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**Datasheet for the decision
of 24 June 2014**

Case Number: T 1564/12 - 3.3.09

Application Number: 98934911.3

Publication Number: 0986313

IPC: A23K1/00

Language of the proceedings: EN

Title of invention:

STARCH-BASED PHOSPHATASE GRANULATES

Patent Proprietor:

BASF SE

Opponents:

NOVOZYMES A/S
DuPont Nutrition Biosciences ApS

Headword:

Relevant legal provisions:

EPC Art. 84
RPBA Art. 13(1), 16(1)

Keyword:

Late-filed document - admitted (no)
Claims - clarity (no)
Apportionment of costs - (no)

Decisions cited:

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1564/12 - 3.3.09

**D E C I S I O N
of Technical Board of Appeal 3.3.09
of 24 June 2014**

Appellant: BASF SE
(Patent Proprietor) 67056 Ludwigshafen (DE)

Representative: Wolf, Christian
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Respondent 01: NOVOZYMES A/S
(Opponent 01) Krogshøjvej 36
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Respondent 02: DuPont Nutrition Biosciences ApS
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 30 April 2012
revoking European patent No. 0986313 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

| | |
|-----------------|-------------------|
| Chairman | W. Sieber |
| Members: | J. Jardón Álvarez |
| | E. Kossonakou |

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the proprietor of European patent No. 0 986 313, BASF SE (former BASF Aktiengesellschaft), against the decision of the opposition division to revoke the patent.
- II. Both opponent 01, Novozymes A/S, and opponent 02, Danisco A/S (now DuPont Nutrition Biosciences ApS), had requested revocation of the patent in its entirety on the grounds that the claimed subject-matter was neither novel nor inventive (Article 100(a) EPC), that the patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Article 100(b) EPC), and that the patent contained subject-matter which extended beyond the content of the application as originally filed (Article 100(c) EPC).

The documents cited during the opposition proceedings included:

E1: WO 97/39116 A1

- III. In its decision the opposition division held that:
- the subject-matter of independent claims 7, 8, 12, 14 and 17 to 19 of the then pending main request lacked novelty in view of the disclosure of E1;
 - the subject-matter of claim 1 of auxiliary requests 1 and 3 did not fulfil the requirements of Article 84 EPC; and

- the subject-matter of claim 1 of auxiliary request 2 lacked inventive step, starting from E1 as closest prior-art document.

Concerning auxiliary requests 1 and 3, the opposition division concluded that the amendments made fulfilled the requirements of Article 123(2) EPC, but not the requirements of Article 84 EPC because the feature "having an activity of from 6,000 to 10,000 FTU/g" was to be considered as a result to be achieved and such a definition was only permissible if the alleged invention could not be defined in more concrete terms.

- IV. This decision was appealed by the patent proprietor (in the following: the appellant). The appellant no longer pursued the main and the second auxiliary requests before the opposition division. It maintained only auxiliary requests 1 and 3 and requested that the board acknowledge that these requests complied with Article 84 EPC and remit the case to the opposition division for the further consideration of novelty and inventive step.

Claim 1 of both requests is identical. It reads as follows:

"1. A process for the preparation of a phytase-containing granulate having an activity of from 6,000 to 10,000 FTU/g suitable for use in an animal feed comprising:

- a) making a mixture of a phytase and a solid carrier comprising at least 30% (w/w) of starch and water,
- b) mechanically processing the above mixture to obtain enzyme-containing granules with a water content of 30 % to 40 % and
- c) drying the granules."

V. With their replies both opponents (in the following respondent 01 and respondent 02) disputed the arguments submitted by the appellant and requested that the appeal be dismissed. They also requested that the case not be remitted to the opposition division for further prosecution. Respondent 01 filed the following document:

E8: WO 95/28850 A1.

VI. In a communication issued prior to oral proceedings the board indicated the points to be discussed during the oral proceedings.

The board *inter alia* indicated that it would have to be decided whether the feature "having an activity of from 6,000 to 10,000 FTU/g" added to claim 1 from the description fulfilled the requirements of Article 84 EPC. In a first step it would have to be clarified whether the phytase activity could be clearly and reliably determined. As set out in the patent the phytase activity was determined according to the procedure "ISL-method 61696" obtainable on request from Gist-brocades. As regards the appellant's arguments relied upon in the decision under appeal, namely that (a) the method for determining the enzyme activity could still be obtained from DSM, the successor to Gist-brocades, and (b) there was no significant difference in the activity values determined by different methods, the board pointed out that these arguments were mere assertions which lacked any substantiation.

If this objection could be overcome, it would have to be further clarified whether the conclusion of the

opposition division was correct that the feature objected to defined the invention as a result to be achieved in an unallowable manner.

VII. On 19 May 2014 the appellant filed a reply to the board's communication, including experimental results concerning the measurement of the phytase activity, and the following documents:

D9: A. J. Engelen *et al.*, Journal of AOAC International 77(3), 1994, pages 760-764;

D10: A. J. Engelen *et al.*, Journal of AOAC International 84(3), 2001, pages 629-633;

D11: International Standard ISO/30024, First edition 15.07.2009; and

D12: WO 98/55599 A2.

VIII. On 26 May 2014 respondent 02 filed a further submission requesting that documents D9-D12 not be admitted into the proceedings and that the appellant pay its costs for preparing and attending the oral proceedings.

IX. On 24 June 2014 oral proceedings were held before the board. In addition to its written requests respondent 02 also requested that the experimental tests provided in the appellant's letter of 19 May 2014 not be admitted into the proceedings. Respondent 01 also requested apportionment of costs.

X. The arguments of the appellant, insofar as they are relevant for the present decision, may be summarised as follows:

- Documents D9 to D11 had been filed in reaction to the communication of the board in order to support the argument that the method for determining the phytase activity mentioned on paragraph [0061] of the patent specification could be obtained from the company DSM, the successor to Gist-brocades. D9 had been published in 1993 before the filing of the patent and described the method used in the patent. Document D10 had been filed to show that the company DSM had the same address as Gist-brocades, the company indicated in the patent as able to supply the method for determining the phytase activity. D11 was the actual standard for the measurement of enzyme activity. The experimental evidence filed on 19 May 2014 showed that both the method of the patent and the standard norm yielded the same results. D12 had been filed in relation to inventive step.

- Even if D9 to D11 were not admitted into the proceedings, the subject-matter of claim 1 was still clear because the activity of phytase was measured under conditions already standardised at the filing date of the patent.

- No costs should be awarded to the opponents. The appellant had requested that the compliance of its requests with the requirements of Article 84 EPC be acknowledged, and that the case be remitted to the opposition division for further examination. Under these circumstances a detailed argumentation on inventive step was not necessary. In any case, it was evident from the written proceedings that the appellant intended to base its arguments concerning inventive step on the activity of the phytase-containing granulate.

XI. The arguments of the respondents may be summarised as follows:

- Documents D9 to D11 were clearly late-filed without justification and were not relevant. There was no correlation between these documents and the method described in the patent specification. Moreover, the tests filed by the appellant with letter dated 19 May 2014 should also not be admitted into the proceedings because they had not been carried out according to the method described in the patent.
- The skilled person was not able to find out what the unit FTU meant and how it could be determined. The only guidance in the patent was the reference to "ISL-method 61696" obtainable from Gist-brocades. However, the company Gist-brocades no longer existed and the appellant had not been able to provide a copy of the test.
- The appellant should pay their costs for preparing and attending the oral proceedings before the board. In at least two ways, the appellant had failed to comply with the invitation in the board's communication: it had not filed its arguments on inventive step without delay, and those arguments were inconclusive. In the view of respondent 02, the conduct of the appellant constituted an abuse of the proceedings aiming to keep its patent alive for as long as possible with minimum effort.

XII. The appellant requested that the decision under appeal be set aside, that the compliance of auxiliary

requests 1 and 3, as filed during the opposition proceedings with letter dated 20 February 2012, with the requirements of Article 84 EPC be acknowledged by the board and that the case be remitted to the opposition division for consideration of the novelty and inventive step of the subject-matter concerned.

XIII. Both respondents requested that the appeal be dismissed. They further requested that the case not be remitted to the opposition division, and apportionment of their costs for preparing and attending the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

AUXILIARY REQUESTS 1 AND 3

The respondents raised objections against amended claim 1 under Articles 123(2) and 84 EPC. At the oral proceedings the board came to the conclusion that the subject-matter of amended claim 1 does not extend beyond the content of the application as filed, and therefore complies with Article 123(2) EPC. There is, however, no need for the board to give detailed reasons on this point since, as set out below, amended claim 1 is not allowable due to lack of clarity.

2. *Amendments (Clarity)*

2.1 Claim 1 is identical in both requests. It is based on claim 1 of the granted patent wherein the process has been limited to the preparation of a phytase-containing granulate (based on granted claim 2) "having an

activity of from 6,000 to 10,000 FTU/g". The latter amendment is based on paragraph [0042] of the patent specification (cf. page 14, lines 12 to 14 of the application as filed).

2.2 The appellant made these amendments during the opposition proceedings. The activity of the phytase-containing granulate is now the key feature of the claimed process which aims to distinguish it from the prior art cited by the respondents. Its role in defining the matter for which protection is sought is therefore crucial. As this feature has been taken from the description, it needs to be investigated whether it fulfils the requirements of clarity.

2.3 According to EPO practice, when a product is characterised by a parameter the requirement of clarity is fulfilled if the parameter can be clearly and reliably determined. The question to be answered therefore is whether or not the skilled person is taught by the specification of the patent, or would already know because it was a standard test, how to determine the phytase activity of the granulate obtained by the process of claim 1.

2.4 The patent specification states in paragraph [0061] that "Phytase activity was determined according to the procedure "ISL-method 61696" (manual vanadate assay)" and that "ISL-methods are obtainable on request from Gist-brocades, Food Specialities, Agri Ingredients Group, Wateringseweg 1, P.O. Box 1, 2600 MA, Delft, The Netherlands".

However, as pointed out in particular by respondent 01 in its letter dated 14 January 2013 and by the board in its communication, the company Gist-brocades no longer

exits and the appellant has not been able to provide a copy of ISL method 61696.

2.5 Admissibility of documents D9 to D11 and experimental tests submitted with letter dated 19 May 2014

The appellant filed D9 to D11 as a direct reaction to the communication of the board raising objections concerning whether the required phytase activity could be clearly and reliably determined.

2.5.1 Document D9 is a publication of Gist-brocades, Intracompany Service Laboratory (ISL) entitled "Simple and Rapid Determination of Phytase Activity". The method is based on the determination of inorganic orthophosphate released on hydrolysis of sodium phytate at pH 5.5 (Abstract).

There is, however, no mention at all in D9 that the phytase assay disclosed therein is the "ISL-method 61696 (manual vanadate assay)" referred to in paragraph [0061] of the patent specification. The method of D9 is marked neither as "method 61696" nor as "manual vanadate assay". There is also no further evidence (e.g. a letter from the appellant to DSM or a reply from DSM) linking D9 to the method mentioned in the patent specification. The affirmation of the appellant that D9 is the document one receives from DSM is an unsubstantiated assertion and can therefore not establish the missing link between D9 and the method referred to in the patent.

2.5.2 D10 describes the determination of phytase activity in feed by a colourimetric enzymatic method. The document was published after the filing date of the patent and was filed by the appellant only to show that the postal

address of Gist-brocades and its successor, DSM Food Specialities, was the same. D10 does not refer to the phytase activity assay referred to in the patent.

2.5.3 Lastly, document D11 is the international standard method ISO 30024 for determination of phytase activity as published on 15 July 2009. This document was filed by the appellant, together with the results of a comparative experiment, in order to show that there was no substantial difference in the phytase activity when measured by the method of D9 and by the now established standard D11. As apparent from page 1 under the heading "1 Scope" the method of D11 "is suitable and validated exclusively for the determination of phytase activity and exclusively in complete feeds". As pointed out by the respondents, the process of claim 1 is not directed to a complete feed. So the relevance with regard to the method mentioned in the patent is questionable in any case. Given that it has also not been established that the disclosure of D9 represents "ISL-method 61696" used in the patent, a comparison between the values obtained according to D9 and D11 is meaningless.

2.5.4 In summary, documents D9 to D11 (and the experimental tests related to D9 and D11) cannot prove that ISL-method 61696 for determining phytase activity was available to the public at the filing date of the patent. They cannot establish that the phytase activity can be clearly and reliably determined according to the information in the patent.

Therefore the board exercised its discretion under Article 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA) not to admit documents D9 to D11 (and the experimental results related to D9 and D11) into the proceedings.

2.6 In view of the absence of any evidence to the contrary, the board concludes that the patent specification does not contain instructions enabling the skilled person to measure the phytase activity so as to obtain reproducible results in a reliable manner.

It goes without saying that no other conclusion would have been reached if documents D9 to D11 (and the experimental results related to D9 and D11) had been admitted. As explained above, these documents simply cannot establish that ISL-method 61696 disclosed in the patent is the method described in D9.

2.7 It remains to be decided whether the determination of phytase activity was part of the skilled person's common general knowledge, as maintained by the appellant during the oral proceedings. The appellant argued by referring to E8 that the incubation conditions were standard at the filing date of the patent and that the measurement methods used by the different companies would indeed give the same results in order to allow a comparison of the results. This affirmation was, however, contested by both respondents.

There is no evidence on file that, at the filing date of the patent, there was a standard test procedure for the determination of phytase activity.

On the contrary, the documents on file specify in each case which test is used for the measurement. In document E8, on which the appellant mainly relied, the incubation conditions of the enzyme and the method used to measure the released inorganic phosphate are specified and reference is made to the detailed

analytical method used (cf. E8, page 12 under "Phytase activity"). Whether or not the method used in the patent gives the same results cannot be established.

2.8 In summary, the skilled person reading claim 1 would not know how to measure the phytase activity, either from the patent itself or from his common general knowledge. Since the phytase activity range represents an essential feature of the claimed invention, the fact that it cannot be determined in a reliable and reproducible manner results in a lack of clarity of the claimed subject-matter.

2.9 For these reasons, claim 1 of auxiliary request 1 and auxiliary request 3 (for which the same reasoning applies *mutatis mutandis*) does not meet the requirements of Article 84 EPC.

3. Costs

3.1 According to Article 16(1) RPBA the board may, subject to Article 104(1) EPC, order a party to pay some or all of another party's costs, where a party has e.g. incurred costs due to amendment of a party's case pursuant to Article 13 RPBA (Article 16(1)(a) RPBA), extension of a time limit (Article 16(1)(b) RPBA) acts or omissions prejudicing the timely and efficient conduct of oral proceedings (Article 16(1)(c) RPBA), failure to comply with a direction of the board (Article 16(1)(d) RPBA) or an abuse of procedure (Article 16(1)(e) RPBA). Only costs necessarily and reasonably incurred may be ordered to be paid (Article 16(2) RPBA). Moreover, the apportionment of costs must be equitable (Article 104(1) EPC).

- 3.2 The respondents requested apportionment of costs in their favour mainly on the grounds that the appellant did not comply with the board's directions in good time and in substance and because in their view the appellant was abusing the proceedings by not presenting substantive arguments on inventive step.
- 3.3 Concerning the first issue, the board indicated in its communication of 5 March 2014 that it would take a final decision on remittal during the oral proceedings, and that the parties should be prepared to discuss all other pending issues at the oral proceedings. The board also requested the appellant to provide its arguments without delay. The board set a deadline for making written submissions at one month before the oral proceedings. No separate time limit was set for the arguments of the appellant concerning inventive step.
- 3.3.1 The appellant filed its arguments within the time limit set. The respondents argued that the appellant should have filed its arguments earlier. The board cannot identify any evident disadvantage for the respondents which resulted from the filing of the appellant's arguments one month before the oral proceedings.
- 3.3.2 Concerning the allegation that the arguments of the appellant were entirely inconclusive and that the appellant was merely trying to keep its patent alive for as long as possible, the board notes that any party to the proceedings is free to file the arguments it finds appropriate to defend its case. Moreover, the request that a case be remitted to the opposition division for further prosecution cannot be considered as an abuse of procedure. The assertion that the appellant seemed to be trying to keep this patent alive for as long as possible with minimum effort rather than

defending it on the merits is mere speculation. It is not up to the board to speculate.

- 3.4 Unless there are reasons of equity for deciding otherwise, each party to the proceedings must bear its own costs. Accordingly, the requests for apportionment of costs are refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The requests for apportionment of costs are refused.

The Registrar:

The Chairman:



M. Cañueto Carbajo

W. Sieber

Decision electronically authenticated