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**Datasheet for the decision
of 28 November 2008**

Case Number: T 0098/07 - 3.3.06

Application Number: 98204263.2

Publication Number: 0926543

IPC: G03C 1/005

Language of the proceedings: EN

Title of invention:

Silver halide emulsions with recombinant collagen suitable for photographic application and also the preparation thereof

Patentee:

Fuji Photo Film B.V.

Opponent:

Fibrogen Inc.

Headword:

Silver halide emulsion/FUJI

Relevant legal provisions:

EPC Art. 111(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Late-filed documents admitted"
"Remittal to Opposition Division"

Decisions cited:

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Catchword:

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Case Number: T 0098/07 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 28 November 2008

Appellant: Fuji Photo film B.V.
(Patent Proprietor) P.O. Box 80150
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Representative: Nederlandsch Octrooibureau
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Respondent: Fibrogen Inc.
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Representative: Carpmaels & Ransford
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 12 January 2007
revoking European patent No. 0926543 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: P.-P. Bracke
Members: E. Bendl
A. Pignatelli

Summary of Facts and Submissions

- I. This appeal is against the decision of the Opposition Division to revoke the European patent no. 0 926 543 concerning silver halide emulsions.
- II. In the notice of opposition the Opponent requested revocation of the patent in its entirety because of amendments extending beyond the content of the application as filed (Art. 100c) EPC 1973), lack of sufficiency of disclosure (Art. 100b) EPC 1973), lack of novelty and inventive step (Art. 100a) EPC 1973).
- III. In his letter of reply the Proprietor requested maintenance of the patent in amended form.
- IV. The set of claims which formed the basis for the decision of the Opposition Division consisted of Claims 1-37 as granted and Claims 38-48 submitted during the oral proceedings held on 22.11.2006.
- V. The independent Claims 1, 31, 35, 37, 38 and 48 forming the basis of the Opposition Division's decision read as follows:

"1. A tabular silver halide emulsion wherein the tabular grains account for more than 75% of the total grain projected area said emulsion comprising at least one peptizer, said peptizer being substantially pure recombinant collagen like material free of helix structure and said peptizer having an amino acid sequence comprising more than 4 different amino acids."

"31. A process of preparing tabular silver halide emulsion wherein the tabular grains account for more than 75% of the total grain projected area said process comprising nucleation of silver halide grains in the presence of nucleation peptizer and thereafter

growing said silver halide grains in the presence of growth peptizer, wherein both peptizers are present in a defined amount and at least one peptizer is collagen like material being free of helix structure prepared by genetic engineering of native collagen encoding nucleic acid, said peptizers having an amino acid sequence comprising more than 4 different amino acids."

"37. Photographic element obtained according to the process according to claim 35 or 36."

"35. A process of photographic element production comprising application of an emulsion according to any of claims 1-30 or obtainable from a process according to any of claims 31-34 for obtaining a silver halide emulsion to be applied in a manner known per se for photographic element production with at least one silver halide emulsion layer, wherein the silver halide crystals of said layer have an aspect ratio of 5 or more."

"38. A process of producing recombinant collagen like polypeptide comprising expression of a collagen like polypeptide encoding nucleic acid sequence by a methylotrophic yeast to a degree exceeding 0.95 gram/liter, said nucleic acid sequence being free of procollagen and telopeptide encoding sequences and encoding a polypeptide having more than 4 different amino acid types, said recombinant collagen being free of helix structure."

"48. A substantially pure, recombinant collagen like material being free of helix structure prepared by genetic engineering of a native collagen encoding nucleic acid, said peptizer having an amino acid sequence equivalent to that occurring in nature for collagen, wherein equivalent implies amino acid identity of at least 80% and wherein said collagen occurring in nature is collagen type I, II or III, comprising more than 4 different amino acid types, having a weight on amino acid basis of 2.5-100 kDa and said peptizer being free of procollagen and telopeptides."

VI. Documents D1 - D25 were submitted in the course of the opposition procedure.

VII. In its decision the Opposition Division considered the requirements of Articles 123(2),(3), 83, 84 and 54 EPC 1973 as being met. However, the subject-matter of Claim 1 was not considered to involve an inventive step. Inventive step of the remaining claims was not considered.

VIII. A notice of appeal against this decision was filed by the Proprietor with his letter dated 19.01.2007. In the statement setting out the grounds of appeal it was requested to set aside the Opposition Division's decision and to maintain the patent on the basis of a new main request submitted with the same letter. Arguments with regard to inventive step were submitted.

IX. The Respondent requested rejection of the appeal and refusal of the new main request due to the failure to meet the requirements of Articles 83, 54 and 56 EPC 1973 as well as Rule 80 EPC (Rule 57a EPC 1973). In addition documents

D26 = Agric Biol Chem 47(8) 1711-1716, 1983

D27 = Biochem 13(14) 2946-2953, 1974

D28 = Biochem J 215 183-189, 1983

D29 = US 5 238 805

D30 = US 5 439 787

D31 = BMC Bioinformatics 7 415, 2006

were newly cited.

X. With his letter dated 28.10.2008 the Appellant reacted to Respondent's arguments by commenting on the newly filed documents and by submitting a new main request and auxiliary requests 1-18 as well as document

D32 = Nature 187 150-151, 1960.

The Respondent received Appellant's letter on 27.11.2008. He did not object to discuss the subject-matter of Claim 1 of the main request during the oral proceedings before the Board.

XI. Claim 1 of all the requests was identical to Claim 1 of the request filed with the statement of ground of appeal reading:

"1. A tabular silver halide emulsion wherein the tabular grains account for more than 75% of the total grain projected area said emulsion comprising at least one peptizer, said peptizer being a substantially pure, recombinant collagen like material being free of helix structure prepared by genetic engineering of native collagen encoding nucleic acid, said peptizer having an amino acid sequence equivalent to that occurring in nature for collagen, wherein equivalent implies amino acid identity of at least 80% and wherein said collagen occurring in nature is collagen type I, II or III, comprising more than 4 different amino acid types, having a weight on an amino acid basis of 2.5-100 kDa, and said peptizer being free of procollagen and telopeptides."

XII. Oral proceedings took place on 28.11.2008. The requirements of Articles 83, 54 and 56 EPC 1973 with regard to Claim 1 of the main request were discussed only taking into account documents D1-D25.

XIII. After having heard the arguments of both parties the Board made clear to the parties that the requirements of the EPC were not considered to be met by Claim 1 of the main request and consequently also not by Claim 1 of auxiliary requests 1 to 18.

XIV. As a reaction the Appellant withdrew all requests filed with letter of 28.10.2008 and replaced them by a new main request and ten auxiliary requests. The new requests are identical to the ones submitted with the letter of 28.10.2008, except that Claims 1-32 were deleted in all requests.

Remaining Claims 33 and 43 of the main request submitted during the oral proceedings are identical to Claims 38 and 48 forming the basis of the decision of the Opposition Division.

XV. The Appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or alternatively of one of the auxiliary requests 1 to 10 as filed during the oral proceedings before the Board.

XVI. The Respondent requested that the appeal be dismissed.

XVII. The Respondent raised the objection that the admission of new requests at this time in the proceedings amounts to a fundamental procedural violation.

The Respondent reserved the right to file a petition according to Article 112a EPC. In particular he objected against the introduction of further sets of claims at the late stage of the proceedings. Due to the delay of the procedure which would be caused by a possible remission of the patent-in-suit to the Opposition Division, the resulting prolonged period of legal insecurity and the lack of reasoning given by the Appellant for the late submissions, he regarded the

Appellant's submissions as a procedural abuse and the Board's decision as a procedural violation.

Reasons for the Decision

1. Admission into the proceedings of the requests filed during the oral proceedings before the Board

The requests filed during the oral proceedings before the Board represent an amendment of the party's case after it has filed its grounds of appeal and after oral proceedings have been arranged.

- 1.1 The Respondent objected against the admission into the proceedings of the requests because the delay of the procedure which would be caused by a possible remission of the case to the first instance department would result in a prolongation of the period of legal insecurity. Furthermore, he held that there were no reasons for the late submissions. Therefore, the filing of the requests represents in its opinion an abuse of procedure.

The Board cannot follow the arguments for the following reasons:

- a) The prolongation of the period of legal insecurity due to a remittal cannot per se be a reason not to admit new requests.

The EPC foresees in Article 111(1), 2nd sentence, the possibility to remit the case to the department of first instance for further

prosecution. This always causes a prolongation of the period of legal insecurity. This means that the EPC does not consider this aspect as being per se prejudicial to the proceedings.

- b) The argument of the Respondent that there were no reasons for the late submissions is not correct.

The new requests filed during the oral proceedings were a reaction to the discussion and finding of the Board on claim 1 of the previous requests. Thus, there was a reason to file the new requests at this stage of the proceedings.

1.2 According to Article 13(1) RPBA (Supplement to the OJ EPO 1/2008, page 38), an amendment of the party's case after it has filed its grounds of appeal may be admitted **and even considered** at the Boards discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy. Article 13(3) RPBA states that amendments made after oral proceedings have been arranged shall not be admitted if they raise issues which the Board or the other party cannot reasonably be expected to deal with without adjournment of the oral proceedings.

- a) The requests filed during the oral proceedings did not represent new subject-matter. In fact, the Appellant simply abandoned the subject-matter which was apparently seen as being not inventive after the discussion in the oral proceedings before the Board and restricted itself to the

remaining subject-matter which of course was on file already during the opposition procedure.

- b) The requests were filed at the earliest possible moment for doing so, namely as soon as the Appellant was aware of the position of the Board after the discussion of claim 1. Thus, the Board considers that this behaviour was appropriate for this stage of the proceedings and consistent with the need for procedural economy.
- c) Article 13(3) RPBA cannot be interpreted in a way that would prevent any amendment of requests during oral proceedings that necessitate remittal to the first instance department because this would be in contrast with Article 111 EPC. The RPBA are a subordinated regulation to the EPC. In case of a contrast between Articles of the EPC and depending regulations, the EPC - as the higher ranked rule - has to prevail.

The Board, therefore, in exercising its power of discretion decided to admit the new requests into the proceedings.

2. Remittal to the department of first instance

The Opposition Division decided on the question of inventive step only as far as Claim 1 is concerned, which is no more subject-matter of the proceedings, and did not examine inventive step of the now remaining subject-matter.

Furthermore, the Respondent submitted at the appeal stage many new documents which concern this remaining subject-matter.

Therefore, the Board makes use of the possibility given to it by Article 111 EPC and remits the case to the first instance for further prosecution in order to give to the parties the possibility to have the formal admissibility of the requests and their patentability also in view of the new filed documents be considered by two instances.

Order

For these reasons it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar

The Chairman

D. Sauter

P.-P. Bracke