**Internal distribution code:**

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

# Datasheet for the decision of 4 February 2016

**Case Number:** T 1738/12 - 3.3.01

**Application Number:** 03732685.7

**Publication Number:** 1515969

**IPC:** C07D471/10, A01N43/90, C07D491/10, C07D211/76, C07D211/70

**Language of the proceedings:** EN

**Title of invention:**
SPIROINDOLINEPIPERIDINE DERIVATIVES

**Patent Proprietors:**
Syngenta Limited
Syngenta Participations AG

**Opponent:**
Intervet International BV
(opposition withdrawn)

**Headword:**
Spiroindolinepiperidines/SYNGENTA

**Relevant legal provisions:**
EPC R. 103(1)(a), 116
EPC Art. 113(1), 111(1), 56, 114(2)
RPBA Art. 11

**Keyword:**
Substantial procedural violation (yes): prima facie relevant evidence not admitted, triggered by summons
Reimbursement of the appeal fee (yes)
Remittal (no)
Main request, allowable

Europäisches Patentamt
European Patent Office
Office européen des brevets

**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 1738/12 - 3.3.01**

# D E C I S I O N
# of Technical Board of Appeal 3.3.01
# of 4 February 2016

| | |
|---|---|
| **Appellants:** (joint patent proprietors) | Syngenta Limited<br>European Regional Centre<br>Priestley Road<br>Surrey Research Park<br>Guildford<br>Surrey GU2 7YH (GB) |
| | Syngenta Participations AG<br>Schwarzwaldallee 215<br>4058 Basel (CH) |
| **Representative:** | Syngenta International AG<br>WRO-1008-Z1-26<br>Schwarzwaldallee 215<br>4058 Basel (CH) |
| **Decision under appeal:** | **Decision of the Opposition Division of the European Patent Office posted on 13 July 2012 revoking European patent No. 1515969 pursuant to Article 101(3)(b) EPC.** |

**Composition of the Board:**

| | |
|---|---|
| **Chairman** | A. Lindner |
| **Members:** | L. Seymour |
| | M. Blasi |

## Summary of Facts and Submissions

I. The joint appellants (joint patentees) lodged an appeal against the decision of the opposition division revoking European patent No. 1 515 969.

II. The following documents, cited during the opposition/ appeal proceedings, are referred to below:

(1) WO 95/01358

(3) US-A-4 307 235

(7) Declaration of Dr. A. Heckeroth dated 25 May 2011

(7') Experimental report filed with letter dated 12 January 2012

(12) WO 98/25605

(16) List of active compound filed with letter dated 17 May 2012

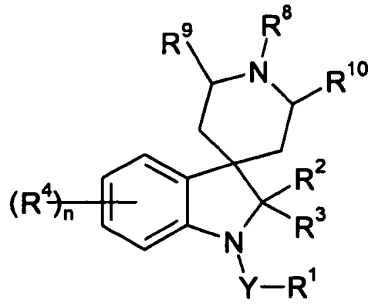
(17) Experimental report filed with letter dated 8 June 2012

(18) Experimental report filed with letter dated 18 June 2012

(19) Experimental report filed with the statement of grounds of appeal dated 12 November 2012

III. Auxiliary request 2 filed during oral proceedings before the opposition division reads as follows:

"1. A method of combating and controlling insects, acarines, nematodes or molluscs which comprises applying to a pest, to a locus of a pest, or to a plant susceptible to attack by a pest an insecticidally, acaricidally, nematicidally or molluscicidally effective amount of a compound of formula 1K:



1K

wherein Y is a single bond, C=O or $SO_2$;
R1 is $C_{1-8}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ cyanoalkyl, $C_{3-7}$ cycloalkyl($C_{1-6}$)alkyl, $C_{3-6}$ alkenyloxy-($C_{1-6}$)alkyl, $C_{3-6}$ alkynyloxy($C_{1-6}$)alkyl, $C_{1-6}$ carboxyalkyl, $C_{1-6}$ alkylcarbonyl($C_{1-6}$)alkyl, $C_{2-6}$ alkenyl-carbonyl($C_{1-6}$)alkyl, $C_{2-6}$ alkynylcarbonyl($C_{1-6}$)alkyl, $C_{1-6}$ alkoxycarbonyl($C_{1-6}$)alkyl, $C_{3-6}$ alkenyloxycarbonyl($C_{1-6}$)-alkyl, $C_{3-6}$ alkynyloxycarbonyl($C_{1-6}$)alkyl, $C_{1-6}$ alkylthio($C_{1-6}$)-alkyl, $C_{1-6}$ alkylsulfinyl($C_{1-6}$)alkyl, $C_{1-6}$ alkylsulfonyl($C_{1-6}$)alkyl, aminocarbonyl($C_{1-6}$)alkyl, $C_{1-6}$ alkylaminocarbonyl($C_{1-6}$)alkyl, di($C_{1-6}$)alkylamino-carbonyl($C_{1-6}$)alkyl, phenyl($C_{1-4}$)alkyl (wherein the phenyl group is optionally substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), heteroaryl($C_{1-4}$)alkyl (wherein the heteroaryl group may be substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), heterocyclyl($C_{1-4}$)alkyl (wherein the heterocyclyl group may be substituted by halogen, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$

haloalkoxy), phenyl (optionally substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), heteroaryl (optionally substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), $C_{1-6}$ alkoxy, $C_{1-6}$ haloalkoxy, $C_{2-6}$ alkenyl, $C_{2-6}$ haloalkenyl, $C_{2-6}$ cyanoalkenyl, $C_{2-6}$ alkynyl, $C_{3-7}$ cycloalkyl, formyl, heterocyclyl (optionally substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy) or $C_{1-6}$ alkylthio;

$R_2$ and $R_3$ are independently hydrogen or $C_{1-4}$ alkyl;

each $R_4$ is independently halogen, cyano, $C_{1-10}$ alkyl optionally substituted by $C_{1-6}$ alkoxy, halogen, phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy), $C_{2-6}$ alkenyl optionally substituted by $C_{1-6}$ alkoxy, halogen, phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy) or $C_{2-6}$ alkynyl optionally substituted by $C_{1-6}$ alkoxy, halogen, phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy);

n is 0, 1, 2, 3 or 4;

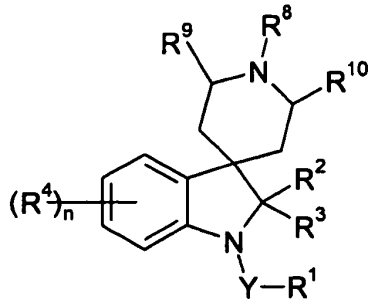
$R_8$ is $C_{1-10}$ alkyl optionally substituted by $C_{1-6}$ alkoxy, halogen or phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy), $C_{2-6}$ alkenyl optionally substituted by $C_{1-6}$ alkoxy, halogen or phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy) or $C_{2-6}$ alkynyl optionally substituted by $C_{1-6}$ alkoxy, halogen or phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy);

$R_9$ and $R_{10}$ are both hydrogen; and salts or N-oxides thereof

provided that $R_8$ is not methyl and $YR_1$ is not $SO_2CH_3$, methyl, ethyl, phenyl or fluoro substituted phenyl

provided the method is not for the treatment of the human or animal body by therapy.

2. A compound of formula



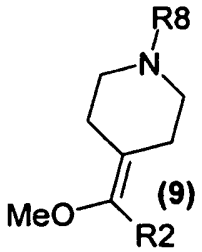
wherein Y is C=O;

$R_1$ is $C_{1-8}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ cyanoalkyl, $C_{3-7}$ cycloalkyl($C_{1-6}$)alkyl, $C_{3-6}$ alkenyloxy-($C_{1-6}$)alkyl, $C_{3-6}$ alkynyloxy($C_{1-6}$)alkyl, $C_{1-6}$ carboxyalkyl, $C_{1-6}$ alkylcarbonyl($C_{1-6}$)alkyl, $C_{2-6}$ alkenyl-carbonyl($C_{1-6}$)alkyl, $C_{2-6}$ alkynylcarbonyl($C_{1-6}$)alkyl, $C_{1-6}$ alkoxycarbonyl($C_{1-6}$)alkyl, $C_{3-6}$ alkenyloxycarbonyl($C_{1-6}$)-alkyl, $C_{3-6}$ alkynyloxycarbonyl($C_{1-6}$)alkyl, $C_{1-6}$ alkylthio($C_{1-6}$)-alkyl, $C_{1-6}$ alkylsulfinyl($C_{1-6}$)alkyl, $C_{1-6}$ alkylsulfonyl($C_{1-6}$)alkyl, aminocarbonyl($C_{1-6}$)alkyl, $C_{1-6}$ alkylaminocarbonyl($C_{1-6}$)alkyl, di($C_{1-6}$)alkylamino-carbonyl($C_{1-6}$)alkyl, heteroaryl($C_{1-4}$)alkyl (wherein the heteroaryl group may be substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), heterocyclyl($C_{1-4}$)alkyl (wherein the heterocyclyl group may be substituted by halogen, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), heteroaryl (optionally substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), $C_{1-6}$ alkoxy, $C_{1-6}$ haloalkoxy, $C_{2-6}$ alkenyl, $C_{2-6}$ haloalkenyl, $C_{2-6}$ cyanoalkenyl, $C_{2-6}$ alkynyl, $C_{3-7}$ cycloalkyl, formyl, heterocyclyl (optionally substituted by halogen, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy) or $C_{1-6}$ alkylthio;

$R_2$ and $R_3$ are independently hydrogen or $C_{1-4}$ alkyl;

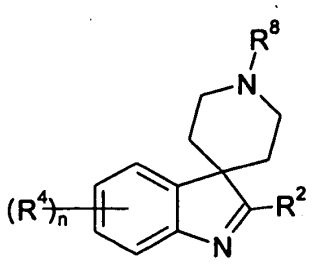
each $R_4$ is independently halogen, cyano, $C_{1-10}$ alkyl optionally substituted by $C_{1-6}$ alkoxy, halogen, phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy), $C_{2-6}$ alkenyl optionally substituted by $C_{1-6}$ alkoxy, halogen, phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy) or $C_{2-6}$ alkynyl optionally substituted by $C_{1-6}$ alkoxy, halogen, phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy);
n is 0, 1, 2, 3 or 4;
$R_8$ is $C_{1-10}$ alkyl optionally substituted by $C_{1-6}$ alkoxy, halogen or phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy), $C_{2-6}$ alkenyl optionally substituted by $C_{1-6}$ alkoxy, halogen or phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy) or $C_{2-6}$ alkynyl optionally substituted by $C_{1-6}$ alkoxy, halogen or phenyl (itself optionally substituted by halogen, $C_{1-4}$ alkyl or $C_{1-4}$ alkoxy);
provided that $R_8$ is not methyl;
$R_9$ and $R_{10}$ are both hydrogen; and salts or N-oxides thereof.

3. A compound of formula




(9)

where $R_2$ is hydrogen or $C_{1-4}$ alkyl and $R_8$ is phenyl($C_{2-4}$)alkenyl (wherein the phenyl group is optionally substituted by halogen, $C_{1-4}$ alkyl, $C_{1-4}$ alkoxy, $C_{1-4}$ haloalkyl, $C_{1-4}$ haloalkoxy, CN, $NO_2$, phenyl, heteroaryl, amino or dialkylamino); or a compound of formula (9A)



(9A)

where R2 is hydrogen or $C_{1-4}$ alkyl and R4 halogen, cyano, $C_{1-8}$ alkyl, $C_{1-8}$ haloalkyl, $C_{1-8}$ cyanoalkyl, $C_{1-6}$ alkoxy($C_{1-6}$)alkyl, $C_{2-6}$ alkynyl, trimethylsilyl($C_{2-6}$)-alkynyl, $C_{1-6}$ alkoxycarbonyl, $C_{3-7}$ cycloalkyl, $C_{1-3}$ alkyl($C_{3-7}$)cycloalkyl, phenyl (optionally substituted by halogen, $C_{1-4}$ alkyl, $C_{1-4}$ alkoxy, $C_{1-4}$ haloalkyl, $C_{1-4}$ haloalkoxy, CN, $NO_2$, heteroaryl, amino or dialkylamino), heterocyclyl (optionally substituted by halo, nitro, cyano, $C_{1-6}$ alkyl, $C_{1-6}$ haloalkyl, $C_{1-6}$ alkoxy or $C_{1-6}$ haloalkoxy), $C_{1-8}$ alkoxy, $C_{1-6}$ haloalkoxy, phenoxy (optionally substituted by halogen, $C_{1-4}$ alkyl, $C_{1-4}$ alkoxy, $C_{1-4}$ haloalkyl, $C_{1-4}$ haloalkoxy, CN, $NO_2$, phenyl, heteroaryl, amino or dialkylamino), heteroaryloxy (optionally substituted by halo, nitro, cyano, $C_{1-3}$ alkyl, $C_{1-3}$ haloalkyl, $C_{1-3}$ alkoxy or $C_{1-3}$ haloalkoxy), di($C_{1-8}$)alkylamino, or 2 adjacent groups R4 together with the carbon atoms to which they are attached form a 4, 5, 6, or 7 membered carbocylic or heterocyclic ring which may be optionally substituted by halogen; n is 0, 1, 2, 3 or 4; R8 is phenyl($C_{2-4}$)alkenyl (wherein the phenyl group is optionally substituted by halogen, $C_{1-4}$ alkyl, $C_{1-4}$ alkoxy, $C_{1-4}$ haloalkyl, $C_{1-4}$ haloalkoxy, CN, $NO_2$, phenyl, heteroaryl, amino or dialkylamino)."

IV. In the decision under appeal, the subject-matter of this request was found to fulfill the requirements of Articles 123, 83 and 54 EPC.

The opposition division decided not to admit test reports (17) and (18) into the proceedings. In its reasoning, the opposition division highlighted that the patentees had already filed one experimental report in reply to the summons to oral proceedings (document (16)), but that this "did not take into account the request of the Opposition Division for providing data relating to the same entities as those tested by the Opponent". Moreover, in said reply, the intention to file further tests had not clearly been stated. Finally, the subsequent very late filing of reports (17) and (18) meant that the opponent would not have enough time to analyse the results, or prepare further test reports. More time would have particularly been required to adequately reply to the results in document (18) relating to the activity of specific compounds against *Aedes aegypti*, since, under different conditions, the opponent had previously found the same compounds to be inactive against the same species (document (7)).

In its analysis of inventive step of auxiliary 2, the opposition division identified document (1) as representing the closest prior art. The problem to be solved was defined as lying in the provision of a further method for combating and controlling insects, acarines, nematodes or molluscs and corresponding compounds. Inventive step was denied, because, based on the opponent's experimental data (document (7)), said problem could not be regarded as having been solved over the whole breadth claimed.

V. With their statement of grounds of appeal, the appellants submitted, as their main request, a set of claims that was identical to auxiliary request 2 on which the decision under appeal was based (see above

point III). In addition, auxiliary requests and a further test report (19) were filed.

VI. The opponent did not file any comments in reply to the statement of grounds of appeal, and withdrew its opposition by letter of 1 July 2013, thereby ceasing to be a party to the present appeal proceedings as far as the substantive issues are concerned.

VII. In a communication sent as annex to the summons to oral proceedings, the board indicated its preliminary opinion that the patentability of the subject-matter of claims 1 and 2 of the main request could be acknowledged, but raised questions with respect to the subject-matter of claim 3.

VIII. With their response dated 4 January 2016, the appellants modified their auxiliary requests, but maintained their main request.

IX. Oral proceedings were held before the board on 4 February 2016.

X. The appellants' arguments, insofar as they are relevant to the present decision, may be summarised as follows:

The opposition division's failure to admit documents (17) and (18) into the proceedings constituted a substantial procedural violation justifying reimbursement of the appeal fee. The opposition division had exercised its discretion incorrectly, as it had failed to assess the *prima facie* relevance of the data. Moreover, the opposition division had failed to take into account that these experimental reports had been filed at the earliest possible date, in direct response to the preliminary opinion of the opposition division.

This had been issued with the summons only about three months prior to the oral proceedings, and contained a request for the provision of data relating to the same entities as those tested by the opponent. The refusal to admit documents (17) and (18) into the proceedings had been pivotal in the revocation of the patent in suit and had unduly disadvantaged the patentees by forcing them to file an appeal, which could otherwise have been avoided. These test reports were easy to comprehend, and other solutions could have been found, such as allowing the opponent and its technical expert sufficient time to study the data during the oral proceedings, or even by postponement, if required. By disregarding documents (17) and (18), the opposition division had violated the patentees' right to be heard.

Despite the substantial procedural violation, the appellants argued that the case should not be remitted for further prosecution, but rather that it should be dealt with by the board in substance, in order to avoid further unnecessary procedural delays.

The data provided by the appellants, in the patent in suit, as well as in documents (7') and (16) to (19), convincingly demonstrated that the compounds covered by claims 1 and 2 of the main request, including those tested in document (7), were indeed pesticidal and thus inventive.

With respect to the subject-matter of claim 3, the appellants defined the problem to be solved starting from document (12) as lying in the provision of further intermediates useful for making specific spiroindoline-piperidine derivatives, bearing an *N*-phenylalkenyl substituent at the piperidine moiety. The proposed solution, namely, the correspondingly substituted

piperidine intermediates (9) and (9A) were not suggested in the prior art. Document (12) itself taught the use of electron-withdrawing benzyloxycarbonyl protecting groups at the piperidine ring in analogous Fischer indole reactions (page 89, scheme 3). This was consistent with the teaching of document (3), since methyl substitution at said position gave totally unsatisfactory results (see column 3, lines 34 to 54). It could not therefore have been predicted that the phenylalkenyl-substituted compounds of formulae (9) and (9A) would be suitable intermediates for the synthesis of the target compounds in satisfactory yields, without the need for cumbersome protection and deprotection steps, as had been demonstrated in the patent in suit (see e.g. Example 4). The intermediates claimed therefore derived their inventiveness by virtue of this "process effect".

XI. The appellants requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of the main request filed with the statement of grounds of appeal dated 12 November 2012, or, alternatively, on the basis of one of auxiliary requests 1 to 3 filed with letter dated 4 January 2016, or of auxiliary request 4 filed as auxiliary request 2 with the statement of grounds of appeal dated 12 November 2012.

The appellants further requested reimbursement of the appeal fee.

XII. At the end of the oral proceedings, the decision of the board was announced.

## Reasons for the Decision

1. The appeal is admissible.

2. *Substantial procedural violation; reimbursement of the appeal fee*

2.1 Pursuant to Rule 103(1)(a) EPC, the appeal fee shall be reimbursed in full if the board deems the appeal to be allowable (cf. points 6 and 7 below), and a substantial procedural violation has occurred which renders the reimbursement equitable.

In the present case, the alleged substantial procedural violation relates to the decision of the opposition division not to admit two test reports into the proceedings, namely, documents (17) and (18), which were submitted after the final date for making written submissions in preparation for the oral proceedings pursuant to Rule 116 EPC.

2.2 The decision on the admission of these late-filed documents (17) and (18) lay within the discretion of the opposition division pursuant to Article 114(2) EPC. According to established case law, first-instance departments exercising their discretion in certain circumstances on procedural questions have some freedom, not subject to review by the boards of appeal: a board should object to the exercise of this discretion only if it concludes that the department has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (cf. "Case Law of the Boards of Appeal of the European Patent Office", 7th edition 2013, IV.C.1.3.3 and IV.E.3.6).

2.3 Hence, in order to decide whether a procedural violation has occurred, it must be assessed whether the opposition division exercised its discretion taking into account the correct principles and in a reasonable manner. The criteria to be applied by the opposition division are summarised in the Guidelines for Examination in the EPO (see version of June 2012, Part E-V.2 (applicable to the case at hand), or corresponding passage in the version of November 2015, Part E-V.2; cf. also Case Law of the Boards of Appeal, *supra*, IV.C.1.3.3):

"In deciding whether to admit facts, evidence or grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for belated submission are to be considered. If examination of late-filed grounds for opposition, late-filed facts or late-filed evidence reveals without any further investigation (i.e. ***prima facie***) that they are relevant, i.e. that the basis of the envisaged decision would be changed, then the competent department has to take such grounds, facts or evidence into consideration no matter what stage the procedure has reached and whatever the reasons for belated submission."

2.4 From the reasoning in the decision under appeal as summarised above in point IV, it is apparent that the opposition division failed to give any consideration to the essential criterion as to the *prima facie* relevance of the data presented in documents (17) and (18). The minutes of the oral proceedings before the opposition division also do not reflect that any such discussion took place. However, the documents were readily identifiable as being *prima facie* relevant, since they related to the pesticidal activity of compounds tested by the opponent in document (7).

Moreover, relevant facts relating to the reasons for belated submissions were not taken into account.

In particular, it is noted that, in the communication accompanying the summons to attend oral proceedings, the opposition division repeatedly criticised that "although the Proprietor made the effort to provide biological tests for structurally similar compounds, he didn't test the same compounds as the Opponent or at least some of them for their activity in the same or even other pest species" (see annex to the summons, pages 9 and 13). As acknowledged in the decision under appeal (cf. above point IV), this was to be understood as a request on the part of the opposition division to provide "data relating to the same entities as those tested by the Opponent". The filing of documents (17) and (18), which related to the pesticidal activity of compounds tested by the opponent in document (7), therefore must be seen as a direct and legitimate reaction on the part of the patentees, triggered by the preliminary opinion of the opposition division.

The filing of documents (17) and (18) shortly prior to oral proceedings cannot be regarded as being in any way abusive, in view of the limited time available between the notification of the summons and the final date specified for making written submissions (two months), or the date of oral proceedings (three months), during which new compounds had to be synthesised and tested in order to accede to the opposition division's request.

Finally, although it objected to the late-filing of documents (17) and (18), it is not apparent from the content of file that the opponent actually requested adjournment of oral proceedings, or an opportunity to conduct further tests. Indeed, the board sees no reason

why these should be considered necessary in order to evaluate the evidence on file: the results obtained in document (7), and documents (17) and (18), merely demonstrated that a given compound may be active in a given test system and inactive in another, and further data would not alter this fact. It is therefore not apparent why the opponent's right to be heard could not have been preserved by simply granting more time for it to familiarise itself with the documents filed by the patentees.

In summary, the board concludes that the opposition division, in exercising its discretion, did not consider the correct principles in a reasonable manner. The opposition division's failure to admit documents (17) and (18) therefore constitutes a procedural violation.

2.5 Since the core of the opposition division's reasoning with regard to inventive step was based on the question of whether pesticidal activity was plausible within the scope claimed (see, in particular, decision under appeal, point 5.5.4), the refusal to consider documents (17) and (18) of pertinence to this issue (cf. above point 2.4) violated the patentees' right to be heard, contrary to Article 113(1) EPC. Moreover, a causal link can be seen between the procedural deficiency and the final adverse decision on inventive step. The procedural defect was therefore decisive for the outcome of the case and thus substantial.

2.6 Hence, a substantial procedural violation has occurred in the present case which renders the reimbursement of the appeal fee in full equitable pursuant to Rule 103(1)(a) EPC.

3. *Admission of documents (17) and (18)*

In view of the considerations set out above in points 2.2 to 2.4, the board decided to overrule the way in which the opposition division exercised its discretion, and admit documents (17) and (18) into the proceedings.

4. *Non-remittal of the case to the opposition division*

Article 11 of the Rules of Procedure of the Boards of Appeal stipulates that a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise. In the present case, the joint appellants, who are the only remaining party to the proceedings (cf. above point VI), requested that the case should be dealt with by the board in substance (cf. above point X). In the interest of procedural efficiency, the board decided to accede to the appellants' request and make use of its power under Article 111(1) EPC to decide on the appeal itself.

5. In the decision under appeal (see points 5.1 to 5.4), the subject-matter of the present main request, which was then the second auxiliary request, was found to fulfill the requirements of Articles 123, 83 and 54 EPC. The board sees no reason to differ from the conclusions of the opposition division in this respect.

6. *Main request - Inventive step (Article 56 EPC)*

6.1 *Claims 1 and 2*

6.1.1 Claims 1 and 2 are directed to a method for combating and controlling insects, acarines, nematodes or

molluscs, and corresponding spiroindolinepiperidine compounds.

The board considers, in agreement with the appellants and the opposition division, that document (1) represents the closest state of the art. This document discloses spirocyclic pyrrolidinedione derivatives and their use as pesticides (see e.g. claims 11 to 14; see also e.g. page 25, lines 1 to 4, and page 45, lines 16 to 21).

In the light of document (1), the problem to be solved is defined as lying in the provision of further spirocyclic pesticidal compounds.

The solution proposed relates relates to the spiroindoline compounds and uses thereof as defined in claims 1 and 2.

6.1.2 As a next step, it has to be decided whether it has been rendered credible that the problem posed has been successfully solved over the whole breadth claimed. Having regard to the numerous examples for a wide diversity of compounds reported in the patent in suit, as well as in documents (7') and (16) to (19), the board is satisfied that this is indeed the case. Document (7), filed by the opponent, demonstrated that, in certain test systems, no activity was observed for a number of compounds falling within the claims. However, in documents (17) to (19), evidence was provided, in a representative manner, that a number of the compounds tested in document (7) were not intrinsically inactive, but rather that they did indeed exhibit pesticidal activity under different conditions. Under these circumstances, it is concluded that it has been credibly

demonstrated that pesticidal activity can be achieved across the whole scope claimed.

6.1.3 It remains to be decided whether the proposed solution would have been obvious to the skilled person in the light of the prior art.

The compounds disclosed in document (1) are structurally remote from those appearing in present claims 1 and 2, and none of the remaining cited prior art suggests the substitution of the pyrrolidinedione ring according to document (1) for an indoline moiety as a solution to the problem posed.

The subject-matter of claims 1 and 2 therefore involves an inventive step.

6.2 *Claim 3*

During the opposition proceedings and prior to withdrawal of the opposition, the subject-matter of present claim 3, relating to the intermediates (9) and (9A), was not challenged under Article 56 EPC (see, in particular, notice of opposition, point 6, last sentence). In view of the appellants' substantiated analysis in support of an inventive step, as set out above in point X, the board sees no reason to raise any further objections of its own motion (cf. above point VII).

6.3 The board therefore concludes that the subject-matter of the main request meets the requirements of Article 56 EPC.

7. Since the main request is considered to be allowable, the board need not decide on the lower-ranking requests.

**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 in amended form on the basis of the main request filed with the statement of grounds of appeal dated 12 November 2012, and a description to be adapted thereto.

3. The request for reimbursement of the appeal fee is allowed.

The Registrar: The Chairman:

M. Schalow A. Lindner

Decision electronically authenticated