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**Datasheet for the interlocutory decision  
of 28 January 2014**

**Case Number:** T 2522/10 - 3.3.04

**Application Number:** 02029008.6

**Publication Number:** 1308455

**IPC:** C07K 1/18, C07K 16/32

**Language of the proceedings:** EN

**Title of invention:**  
A composition comprising anti-HER2 antibodies

**Patent Proprietor:**  
Genentech, Inc.

**Opponent:**  
Synthon B.V.

**Headword:**  
File exclusion/GENENTECH

**Relevant legal provisions:**  
EPC Art. 128(4)  
EPC R. 115(1), 132(2), 144(d)

**Keyword:**  
"Exclusion from file inspection (no)"  
"'Confidentiality club' in EPO proceedings (no)"

**Decisions cited:**  
T 699/06, T 1839/11  
Smith & Nephew plc. v. Convatec Technologies Inc. and Another  
[2014] EWHC 146 (Pat)

**Catchword:**  
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Case Number: T 2522/10 - 3.3.04

**INTERLOCUTORY DECISION**  
of the Technical Board of Appeal 3.3.04  
of 28 January 2014

**Appellant:** Genentech, Inc.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted on 5 October 2010  
revoking European patent No. 1308455 pursuant  
to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** C. Rennie-Smith  
**Members:** R. Morawetz  
B. Claes

## **Summary of Facts and Submissions**

- I. This interlocutory decision is concerned only with the request of the appellant (patent proprietor) that certain evidence be excluded from public file inspection. The appeal has been brought against the decision of the opposition division of 5 October 2010 to revoke European patent No. 1308455. The central finding of the opposition division was that the patent was not novel over document D6 (WO 97/04801). Notice of appeal was filed and the appeal fee was paid on 9 December 2010 by the appellant's then representative. The statement of grounds of appeal was filed on 15 February 2011 and the respondent (opponent) filed its reply on 1 July 2011.
- II. On 22 July 2013 the appellant filed additional evidence in the form of five declarations, two with accompanying annexes called Confidential Annexes, and requested (hereafter the "exclusion request") that these Confidential Annexes be excluded from public file inspection as they contain information which may be useful to third parties and it could damage the appellant's economic interests if that information is made available to the public. It was explained in one of the declarations (that of Laura Storto) that the other declarations and their annexes (including the Confidential Annexes) were the result of internal inquiries made recently for the purposes of national proceedings between the appellant and another party which also concern the validity of the patent in suit. (The appellant's arguments are summarised in section VI below.)

III. The board issued a communication dated 14 August 2013 relating only to the exclusion request and observing that the admissibility of each and all of the declarations and annexes enclosed with the letter of 22 July 2013 was a separate matter to be considered subsequently. Before considering the exclusion request further, the board invited the appellant to provide further information by way of answers to the following questions.

(a) Did the appellant wish to prevent disclosure of the Confidential Annexes to the respondent and, if so, on what basis?

(b) If not, how could exclusion from file inspection be justified on the basis (as set out in the letter of 22 July 2013) that the Confidential Annexes contain information useful to competitors?

(c) If, as appeared from Ms Storto's declaration to be the case, the appellant had already disclosed the documents contained in the Confidential Annexes in national proceedings, why should the board limit the availability of those documents in these proceedings?

The appellant was invited to file its reply within one month of the deemed date of receipt of this communication. That was one month less than the minimum provided for in Rule 132(2) EPC (if applicable), an abridgement of time which the board considered appropriate since the issue concerned both the right of the respondent to see the evidence filed in support of the case against it and the right of the public to inspect the file (Rule 144(d) EPC providing that

exclusion is of documents which would not serve the purpose of informing the public about the patent in question). The appellant was thus further invited to agree to the short time limit which would also apply if the board subsequently asked the respondent to comment. Pending the appellant's reply the Confidential Annexes would be provisionally excluded from inspection pursuant to Article 1(3) of the Decision of the EPO President of 12 July 2007 (OJ EPO 3/2007, 125 - "the Decision") and the patentee's letter of 22 July 2013 and all its enclosures except the Confidential Annexes would be sent to the respondent.

- IV. The appellant replied to the board's communication in a letter of 23 September 2013. Its further submissions and arguments are also summarised in section VI below. The board then sent a communication dated 11 October 2013 inviting the respondent to file written comments on the exclusion request in the light of the appellant's letters of 22 July 2013 and 23 September 2013 and the Board's communication of 14 August 2013. The Board repeated the observation in its previous communication that it was considering only the exclusion request. The respondent replied by filing its comments in a letter dated 19 November 2013. Its submissions and arguments, which are summarised in section VII below, included a request for oral proceedings if the board should arrive at a preliminary opinion other than to reject the exclusion request.
- V. On 19 December 2013 the board issued a summons to oral proceedings on 28 January 2014 and in a communication sent with the summons observed that these oral proceedings were solely for the purpose of hearing the

parties on the issue of the appellant's exclusion request and that, for the same reasons that the parties had been requested to reply to the board's previous communications within one month, less than the usual two months' notice of these oral proceedings was being given. In a letter dated 31 December 2013 the appellant's representative requested postponement of the oral proceedings due to previously summoned oral proceedings before the opposition division on the same date. In a communication dated 16 January 2013 the board refused that request. Oral proceedings took place on 28 January 2014 at which both parties were represented and heard and at the end of which the board announced its decision to refuse the exclusion request.

VI. The arguments of the appellant, in its letters of 22 July 2013 and 23 September 2013 and at the oral proceedings, can be summarised as follows.

*The exclusion request*

1. The five declarations and accompanying annexes filed with the appellant's letter of 22 July 2013 were evidence of critical importance in the present appeal because it related to certain issues of fact on which the opposition division's decision was based. Specifically, the evidence was critical to a correct reading of the disclosure in document D6 as regards novelty of the claimed compositions in the patent in suit and whether the D6 disclosure amounts to an enabling disclosure of those compositions.
2. The appeal is against the decision to revoke the patent for lack of novelty over document D6 which is a

patent application of the appellant. That decision was made following what appeared to be the logical chronology of events - that the work described in the patent followed the work described in D6. As explained in one of the new declarations (that of Laura Storto), and as proved by the supporting declarations, that assumed chronology is wrong. The work described in the patent had in fact been carried out before the work described in D6. Further, the work described in D6 was carried out using antibody samples that had already been subject to the inventive cation exchange chromatography process described in the patent. It was undisputed in the opposition proceedings that the cation exchange chromatography process had not been disclosed in any prior art and certainly not in D6 and was otherwise not available to the public before the priority date of the present patent. D6 could not be novelty destroying because the skilled addressee would not have been able to produce the claimed compositions in the patent relying on D6 alone.

3. Laura Storto's declaration explains how this new evidence came to light. In the course of preparation for pending national proceedings, the appellant started extensive investigations into the history of the experimental work underlying the examples described in the patent, this led to further investigations into the experimental work underlying the examples in D6 and this critical new evidence first came to light in recent months.

4. The appellant requested that the Confidential Annexes attached to two of the declarations (those of Carol Basey and Janet Yang) be excluded from public

file inspection pursuant to the board's discretion under Rule 144 EPC and Article 1(2)(a) of the Decision. Information not relevant to this case had been redacted from the Confidential Annexes to Carol Basey's declaration but the remainder remained confidential.

The Confidential Annexes are internal documents which set out detailed information about the commercial manufacture of trastuzumab (marketed as Herceptin) including information detailing, step by step, the methods used in the downstream processing of Herceptin, the organization by the appellant of its commercial production, the through-put achieved by the appellant and the development of the final fill and finish process including conditions and formulation constituents. Such detailed information has not been made public. Competitors of the appellant would gain a valuable insight into the manufacture of trastuzumab from the Confidential Annexes. This would assist their own development of a commercial manufacturing process for products in competition with the appellant. It is known that a number of competitors of the appellant are currently either considering or actively preparing to bring to market biosimilar trastuzumab products. In parallel proceedings, the appellant has designated documents comprised within the Confidential Annexes as confidential and only made them available to identified individuals who are subject to terms of confidentiality. The appellant therefore seeks to keep the documents confidential and to keep them off the EPO register to protect its economic interests and in order to maintain consistency with the parallel proceedings.



5. The appellant answered the board's questions in its communication of 14 August 2013 (see section III above) as follows.

(a) While the appellant did not wish to prevent disclosure of the Confidential Annexes to the respondent, it did request that any disclosure be provided on a limited and confidential basis. As in the parallel national proceedings, the appellant's confidential information should only be provided to the respondent's professional advisors and those persons within the respondent's organization who are required to review such disclosure for the purpose of these appeal proceedings. The identity of the persons to whom the Confidential Annexes would be provided should be agreed with the appellant and each of those persons should be asked to provide confidentiality undertakings similar to those provided in the national proceedings.

The appellant supplied a suggested confidentiality agreement which provided *inter alia* that the Confidential Annexes would be treated as confidential; not used for any purpose other than these appeal proceedings; and not disclosed, discussed or otherwise distributed to any person other than the respondent's legal advisors and other persons who have been agreed by the appellant and who have signed such a confidentiality undertaking. The undertakings expressly do not apply to information and documents that are already publicly available so there was no question of the appellant seeking to limit the availability of documents that have already been made public.

(b) The appellant requested that the Confidential Annexes be provided to the respondent only on a confidential basis, including restricting use to use in these appeal proceedings. In this way the transfer of information would be limited to certain individuals at a single competitor of the appellant who would be restricted from making use of the information outside these appeal proceedings. If, in contrast, the Confidential Annexes were placed on the public file any competitor would be free to view and make use of the appellant's commercially sensitive information for any purpose. The appellant's proposal would alleviate the problem of information being provided to the respondent and other competitors who would obtain an unfair advantage in connection with the commercial manufacture of biosimilar trastuzumab.

(c) The Confidential Annexes have not been publicly disclosed in the parallel national proceedings. Certain documents which appear in the Confidential Annexes have been disclosed on a confidential basis to the claimant in those proceedings, Hospira UK Limited, as part of the appellant's disclosure obligations under UK civil procedure rules. However, these documents have been disclosed only to Hospira's UK legal advisers and those persons within Hospira who are required to review such disclosure for the purpose of the national proceedings and who have provided confidentiality undertakings equivalent to those now suggested.

The appellant was currently unaware of any public disclosure of the documents contained within the Confidential Annexes. Should this situation change in

the future, the appellant would inform the Board at the earliest opportunity.

6. As an alternative to exclusion from public file inspection under Rule 144 EPC and the Decision, the appellant requested that the Confidential Annexes be excluded from public file inspection pending the Board's decision on the substantive appeal and that the Board invite further submissions from the parties on the exclusion request once that decision is published.

7. All the Confidential Annexes have been made available to Hospira in a limited manner in the national proceedings. The appellant has tried to redact the annexes as far as possible without destroying the sense but they could still provide a competitor with useful information. They cannot be redacted further without risking the usefulness of the evidence. However, the annexes to the Yang declaration have not so far been redacted and this could be done. The Confidential Annexes are not required to inform the public about the patent. All the information needed is in the declarations and the public does not need the annexes to understand the logic of the appellant's case and to judge document D6. The appellant has key arguments and its key documents are the declarations. The Confidential Annexes do not add anything to the facts nor do they verify any information which the public can obtain from the declarations, they just show that the witnesses who have given the declarations are credible.

*Postponement of the oral proceedings*

8. As regards postponement of the oral proceedings the appellant submitted that its representative very much appreciated that the board was giving this case so much priority and had offered to deal with the exclusion request on such short notice. The representative would have been prepared to attend the oral proceedings on 28 January 2014, although the time for preparing the case would have been extremely limited. However, he had already been summoned to oral proceedings before the opposition division on that date. In that case, he represents an opponent, which is also the appellant in the present case, and has done so from the very beginning of the proceedings. Since both cases are rather complex, it is not possible to transfer the responsibility for either to another attorney in his firm, in particular in view of the short time left to prepare for the oral proceedings. It is also the explicit wish of the appellant that he presents its case. Thus, in accordance with the Notice from the European Patent Office dated 18 December 2008 concerning oral proceedings before the EPO (OJ EPO 2009, 68), the appellant requested to change the date for the oral proceedings and suggested alternative dates in February 2014.

VII. The arguments of the respondent, in its letter of 19 November 2013 and at the oral proceedings, can be summarised as follows.

1. The respondent's comments relate to the legal standard for exclusion of documents pursuant Rule 144(d) EPC, the transparency of opposition

proceedings, and the impact of exclusion on the respondent and the board.

2. As regards the legal standard for exclusion of documents from the file, the Decision provides for an exclusion from public inspection if this would be prejudicial to the legitimate personal or economic interests of, in this case, the appellant. However, Rule 144(d) EPC is more restrictive as to the exclusion of information because only information which would not serve the purpose of informing the public about the European patent or patent application is to be excluded from the file. This implies that information that is relevant for the assessment of novelty, inventive step and/or sufficiency of disclosure of a European patent, and thus informs the public about the patentability of the European patent, should generally not be excluded from the file.

3. As regards transparency of opposition proceedings, in such proceedings the patentee defends a patent monopoly. Therefore, opposition proceedings before the EPO are public and allow for a full and open procedure that can be followed by any party, including the oral proceedings and the written decision. Moreover, opposition proceedings are not only a civil action between parties. The EPO, in this case the board, actively participates in these proceedings to ensure that the procedure follows the procedural rules, and to guarantee that the interests of the parties (including third parties) are not violated at any time. In particular, any party should be able to take notice of any document, fact and argument which was brought to

the attention of the board and may be of relevance in relation to the decision taken by the board.

Allowing information into the proceedings that is excluded from public file inspection would be a clear violation of the basic principle of full and open examination of the validity of the patent monopoly. In particular, a third party cannot file submissions as to patentability in relation to documents, facts or arguments which are excluded from file inspection. And it appears problematic as to how the board would handle arguments in its decision that are based on subject matter excluded from file inspection.

Thus, the Board has to balance on the one hand the principles enshrined in the EPC for opposition on the basis of publicly available documents, information, facts and arguments, and on the other an alleged unproven economic interest. As regards impact on the respondent, exclusion would unjustifiably limit the respondent in reacting to the information excluded from file inspection.

4. The appellant refers to UK proceedings between the appellant and another party (not participating in these opposition appeal proceedings). It is noted that in UK patent proceedings under specific national legal rules, the parties may be allowed to receive confidential information from the other party in relation to the validity/infringement proceedings under a confidentiality undertaking. However, before the EPO there is no legitimate right or desire to receive from the other party confidential information. Thus, the

comparison with and reference to UK proceedings is not applicable to EPO opposition proceedings.

In this respect, the proposed confidentiality undertaking would force the respondent into an undesired situation in which its strategy in attacking the validity of the patent monopoly would be unjustifiably hampered. For instance, the respondent would need approval from the appellant for consulting internal and external experts.

5. The real reason for the appellant's request appears from page 2 of its letter of 22 July 2013, namely it wants to show document D6 is not novelty destroying because its disclosure is not enabling. However, evidence used for that purpose cannot be excluded from inspection since it informs the public about the patent - see Rule 144(d) EPC. T 379/01 of 24 March 2004 (see Reasons, point 6.1) said that in the case of a key document in an *inter partes* case a strict standard has to be applied. In T 1401/05 of 20 September 2006, the board held that a balance must be struck between the right of the public to know about the contents of documents and the fundamental rights of natural or legal persons affected by their inspection. If the appellant should redact information relating to document D6, the public will not understand and the respondent will find it hard to argue its case. This case has very different facts from those in T 1839/11 of 29 June 2012 - in that case both parties to the appeal were also parties to the national proceedings and members of the "confidentiality club", in this case the respondent is outside the club. A published document is normally taken as state of the art unless

it is unequivocally proved that its disclosure is not enabled, whereas the appellant's approach is a non-traditional way of looking at enablement. If the appellant considers its declarations are not enough but needs the Confidential Annexes for credibility, then that shows that the annexes serve the purpose of informing the public about the patent.

6. Finally, the respondent objects to the filing of further documents at this late stage of the appeal proceedings. Particularly, because the related document D6 is in the name of the patentee and subject of the opposition proceedings *ab initio*.

VIII. The appellant's requests at the oral proceedings were:

(i) that the Confidential Annexes attached to the declarations of Carol Basey and Janet Yang filed on 22 July 2013 be excluded from file inspection;

(ii) that those annexes only be supplied to the respondent on a limited and confidential basis as set out in the appellant's letter of 23 September 2013;

(iii) that the public be excluded from the oral proceedings if the appellant needed to refer to the contents of the Confidential Annexes;

and, as auxiliary requests,

(iv) that the oral proceedings be postponed if there should be any discussion of substantive issues such as document D6;



(v) that the appellant have an opportunity to file redacted versions of Annexes A and D to the declaration of Janet Yang.

After hearing the parties and deliberation, the board announced its opinion that request (i) would be refused. It expressed the view that this obviated the need to pursue the appellant's other requests and the appellant agreed.

The respondent requested that the appellant's request to exclude the Confidential Annexes from file inspection be refused.

IX. At the end of the oral proceedings the appellant requested the board to record the following in the minutes.

"The appellant requested to record in the minutes that the Board's refusal of the appellant's request for the postponement of the oral proceedings given in the Board's communication of 16 January 2013 constitutes a procedural violation in particular in connection with not observing the time limit set forth in Rule 115(1) EPC, appellant's right to be heard in accordance with Article 113 EPC and the appellant's free choice of representative, which is a generally accepted principle of procedural law of the Contracting States of the EPC, and that the appellant reserved its right to file a petition for review by the Enlarged Board of Appeal under Article 112a EPC."

## **Reasons for the Decision**

### *Short Notice*

1. The board took the view that the exclusion request needed to be dealt with as expeditiously as possible. Exclusion of documents from the public file denies information to the public and may thus amount to a limitation on the freedom of information. In this particular case, the appellant's initial arguments included the need, as it saw it, to keep the content of the Confidential Annexes from its competitors who apparently included the respondent and thus, for the duration of the written and oral proceedings relating to the exclusion request, the respondent was not in possession of copies of those annexes. That was a period of some six months which is a considerable time for a party to be denied details of the case against it. It was also in the appellant's interest to know as soon as possible whether or not its exclusion request was to be allowed or not.
  
2. The board thus took the view from the outset that it would attempt to make the parties agree to short time limits. Thus in its first communication of 14 August 2013 it clearly stated that it was setting a time limit of one month and that this reduction of the usual minimum provided for in Rule 132(2) EPC seemed appropriate in the interest of the respondent and the public. Since the board has no power to abridge time limits without the agreement of the parties, the appellant was invited to agree. The appellant made no comment on that in its reply but filed its reply in one month, thus indicating its agreement. The same time

limit was complied with by the respondent in replying to the board's next communication of 11 October 2013.

3. In its next communication accompanying the summons to oral proceedings, the board indicated that, for the same reasons that the parties had been requested to reply to previous communications within one month, less than the usual two months' notice of the oral proceedings had been given and observed that it could not see that either party could object to short notice since an early resolution of this issue was in the interest of the parties and the public. The appellant did in fact object at the end of the oral proceedings to non-observance of the time limit in Rule 115(1) EPC, although it had previously, in its letter of 31 December 2013, acknowledged its appreciation of the board's priority treatment of its exclusion request. It is clear that this objection was only raised belatedly as part of the appellant's reaction to the refusal of a postponement of the oral proceedings (see section V above and points 4 to 8 below). During the course of the proceedings concerning the exclusion request, both parties shared the board's objective of resolving the issue expeditiously and agreed to shortened time limits to achieve that.

*Request to postpone oral proceedings*

4. The respondent's arguments for a postponement of the oral proceedings are summarised in section VI.8 above. The board did not seek the respondent's views on the request since it was not persuaded by the appellant's reasons. The board's reasons set out below for refusing

the request are as given in the communication of 16 January 2013.

5. As the board had observed in its previous communication of 19 November 2013, the oral proceedings on 28 January 2014 were solely for the purpose of hearing the parties on the issue of the appellant's request to exclude certain documents from the public file. There was no question of any other issue being discussed and the parties needed only prepare to discuss that limited issue. The time of just over one month from the summons of 19 December 2013 to 28 January 2014 should have been sufficient for another representative to prepare. There was clearly no question of the appellant's representative being required to transfer responsibility for the whole matter as he had suggested. Even if the case as a whole is complex (a view taken, unsurprisingly, by most parties of their cases), the limited issue of the exclusion request was clearly not.
  
6. To postpone the oral proceedings would have meant that a question of public interest, namely whether the public should or should not have access to evidence relied on in proceedings concerning a monopoly, would have been left unanswered for longer than six months (the appellant's exclusion request having been filed on 22 July 2013). There could be no doubt such exceptional matters should be resolved expeditiously and the appellant, whose request had created the exceptional situation, should not expect any indulgence which would have the effect of delaying its resolution. The board could not hear the case on any of the alternative dates suggested by the appellant's representative. In the exceptional circumstances created by the exclusion

request the board refused the request to postpone the oral proceedings.

7. The board notes that, in the event, the appellant was represented at the oral proceedings by no fewer than three other representatives, two of whom were from the same firm as the original representative, and that they were clearly prepared to deal with the appellant's exclusion request.
  
8. In its statement recorded in the minutes at the end of the oral proceedings (see section IX above), the appellant referred to three arguments which it had not raised previously and which, if so raised, would have been considered in debate with the parties. As it is, the board can only comment. First, the appellant objected for the first time to short notice of the oral proceedings, as to which the board refers to point 3 above. Second, it alleged that its right to be heard was not observed, as to which the board refers to point 7 above. Third, it alleged that the appellant's free choice of representative, which is a generally accepted principle of procedural law of the Contracting States of the EPC (an apparent reference to Article 125 EPC), was not observed. In this respect the board refers to its decision, in a different composition and relating to different factual circumstances, in T 699/06 of 29 June 2010 (see reasons, point 12) in which it acknowledged the right of a party to the representative of its choice but not of a consequent right of that representative to postponement in order to ensure his or her presence. While the circumstances of that case were much different, the principle may be applicable - if the appellant makes a request which

requires expeditious treatment for *inter alia* the appellant's benefit and it acquiesces in and even expresses appreciation of such expedition, it lies ill in its mouth to complain retrospectively when it is thereby unable to deploy its first choice representative.

*Exclusion of evidence from the public file*

9. The legal position regarding exclusion from file inspection was clearly and comprehensively summarised by board 3.3.0.9 in its decision T 1839/11 of 29 June 2012 as follows (see points 3.1 to 3.3):

*"3.1 Article 128(4) EPC provides that:*

*"After the publication of the European patent application, the files relating to the application and the resulting European patent may be inspected on request, subject to the restrictions laid down in the Implementing Regulations."*

*Rule 144 EPC provides that:*

*"The parts of the file excluded from inspection under Article 128, paragraph 4, shall be:*

*(d) any ... document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the European patent."*

Article 1(2) of the Decision of the President dated 12 July 2007 (OJ EPO, 2007, Special edition No. 3, p.125) provides that:

*"Documents or parts thereof ... (a) shall be excluded from file inspection at the reasoned request of a party or his representative if their inspection would be prejudicial to the legitimate personal or economic interest of natural or legal persons".*

*3.2 Prejudice to the economic interests of a party is therefore a necessary requirement for exclusion from file inspection in a case such as the present but is not of itself a sufficient requirement. The overreaching principle is set out in Rule 144(d) EPC, to which the President's Decision must read as being subject, namely, that documents may be withheld from public inspection (only) if such inspection would not serve the purpose of informing the public about the patent. To this may be added the following two comments:*

*(a) The provisions making an exception from the general principle of public access to the file are to be construed narrowly (see T 379/01, point 6.1 of the decision).*

*(b) One of the purposes of file inspection is to enable the public to obtain information about the patent, being information to which it is entitled in return for the exclusive monopoly rights which the patent confers (indeed, this is the "paramount" purpose of file inspection according to the Board in T 1401/05 - see point 5 of the decision).*

*3.3 Examples where file inspection would not have served the purpose of informing the public about the patent are to be found in the decisions T 379/01, T 1401/05 and J 23/10. In each of these cases the material which was the subject of a request for exclusion from file inspection had no relevance to the subject matter of the patent."*

10. The test for exclusion or non-exclusion is therefore clear and straightforward - would the document in question serve the purpose of informing the public about the patent or patent application in issue? While the answer to that question will depend on the facts of each case, if the answer once ascertained is "yes", then there may be no exclusion and the matter need not be considered further. If the answer is "no", then consideration must be given to a further question, namely whether inspection would be prejudicial to the legitimate personal or economic interest of natural or legal persons.
  
11. In the present case the board has no hesitation in finding that the Confidential Annexes which the appellant seeks to exclude from file inspection would serve the purpose of informing the public about the patent. This conclusion follows axiomatically from the appellant's own submissions (see section VI.1 and 2 above) that the declarations and annexes (including the Confidential Annexes) filed with its letter of 22 July 2013 were evidence of critical importance which related to issues of fact on which the opposition division decision was based and which was critical to a correct reading of document D6 which the evidence would show



was not novelty destroying. It is difficult to see how documents filed in order to show that the very basis of a decision to revoke a patent was incorrect could not serve the purpose of informing the public about that patent.

12. At the oral proceedings before the board, the appellant refined its argument in this respect to a narrower position (see section VI.7 above). It argued that the Confidential Annexes (the documents it sought to exclude from file inspection) are not required to inform the public about the patent since all the information needed is in the declarations and the public does not need the annexes to understand the logic of the appellant's case and to judge document D6. The key documents are the declarations and the Confidential Annexes neither add anything to the facts nor verify any information which the public can obtain from the declarations, they just show that the witnesses who have given the declarations are credible.
  
13. The board readily appreciates that different items of evidence may have a different weight and play a different rôle in a party's case. However, the board cannot make any finding as to the relative weight of parts of a party's evidence when deciding whether or not to exclude documents from file inspection. If certain evidence is of no particular importance, it may not even be admitted in appeal proceedings. If admitted then, on consideration of allowability of the appeal, it may be found to have little or no probative value. However, both admissibility of new evidence and allowability of the appeal are matters to be decided later. What has to be decided now is whether or not the

Confidential Annexes inform the public about the patent in suit. The appellant submits that at most they lend credibility to the declarations of witnesses whose evidence shows that the decision of the opposition division was incorrect. In the board's opinion, the appellant's own submission is again conclusive. If the declarations inform the public about the patent and the Confidential Annexes support the credibility of the declarations, then the Confidential Annexes also inform the public about the patent. The board cannot see any scope for distinguishing between degrees or levels of information provided to the public. If a document plays any rôle in a party's case for or against allowing the appeal, then it gives the public information about the patent in suit in that appeal and the public is not only entitled to that information but also to make its own assessment of whether it is important or not. There is no obligation on a party to file any item of evidence but any item which it does file cannot be excluded from file inspection because the party claims it is only of secondary importance. The only means of exclusion is for the party not to file it at all.

14. The appellant also argued at some length that the Confidential Annexes should be disclosed to the respondent on terms which would limit those who saw them but otherwise excluded from file inspection. It drew attention to the arrangements which had been made in other proceedings in England involving validity of the same patent and suggested that similar arrangements be made in these proceedings. The board sees no need to refer to the details of the arrangements, either as proposed by the appellant (see section VI.5 above) or as used in English proceedings where they are usually

- termed a "confidentiality club" (see a good summary in the recent decision of 31 January 2014 of the Patents Court in *Smith & Nephew plc v. Convatec Technologies Inc and Another* [2014] EWHC 146 (Pat), points 4 to 9 of the judgment).
15. The board cannot see how any such arrangements would avoid the fundamental problem in the appellant's case, namely that once it is established that a document may inform the public about a patent, that document cannot be excluded from file inspection. The whole debate about whether arrangements could or should be made to allow the respondent limited access to the Confidential Annexes was predicated upon the Confidential Annexes being excluded from file inspection. That is shown by the fact that the appellant at the outset relied on the argument that the Confidential Annexes should be excluded because they would be of value to competitors and this prompted the board to question the position of the respondent, which may be at least a potential competitor and is certainly at least and probably more entitled to see the appellant's evidence than the public. However, as the extract from T 1839/11 quoted above shows, economic interest (which would include competition) only comes into question if the material to be excluded would not inform the public about the patent (see points 9 and 10 above).
16. In addition to its economic interest, the appellant also argued that a "confidentiality club" would be appropriate in this case to maintain consistency with parallel proceedings. The board sees no merit in that argument. The two sets of proceedings can only be called "parallel" in as much as they are apparently

co-existent. These proceedings before the board are appeal proceedings from a first instance decision of 5 October 2010 while the appellant has not supplied any information about the stage reached in the English proceedings. More importantly, the other party in the English proceedings, Hospira UK Limited, is not a party in these appeal proceedings and the respondent in these proceedings is not a party in the English proceedings. In that respect the factual position is markedly different from T 1839/11 in which both parties were parties in both appeal proceedings in board 3.3.0.9 and in truly parallel English proceedings and the issues related to the use in the appeal proceedings of documents provided in the English proceedings within a "confidentiality club" arrangement in which it appears some account was taken of such use (see T 1839/11, reasons, point 3.7).

17. The board adds the further observation that it is difficult to envisage how a "confidentiality club" or any similar arrangement for limited disclosure of possibly sensitive material could be allowed in any EPO proceedings in view of the legal provisions referred to above (see points 9 and 10). Parties could agree to give disclosure between them under a private, contractually binding arrangement. If that should lead to or be followed by an agreed disposal of the proceedings, it would be both workable and beneficial. Otherwise however, the parties would eventually have to file the sensitive material with the first instance department or board of appeal and the difficulties facing the appellant in this case would then arise. A further possible difficulty would be that, if a "confidentiality club" or similar arrangement were to

be set up, the first instance department or board of appeal has no power to sanction a party which acted contrary to the undertakings it had given.

18. Lastly the board observes again that this decision has been concerned only with the exclusion request. The fact that this request has not been allowed and that the Confidential Annexes are available for public inspection has no effect upon subsequent issues of admissibility and allowability. In particular the respondent has submitted (see section VII.6 above) that the evidence filed by the appellant with its letter of 22 July 2013 should not be admitted as late-filed and that issue remains to be decided.

## **Order**

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

The request for excluding the Confidential Annexes attached to the declarations of Carol Bane and Janet Yang filed on 22 July 2013 from file inspection is refused.

The Registrar:

The Chairman:

P. Cremona

C. Rennie-Smith