

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 20 January 2014**

**Case Number:** T 0075/10 - 3.3.02

**Application Number:** 01115854.0

**Publication Number:** 1153603

**IPC:** A61K31/135, A61P25/22

**Language of the proceedings:** EN

**Title of invention:**

New treatments using phenethylamine derivatives

**Patent Proprietor:**

Wyeth LLC

**Opponent:**

EGIS Gyógyszergyár Nyrt

**Headword:**

Use of phenethylamine derivatives for treatment of panic disorders/WYETH LLC

**Relevant legal provisions:**

EPC Art. 114, 113(1), 104, 111

EPC R. 99(1)(a), 101(2)

RPBA Art. 16

**Keyword:**

Admissibility of appeal (yes)

Duly exercise of discretion by opposition division under  
Article 114(2) EPC (yes)

Substantive procedural violation of right to be heard under  
Article 113(1) EPC (yes)

Remittal

**Decisions cited:**

**Catchword:**



**Beschwerdekammern  
Boards of Appeal  
Chambres de recours**

European Patent Office  
D-80298 MUNICH  
GERMANY  
Tel. +49 (0) 89 2399-0  
Fax +49 (0) 89 2399-4465

Case Number: T 0075/10 - 3.3.02

**D E C I S I O N  
of Technical Board of Appeal 3.3.02  
of 20 January 2014**

**Appellant:**  
(Patent Proprietor)

Wyeth LLC  
235 East 42nd Street  
New York, NY 10017-5755 (US)

**Representative:**

Pfizer  
European Patent Department  
23-25 avenue du Docteur Lannelongue  
75668 Paris Cedex 14 (FR)

**Respondent:**  
(Opponent)

EGIS Gyógyszergyár Nyrt  
Keresztúri út 30-38  
1106 Budapest (HU)

**Representative:**

Stolmár & Partner  
Blumenstraße 17  
80331 München (DE)

**Decision under appeal:**

**Decision of the Opposition Division of the  
European Patent Office posted on 6 November 2009  
revoking European patent No. 1153603 pursuant to  
Article 101(2) EPC.**

**Composition of the Board:**

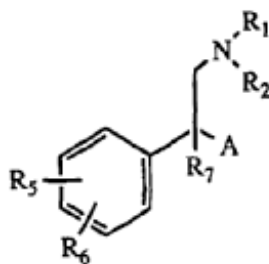
**Chairman:** L. Bühler  
**Members:** M. C. Ortega Plaza  
T. Sommerfeld

## Summary of Facts and Submissions

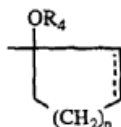
- I. European patent No. 1 153 603, based on European patent application No. 01115854.0, which was filed as a divisional application of the application No. 94304252.3 (parent application), was granted with seven claims.

Claim 1 as granted reads as follows:

"1. Use of a compound having the formula



in which A is a moiety of the formula



wherein

the dotted line represents optional unsaturation; R<sub>1</sub> is hydrogen or alkyl of 1 to 6 carbon atoms; R<sub>2</sub> is alkyl of 1 to 6 carbon atoms; R<sub>4</sub> is hydrogen, alkyl of 1 to 6 carbon atoms, formyl, or alkanoyl of 2 to 7 carbon atoms; R<sub>5</sub> and R<sub>6</sub> are independently hydrogen, hydroxyl, alkyl of 1 to 6 carbon atoms, alkoxy of 1 to 6 carbon atoms, alkanoyloxy of 2 to 7 carbon atoms, cyano, nitro, alkylmercapto of 1 to 6 carbon atoms, amino, alkylamino of 1 to 6 carbon atoms, dialkylamino in which each alkyl group is of 1 to 6 carbon atoms, alkanamido of 2 to 7 carbon atoms, halo,

trifluoromethyl, or when taken together, methylene dioxy; R<sub>7</sub> is hydrogen or alkyl of 1 to 6 carbon atoms; and n is 0, 1, 2, 3, or 4; or a pharmaceutically acceptable salt thereof, to prepare a medicament for the treatment of panic disorder."

Dependent claim 4 as granted reads as follows:

"4. Use as claimed in claim 2 wherein the compound is 1-[(2-dimethylamino)-1-(4-methoxyphenyl)ethyl] cyclohexanol or a pharmaceutically acceptable salt thereof."

II. Opposition was filed and revocation of the patent in its entirety was requested on grounds pursuant to Article 100(a) EPC (lack of novelty and lack of inventive step).

III. The following documents and evidence were cited *inter alia* in the opposition and appeal proceedings:

D1 S.L. Dubovsky, J. Clin. Psychiatry 54:5 (suppl), May 1993, 75-83

D25 "Dialog-File 545: Investext(r)Archive", two printed pages

D26 "Investext (Industry and Market Intelligence)", 9351199, "American-Home Products-Company Report", Buell, S.J., 4 October 1989, Kidder, Peabody & Company, Incorporated, (Copyright © 1997 The Investext Group)

D27 Dialog<sup>R</sup> 545, Investext<sup>R</sup> Archive; ONTAP<sup>R</sup> Investext<sup>R</sup> (277), "Last Loaded on Web: Monday, February 01, 2010, Last Update To Bluesheet: August 13, 2009"

- IV. The present appeal lies from a decision of the opposition division revoking the patent (Article 101(2) EPC).
- V. The opposition division admitted document D25, which was filed with the opponent's letter dated 18 September 2009, and document D26, which was filed during the oral proceedings before the opposition division, into the proceedings since it considered them to be *prima facie* relevant for the novelty issue. In particular, in the opposition division's view "*the disclosure of D25/D25*" [sic] was to be seen "*as a matter of fact*" (point 2.2 of the reasons for the decision).

Furthermore, the opposition division expressed the opinion that document D25 was not "*an internet publication*" and that said document was "*accessible by retrieving the indicated record number from the Investtext(r) Archive in Dialog-File 545*".

Additionally, the opposition division mentioned the following in point 2.2 of the reasons for the decision, first paragraph on page 6: "*According to the description of Investtext Archive in Dialog, "Investtext provides worldwide investment research and data" and covers from July 1982 through March 2007*".

Additionally, the opposition division was of the opinion that the patent proprietor had had "*sufficient time to react on the submission of D25 since the document could be located by using the bibliographic information provided, i.e. database and accession number*". The opposition division was of the opinion that "*whether or not paying a fee is required to access the information is of no relevance for novelty*".

In relation to the novelty issue, the opposition division considered that document D1 was not novelty-destroying for the subject-matter claimed in the claims as granted, since it did not disclose directly and unambiguously the use of venlafaxine for treating panic disorders.

However, the opposition division considered that the subject-matter claimed in claim 1 as granted lacked novelty vis-à-vis documents D25/D26. In particular, the opposition division considered that documents D25/D26 were available to the public and disclosed the use of venlafaxine to treat panic disorder.

VI. The patent proprietor (appellant) lodged an appeal against said decision and filed grounds thereto. It requested that the decision under appeal be set aside and that the patent be maintained as granted. It also requested that the case be remitted to the department of first instance for further prosecution ("*examination of the remaining ground of opposition*").

The appellant also requested that the opposition division's decision to admit documents D25 and D26 into the proceedings be reviewed since there was no proof that these documents were available to the public at the relevant date. In this context the appellant filed document D27 and stated *inter alia* that Dialog and Investext(r) Archive were subscriber websites and that documents could not be downloaded from these websites unless the applicant was a subscriber and had agreed to pay for the service.

Furthermore, the appellant argued that the opponent had handed over document D26 at the oral hearing before the opposition division and that the patent proprietor had

requested postponement of the hearing in order to investigate the provenance of the document. However, this had been refused by the opposition division on the basis that the disclosure had to be seen as "a matter of fact" and that the patent proprietor had been given sufficient time to react to the submission of D25.

- VII. The opponent (respondent) filed counter-arguments to the patentee's appeal. It requested that the patentee's appeal be dismissed. It also filed several documents.

The respondent submitted *inter alia* that the date of 4 October 1989 appearing in documents D25 and D26 was correct and that, on the balance of probabilities, these documents were published before the priority date of the patent in suit.

The respondent also mentioned that there was a formal deficiency which cast doubts on the admissibility of the appeal, since in the notice of appeal Wyeth Pharmaceuticals, which was not the same as the patent proprietor, appeared at the top of the letter. Therefore the appeal was inadmissible since it did not meet the requirements of Rule 99(1) together with Rule 41(2) (c) EPC.

- VIII. The board sent on 4 October 2013 a communication pursuant to Article 15(1) RPBA as an annex to the summons to oral proceedings.

In said communication the board *inter alia* drew the parties' attention to the fact that it was not self-evident from the grounds of appeal whether the appellant was arguing that the opposition division had not duly exercised its discretionary power under Article 114(2) EPC when admitting documents D25 and



D26, or that the opposition division had committed a substantial procedural violation infringing the patentee's right to be heard when refusing its request for postponement of the oral proceedings.

- IX. With a letter dated 20 November 2013 the appellant filed a reply to the board's communication. It maintained its request that the patent be maintained as granted, and filed a first auxiliary request. Claim 1 of the first auxiliary request reads as follows:

"1. Use of 1-[(2-dimethylamino)-1-(4-methoxyphenyl)ethyl]cyclohexanol or a pharmaceutically acceptable salt thereof, to prepare a medicament for the treatment of panic disorder".

The appellant clarified that it submitted that the opposition division had not exercised its discretionary power properly under Article 114(2) EPC when admitting the late-filed documents D25 and D26, and gave reasons supporting this position. Moreover, the appellant submitted that after the decision to admit the late-filed documents D25 and D26 into the proceedings, the opposition division had committed a substantial procedural violation in not adjourning the oral proceedings to allow sufficient time for the patent proprietor to investigate D25 and D26 fully. The appellant gave reasons in favour of its position. It also filed additional documents.

- X. With a letter dated 20 December 2013 the respondent filed a reply to the board's communication. It also filed two further documents.

The respondent argued in favour of the opposition division's decision to admit documents D25 and D26, in

particular because these documents were *prima facie* highly relevant.

XI. Oral proceedings took place on 20 January 2014.

During the oral proceedings the following documents were presented:

- general authorisation No. 558620.1 by Wyeth LLC dated 14 January 2010 (2 pages);
- request for grant (EPO form 1001) of European patent application No. 01115854.0 received by the EPO on 28 June 2001 (2 pages);
- printout of the Client Data System of the EPO concerning general authorisation No. 21410.6 (1 page);
- printout of the Client Data System of the EPO concerning general authorisation No. 453140.6 by Wyeth (1 page);
- printouts dated 17 January 2014 of the following web pages (9 pages in total):
  - web page of the Boston University entitled "Resources For Analyst Reports" (5 pages);
  - web page of the University of California entitled "More about Thomson Research Investext" (1 page);
  - web page of the University of California entitled "Investext (Via Thomson ONE)" (1 page);
  - web page of the Georgia State University entitled "Investext (via Thomson ONE Banker / Internet Explorer Only)" (1 page);
  - web page of the University of Chicago entitled "Investext" (1 page).

XII. The appellant's arguments, as far as relevant for the present decision, may be summarised as follows.

(a) In reply to the respondent's objection in relation to the authorisation of the representatives present at the oral proceedings before the board, the appellant filed a printout of general authorisation No. 558620.1 by Wyeth LLC dated 14 January 2010.

The appellant submitted that the identity of the appellant was clearly stated in the notice of appeal dated 5 January 2010. The appellant was the patent proprietor Wyeth and the person who had signed the notice of appeal (Ms Mannion) was an authorised representative for Wyeth. Ms Mannion too had signed the statement of grounds of appeal dated 8 March 2010. Thereafter, a request for registration of a change of the proprietor's name from Wyeth to Wyeth LLC had been filed with a letter dated 11 March 2010 signed by Mr Markus (also an authorised representative in the GA submitted).

Moreover, it was not unusual for American companies and their representatives to indicate a European address for prompt correspondence with the EPO. However, there was only one legal entity which was the patent proprietor Wyeth, as clearly stated in the notice of appeal. Wyeth Pharmaceuticals in the UK was a subsidiary of Wyeth. The appellant also pointed out that the applicant American Home Products had changed its name to Wyeth and that this change had been registered during examination proceedings.

(b) The appellant submitted that the opposition division's decision to admit documents D25 and D26 into the proceedings should be overturned since the opposition division had not duly exercised its discretionary power under Article 114(2) EPC and it had also committed a substantial procedural violation

infringing the patentee's right to be heard (Article 113(1) EPC). In particular, the opposition division had not given the patent proprietor adequate opportunity to prepare its defence vis-à-vis the two late-filed documents D25 and D26 when refusing its request for postponement of the oral proceedings.

The appellant summarised the facts from the opposition file, which concerned: the summons to attend oral proceedings to be held on 29 September 2009 (sent on 20 March 2009), the deadline of 28 August 2009 under Rule 116(1) EPC, the opponent's filing by telefax at the EPO of a letter dated 18 September 2009 with a document D25 annexed thereto, the EPO sending the copy of said opponent's letter (with the annex D25) to the patentee on 21 September 2009, and, finally, the filing of document D26 on 29 September 2009 during the oral proceedings before the opposition division.

The appellant argued that the patentee had not been given sufficient opportunity to identify and examine the provenance of document D25 and its public accessibility. Moreover, it had not been possible for the patentee to assess whether or not the content of document D25 was complete, since there was an empty space after the word "panic" in the first line under the heading "TEXT".

Additionally, an attempt to access the "DIALOG\_File 545: Investext(r)Archive" mentioned at the top of document D25 before the oral hearing of 29 September 2009 had failed since the patentee was not a subscriber to the database. The patentee had also not had a true opportunity to investigate the actual date of publication, or the public availability of the supposedly relevant content. This situation became even

worse after the filing at the oral proceedings before the opposition division of document D26, since the date 4 October 2009 was indicated under the name Buell, S.J. on the front page of said document (see also the mention of Kidder, Peabody & Company, Incorporated) at the same time as the information at the bottom about "Copyright © 1997, The Investext Group". As the opposition division had admitted documents D25 and D26 into the proceedings the patentee had again requested postponement of the oral proceedings in order to have an adequate opportunity to prepare its defence, but the opposition division had refused the request.

The appellant also submitted that the opponent's filing of documents D25 and D26 was an abuse of procedure, and cited decision T 718/98 of 26 November 2002. These documents should have been dismissed irrespective of their relevance, since in the opposition proceedings the opponent had not given any justification for their late filing. With this late and in sequence filing the opponent had improved its position against the patentee. If these documents were the result of a search in Internet and easily accessible, as argued by the respondent, then it was not understandable why such a search could not have been performed earlier or why documents D25 and D26 were filed one after the other.

The appellant also mentioned that the opposition division had relied on document D26 as originating from the patentee, since on the front page could be read "American Home Products - Company report". The appellant had required a certain time to investigate and find out that document D26 did not originate from the patentee. However, the opposition division did not give the patentee an adequate opportunity for this

investigation, which would have required to grant its request for postponement of the oral proceedings.

Although the patentee was taken by surprise with the filing and admission of documents D25 and D26 it was only given a restricted opportunity to prepare its defence vis-à-vis these late-filed documents despite its reasoned request for postponement of the oral proceedings. It could be argued that the adjournment of about twenty-three minutes after the opponent had filed document D26 during the oral proceedings before the opposition division could have sufficed for the preliminary assessment of its admissibility. However, as reflected in the minutes, the patentee had clearly again requested a postponement of the oral proceedings after the opposition division's announcement that documents D25 and D26 were admitted into the proceedings, in order to have an adequate opportunity to prepare its defence. Since the opposition division refused this request for postponement, the patentee's right to be heard had been infringed (Article 113(1) EPC). In this context it cited decision J 20/85 of 14 May 1986 (Headnote 2 and point 4 a) of the reasons) and Enlarged Board of Appeal decision G 4/92, OJ EPO 1994, 149.

As regards the respondent's internet search on the day before the oral proceedings before the board, it was completely irrelevant since what counted was the situation in 2009. The internet world had changed substantially since 2009. Therefore, the printouts filed by the respondent at the oral proceedings before the board should not be admitted into the proceedings.

The respondent's assertion that document D25 was immediately available to the patentee was not true.

Moreover, it could be that there was a difference of access if one performed an internet search from Munich or from the UK. It took the patentee days or even weeks to get access to Investext Archive. Moreover, the appellant never got any fax from the EPO with document D25. The copy of the opponent's letter with document D25 was sent by post only. Additionally, only after reading D26 had it become clear that the questionable sentence in document D25 also had an empty space in document D26.

The reasons for the request for postponement before the opposition division were not to have adequate time and opportunity to verify the complexity of the words, but their accuracy, as well as the actual date of their public availability.

During the first-instance proceedings, the patentee had not been in a position to understand the structure for public access to the database cited by the opponent at the oral proceedings before the opposition division. Additionally, the opponent had not provided any real proof of the public availability of the late-filed documents and their contents.

Remittal to the department of first instance was justified in the present case, to secure two instances that decided on essential issues.

The appellant also submitted that the situation it had previously depicted also justified its requests for reimbursement of the appeal fee and apportionment of the proprietor's costs incurred at appeal proceedings. In particular, the unjustified late-filing of documents D25 and D26 and the refusal to postpone the oral

proceedings before the first instance had forced the patentee to file an appeal.

XIII. The respondent's arguments, as far as relevant for the present decision, may be summarised as follows.

(a) The respondent expressed formal objections about a possible lack of authorisation for the appellant's representatives present at the oral proceedings before the board. Moreover, the respondent maintained the objection against the admissibility of the appeal as raised in the letter dated 8 April 2010 by the earlier respondent's representative. In particular, either the identity of the appellant was not clear in the notice of appeal or the appeal had not been filed by the American patent proprietor to whom the patent had been granted. In particular, it referred to Rule 99(1) (a) in connection with Rule 41(2) (c) EPC, and to Rule 101(1) and (2) EPC.

(b) Documents D25 and D26 were late-filed documents in the opposition proceedings. However, the opposition division had duly exercised its discretion when admitting them into the proceedings, since without any further investigation (i.e. *prima facie*) they were relevant so that the tenor of the envisaged decision would have changed. Rule 116(1) EPC was an implementation of Article 114(2) EPC and did not deprive the opposition division of the power to exercise its discretion when deciding to admit *prima facie* relevant late-filed documents or evidence. The opposition division had to consider in the first place the relevance of the late-filed documents on a *prima facie* basis and only in second place the procedural expediency, possibility of abuse of procedure, and the question as to whether the parties could reasonably be



expected to familiarise themselves in the time available with the new documents or evidence. In this context the respondent cited decision T 1002/92, OJ EPO 1995, 605. The relevant parts of documents D25 and D26 were quite simple, since venlafaxine and efficacy in panic disorder were explicitly mentioned in two sentences. The respondent further argued that the opposition division had acted in the interest of justice when admitting documents D25 and D26 and cited Article 114(1) EPC.

The respondent also cited decision R 4/09 of 30 April 2010.

Additionally, there was no reason for accusing the opponent of abuse of procedure, since the opponent had filed the highly relevant document D25 as soon as it had become aware of it. The late filing of the documents had not been deliberate. Since the person who had been the opponent's representative during opposition proceedings had died, it would be pure speculation to try to say why documents D25 and D26 had been filed one after the other. The situation underlying decision T 718/98 was quite different from the present situation since it had to do with the filing of a priority document and thus was not directly applicable to the present case.

The respondent acknowledged that from documents D25 and D26 it was not definitively clear whether these documents or the preliminary studies mentioned therein had been published or performed by the appellant. However, whether the studies mentioned in D26 had been performed by the appellant or by a competitor did not change the fact that D25 and D26 were novelty-

destroying and that the relevant passages were very brief.

The respondent also argued that D25 was a printout from Investext Archive and that D26 was the "complete document". It further argued that the day before the oral proceedings before the board it had performed an internet search in Google<sup>R</sup> and that Investext was mentioned in connection with entries for universities. In this context it filed during the oral proceedings before the board several printouts from the internet search it said it had performed the day before. In its opinion, these printouts should serve as a proof that Investext was accessible to everybody.

The respondent further submitted that, if a payment was required in order to have access either to the database or to a particular article, then this could be simply done by means of a credit card. If the patentee stated that an subscription was required it should provide proof of that. The publication date of document D26 was not unclear since it appeared on the front page as 4 October 1989. D26 concerned an investment opinion about American Home Products and disclosure of their products. The mention of a copyright had nothing to do with the publication date.

Accordingly, the respondent submitted that it was simple and did not take much time to verify documents D25 and D26 as novelty-destroying prior art. Therefore, the opposition division had acted correctly.

The case should not be remitted to the department of first instance since the opposition division had already found that documents D25 and D26 were novelty-destroying for the subject-matter claimed.

Moreover, the appeal fee should not be reimbursed since it was not justifiable in the present case. The present situation was not an extraordinary one and there was no reason in the present case to burden the respondent with the appellant's costs incurred at appeal. None of the situations depicted in Article 16 RPBA applied.

- XIV. The appellant (patent proprietor) requested that the decision under appeal be set aside, the appeal fee be reimbursed and the case be remitted to the department of first instance for further prosecution. It also requested that the payment by the opponent of the costs incurred by the patent proprietor with the appeal be ordered. In the alternative, the appellant requested that the patent be maintained as granted (main request) or, alternatively, in amended form on the basis of the first auxiliary request filed with the letter dated 20 November 2013.

The respondent (opponent) requested that the appeal be rejected as inadmissible or, alternatively, that the appeal be dismissed and the patent be revoked. It also requested that the request for remittal be refused and that the request for payment of the costs incurred by the patent proprietor with the appeal be refused.

## **Reasons for the Decision**

### *1. Formal matters/Admissibility of the appeal*

- 1.1 The request for grant of a European patent on the basis of European patent application No. 01115854.0 to the applicant American Home Products Corporation was dated

28 June 2001, and the authorised representative was Mr Connelly (a printout was distributed to the parties at the oral proceedings before the board). The registered general authorisation (GA) number indicated in said request for grant was 21410.6. Mr Connelly, as well as Ms Mannion, are authorised representatives under said GA (client data system printout, which was also distributed to the parties at the oral proceedings).

- 1.2 Furthermore, a request for registration of a change of name was filed on 19 April 2002, since a change of name "*from American Home Products to Wyeth*" was effected (the request and the accompanying certificate can be seen in the online file). On 6 May 2002 the EPO informed the applicant that the requested registration of the amendment to the entries pertaining to the applicant/proprietor had taken place with effect from 19 April 2002.

Moreover, it can be seen from said EPO communication that the amendments to the entries pertaining to the applicant/proprietor only concern the change of name of the applicant/proprietor to Wyeth, but do not change the address of the applicant/proprietor, which remains the one indicated in the request for grant of a European patent in accordance with Rule 41(2)(c) EPC.

- 1.3 Thus, European patent EP 1153603 was granted (date of publication and mention of the grant of the patent is 18 October 2006) to Wyeth as patent proprietor with the address Madison, NJ 07940-0874 (US) (which is a shortcut of the full address indicated in the request for grant of a European patent under Rule 41(2)(c) EPC).

- 1.4 European patent EP 1153603 underwent opposition proceedings and the opposition division issued a decision dated 6 November 2009 revoking the patent.
- 1.5 The "*Notice of Appeal in the matter of European Patent No. 1153603*", which was filed on 5 January 2010, is signed by Ms Mannion who is an authorised representative for Wyeth, as can be seen from the client data system (printout of GA No. 453140.6 distributed to the parties at the oral proceedings before the board).

Moreover, the notice of appeal clearly identifies the appellant since it states "**Wyeth** hereby files Notice of Appeal against the decision of the Opposition Division in respect of EP 1153603 dated 6 November 2009. The Decision is appealed in its entirety and **the Proprietor** maintains its original request that the Patent is maintained as granted" (emphasis added).

Therefore, no doubt can be cast upon the identity of the appellant, who was clearly and unambiguously identified in the notice of appeal and is the proprietor of the patent in suit EP 1153603.

The post address "*Huntercombe Lane South, Taplow, Maidenhead, Berkshire, SL6 0PH*" which appears in small letters at the top left of the letter with the notice of appeal is the same as the address indicated in the request for grant of a European patent as the address for correspondence with the representative in accordance with Rule 41(2)(d) EPC. The identity of the patent proprietor and appellant is not affected by the fact that this postal address for correspondence with the representatives before the EPO corresponds to "*Wyeth Pharmaceuticals*", since it is normal that for

prompt postal delivery companies' representatives give a European postal address, as well as telephone and fax numbers (Rule 41(2)(d), in conjunction with paragraph (c), EPC). In fact, also the telephone and fax number of the Patent and Trade Marks Department at the top right of the letter with the notice of appeal are the same as those indicated in the request for grant of a European patent cited above.

- 1.6 The board did not issue any communication under Rule 101(2) EPC inviting the patent proprietor to remedy any possible deficiencies concerning Rule 99(1)(a) EPC, since the name and address of the patent proprietor were clearly and consistently recorded in the European Patent Register, as could be verified in the online register, and the notice of appeal was clear and sufficient as regards the establishment of the identity of the appellant/proprietor and was signed by an authorised representative of the appellant/proprietor. Therefore, the identity of the appellant was established on the basis of the entries in the European Patent Register effective vis-à-vis the EPO (see Rule 143(1)(w) EPC together with Rules 85 and 22(3) EPC). The succession in title and thereby the status as patent proprietor and appellant were confirmed on 11 March 2010 by the certificate of conversion of 11 September 2009.
- 1.7 Therefore, the appeal is admissible since the requirements of Rule 99 EPC are met.
- 1.8 Additionally, from the online file it can be seen that a request for registration of a conversion "*from Wyeth to Wyeth LLC*" (together with a certificate of the conversion entailing a change of name) was filed at the EPO on 11 March 2010 and signed by Mr Markus who

appears as authorised representative for Wyeth LLC under GA No. 558620.1 (a copy of this general authorisation was filed by the appellant's representatives at the oral proceedings before the board).

- 1.9 Although the request for registration of the conversion dated 11 March 2010 was made conditional on the state of the proceedings ("pending European applications"), the EPO informed the patent proprietor on 19 March 2010 that the amendment to the entries pertaining to the patent proprietor had taken place for EP 1153603 according to Rule 143(1)(f) EPC. This amendment was the conversion from Wyeth to Wyeth LLC for the patent proprietor.

After being informed of the change of name in the register the patent proprietor did not contest this amendment to the entries pertaining to its name.

- 1.10 At the beginning of the oral proceedings the respondent questioned whether the present representatives Ms Laurent and Mr Hayles were authorised to represent the appellant. As a reply Ms Laurent and Mr Hayles filed a copy of GA No. 558620.1 dated 14 January 2010. Both representatives (as well as Mr Markus) are authorised representatives under said GA for Wyeth LLC.

Therefore, the appellant's representatives present at the oral proceedings before the board were authorised to represent the appellant patent proprietor.

2. *Admission of documents D25/26 by the opposition division and refusal of the patentee's request for postponement/adjournment of the oral proceedings before*

*the opposition division. Further related appellant's procedural requests.*

- 2.1 The minutes of the oral proceedings before the opposition division show that the patent proprietor requested postponement of the oral proceedings if document D25 was admitted. It has to be mentioned here that at the beginning of the oral proceedings before the opposition division both documents D25 (filed with the letter of 18 September 2009) and D26 (filed at the oral proceedings before the opposition division) were identified simultaneously as D25, because the opponent had previously stated at the oral proceedings that document D25 was an extract, page 16 being page 24, of the document filed during the oral proceedings. The document filed at the oral proceedings was later identified as D26 (see point 1, under the heading "Opponent", point 3 and last paragraph on page 2 of the minutes). According to the minutes, the opposition division announced at the oral proceedings its finding that "D25" (meaning still both documents: D25 and D26) was admitted into the proceedings. Thereafter the patent proprietor maintained its request for postponement or adjournment of the oral proceedings (see page 2 of the minutes).

After announcing the decision that the oral proceedings would not be postponed, the opposition division identified separately the two documents as D25 and D26, meaning that D26 was the "*complete document*" provided during the oral proceedings by the opponent (end of page 2 of the minutes).

- 2.2 It must be borne in mind that the opposition division sent a summons to attend oral proceedings pursuant to Rule 115(1) EPC on 20 March 2009. A communication of



the opposition division was sent as an annex thereto. In said summons 28 August 2009 was fixed as the final date for making written submissions and/or amendments (Rule 116 EPC).

Document D25 was filed by the opponent on 18 September 2009 and document D26 was filed by the opponent at the oral proceedings before the opposition division held on 29 September 2009, so both documents were late-filed.

Moreover, the reasons for the separate filing of documents D25 and D26 are not apparent from the online file and the opponent's representative who filed them in such a sequence has since died.

2.3 The opposition division admitted documents D25 and D26 into the proceedings basically since it considered them to be *prima facie* relevant for the novelty issue. In particular, in the opposition division's view "the disclosure of D25/D25" [sic] was to be seen "as a matter of fact" (point 2.2 of the reasons for the decision).

2.4 If the way in which a department of first instance has exercised its discretion on a procedural matter is challenged in appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, and to decide whether or not it would have exercised its discretion in the same way. A board of appeal should only overrule the way in which a department of first instance has exercised its discretion if the board concludes that it has applied the wrong principles, or not taken into account the right principles, or has acted in an unreasonable way (G 7/93, OJ EPO 1994, 775, point 2.6 of the reasons).

The board is therefore charged in the first place with reviewing the opposition division's exercise of its discretion under Article 114(2) EPC.

The opposition division correctly exercised its discretion when admitting into the proceedings the late-filed documents D25 and D26, since in the light of a *prima facie* analysis the documents appeared to be highly relevant for the novelty issue. Venlafaxine was a compound expressly mentioned in said documents and (in a sentence before that mention) it was mentioned "*panic, obsessive/compulsive syndrome*". Thus, the opposition division was of the opinion that documents D25 and D26, if admitted into the proceedings, would change the decision upon novelty of the subject-matter claimed. Moreover, also as a result of a *prima facie* analysis, the date "October 4, 89" could be found in document D25 and the same date appeared on the front page of document D26.

- 2.5 In consequence, the board sees no reason to overturn the opposition division's decision to admit documents D25 and D26 into the proceedings. Therefore, the board rejects the appellant's request that it hold inadmissible documents D25 and D26 and concludes that both documents are in the proceedings.
- 2.6 However, as regards the procedural conduct of the oral proceedings before the first instance, the board considers that the opposition division should have granted the patentee's request for postponement of the oral proceedings, after deciding to admit documents D25 and D26 into the proceedings, in order to give the patentee an adequate opportunity to prepare its defence vis-à-vis these two late-filed documents.

- 2.6.1 The reasons given in the opposition division's decision for refusing the patentee's request for postponement of the oral proceedings are as follows:

*"The concerns put forward by the patent proprietor regarding the admissibility of D25/26 were not found convincing, the relevant text of the document [sic] was rather short and the issue to be decided [was] prima facie a question of novelty".*

- 2.6.2 However, there is an essential difference between a *prima facie* assessment of the possible relevance and publication date of a late-filed document for deciding upon its admission into the proceedings and the full in-depth assessment of novelty vis-à-vis such a document. Such an in-depth assessment requires *inter alia* determining whether or not it can be established beyond reasonable doubt that the document (and the information which it contains) was actually made available to the public before the effective filing date of the patent in suit, and thus forms part of the state of the art under Article 54(2) EPC, as well as an assessment about the accuracy of the potentially novelty-destroying technical information. This necessitated inquiries with the database provider which obviously could not be expected to be dealt with without adjournment of the oral proceedings.

The respondent has not denied that both documents were generated from an archive, namely Investext Archive, which does not appertain to the databases and archives commonly used for a prior-art search in the technical fields underlying the patent in suit. In fact, it is rather an unusual database to use when looking for technically relevant prior art. This is a plausible reason in favour of the respondent's assertion that the

filing of the documents one after the other was not done as an abuse of procedure. However, at the same time, it is also a reason in favour of the plausibility of the difficulties encountered by the patentee at the oral proceedings before the opposition division when trying to verify the origins and accuracy of the late-filed documents in order to prepare its own defence.

Therefore, the opposition division should have taken seriously the patentee's allegations in relation to the difficulties it had encountered with respect to the lack of direct online access for these two documents, and should have provided it, by granting the request for postponement, with sufficient time and adequate opportunity to prepare its defence against the two late-filed documents which the opposition division had just admitted into the proceedings.

Moreover, it has also to be said that the respondent did not deny that in 2009 a certain payment was necessary.

Therefore, under the circumstances depicted above, the opposition division's refusal of the patentee's request for postponement (after it had announced the admission of the late-filed documents into the proceedings) was not just unfair since it disappointed the patentee's expectations, but it also deprived the patentee of its right to be heard in relation to this late-filed attack of lack of novelty based on documents D25 and D26. Thus, the opposition division committed a substantive procedural violation by infringing the patentee's right to be heard (Article 113(1) EPC).

The present situation differs from the situation underlying decision R 4/09, since the patentee had

requested at the oral proceedings before the opposition division a postponement to prepare its defence. Moreover, it was not only the content of said documents which had to be verified but also, and most importantly, their origins and date of availability to the public. This could not have been done in the present case during the pause for preparing the patentee's position regarding admissibility of the documents and their *prima facie* relevance.

2.7 The patentee did not request apportionment of costs under Article 104 EPC during opposition proceedings before the first instance, since the oral proceedings were not postponed and thus it bore the costs it had incurred, as is the usual situation. Moreover, it was the opposition division which gave the opponent an undue strategic advantage when refusing postponement of the oral proceedings after admitting the late-filed documents. It was also as a result of this opposition division's decision that the patentee was deprived of an adequate opportunity to prepare its defence. Additionally, the respondent's behaviour during appeal proceedings did not justify a request under Article 16 RPBA either. Therefore, the appellant's request for apportionment of costs incurred by the patentee during the appeal proceedings is refused.

2.8 As regards the appellant's request for reimbursement of the appeal fee, the following has been considered. The appeal fee shall be reimbursed where the board deems the appeal to be allowable if such a reimbursement is equitable by reason of a substantial procedural violation (Rule 103(1)(a) EPC). In the statement of the grounds of appeal the appellant contested the public availability of documents D25 and D26, and filed document D27 for that purpose. Therefore, the

appellant's primary aim was to overturn the opposition division's decision to admit the late-filed documents D25 and D26 into the proceedings, instead of requesting remittal in view of a substantial procedural violation. The board has concluded, however, that the opposition division duly exercised its discretion in admitting documents D25 and D26 (Article 114(2) EPC), which are thus in the proceedings.

However, the board established that, as the facts on file stood, it had to clarify whether the appellant also meant that a substantial procedural violation had been committed by the department of first instance. Therefore, the board raised this issue in its communication sent as an annex to the summons of oral proceedings. It was only with the appellant's response dated 20 November 2013 that it made its case in relation to the procedural violation committed by the opposition division within the meaning of Article 113(1) EPC in a clear and complete manner (Article 12 RPBA).

Therefore, under these circumstances the board does not consider it equitable to order the reimbursement of the appeal fee.

2.9 Finally, the printouts allegedly obtained from an internet search by the respondent the day before the oral proceedings before the board are not admitted into the proceedings since they have no evidential value in relation to the situation in 2009 and no apparent *prima facie* significance with respect to the issues discussed.

3. *Remittal to the department of first instance under Article 111(2) EPC.*

Having regard to the fact that the decision under appeal was taken on grounds against which the appellant did not have an adequate opportunity to present a proper defence under Article 113(1) EPC, the decision under appeal has to be set aside.

Moreover, the circumstances of the case justify remitting the case to the department of first instance in order that two instances can decide upon the issues pursuant to grounds of opposition under Article 100(a) EPC which require a detailed and in-depth assessment after both parties have been duly heard.

## **Order**

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

1. The appeal is admissible.
2. The decision under appeal is set aside.
3. The case is remitted to the department of first instance for further prosecution.
4. The request for reimbursement of the appeal fee is refused.
5. The request for apportionment of costs incurred during the appeal proceedings is refused.

The Registrar:

The Chairman:



N. Maslin

L. Bühler

Decision electronically authenticated