, and thus before the time for filing the notice of appeal had expired.

- 6.11 Although it is not entirely clear what the Board meant by the phrase "*implicitement mais nécessairement*" in this context, the facts of that case are indisputably very close to those of the present one. The appeal here was filed by the representative who had previously been authorised to act on behalf of the opponent and whose authority had never been rescinded, and whose authority to act on behalf of the successor has subsequently been affirmed.
- 6.12 As regards this decision, the Respondent seeks to distinguish it on the basis that in the present case there had been a transfer of the opposition and relevant assets before Aventis R&T ceased to exist and before the appeal was filed. But these points have already been dealt with.
- 6.13 The Respondent relied on T 956/03 (decided on 19 July 2006; grounds for the decision published in April 2007).

There, an appeal was filed in the name of an opponent's universal successor before any evidence concerning the succession was filed. The appeal was held to be inadmissible, the Board concluding that the rules relating to the recognition of a transfer in the case of a universal successor were the same as in the case of an *inter-partes* transfer:

"In the present Board's view, the case-law shows a definite balance in favour of the view that a transfer can only be acknowledged from, at the earliest, the date when adequate evidence to prove the transfer has been filed. This is desirable in the interest of legal certainty and, within that principle, to ensure the identity of an opposing party is known. If the transfer takes place before the appeal period expires then the entitlement of the transferee to replace the opponent must be established by filing the necessary evidence before the appeal period expires. Accordingly, since that was not done in the present case, the appeal of appellant III is inadmissible." (Point 7 of the Reasons).

6.14 It is implicit from this decision that had the appeal been filed in the name of the original opponent, it would have been admissible. The decision in T 425/05 (see Point 6.10, above), which had only very recently been published, does not appear to have been cited to the Board and understandably the Board appears not to have been aware of it. In any event, it is not clear from the facts of T 956/03 whether the original opponent had ceased to exist at the date the notice of appeal was filed, but given that this seems to have



been the same Sanofi-Aventis Deutschland GmbH as in the present case, presumably it did still exist.

6.15 The Respondent also relies on T 6/05, decided on 9 October 2007 and in which neither T 956/03 nor T 425/05 appears to have been cited to the Board. Here, in contrast to T 956/03, the Board held that an appeal filed by a universal successor before any evidence of the succession is filed is admissible: a universal successor acquires opponent status from the moment of succession and not first when evidence of the transfer has been supplied. The Board noted that as regards transfer of ownership of a patent, the position in the case of transfer to a universal successor is different than in the case of an *inter-partes* transfer. In the case of a universal successor of the patent proprietor, the successor automatically acquires party status from the date on which the succession becomes effective and not only once sufficient evidence of it has been produced. Since according to the jurisprudence of the Boards of Appeal the principles for transferring a European patent were to be applied *mutatis mutandis* to the transfer of opponent status, it was justified to apply the same considerations and conclusions with respect to the transfer of the opponent status due to universal succession.

"Thus, in the case of transfer of the opposition by way of universal succession, the universal successor automatically acquires the bundle of procedural rights of his predecessor and hence party status from the date on which the merger became effective and not only once sufficient

evidence to this effect has been produced."

(Point 1.7 of the Reasons)

6.16 Since in that case the appeal had been filed in the name of the universal successor of the opponent and since it had automatically acquired party status, it was adversely affected by the decision under appeal, and the appeal was admissible even though no evidence of the transfer had been filed (see Point 1.9 of the Reasons). Again, it is not clear from the facts of that case whether the original opponent had ceased to exist at the date when the notice of appeal was filed.

6.17 It appears to the Board that the decisions in T 956/03 and T 6/05 are conflicting. On one view it is not necessary to decide between the two because: (a) T 425/05 points clearly to a solution in the present case; (b) the appeal in the present case was filed in the name of the original opponent, not its universal successor, so that the decisions in T 956/03 and T 6/05 are *prima facie* not relevant; and (c) in any event in the present case there is a request for correction. Nevertheless, the apparent conflict between the two cases does present a difficulty, because on one view the consequence of T 6/05 is that, subject to the issue of correction, the appeal in the present case filed in the name of the original opponent is inadmissible (although the Board in T 6/05 was not concerned with the kind of facts present here and obviously said nothing about the position) and that of T 956/03 that, while the appeal in the present case is admissible, it is not a case where correction of the name of the Appellant is appropriate, since it was only later, after evidence of the universal succession was filed,

that the status of Sanofi-Aventis as successor could be acknowledged. It is also not clear from T 956/03 whether the original opponent was still in existence, and what difference this might have made to the decision. (It should be noted that there was no request for correction in T 956/03 because the appeal had clearly been deliberately filed in the name of the universal successor as opponent, and there was no mistake). Further, the decision in T 15/01, referred to in Point 7.6 below, indicates that correction is appropriate.

*The request for correction*

7. Taking the view therefore that the position is uncertain, and assuming, without deciding the issue, that it may be correct that the appeal and statement of grounds of appeal filed in the name of the original opponent in the present case were defective, is this a case where correction should be allowed?
  - 7.1 In the present case the period for filing the notice of appeal and the grounds of appeal expired before the coming into force of EPC 2000 on 13 December 2007. The provisions of the EPC 1973 therefore apply: see T 157/07, Point 1.6 of the Reasons.
  - 7.2 The request for the correction of the name of the Appellant in the notice of appeal and statement of grounds of appeal was made under Rule 64(a) EPC 1973 in conjunction with Rule 65(2) EPC 1973, alternatively under Rule 88 EPC 1973 (corresponding to Rules 101(2) and 139 EPC 2000 respectively). As to these alternatives, as was pointed out in T 715/01, Rule 88

EPC 1973 appeared in chapter V of part VII of the Implementing Regulations to the Convention, which relates directly to part VII of the Convention, and not to part VI relating to the appeal procedure. Rule 65(2) EPC 1973 provides an explicit remedy for deficiencies in the name and address of the notice of appeal as it refers to Rule 64(2) EPC 1973, sub-paragraph (a). The Board in T 715/01 therefore considered that the relevant provision was Rule 65(2) EPC 1973. The present Board follows this approach and in the event it has not been necessary to examine whether a correction of the name of the Appellant in the notice of appeal could also be allowed under Rule 88 EPC 1973 (as was accepted in T 814/98, point 1 of the Reasons, and T 460/99, point 1 of the Reasons)

7.3 The rule provides:

"(2) If the Board of Appeal notes that the appeal does not comply with the provisions of Rule 64, sub-paragraph (a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible."

Rule 64(a) provides that the notice of appeal should contain the name and address of the appellant in accordance with the provisions of Rule 26, paragraph 2(c) EPC 1973.

7.4 The principles for correction under Rule 65(2) EPC 1973 were set out in T 97/98. In that case the opposition

had been filed by, and the decision of the Opposition Division given against, Fresenius Medical Care Deutschland GmbH but in the notice of appeal, a different legal entity, namely Fresenius AG, was indicated as "opponent" and thus as appellant (see Point 1.1 of the Reasons). The appeal was filed by the same representative who had represented the opponent before the Opposition Division. It was explained that Fresenius Medical Care Deutschland GmbH and Fresenius AG were separate legal entities within the same group of companies. There was no question of any transfer of the opposition; the indication of Fresenius AG in the notice of appeal simply constituted an error. The Board held (Point 1.3 of the Reasons) that correction was possible:

"What is required under Rules 64(a) and 65(2) EPC is that there was indeed a deficiency, i.e. that the indication was wrong, so that its correction does not reflect a later change of mind as to whom the appellant should be, but on the contrary only expresses what was intended when filing the appeal. It must be shown that it was the true intention to file the appeal in the name of the person, who is, according to the request, to be substituted."

The Board added that, for the purposes of Rules 64(a) and 65(2) EPC 1973 it must be possible on the expiry of the time limit for appeal to determine whether or not the appeal was filed by a person entitled to appeal in accordance with Article 107 EPC. For this, it is sufficient if:

"... it is possible to derive from the information in the appeal with a sufficient degree of probability, where necessary with the help of other information on file, e.g. as they appear in the impugned decision, by whom the appeal should be considered to have been filed ...". (Point 1.3 of the Reasons).

In a later passage (Point 1.6 of the Reasons), the Board also indicated that the identity of the true appellant should be derivable within the appeal period by a person not knowing all the details later presented to the Board.

- 7.5 In that case an appeal had been filed in the name of someone who was not the opponent but the Board considered it sufficiently probable that it was the intention to file the appeal on behalf of the person who was the opponent. The present case is in some respects different, since it would not have been possible to derive from the information in the appeal, even with the help of other information on file, but not knowing all the details presented later to the Board, that it was the intention to file the appeal in the name of the original opponent's universal successor. Nevertheless, the Board does not read T 97/98 as making this a necessary requirement for correction; the Board in that case was not only dealing with a different factual case but also merely said that it was "sufficient" if this requirement was satisfied. The significant point in the present case is that it is highly probable that it was the intention to file the appeal on behalf of the person who was the opponent (see Point 7.10, below).

7.6 The facts of T 15/01 (decided on 17 June 2004, published OJ EPO 2006, 153) are similar to those of the present case. There, an appeal was filed in the name of the original proprietor (SIDD) but at a time when it no longer existed and when, as a matter of substantive law, a universal successor (SDLO) had become the proprietor of the patent. Correction of the name of the appellant was requested, which the Board considered was possible both under Rule 65(2) EPC 1973 and Rule 88 EPC 1973 (see Point 14 of the Reasons). The Board said 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 ... 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." (Point 12 of the Reasons)

7.7 The Board was satisfied that the it was the intention to file an appeal on behalf of SDLO:

"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. ... [T]his 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." (Point 15 of the Reasons)

7.8 The Board therefore allowed the requested correction (although such order for correction does not form part of the final order) and the appeal of appellant I was held admissible (see Point 16 of the Reasons). In some respects the approach taken in this decision was



different from that taken in the later case of T 425/05 (see Point 6.10, above), in which T 15/01 appears not to have been cited to the Board. As already pointed out, in that case it was considered in similar circumstances that the notice of appeal had been implicitly and necessarily filed on behalf of the successor, and no order for correction appears to have been made (see Point 6.10, above).

7.9 The Respondent argues that T 15/01 is not relevant as it concerned an appeal by a proprietor, as to which the rules are different (in particular Rule 90(1)(a) EPC 1973, quoted in the decision, above). It also did not concern an appeal by an opponent who had previously transferred the relevant assets and who then had ceased to exist. However, the reasoning in the case applies equally to the wrong designation of an opponent/appellant, as is clear from T 97/98, above, which concerned such an appeal, and more generally since the same principles applicable to the status of proprietor should be applied *mutatis mutandis* to opponent status (see T 6/05, point 6.15, above). While it is correct that Rule 90(1)(a) EPC 1973 deals with the status of proprietor, Rule 101(7) EPC 1973, cited with it in T 15/01, deals with the position of termination of authorisations in general.

7.10 As to the facts of the present case, reference has already been made to the contents of the notice of appeal and statement of grounds of appeal. These documents were filed by the representative who had been acting in the opposition proceedings and whose authority to act on behalf of Sanofi-Aventis has been affirmed subsequently. The Appellant explained that

because of the uncertainty about how the Office would treat a request to transfer the opposition following the Technology Transfer Agreement, a deliberate decision was taken to continue to conduct the opposition proceedings in the name of Aventis R&T. See the declarations of Dr Dörr (Z9), Dr Kiy (Z10) and Dr Rüsing (Z11). In its communication dated 24 March 2010, the Board queried why the opposition and the appeal had continued to be conducted in the name of Aventis R&T after May 2003, at a time when the relevant parties might have been expected to know that this company no longer existed. The answer provided was that although it had been decided that the party position should remain unchanged (i.e., that Aventis R&T should remain as opponent), it was also decided that the overall conduct of the proceedings (and opposition proceedings against another patent, EP 0512997), and the responsibility for the costs, should be undertaken by the purchasers of the business from Aventis R&T under this agreement. The overall control of the opposition had therefore been left in the hands of these purchasers (namely, Axiva, Celanese Ventures GmbH, Nutrovina Nutrition Specialities & Food Ingredients GmbH, as well as subsequently Lonza Ltd), who had instructed Dr Ahrens and Hoffmann Eitle directly through a company coordinating the proceedings. Because of this, Sanofi-Aventis, the successor to Aventis R&T, had had little contact with Dr Ahrens and had not informed her or her sub-agent of the merger of this company and succession to Sanofi-Aventis. From their side, Dr Ahrens and Hoffmann Eitle had seen no break in the continuity of their instructions and had been unaware that they were continuing to act, and had filed a notice of appeal and a statement of grounds of appeal,

- in the name of a company that no longer existed. Their intention, however, was to continue to act for the opponent. See e.g., Dr Ahrens' declaration, Z19.
- 7.11 The Board accepts this explanation. Adapting the wording of T 15/01 (see point 15 of the reasons, cited above), the Board is therefore satisfied that it was the intention to file a notice of appeal and statement of grounds of appeal on behalf of the person who had party status as opponent during the opposition and who was adversely affected by the appealed decision, and that this person was Sanofi-Aventis. The fact that these acts were done in the name of Aventis R&T was a mistake.
- 7.12 Finally, the Respondent also says that correction is not possible here because the mistake which was made was one of law, not fact, relying on T 656/98, point 5 of the Reasons. The Board there was considering the effect of Rule 88 EPC 1973, not Rule 64(a) EPC 1973. But even so, the present Board has concluded that the notice of appeal and statement of grounds of appeal were filed by representatives in the name of Aventis R&T being unaware that this company no longer existed and that it had a universal successor. This was a mistake of fact.
- 7.13 The principles which are applicable to correction of the notice of appeal under Rule 65(2) apply also to the correction of the statement of the grounds of appeal: see T 715/01, Point 10 of the Reasons, and T 15/01, point 14 of the Reasons. It also does not matter for the purposes of Rule 65(2) EPC that it was not the Board but the Respondent who raised the point about the

Appellant's identity. See e.g., the facts of T 15/01 and T 157/07.

- 7.14 The Board therefore considers that it is appropriate to order the correction of the name of the Appellant in the notice of appeal and in the statement of grounds of appeal to Sanofi-Aventis.
8. In the circumstances it is not necessary to consider whether the terms of the Technology Transfer Agreement were such that, if sufficient evidence of it had been filed with the Office together with an appropriate request, the Office would have acknowledged a transfer of opposition status.

*The objection under Article 84 EPC*

9. Claim 1 of the patent as granted read:

"A single cell-edible oil characterized in that docosahexaenoic acid (DHA) makes up at least 5% of the oil by weight, preferably at least 20%, more preferably at least 30% and most preferably at least 35%."

10. In the First Appeal, the main request of the proprietor, as filed during the oral proceedings, was for maintenance of the patent in amended form, whereby *inter alia* the oil was now defined as being "obtainable from a unicellular organism by hexane extraction" and wherein the DHA content was restricted to a value of "at least 35%". As a first auxiliary request, also filed during the oral proceedings, the word "directly"

was introduced into Claim 1 before the term "obtainable".

10.1 The decision of the Board in the First Appeal (see Point XII of the reasons) records that the opponent contested the admissibility of the newly filed sets of claims under Article 123(2) EPC, *inter alia* as regards the introduction of word "directly" into the first auxiliary request. As to novelty, it argued that the term "being obtainable by hexane extraction" was not a restriction on the claimed oil, so that any prior art oil containing more than 35% DHA was novelty-destroying for this claim.

10.2 As regards the main request, the Board rejected the objections under Articles 123(2) and 100(b) EPC but held that the subject matter of Claim 1 was not novel. As regards the first auxiliary request, the Board rejected the argument under Article 123(2) EPC relating to the introduction of the word "directly". As regards novelty, the Board observed that:

"Contrary to the main request, claim 1 is now directed to the product "directly" obtainable from a unicellular organism by hexane extraction. There is now a clear restriction to the claimed oil for the skilled person ... .".

The Board went on to hold that its subject matter was not anticipated by the cited prior art.

10.3 The Board then had to consider the conflicting requests for remittal, i.e., the proprietor's request that the case be remitted to the Opposition Division for further

prosecution and the Opponent's request that the Board should itself examine inventive step of the auxiliary request without remitting the case (see Point VIII of the Reasons and also the Minutes of the proceedings). As to this the Board said:

"The rejection, by the Board, of the present main request and its findings in relation to the present first auxiliary request under Articles 123(2)(3), 83 and 54 EPC are *res judicata*. ...

The Opposition Division decided that claim 1 was not patentable on the grounds of lack of novelty but left out the essential issue of inventive step (Articles 52(1), 56 EPC). This issue, however, forms, *inter alia*, the basis for the requests of the respondents that the patent be revoked in its entirety and must therefore be considered as an essential substantive issue in the present case." (Point 4 of the Reasons)

- 10.4 The Board concluded that it was necessary to remit the case to the Opposition Division for further prosecution on the basis of the set of claims of the first auxiliary request. It further noted that Opponent I (who had filed written submissions but who had not appeared at the appeal hearing) would "have the opportunity to give its view on the issue of inventive step which remains to be decided by the first instance." See point 4 of the Reasons. On this basis, the Board set aside the decision under appeal and remitted the case to the Opposition Division for further prosecution.

11. There were then extensive exchanges and delays before a further hearing before the Opposition Division took place. In the course of these, the Respondent filed various new requests, although always retaining the feature of "directly obtainable" in Claim 1 of the main request. In a communication from the Opposition Division dated 5 June 2003 sent in accordance with Article 101(2) EPC 1973 and Rules 58(1) to (3) EPC 1973, the Opposition Division recorded that its task was to decide on the issue of inventive step of the claims according to the first auxiliary request accepted by the Board of Appeal as a basis for remittal of the case and, as appropriate, to decide on the allowability of any amendments to this request as subsequently filed by the Respondent. On 24 November 2003, the Appellant replied at length, pointing out that it was only the issue of inventive step which had to be considered by the Opposition Division, and making detailed comments on this issue, and raising objections to the further amendments which had now been made. Then, in its letter dated 27 June 2005 the Appellant raised for the first time the argument that the introduction of the term "directly obtainable" gave raise to a clarity objection under Article 84 EPC, which it argued remained open for discussion. The argument was that it was clear from the description that an intermediate step was conducted between culture of the cells and hexane extraction and that therefore the skilled man would not know what "directly obtainable" in the claim meant.
12. In its decision dated 5 September 2005, the Opposition Division concluded that the clarity of the claim had been considered by the Board in the First Appeal and

that the issue should be regarded as having been implicitly dealt with. The Opposition Division took the view that the Board could not have taken a decision on the issue of novelty without considering the clarity of the claims (Points 1 and 4 of the Reasons). It added that the Board had issued an unequivocal interpretation of the claim which was binding on the Division (Point 5 of the Reasons) and that in an any event if the Board had wished to entertain further discussion on the clarity of the wording it would have said so. The Division concluded that the clarity objection under Article 84 was not open for discussion.

13. In the present appeal, the Respondent argues that the issue of clarity is *res judicata*. For the reasons which follow, the Board does follow this approach although for other reasons it nevertheless accepts that the Appellant is not entitled to raise this objection.

13.1 Article 111(2) EPC provides that:

"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. ..."

13.2 The "ratio" of any decision is "the ground or the reason for making it, in other words, the point in a case which determines the outcome of the judgment." (see T 934/91, OJ EPO 1994, 184). In the First Appeal the Board expressly decided that Claim 1 of the first auxiliary request did not contravene Article 123(2) EPC and was novel over the cited prior art, but did not



expressly decide that the amendments made to the granted claims did not give rise to a breach of Article 84 EPC. The present Board has reservations about the Opposition Division's statement that the Board in the First Appeal could not have taken a decision on the issue of novelty without considering the clarity of the claims (see Point 12, above) because in principle a claim can be novel although unclear. As to the Opposition Division's statement that the Board had issued an unequivocal interpretation of the claim which was binding on the Division (Point 12, above), the Board's statement about the meaning of the amended claim was made only in the context of novelty, to the effect that with the introduction of the word "directly" there was now a clear restriction to the claimed oil for the skilled person, and that the wording implied that the amount of 35% of DHA must already be present in the extracted neutral lipid fraction of the unicellular organism (Point 3.2 of the Reasons). The Board cannot see this as an interpretation of the claim which rules out the particular clarity argument put forward by the Appellant. Finally, the Opposition Division's statement that if the Board had wished to entertain further discussion on the clarity of the wording it would have said so, while understandable, is not really in point.

- 13.3 However, in the present Board's view these arguments on *res judicata* do not take into account a wider, more general point. As is generally well known, it is the practice and indeed the obligation of the Boards of Appeal when amended claims are filed during appeal proceedings to examine the claims *ex officio* for formal compliance with the EPC (see G 9/91, Point 19 of the

Reasons) and at the same time also to give the opponent the opportunity to make its own objections on these grounds. Such objections include both objections under Articles 123(2) and (3) and under Article 84 EPC. If and when any such objections are cleared away, the claims are then ready to be examined for novelty and/or inventive step, as the case may be, either directly by the Board or by the Opposition Division after remittal of the case.

13.4 Thus in T 952/99, cited by the Respondent, the Board said this of the practice of the Boards in the past:

"In particular, the Boards of appeal allowed amended or auxiliary requests during the appeal procedure provided such requests were *bona fide* attempts to overcome objections raised and furthermore were clearly allowable, ie it was immediately clear that the requirements of Articles 123(2) and (3), 84 and preferably 54 EPC were met (T 840/93, point 3.2.1 of the reasons)." (Point 1.3 of the Reasons)

And in T 301/87 (OJ EPO, 1990, 335) the Board said:

"... when amendments are made to a patent during an opposition, Article 102(3) EPC requires consideration by either instance as to whether the amendments introduce any contravention of any requirement of the Convention, including Article 84 EPC ..." (Point 3.8 of the reasons).

13.5 This is clearly what took place in the First Appeal. As it happened, no objection was raised by the Board or

the opponent (i.e. the present Appellant) under Article 84 EPC. The present Board can only conclude that this was because no one considered that the claims were unclear. The objections under Articles 123(2) and 83 EPC then having been cleared away, and the claims having been found to be novel over the cited prior art, the case was ready for a decision on inventive step. This was abundantly clear to everyone, not least the Appellant, who in fact wanted the Board to decide this issue there and then, and who then, after the case had been remitted, made its position clear that inventive step was the only remaining live issue.

13.6 In T 446/00 the Board identified two types of behaviour as being abuses, namely (a) not to comply with a procedural direction of the Board requiring a party to take a certain step or steps and (b) for a party to adopt an unequivocal position on an issue and subsequently to depart from that position without explanation. The latter type of behaviour was held particularly capable of being an abuse in *inter partes* proceedings, in which the other party is entitled to rely on that position as part of the case it has to meet. At the same time the Board made it clear that these types of behaviour did not form an exhaustive list of procedural abuses. T 446/00 was later referred to in T 762/07, as follows:

"5. Appellant III referred to T 446/00 of 3 July 2003 in which a patentee specifically stated, in answer to a challenge from the opponent, that it would not rely on a certain claim and then later re-introduced that claim without explanation. That was held to be an abuse of procedure ... . In the

present case there was no such specific retraction, but the effect of three years silence broken only at the very last possible opportunity must be viewed as having much the same effect. In T 1449/03 of 26 September 2006, a patentee's departure for the first time at oral proceedings from a position previously and persistently held was not allowed inter alia because the opponent might have been lulled into a feeling of false security (see Reasons, points 2.8 and 2.9).

6. In all the circumstances, the Board finds that the manner in which Appellant I reverted to the claims as granted was an abuse of procedure which the opposition division should not have allowed."

13.7 Article 114(2) EPC gives the EPO the right to disregard "facts or evidence" which are not submitted in due time by the party concerned. The Article 84 EPC point raised by the Appellant was not a new fact or new evidence, but rather a new argument based on the existing material and the law. However, in T 951/91 (OJ EPO 1995, 202) the Board said:

"The discretionary power given to the departments of the EPO pursuant to Article 114(2) EPC serves to ensure that proceedings can be concluded swiftly in the interests of the parties, the general public and the EPO, and to forestall tactical abuse. Parties must take into account the possibility that late-filed material will be disregarded and do their best to submit the facts, evidence and arguments relevant to their case as early and completely as possible. If a party fails

to do so without adequate excuse, and admitting the evidence would lead to an excessive delay in the proceedings, the Boards of Appeal are fully justified in refusing to admit it in exercise of the discretion provided by Article 114(2) EPC." (Point 5.15 of the Reasons)

13.8 In T 201/92 the Board referred to the distinction between facts and evidence on the one hand, and arguments on the other:

"The submission of facts and evidence is different from the mere submission of arguments (see also: T 92/92 of 21. September 1993). They need not be restricted insofar as they do not essentially change the procedural situation. However, in written proceedings the filing or exchange of submissions has also to be brought to an end, in particular when oral proceedings are going to follow." (Point 3.8 of the Reasons).

13.9 Further, the Departments of First Instance and Boards of Appeal have an inherent power to control proceedings before them with a view to their economical and fair disposal. As the Board said in T 201/92:

"... it follows clearly from the provisions of the EPC as well as from the nature and the purpose of appeal proceedings (see inter alia Article 110(2), 111, 114(1), 114(2), 116(1), 117, 122, 125 EPC) that it is the competent Board who has the duty to direct and control the proceedings before it. Due to the fact that every legal and judicial procedure has to come to an end within due time,

the principle of procedural economy is inherent in any procedural law, as it appears in the EPC inter alia in Article 114(2) and also clearly follows from the Travaux Préparatoires of the EPC (see: T 951/91, OJ 1995,202).

That means that any party, and not least the attacking ones, has to observe a fair degree of **procedural vigilance.**" (Point 3.5 of the Reasons).

13.10 Each case will turn on its own facts, and while the Appellant cannot be accused of precisely the above types of behaviour in the present case, the Board finds the above statements helpful. In the present case the Board in the First Appeal had remitted the case for further prosecution in the clear and shared belief that the only remaining issue in the case was inventive step. The Appellant not only shared this belief at the time but subsequently affirmed it. It then later changed its position and thereby sought to change the "procedural situation" (see the citation from T 201/92, above). It did not give an explanation for doing so although it is a reasonable inference that it was because, with a change of representative, the new point had only just been thought of.

13.11 In these circumstances the Board considers that it would not have been in accordance with normal procedural efficiency and principles of fairness to have allowed the Appellant to re-open questions relating to the formal allowability of the claim and attempt to raise a new issue that it had had the opportunity to raise and which it should have raised at an earlier stage of the proceedings, and in doing so to

resile from its previous position. To allow it to do so would not have been fair on the Respondent and could have led to further delay and increased cost. This was particularly so given that the Board in the First Appeal had examined the amended claim for formal compliance with the EPC and it had not occurred to the Board that there might be a problem with Article 84. The Opposition Division would therefore have been entitled not to allow this argument to be raised. It does not matter whether one terms such procedural manoeuvring an abuse of process or not, the result is the same.

13.12 For the same reason the Board did not allow this issue to be raised in the appeal proceedings.

*The objection under Article 83 EPC*

14. In the First Appeal, the Board considered an Article 83 EPC objection concerning the product claim according to Claim 1 of the then main request (see Point VIII of the reasons for the nature of the objection). The Board rejected it.

14.1 When the Board came to the first auxiliary request, the only formal objections raised were under Article 123 EPC in relation to the introduction of the word "directly". The Article 83 EPC objection which had been raised in relation to the main request would have applied equally for Claim 1 of the first auxiliary request but was obviously not repeated given the Board's previous rejection of it. The opponent did not raise any further Article 83 EPC objection.

14.2 Under point 4 of the reasons the Board stated that "the rejection, by the Board, of the present main request and its findings in relation to the present first auxiliary request under Articles 123(2), 83 and 54 EPC are *res judicata*". It is quite true, as the Appellant argues, that the Board in its earlier reasoning had expressly only dealt with Article 83 EPC in relation to the main request but the present Board considers that the finding in relation to this Article 83 EPC objection was intended to apply to both requests: this is why it included the reference to both requests under Point 4 of the Reasons. The finding is therefore *res judicata* in these proceedings. The fact that the Appellant has come up with a new line of attack under Article 83 EPC (relating to the feature "directly extracted") does not open up the finding again.

14.3 The new Article 83 EPC objection was raised by the Appellant for the first time in its letter dated 29 December 2006, i.e., nearly a year after its statement of the grounds of appeal was filed. The introduction of this new argument into the appeal proceedings would therefore have required an amendment to the Appellant's case (see Article 13(1) RPBA). Given that, for the above reasons, it was bound to fail the Board in the exercise of its discretion did not admit such an amendment.

*Inventive step*

15. The subject-matter of the patent in suit

15.1 The invention relates to single-cell edible oils containing DHA. The starting point for the teaching of



- the patent is the observation that DHA-containing edible oils derived from fish are often problematic for human consumption because of the contamination with environmental pollutants, fishy odour and unpleasant taste. These disadvantages render fish oils unsatisfactory for use in edible compositions such as baby food and infant formulas (patent specification, column 1, lines 5 to 33).
- 15.2 In order to overcome these problems it is an object of the invention to provide a single-cell oil containing considerable amounts of DHA but which have no significant quantities of other polyunsaturated fatty acids, and to provide a method for producing the single-cell oil by cultivation of microorganisms (column 2, lines 21 to 47).
- 15.3 Under the heading "Summary of the invention" (column 3, lines 5 to 9) it is stated that: "The present invention relates to the cultivation of microorganisms, notably dinoflagellates, in a fermentor, induction of those microorganisms to produce significant quantities of single cell oil containing a high proportion of DHA and recovery of that oil. As used herein, "single cell oil" refers to a lipid product of a unicellular organism".
- 15.4 Furthermore, the description states in column 8, lines 7 to 14 that: "The present invention also includes food products such as infant formulas and baby foods, as well as dietary supplements, which contain the single-cell oil containing DHA of the present invention. While those of skill in the art have recognized that infant formulas containing DHA are desirable, the prior art infant formulas contained DHA

from fish oil, with its attendant unpleasant tastes and organoleptic characteristics."

15.5 From the above it would be immediately evident to a skilled person that the teaching underlying the patent is confined to the provision of DHA-containing oils which exclusively originate from unicellular microorganisms, i.e. from a vegetarian source, in order to avoid the disadvantages of fish oils.

15.6 Thus, the skilled person would assume that the pertinent prior art relating to the invention is represented by documents dealing with DHA-containing oils obtained by cultivating unicellular microorganisms.

16. The closest prior art

16.1 In view of the above considerations D4 relating to DHA-containing oils from unicellular microorganisms is taken as the closest prior art. This document concerns a study on the heterotrophic marine dinoflagellate *Cryptothecodinium cohnii* (*C. cohnii*). The study in particular investigates the influence of oxygen, temperature, culture age at harvest, salinity and light on the DHA content of the neutral lipid fraction (triacylglycerol) and polar lipid fraction (phosphatidylcholines) of the oil isolated from *C. cohnii* cultures (page 57, first paragraph). The essential results are summarized in Table 1 at page 59. The following data in relation to the growing conditions are listed:

- cell number/ml x  $10^3$  at inoculation and at harvest;
- total lipids (mg/ $10^9$  cells);

- percentage of dry weight cells;
- percentage of neutral lipids in relation to total lipids
- percentage of triacylglycerols in relation to neutral lipids (the triacylglycerols represent the edible oils to which the invention relates);
- percentage of polar lipids in relation to total lipids;
- percentage of phosphatidylcholine in relation to total lipids.

16.2 It emerges from this table in conjunction with the declaration D57, which was not contested by the Appellant, that the highest biomass density of  $3390 \times 10^3$  cells/ml, i.e. a biomass density of 2.85 g/L is obtained by imposition of a stationary phase of 4 days in comparison with a stationary phase of 1 or 2 days. According to Figure 6 the DHA content in the triglyceride portion is slightly below 20%.

16.3 The table also shows in conjunction with Figure 7 at page 63 that cultivation in 0.3% NaCl leads to an oil in which the triacylclycerol portion in relation to neutral lipids is rather low (34%) but in which the triglycerols have the highest DHA content of about 32%, which is slightly below the minimum value of 35% required by Claim 1.

17. *Obviousness - Claim 1*

17.1 The next step in the problem-and-solution approach is to determine what the objective problem is, based on the closest prior art, namely D4. The claimed edible oil - which, as agreed by the parties, essentially

consists of triglycerides as lipid component - differs from the triglyceride fraction isolated from the 0.3% NaCl culture of D4 by its higher DHA content. Therefore, the objective problem to be solved is the provision of an edible oil with an increased DHA content.

17.2 The skilled person having read D4 would have considered that it was not possible to produce any fraction from the microbe with a DHA content of at least 35%. It can be seen that the authors of D4 varied the growth conditions and the highest DHA content they could achieve was less than 35%. Thus, there is no hint in D4 itself how to achieve an edible oil from the microbe with a higher DHA content.

17.3 Combination of D4 with D65a

17.3.1 D65a is concerned with health food containing oils and fats derived from aquatic animals and plants and being rich in Omega-3 fatty acids, in particular DHA (column 1 lines 66 to 73). Inter alia fish and phytoplanktons such as dinoflagellata (the microorganisms used according to the invention belong to the latter) are disclosed in column 3, lines 12 to 21 as a source for obtaining DHA-containing oils.

17.3.2 Manufacture of DHA-concentrates from phytoplanktons, i.e. vegetarian sources, is however, only mentioned generally and is not pursued further in D65a. The experimental part of D65a exclusively focuses on DHA-concentrates (with a DHA content up to 85%, Example 3) isolated from fish (Examples 1 to 6) or euphausia (Example 8). A skilled person could therefore not

extract any detailed teaching from D65a on how to recover DHA-concentrates from vegetarian sources.

17.3.3 As the Respondent convincingly argued in its letter dated 6 January 2011, the area of edible oils derived from unicellular microorganisms is quite different from that derived from fish because manufacture of microbial oils requires techniques (growing of microbial cultures and harvesting the biomass before extracting the oil) which are different from those required for manufacturing oils from fish (direct treatment of parts of fish in an extraction medium). Moreover, microbial oils can be directly recovered from the biomass in a high purity, whereas fish oils often have a fishy odour and an unpleasant taste and can be polluted with contaminants such as metals, depending on the living conditions of the fish. The skilled person manufacturing oil from fish is therefore faced with the problem of purification of the oil, e.g. by chromatography (D65a, column 2, lines 45 to 50 and Examples 1 to 3, 5, 6, 8), which he can avoid when using the technology of isolating oil from unicellular microorganisms.

17.3.4 The Board cannot, therefore, see any reason why a skilled person wishing to provide an edible oil with a high DHA content in a high purity directly from microbial cells and considering the teaching given in D4 would - for the purpose of enhancing the DHA-content of a microbial oil - turn to the different technique of fish oil manufacture according to D65a, which requires expensive post-treatment for removing impurities.

Furthermore, the use of a DHA concentrate from fish oil would be contrary to the whole concept of the invention, namely to avoid oils derived from fish sources. As pointed out by the Respondent, oils derived exclusively from a vegetarian source have considerable advantages when it comes to marketing the product. For example, such oils are both Kosher and Halal. In fact, the addition of fish oil to the vegetarian oil from D4 would ruin the purpose and the effect of the invention, namely the production of an oil which is directly obtainable from a microbe.

17.3.5 In the Board's judgment, a skilled person looking for ways to increase the DHA content of the oil of D4 would rather consider prior art lying in the field of microbial oils, such as D10. However, even such an approach does not lead to a lack of inventive step (see point 17.6 below).

17.3.6 The Appellant's argument that D65a states on page 1, lines 113 to 116 and on page 2, lines 79 to 88 that DHA can be handled in the same way as conventional edible oils, and thus can be added to various foodstuffs, does not alter the above conclusion because these passages relate to the use of the oils as a food supplement and not to blends of the oils with oils derived from other sources.

17.3.7 In summary, the person skilled in the art would not have considered the use of fish oil in combination with microbial oil since it was considered that fish oils have disadvantages which are not present in microbial oils. Thus, the skilled person would not have combined D4 with D65a. Consequently, it is not necessary to

consider whether or not a combination of D4 with D65a in fact leads to the oil of Claim 1 of the main request.

17.4 Combination of D4 with D79

As D79 is also exclusively concerned with fish oils, the above considerations made in respect of the combination of D4 with D65a equally apply to a combination of D4 with D79.

17.5 D65a and D79 taken either alone or in combination

As stated above under points 15.5 and 15.6 the teaching of the patent is confined to the provision of DHA-containing edible oils which are exclusively originated from unicellular organisms. For similar reasons discussed under points 17.3 a skilled person faced with the problem of providing unicellular edible oils with a high DHA content would neither choose D65a nor D79 (both concerning fish oils) as a suitable background art.

17.6 Combination of D4 with D10

17.6.1 D10 is, like D4, concerned with the isolation of oils containing Omega-3 fatty acids such as eicosapentaenoic acid (EPA) and DHA from cultures of unicellular microorganisms, e.g. dinoflagellates (*inter alia* C. cohnii) by solvent extraction (page 4 line 32 to page 6, line 8). Detailed culturing conditions are given in Example 1. The microorganisms are extracted with polar/non-polar solvent mixtures such as methanol/chloroform/water. On page 8 of D10, first full paragraph, it is stated that the extracts (after

esterification of the fatty acids) contain as much as 10 to 50% Omega-3 fatty acids of the total fatty acid fraction. This passage, however, does not mention DHA but relates to Omega-3 fatty acids in general, including DHA amongst other Omega-3 fatty acids such as EPA. Furthermore, the above disclosure is not directed to neutral non-polar fractions (like triglycerides) but includes also polar lipids such as phospholipides (page 8, lines 8 to 10). Thus, no conclusion can be drawn from D10 that the above range of 10 to 50% refers to the content of DHA in the triglyceride fraction. The skilled person could therefore not expect that the DHA content of the triglyceride fraction according to Figure 7 of D4 (with 32% DHA) could be enhanced up to 35% by blending it with the triglyceride fraction (i.e. the edible fraction) according to D10.

17.7 In summary, the oil according to Claim 1 of the main request is therefore based on an inventive step.

18. *Obviousness - Claim 5*

18.1 D4 is also the closest prior art for the process of Claim 5 as this document discloses the isolation of single-cell edible oils from *C. cohnii* cultivated under various conditions.

According to Claim 5 a single-cell edible oil with a DHA content of at least 20% by weight is prepared by cultivating the microorganism to achieve a cell density of at least 10 g/L biomass, thereby inducing the microorganism, by imposition of a stationary phase, to produce the oil at a concentration of at least 1.5 g/L. This biomass density is considerably higher than the



maximum production of biomass reported in D4, which is 2.85 g/L, as Dr. Kyle explained in point 7 of his declaration D57, something which was not contested by the Appellant.

18.2 Therefore, the problem to be solved by the process of Claim 5 is to be seen in the provision of a process which induces the microorganism to produce substantial amounts of a DHA-enriched edible oil.

18.3 As was already known from the prior art (patent specification, column 1, lines 44 go 52 referring to a literature passage) and as corroborated by Dr. Kyle in point 10 of his declaration D57, dinoflagellates like *C. cohnii* are very fragile and shear-sensitive. Furthermore, it is not in dispute that higher cell density causes a higher viscosity in the culture medium, which requires higher agitation rate and shear-forces in order to maintain sufficient aeration of the culture medium.

18.4 A skilled person, being aware of the high fragility and share sensitivity of dinoflagellates, would therefore expect that a too-high biomass density and the higher shear forces applied to agitate the culture medium would destroy the microorganism, thereby preventing the cells from growing and producing substantial amounts of oil. Rather, he would consider the cell density of 2.85 g/L obtained in D4 as a limiting value which it would be difficult to pass.

18.5 The process according to Claim 5, which involves cultivation of the microorganism to achieve a high cell

density of at least 10 g/L, is therefore not obvious from D4.

18.6 As Dr Kyle explained in point 6 of his declaration D57, the authors of D10 cultured *C. cohnii* to a biomass density of 1.2 g/L, a value which is even lower than that obtained in D4. Thus, D10 alone or in combination with D4 does also not lead to the process of Claim 5.

18.7 The process of Claim 5 is therefore inventive also.

19. From the above it follows that the subject-matter claimed in the claims according to the main request is based on an inventive step. The claims are therefore allowable.

## **Order**

### **For these reasons it is decided that:**

1. The appeal is accepted as admissible.
2. The name of the Appellant is ordered to be corrected to "Sanofi-Aventis Deutschland GmbH".
3. The appeal is dismissed.

The Registrar

The Chairman

G. Röhn

W. Sieber