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**Datasheet for the decision
of 10 February 2011**

Case Number: T 1067/08 - 3.3.09

Application Number: 98934912.1

Publication Number: 0990026

IPC: C12N 9/00

Language of the proceedings: EN

Title of invention:

High-activity phytase granulate

Patentee:

BASF SE

Opponents:

Syngenta Limited, European Regional Centre
NOVOZYMES A/S
AB Enzymes GmbH
Finnfeeds International Ltd

Headword:

High-activity phytase/BASF SE

Relevant legal provisions:

EPC Art. 113(2), 123(2)
EPC R. 116
RPBA Art. 12(4)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main request identical to sole request not admitted in
opposition proceedings - not admitted (abuse of procedure)"
"Auxiliary requests - not admitted (withdrawn/should have been
filed in first instance proceedings)"

Decisions cited:

G 0007/93, G 0009/91, G 0010/91, T 0123/85, T 0064/02,
T 1705/07, T 0382/97, T 0339/06, T 0933/04

Catchword:

Exercise of the powers under Article 12(4) RPBA is not conditional upon a party's conducting itself in bad faith or in a manner necessitating adjournment of the oral proceedings (points 3 and 5.3). Neither a party nor the department of first instance is at liberty to bring about the shifting of a case to the second instance as it pleases; such "forum shopping" would jeopardise the proper distribution of functions between the departments of first instance and the boards of appeal. Exercise of those powers may also be justified where a party's conduct - e.g. maintaining a single request which the opposition division had declined to admit into the proceedings as an abuse of procedure, and refusing to file amended and/or auxiliary requests - has in effect prevented the department of first instance from giving a reasoned decision on the critical issues, thereby compelling the board of appeal either to give a first ruling on those issues or to remit the case to the department of first instance (points 7.2 and 8.1).



Case Number: T 1067/08 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 10 February 2011

Appellant:
(Patent Proprietor)

BASF SE
D-67056 Ludwigshafen (DE)

Representative:

Wolf, Christian
BASF SE
Global Intellectual Property
GVX-C6
D-67056 Ludwigshafen (DE)

Respondent 01:
(Opponent 01)

Syngenta Limited, European Regional Centre
Priestley Road, Surrey Research Park, Guildford
Surrey GU2 ZYH (GB)

Representative:

Baldock, Sharon Claire
Boult Wade Tennant
Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT (GB)

Respondent 02:
(Opponent 02)

Novozymes A/S
Krogshøjvej 36
DK-2880 Bagsvaerd (DK)

Representative:

Stevens, Ian Edward
Potter Clarkson LLP
Park View House
58 The Ropewalk
Nottingham NG1 5DD (GB)

Respondent 03:
(Opponent 03)

AB Enzymes GmbH
Kirschenallee
D-64293 Darmstadt (DE)

Representative:

Hiebl, Inge Elisabeth
Kraus & Weisert
Patent- und Rechtsanwälte
Thomas-Wimmer-Ring 15
D-80539 München (DE)

Respondent 04:
(Opponent 04) Finnfeeds International Ltd
Market House
Ailesbury Court
Marlborough, Wiltshire SN8 1AA (GB)

Representative: Williams, Aylsa
D Young & Co LLP
Briton House
Briton Street
Southampton SO14 3EB (GB)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 31 March 2008
revoking European patent No. 0990026 pursuant
to Article 101(3) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: J. Jardón Álvarez
R. Menapace

Summary of Facts and Submissions

I. European patent No. 0 990 026 was granted to BASF AG, now BASF SE, on the basis of European patent application No. 98934912.1 which was filed on 4 June 1998 as international application PCT/EP1998/003328. The mention of grant was published on 12 May 2004 in Bulletin 2004/20. The patent was granted with 29 claims and included nine independent claims. The claim relevant for the present decision, namely Claim 15, read as follows:

"15. A granulate comprising dried granules formed from a phytase and a solid carrier which comprises at least 15% (w/w) of an edible carbohydrate polymer."

II. Notices of opposition against this patent were filed on 10 and 11 February 2005 by:

- Syngenta Limited, European Regional Centre (opponent 01)
- Novozymes A/S (opponent 02),
- AB Enzymes GmbH (opponent 03) and
- Finnfeeds International Ltd (opponent 04).

The opponents requested revocation of the patent in its entirety on the grounds pursuant to Article 100(a) EPC, more specifically for lack of novelty and inventive step, opponent 03 additionally for excluded patentability on the ground of Article 52(4) EPC 1973 and under Article 100(b) EPC.

III. The patent proprietor, by letter dated 15 December 2005, requested that the patent be maintained unamended (main request) and filed a set of eighteen claims as an auxiliary request. Claim 5 of this auxiliary request was directed to the granulate of granted Claim 15 and read as follows:

"5. A granulate comprising dried granules formed from a phytase and a solid carrier which comprises at least 30 % (w/w) of starch, wherein the range of size of the granulate is from 100 μm to 2000 μm , preferably 200 to 1800 μm and most preferably 300 to 1600 μm ."

In a communication dated 7 May 2007 and accompanying the summons to oral proceedings on 29 January 2008, the opposition division pointed out that "it seems that the presence of starch in the amounts as currently defined has not been originally disclosed" (page 4, penultimate paragraph). 29 November 2007 was set as the final date for making written submissions (Rule 71a EPC 1973).

By letter dated 28 November 2007 the patent proprietor withdrew its previous requests and filed an amended main request. Claim 3 of this request was directed to the granulate of Claim 5 of the previous auxiliary request and read as follows:

"3. A granulate comprising dried granules formed from a phytase and a non-fibrous solid carrier which comprises at least 30 % (w/w) of starch, wherein the range of size of the granulate is from 100 μm to 2000 μm and the granulate has an activity of at least 6000 FTU/g."

IV. During the oral proceedings held before the opposition division on 29 January 2008, after an extensive discussion of the main request focusing on Claim 3 in respect of the requirement of Article 123(2) EPC, the opposition division informed the parties that the main request did not meet the requirements of Article 123(2) EPC (point 2.5 of the minutes).

In reaction, the patent proprietor submitted a set of amended claims to become its sole request (point 3 of the minutes). Claim 1 of this request was directed to the granulate of Claim 3 of the previous request and read as follows:

"1. A granulate comprising dried granules formed from a phytase and a non-fibrous solid carrier which comprises at least 15% (w/w) of an edible carbohydrate polymer and the granulate has an activity of at least 6000 FTU/g."

In support of the admissibility of this late-filed request the proprietor argued that it had been taken by surprise by the opposition division's opinion with regard to Article 123(2) EPC and that by filing the new main request it sought to overcome all objections submitted so far. Additionally, the subject-matter of the new request was identical to the subject-matter as granted and thus had been under discussion since the beginning of the opposition proceedings; for that reason, the opponents should not be taken by surprise (point 3.1 of the minutes).

All four opponents objected to the admission of the new request on the ground that its late filing constituted

an abuse of procedure, essentially because they were taken by surprise by the late filing of these claims which were much broader than the claims filed by the proprietor in response to the communication of the opposition division. They also asserted that the late filing of the new main request was in breach of good faith. Opponent 1 said it was not prepared to discuss the new request at all during the oral proceedings; the other opponents said they needed a (substantial) break to prepare properly for discussion of the proprietor's new request.

After deliberation, the chairman announced the opposition division's finding that "the new main request was not allowable".

Thereafter, upon a question by the chairman, the patent proprietor affirmed that this request remained its valid request and stated that he did not want to file a further request (point 3.3. of the minutes).

- V. With its decision announced at the end of the oral proceedings and issued in writing on 31 March 2008, the opposition division revoked the patent on the ground that the patent in suit did not contain a set of claims approved by the proprietor (Article 113(2) EPC) and gave extensive reasoning as to why the submission of the new main/sole request at the oral proceedings constituted an abuse of procedure.

- VI. On 6 June 2008 the patent proprietor (appellant) filed an appeal against the decision of the opposition division and paid the prescribed fee on the same day. With the statement setting out the grounds of appeal,

filed on 11 August 2008, it requested that the appealed decision be set aside, that the main request of 29 January 2008 be admitted into the proceedings, and that the patent be maintained on the basis of that main request. The appellant also filed three further requests and written submissions in support of their allowability.

- VII. Replies to the statement of grounds of appeal were filed by respondent 04 (opponent 04) on 16 December 2008, by respondent 02 (opponent 02) on 19 December 2008 and by respondent 03 (opponent 03) on 22 December 2008. Respondent 02 also filed seven new documents in support of its arguments.
- VIII. On 5 October 2010 the board dispatched the summons to attend oral proceedings. In the attached communication the board drew the attention of the parties to the points to be discussed during the oral proceedings.
- IX. By letter dated 10 January 2011, the appellant maintained its main request, namely that the patent be maintained with the claims not admitted into the proceedings by the opposition division, auxiliarily with the text of one of the three requests filed on 11 August 2008 (point VI above), whose text was enclosed as "Auxiliary Requests 1, 2 and 3".
- X. Claim 1 of Auxiliary Request 1 differs from Claim 1 of the main request by the deletion of the term "non-fibrous".

Claim 1 of Auxiliary Request 2 differs from Claim 1 of Auxiliary Request 1 by the replacement of the wording

"15% (w/w) of an edible carbohydrate polymer" by the wording "30% (w/w) of starch".

Claim 1 of Auxiliary Request 3 is identical to Claim 3 of the main request filed with letter of 28 November 2007 (see point III above).

XI. Oral proceedings, at the end of which the decision of the board was announced, were held on 10 February 2011 in the absence of respondent 01, which had informed the board by letter dated 14 December 2011 that it would not be represented at the oral proceedings.

XII. The arguments presented by the appellant insofar as they are relevant for this decision may be summarised as follows:

- The appellant was surprised at the oral proceedings by the decision of the opposition division that the claims of the request filed with letter dated 28 November 2007 did not comply with Article 123(2) EPC;
- The filing of amended claims without the feature objected to was the only possibility for it to defend the patent. It could not have been a surprise for the other parties that a feature objected to be replaced by the original one in order to fulfil the requirements of Article 123(2) EPC. It would have been easy for the parties, with a short break, to prepare their case as all the features of the amended claims were already in the proceedings.

- It should be given the opportunity to defend that request before the board of appeal, because during the oral proceedings before the opposition division the appellant had felt that he had no reasonable chance of success as regards that request or any new request and had decided, therefore, to seek redress at the department of second instance.

 - In opposition proceedings a proprietor is, as a matter of principle, free to refrain at any time from filing further requests, and may then file different (new) requests in the appeal proceedings.
- XIII. The arguments of the respondents, as far as they are relevant for the present decision, may be summarised as follows:
- There was no good reason for the late filing of the appellant's eventual sole request. In particular, the patent proprietor could not have been surprised that during the oral proceedings the opposition division maintained the negative view on the compliance with Article 123(2) EPC which it had already explained in the previous communication.

 - The respondents could never have foreseen that new claims filed at the oral proceedings would have involved such a broadening of the claims. It was an abuse of the proceedings to file a new main request so late in the proceedings and with claims broadened in scope in respect of several features. It is not up to the opponents to anticipate which

combination of features out of all possible permutations the proprietor is going to pursue.

- The appellant's subsequent refusal to file any further requests, despite having been offered the opportunity to do so, amounted also to a refusal, on the part of the proprietor, to fulfil its duty to cooperate and contribute to the proceedings in defending its patent.
- The opposition division, in not admitting the appellant's late-filed sole request for abuse of the proceedings, had exercised its discretion correctly and reasonably.
- Admitting the same request and new auxiliary requests into the appeal proceedings would put the opponents and the public in a worse position than in the proceedings before the opposition division, because the proceedings would then continue for another six years or so.

XIV. The appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or any of the Auxiliary Requests 1 to 3, all of them filed with letter of 10 January 2011. It further requested remittal of the file to the opposition division in order to deal with novelty and inventive step.

Respondents 02 - 04 requested that the appeal be dismissed.

Respondent 01 (opponent 01) took no active part in the appeal and did not file any request.

Reasons for the Decision

1. The appeal is admissible.

The decision under appeal

2. The patent in suit was revoked for non-compliance with Article 113(2) EPC, following the opposition division's decision not to admit the proprietor's sole request as filed during the oral proceedings (that is what was clearly intended by the opposition division and what was understood by the parties, even if the division said the request was "not allowable" - see minutes, point 3.3.) and the subsequent refusal of the proprietor to amend that request and/or to file auxiliary requests. Whether or not the decision under appeal correctly relied on the absence of a text of the patent submitted or agreed by the proprietor depends, thus, on the answer to the preliminary question whether or not the opposition division was right in not admitting the proprietor's final request filed during the oral proceedings on the ground that its filing constituted an abuse of the proceedings.
3. In principle, during opposition proceedings a patent proprietor is free to withdraw at any time a request which contains limitations made in an attempt to overcome objections raised against its patent, or to amend it subsequently and, in particular, resume a defence of the patent as granted, unless this would

constitute an abuse of procedural law (established case law starting with T 123/85, OJ EPO 1989, 336). In line with this principle, Rule 71a EPC 1973, now Rule 116 EPC, gives the opposition division the discretionary power to refuse new requests for amendments, if amended claims are presented after the final date fixed under that provision. This applies in particular to requests which are, like the one under consideration, presented for the first time during the oral proceedings (case law of the boards of appeal, see e.g. T 64/02). The purpose of this provision is in particular to prevent parties from seeking unjustified procedural advantages by abusive tactics (*nemo auditur propriam turpitudinem allegans* - T 1705/07, it being, however, in this board's view, not a requirement for procedural abuse that the party responsible also acted in bad faith) in disregard of procedural economy and to the disadvantage of other parties. Therefore, any amendment has to be carried out in the most expedient manner, which has to be established by the opposition division taking into account the interests of all parties (T 382/97), and the power to refuse late requests must be exercised by considering all relevant factors which arose in a particular case, taking account *inter alia* of whether there were good reasons for the late filing, whether the other parties are taken by surprise and whether new issues are raised by the amendments made.

4. The opposition division's finding that the filing during the oral proceedings of the new claims according to the proprietor's sole and final request lacked adequate justification and disregarded the legitimate interests of the other parties, and therefore amounted

to an abuse of procedure, was based on the following facts and considerations:

- The appellant's conduct up to the oral proceedings suggested that it intended to defend the patent only in a restricted form, within the amendments made in preparation for the oral proceedings. There was no indication that the proprietor would defend any broader subject-matter and what it might be.
- There were no adequate objective reasons which would have justified the other parties having to prepare and discuss any further issues arising from the submission of the much broader claims comprising the feature "at least 15% (w/w) of carbohydrate polymer", but no longer any feature regarding the particle size.
- There was nothing preventing the proprietor, who was aware, *inter alia* from the preliminary opinion of the opposition division, of the objections under Article 123(2) EPC to the feature "at least 30% (w/w) of starch", from filing the new claims according to his final request in time. As these claims comprised a more general definition of the subject-matter and would involve reviewing a large number of submitted prior-art documents, the proprietor should have realised that the filing of such new claims in advance of the oral proceedings was required, having regard to the legitimate interests of the other parties to the proceedings, including their right to duly prepare for discussion of the new claims.

- The proprietor's contention that the negative finding on compliance with Article 123(2) EPC of the then pending request came as a surprise was unfounded: proprietors should be aware that new sets of claims have to be examined for compliance with Article 123(2) EPC, even more so in the present case where the critical feature had already been questioned by the opponents and by the opposition division during the written proceedings.
5. As regards the appellant's arguments in support of its contention that the opponents could not have been taken by surprise by the late filing of the eventual single request, the board observes the following:
- 5.1 The appellant's submission that the subject-matter of the new request was identical to the subject-matter as granted and thus had been discussed since the beginning of the opposition proceedings (point 3.1 of the minutes of the oral proceedings before the opposition division; point IV, above) is not supported by the facts. Claim 1 according to the eventual single request submitted during the oral proceedings before the opposition division is not at all identical to the text of the corresponding Claim 15 as granted. That text had never been discussed, since the appellant had already submitted an amended version (Claim 5) in response to the notices of opposition.
- 5.2 The same is true for the appellant's contention, during the oral proceedings before the board, that the opponents had already been familiar with all the

features of the final request and the relevant documents.

There is nothing which could justify such an assumption. Quite to the contrary. In the claims filed during the oral proceedings the appellant also deleted the feature concerning the particle size, a feature which had not been objected to at all. This feature had been introduced into the claims as a first reaction to the notices of opposition. It could thus have been assumed by the respondents that this would be one of the essential features of the subject-matter pursued during the opposition proceedings. While it can be admitted that the replacement of the feature "at least 30% (w/w) of starch" following the opposition division's negative finding on its compliance with Article 123(2) EPC was foreseeable, the appellant has not given any reason, nor is there any apparent, for the deletion of the particle size which led to a considerable broadening of the subject-matter at a very late stage of the opposition proceedings. Such an inconsistent course of action by the proprietor was not to be anticipated by the other parties or the opposition division. In addition, the new request would have raised new issues, not least because its claims differed from the subject-matter of the granted claims by a feature taken from the description, namely the "non-fibrous" solid carrier.

- 5.3 Under these circumstances it is irrelevant that the replacement as such of the feature objected to in amended claims could not have been a surprise to the other parties. Nor is it relevant that, as the appellant alleged before the board, the opponents were

facing as a result of their attacks, considerably less complex claims.

As regards the appellant's argument that the admission of the amended claims would have been justified in view of the fact that three of the four opponents were apparently willing to discuss the new claims after a (substantial) break for preparation (point IV above), it is pointed out that the concept of procedural abuse is not limited to conduct necessitating an adjournment of the oral proceedings, and that such necessity is not solely determined by the affected parties' view of whether or not an adjournment of the oral proceedings is necessary or appropriate.

6. For the reasons given by the opposition division and those given above, the board is satisfied that the opposition division, in taking the view that the filing of the amended claims during the oral proceedings was an abuse of procedure and therefore declining to admit them into the proceedings, has correctly exercised its discretionary power, namely on the basis of the given relevant facts, in accordance with the right principles and in a reasonable way. There is therefore no reason to overrule the opposition division's discretionary decision not to admit the late-filed claims (cf. G 7/93, OJ EPO 1994, 775).

Main request

7. The appellant's main request is identical to the (then sole) request which was not admitted into the opposition proceedings. The appellant argued that during the oral proceedings before the opposition

division it had seen no reasonable chance of success with that request or any new requests, and had therefore decided to seek redress at the department of second instance. Therefore, it should be given the opportunity to defend that request before the board of appeal.

7.1 The purpose of the *inter partes* appeal procedure is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits and to obtain a judicial ruling on whether the decision of the opposition division is correct (G 9/91 and G 10/91 - OJ EPO 1993, 408, 420). The appeal proceedings are not about bringing an entirely fresh case; rather, the decision of the board of appeal will in principle be taken on the basis of the subject of the dispute in the first-instance proceedings. The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings and the parties have only limited scope to amend the subject of the dispute in second-instance proceedings (T 1705/07, point 8.4 of the reasons).

7.2 This means that appeal proceedings are not just an alternative way of dealing with and deciding upon an opposition and that - contrary to the appellant's view, which apparently prompted it in the opposition proceedings to eventually limit itself to the request under consideration - parties to first-instance proceedings are not at liberty to bring about the shifting of their case to the second instance as they please, and so compel the board of appeal either to give a first ruling on the critical issues or to remit the case to the department of first instance. Conceding

such freedom to a party (and/or to the department of first instance) would run counter to orderly and efficient proceedings. In effect, it would allow a kind of "forum shopping" which would jeopardise the proper distribution of functions between the departments of first instance and the boards of appeal and would be absolutely unacceptable for procedural economy generally. In order to forestall such abusive conduct, Article 12(4) RPBA provides that the Board has the power to hold inadmissible any requests which were not admitted in the first-instance proceedings.

7.3 Hence, in the present case, neither the fact that the claims according to the main request were filed together with the notice of appeal (Article 12(1)(a) RPBA) nor the appellant's motives for limiting itself to the set of claims according to the single request eventually submitted in the opposition proceedings are, in themselves, a valid reason for admitting those claims into the appeal proceedings.

7.4 Quite to the contrary: given the history of these claims, their admission by the board would be incompatible with the judicial nature of the *inter partes* appeal procedure and would in effect render pointless the opposition division's correct decision not to admit them. Moreover, to admit the appellant's main request in the given circumstances would put the respondents in a worse position than if the request had been admitted and decided upon already by the opposition division. Either the subject-matter of that request would be dealt with only by the board as department of second instance, meaning higher costs and loss of one instance to the opponents (respondents), or

- much more likely, as the opposition division has not yet decided on novelty and inventive step - the case would be remitted to the department of first instance, as requested by the appellant. As pointed out in particular by respondent 3, this could entail a further delay of several years before the present case would be finally settled. Such a prolongation of the proceedings is incompatible with procedural economy and would for a long time and without good reason deprive the other parties and the public of legal certainty about the validity of the patent in suit.

- 7.5 For these reasons, the board has decided to exercise its power under Article 12(4) RPBA not to admit the main request into the appeal proceedings.

Auxiliary requests

8. Similar considerations are valid for the appellant's auxiliary requests. Article 12(4) RPBA makes it clear that new claims, even if filed together with the notice of appeal, are unlikely to be considered if they ought to have been presented in the first-instance proceedings (T 339/06).

- 8.1 Auxiliary Request 1 is, due to the deletion of the feature "non-fibrous", even broader than the main request. The claims of Auxiliary Requests 2 and 3 contain the feature "30% w/w of starch", Claim 1 of the latter request being identical to Claim 3 of the (main) request which the appellant had withdrawn in reaction to the negative opinion of the opposition division regarding that feature's compliance with Article 123(2) EPC. By withdrawing any claim containing that feature

and refusing to file any amended and/or auxiliary requests, the appellant prevented the opposition division from giving a reasoned decision on that issue. Thus, if the appellant had intended to pursue it, it ought not to have withdrawn all claims containing that feature from the proceedings (cf. T 933/04).

8.2 As mentioned earlier, in opposition proceedings a proprietor is free to refrain at any time from filing further requests, and may then file different (new) requests in the appeal proceedings. However, contrary to what the appellant suggested, this does not mean that these new requests then have to be admitted into the proceedings as of right. Rather, the admissibility of a request first submitted in appeal proceedings and relating to an independent claim which, although within the scope of the opposition, had not been considered in the first-instance decision has to be decided in the light of whether it could have been submitted earlier (T 339/06).

8.3 According to the appellant, the reason for not already submitting these or similar requests in the opposition proceedings was its incorrect assumption as to the procedural consequences of not doing so. No objective reason preventing the appellant from following the invitation by the opposition division has been put forward or is apparent to the board, in particular in respect of Auxiliary Request 3 which is identical to a request withdrawn in reaction to the negative (preliminary) ruling of the opposition division on compliance with Article 123(2) EPC. The appellant's purported view that any new requests submitted to the

opposition had no reasonable chance of success was mere speculation.

8.4 For these reasons, the board, in due exercise of its discretionary powers, has decided not to admit Auxiliary Requests 1 - 3 into the proceedings.

9. As there were no further requests, the procedural situation is the same as that prevailing at the end of the opposition proceedings, namely that there is no text of the patent in suit which meets the requirements of Article 113(2) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

G. Röhn

W. Sieber