

Internal distribution code:

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

**Datasheet for the decision
of 5 December 2018**

Case Number: T 1830/13 - 3.3.08

Application Number: 08010015.9

Publication Number: 1975231

IPC: C12N15/00, C12N5/00, C07H21/00

Language of the proceedings: EN

Title of invention:

Compositions and methods for the detection, diagnosis and therapy of hematological malignancies

Patent Proprietor:

Corixa Corporation

Opponent:

Amgen Inc.

Headword:

Methods for treating hematological malignancies/CORIXA

Relevant legal provisions:

EPC Art. 21(1), 111(1), 113, 114(2), 115
RPBA Art. 13(1), 13(3)

Keyword:

Admission of late filed document (yes)

Fresh case (yes)

Remittal to first instance (yes)

Decisions cited:

G 0009/91, G 0010/91

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1830/13 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 5 December 2018

Appellant: Amgen Inc.
(Opponent) 27-4-A, One Amgen Center Drive
Thousand Oaks CA 91320-1789 (US)

Representative: Lee, Nicholas
Kilburn & Strode LLP
Lacon London
84 Theobalds Road
London WC1X 8NL (GB)

Respondent: Corixa Corporation
(Patent Proprietor) CSC
The United States Corporation
2711 Centerville Road
Wilmington, DE 19808 (US)

Representative: Hitchcock, Lucy Rose
GlaxoSmithKline
Global Patents (CN925.1)
980 Great West Road
Brentford, Middlesex TW8 9GS (GB)

Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
26 June 2013 concerning maintenance of the
European Patent No. 1975231 in amended form.

Composition of the Board:

Chairman P. Julià
Members: M. Montrone
 D. Rogers

Summary of Facts and Submissions

- I. The opponent (hereinafter appellant) appealed against the decision of an opposition division to maintain the European patent No. 1 975 231 in amended form.
- II. The patent proprietor (hereinafter respondent) replied to the appellant's statement of grounds of appeal.
- III. Several third party observations were submitted under Article 115 EPC. The third party observations submitted under cover of a letter dated 3 November 2017, included the document WO 02/066516, published on 29 August 2002. This document is referred to in the submissions and in this decision as document D21.
- IV. No submissions were filed by the parties regarding these third party observations.
- V. The parties were summoned to oral proceedings on 5 December 2018. In its communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) dated 19 September 2018 and in preparation of these oral proceedings, the board stated *inter alia* that it intended to disregard the third party observations and not to admit them into the appeal proceedings.
- VI. On 4 December 2018, one day before the oral proceedings, the appellant submitted a request that document D21 should be admitted into the proceedings. The appellant argued that this document was highly relevant as regards the novelty of the patent in suit. The appellant pointed out that this document had been brought to the attention of the parties over a year earlier, and was hence no surprise, and further argued

that it did not raise any complex issues requiring postponement of the oral proceedings.

- VII. At the oral proceedings the respondent requested that document D21 not be admitted into the appeal proceedings. The respondent pointed out that document D21 had neither been filed in the first instance proceedings nor with the appellant's statement of grounds of appeal. The request to admit this document was very late and presented a fresh case. If this document was admitted then, in order for the respondent to have a fair chance to deal with it, the case should be remitted to the opposition division, or the oral proceedings should be adjourned.
- VIII. The appellant requested that the decision under appeal be set aside and that the patent be revoked in its entirety. It further requested that document D21 be admitted into the appeal proceedings, and the proceedings be continued without adjournment or remittal of the case to the opposition division.
- IX. The respondent requested that the appeal be dismissed. In the event that the board decided not to disregard document D21, the respondent requested that the case be remitted to the opposition division or, failing that, that the case be adjourned for the respondent to consider document D21. The respondent also submitted other auxiliary requests, which, in view of the present decision, need not be mentioned.
- X. On 6 December 2018, one day after the closure of the debate and of the oral proceedings, and after the board had announced its decision, the respondent requested that the appellant pay the costs incurred by the

respondent with respect to the oral hearing before the board.

- XI. In reply thereto, the appellant submitted that, in line with established case law of the Boards of Appeal, the respondent's request for costs was inadmissible due to it being filed after the board had announced its decision at the oral proceedings on 5 December 2018.

Reasons for the Decision

Request for costs

1. The board notes that the respondent's request for costs was received one day after the board had heard the parties final requests, closed the debate, and had announced its decision. Moreover, it differs from the respondent's final requests submitted in the oral proceedings before the board (see minutes, page 2, fourth paragraph).
2. According to the case law of the Boards of Appeal, once a decision has been taken the board is no longer empowered or competent to take any further action apart from drafting the written decision (cf. "Case Law of the Boards of Appeal of the EPO", 8th edition 2016, IV.E.6.1.2, 1165). It is established practice that all the parties' requests, including any requests as to costs, must be made before any decision is announced in oral proceedings (cf. "Case Law", *supra*, IV.C.6.3.1, 1000).
3. Therefore, the board shall disregard the respondent's request for costs.

Admission of document D21 into the appeal proceedings

4. Article 21(1) EPC provides that the function of the boards of appeal is to examine appeals rather than to conduct rehearings. The boards do, of course, possess additional powers by virtue of Article 114(1) EPC, but in using these powers they need to exercise their judicial discretion, conferred upon them by Article 114(2) EPC, and reflected in the Rules of Procedure of the Boards of Appeal (RPBA), as to whether to disregard matter, e.g. facts and evidence, submitted for the first time in the appeal proceedings. They also have the power (pursuant to Article 111(1) EPC) to remit the case to the first instance for further prosecution. In exercising their discretionary powers the boards need to take into account the public's as well as the parties' common interest that opposition proceedings should be speedily concluded, an interest that clearly encompasses appeal proceedings as well. This interest is best served if the patent proprietor is made aware as soon as possible of the full and complete case that he or she needs to meet in order to keep the contested patent in force.

5. When exercising its discretion according to Article 114(2) EPC, the board has to take into account that, according to the established jurisprudence (cf. G 9/91, OJ EPO 1993, 408; and G 10/91, OJ EPO 1993, 420), the appeal procedure is a judicial procedure and therefore, the parties' procedural rights to a fair and equal treatment must be respected. In accordance therewith, an important principle in appeal procedure is the board's duty to remain impartial. It is not to be expected that the board itself makes up a party's case in breach of this principle. Therefore, the provisions of Article 114(1) EPC are to be applied in a

restricted manner, especially when examining facts or evidence under the board's own motion (cf. "Case Law", *supra*, IV.E.3.4, 1124; see G 9/91, *supra*, point 18 of the Reasons).

6. The board notes that the appellant's request to admit document D21 was submitted very late and that it represents an entirely fresh case. Such considerations would normally result in the non-admission of a document under either Article 13(1) or 13(3) RPBA.
7. The respondent pointed out that the board has indicated in its communication that it intended to disregard the third parties' submissions under Article 115 EPC, which included *inter alia* document D21. Also for this reason the respondent argues that document D21 should not be admitted into the proceedings.
8. The board's opinion set out in the communication is clearly indicated as being provisional and non-binding. A board might well change its provisional opinion depending on the circumstances of the case and on the parties' submissions at the oral proceedings. Otherwise, the holding of oral proceedings would be without purpose.
9. In the present case, although third party observations had been filed at an earlier stage of the appeal proceedings, none of the parties reacted thereto by filing any submissions commenting on possible procedural and/or substantive issues arising from any of these third party observations. The requirements for admitting third party observations in appeal proceedings have been established by the Boards of Appeal (cf. "Case Law", *supra*, III.N.5, 777, 778, and 782). The admittance of third party observations into

the appeal proceedings thus requires examination by the board. This is necessarily a prior step before examining the facts and any evidence provided in these observations. In this case, the board indicated that it would disregard these third party observations, see point 53 of the board's communication of 19 September 2018.

10. The board notes, that the appellant requested to admit document D21 into the appeal proceedings. Therefore, the issue of the document's admission is not related to any of the third parties' submissions.
11. Although no party appears to have studied document D21 until shortly before the oral proceedings, this document is considered by the board to be of such relevance for the issue of novelty that the board should not exercise its discretion under Article 114(2) EPC to disregard it. Thus, the board decides to admit document D21 into the appeal proceedings.

Remittal (Article 111(1) EPC)

12. The essential function of an appeal in *inter partes* proceedings is to consider whether the decision which has been issued by the first instance department is correct. Hence, a case is normally remitted, if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.
13. Considering the general principles of procedural fairness and of the respondent's right to be heard (Article 113 EPC), the board is of the opinion that this case would benefit from a remittal to the opposition division. Thus, the respondent will have

sufficient time to prepare and present its case as regards document D21.

14. The board has deliberately refrained from going into the merits of the parties' arguments relating to the interpretation of document D21 in order not to pre-empt the consideration of this matter by the opposition division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. Document D21 is admitted into the proceedings.
3. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairman:



L. Malécot-Grob

P. Julià

Decision electronically authenticated