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**Datasheet for the decision
of 14 February 2017**

Case Number: T 1589/12 - 3.3.04

Application Number: 04778282.6

Publication Number: 1651260

IPC: A61K39/02, C12N1/20

Language of the proceedings: EN

Title of invention:

Lawsonia intracellularis of European origin and vaccines,
diagnostic agents and methods of use thereof

Patent Proprietor:

Boehringer Ingelheim Vetmedica, Inc.

Opponents:

Intervet International B.V.
Pfizer, Inc. (opposition withdrawn)

Headword:

Lawsonia intracellularis/BOEHRINGER INGELHEIM VETMEDICA

Relevant legal provisions:

RPBA Art. 12(4), 13(1)

Keyword:

Main request - requirements of the EPC met (yes)

Decisions cited:

G 0009/91, G 0010/91, T 0188/05, T 0724/08

Catchword:



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Case Number: T 1589/12 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 14 February 2017

Appellant: Intervet International B.V.
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Representative: Intervet International B.V.
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Respondent: Boehringer Ingelheim Vetmedica, Inc.
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Representative: Vossius & Partner
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted on 14 May 2012
rejecting the opposition filed against European
patent No. 1651260 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairwoman G. Alt
Members: R. Morawetz
 P. de Heij

Summary of Facts and Submissions

I. The appeal of opponent 1 (hereinafter "appellant") lies against the decision of the opposition division rejecting the opposition filed against European patent No. 1651260, entitled "*Lawsonia intracellularis* of European origin and vaccines, diagnostic agents and methods of use thereof."

Claim 1 as granted reads:

"1. An avirulent *Lawsonia intracellularis* isolate, wherein said avirulent isolate is *Lawsonia intracellularis* deposit isolate ATCC No. PTA-4926 or any avirulent *Lawsonia intracellularis* isolate of European origin, characterized in that said avirulent *Lawsonia intracellularis* does not cause fecal shedding at day 14 post vaccination."

II. The following documents are referred to in this decision:

D1 EP 0 843 818 B1

D4 WO 96/39629

D5 Knittel J. *et al.*, Proceedings of the 16th International Pig Veterinary Society Congress, Melbourne, Australia (2000), page 24

D6 McOrist S. *et al.*, Infection and Immunity (1993), Vol. 61, No. 10, pages 4286-4292

III. The patent was opposed by opponent 1 under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step

(Article 56 EPC) and by opponent 2 under Article 100(a) EPC on the ground of lack of inventive step (Article 56 EPC) and under Articles 100(b) and (c) EPC.

- IV. During the opposition proceedings opponent 1 based its novelty objection against the subject-matter of claim 1 as granted on the disclosure of document D1. Opponent 2 did not raise any novelty objection but argued that the subject-matter of claim 1 as granted lacked inventive step in view of documents D4 or D5 as closest prior art and with reference to document D6.
- V. With letter dated 5 July 2010 opponent 2 withdrew its opposition and thereby ceased to be a party to the proceedings.
- VI. In the communication accompanying the summons to oral proceedings the opposition division indicated that it considered the subject-matter of claim 1 as granted to be novel over the disclosure of document D1 (see points 2.1. to 2.5). In its decision the opposition division then confirmed that the subject-matter of the claims as granted was indeed novel over document D1 (see points 10.1 to 10.6) and also fulfilled the requirements of Article 56 EPC.
- VII. In its statement of grounds of appeal and in a later submission the appellant raised two different novelty objections based on document D6 against the subject-matter of claim 1 as granted.
- VIII. With its reply to the statement of grounds of appeal dated 6 February 2013 the proprietor (hereinafter "respondent") submitted auxiliary requests I to X.

- IX. The board summoned the parties to oral proceedings and issued a communication pursuant to Article 15(1) RPBA. In it the board indicated *inter alia* that it was inclined to hold inadmissible the two novelty objections against the subject-matter of claim 1 which were based on the disclosure of document D6. It further indicated why it considered that neither objection had any merit.
- X. In reply to the summons the respondent filed a corrected version of auxiliary request VII (replacing previous auxiliary request VII) and a new auxiliary request XI.
- XI. Oral proceedings before the board took place on 14 February 2017. In the course of the oral proceedings the respondent made its auxiliary request VIII its new main (and sole) request. The appellant had no objections to that request and withdrew all its objections raised in writing.

Claim 1 of the new main request reads:

"1. A live vaccine for the immunization of an animal, comprising a pharmaceutically effective amount of an avirulent live *Lawsonia intracellularis* isolate and a pharmaceutically acceptable carrier, wherein said avirulent live isolate is *Lawsonia intracellularis* deposit isolate ATCC No. PTA-4926 or any avirulent live *Lawsonia intracellularis* isolate of European origin, characterized in that said avirulent live *Lawsonia intracellularis* does not cause fecal shedding at day 14 post vaccination."

XII. The arguments of the appellant relevant for the present decision may be summarised as follows:

Admission of the novelty objections based on document D6 into the appeal proceedings

As the opposition division had not accepted its arguments based on document D1, the appellant had looked for further documents to argue that the claimed subject-matter lacked novelty. An opponent could not be required to submit all its arguments during the opposition proceedings.

The objections based on document D6 should be admitted because they were relevant.

XIII. The arguments of the respondent relevant for the present decision may be summarised as follows:

Admission of the novelty objections based on document D6 into the appeal proceedings

The novelty objections based on document D6 should not be admitted into the appeal proceedings under Article 12(4) RPBA. Document D6 had been on file from the beginning of the opposition proceedings, but nevertheless had not been relied on to argue lack of novelty before the opposition division, which had therefore not dealt with this objection in its decision.

Nor had document D6 been relied on as closest prior art during the opposition proceedings.

The opposition division had indicated in its summons to oral proceedings that it did not consider the

disclosure in document D1 to be novelty-destroying. Then would have been the time to react; now it was too late.

- XIV. The appellant requested that the novelty objections based on document D6 be admitted into the appeal proceedings.

The respondent requested that the patent be maintained on the basis of the set of claims of the main request filed as auxiliary request VIII with letter dated 6 February 2013.

Reasons for the Decision

Admission of the novelty objections based on document D6 into the appeal proceedings

1. During the appeal proceedings the appellant raised two novelty objections based on the disclosure of document D6 against the subject-matter of claim 1 as granted. The first objection was raised in the statement of grounds of appeal while the second was raised in response to the respondent's reply (see section VII). Neither objection had been raised during the opposition proceedings. The respondent objected to the admission of these objections into the appeal proceedings.
2. It is established case law of the Boards of Appeal that the "*purpose of the appeal procedure inter partes is mainly to give the losing party a possibility to challenge the decision of the Opposition Division on its merits*" (see decision G 9/91 and opinion G 10/91 of the Enlarged Board of Appeal, OJ EPO 1993, 408 and 420, reasons, point 18). As a consequence, the factual and legal scope of appeal proceedings is thus largely

determined by that of the opposition proceedings preceding them.

3. Article 12(4) RPBA provides that the board has discretion to hold inadmissible facts, evidence or requests which could have been presented in the first instance proceedings. In exercising its discretion the board can make admitting a citation into the appeal proceedings dependent on whether it is *prima facie* relevant (see for example decision T 724/08).
4. Under Article 13(1) RPBA any amendment to a party's case after it has filed its statement of grounds of appeal or reply may be admitted and considered at the board's discretion. It is established case law that how this discretion is exercised depends on the facts of each case, but that one factor may be the relevance of the new material and whether it could have been produced before (see for example decision T 188/05).
5. In the present case, the subject-matter of claim 1 objected to by the appellant is the same as that considered in the decision under appeal, *i.e.* that of claim 1 as granted. Document D6 had been filed with opponent 2's notice of opposition, and had been relied upon by opponent 2 in the context of lack of inventive step, albeit not as closest prior art. Document D6 was thus part of the opposition proceedings. The appellant was also aware from the opposition division's communication accompanying the summons to oral proceedings, and thus well before the decision under appeal was issued, that its novelty objection based on the disclosure of document D1 was likely to fail.
6. In the board's judgement, the appellant could thus have filed during the opposition proceedings its novelty

objections based on the disclosure of document D6 against the subject-matter of claim 1 as granted.

7. Moreover, in the board's view, the disclosure of document D6 does not appear to anticipate the subject-matter of claim 1 as granted (see section IX) and the submissions based on this document are thus also not *prima facie* relevant.
8. Hence the board decided, in the exercise of its discretion in accordance with Articles 12(4) and 13(1) RPBA, to hold inadmissible and not to admit, respectively, the novelty objections based on the disclosure of document D6.

Main (sole) request

9. The appellant had no objections to that request and the board is satisfied that the requirements of the EPC are met.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order to maintain the patent on the basis of the set of claims of the main request filed as auxiliary request VIII with the letter dated 6 February 2013, and a description to be adapted thereto.

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated