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**Datasheet for the decision
of 14 November 2019**

Case Number: T 2269/15 - 3.3.02

Application Number: 04763576.8

Publication Number: 1651034

IPC: A01N1/00

Language of the proceedings: EN

Title of invention:

ORGANIC COMPOUNDS

Patent Proprietor:

Elanco Tiergesundheit AG

Opponent:

BASF SE

Headword:

Relevant legal provisions:

EPC Art. 56, 83

EPC R. 80

RPBA Art. 12(4), 13(1), 13(3)

Keyword:

Inventive step
Late-filed request
Late-filed document
Sufficiency of disclosure

Decisions cited:

G 0003/14

Catchword:



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Case Number: T 2269/15 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 14 November 2019

Appellant: BASF SE
(Opponent) 67056 Ludwigshafen (DE)

Representative: BASF IP Association
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Respondent: Elanco Tiergesundheit AG
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Decision under appeal: **Interlocutory decision of the Opposition**
Division of the European Patent Office posted on
26 October 2015 concerning maintenance of the
European Patent No. 1651034 in amended form.

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
L. Bühler

Summary of Facts and Submissions

I. The appeal by the opponent (hereinafter "appellant") lies from the interlocutory decision of the opposition division that the European patent No. 1 651 034 in amended form according to the main request then on file met the requirements of the EPC.

II. Documents D1, D5, D6 and D10, *inter alia*, were referred to during the opposition proceedings:

D1	US 4,205,066 A
D5	US 4,855,133 A1
D6	"The Pesticide Manual", British Crop Protection Council, 12, 2000, entries 347 and 751
D10	Product Data Sheet of Agrimer AL.

III. The main request found allowable by the opposition division contains fourteen claims, with independent claim 1 reading as follows:

*"1. A granule bait for the control of house flies inside houses and animal stalls, folder stores and sanitary installations characterized in that it encompasses
an insect controlling agent being thiametoxam;
one or more lures, selected from the group consisting of muscalure, hexalure, medlure, vanillin, terpineol, farnesol, geraniol, phenylethanol and cis-9-tricosene;
one or more foods, selected from the group consisting of lactose, maltose and glucose;
and a filling material being saccharose."*

Dependent claims 2-9 define particular embodiments of the granule bait of claim 1. Claim 10 is directed to a

method of preparation of the granule bait of claim 1. Dependent claims 11 and 12 relate to particular embodiments of the method of claim 10. Claim 13 is a granule bait in the form of a product defined by its process. Claim 14 relates to the use of the granule bait of claim 1.

- IV. In its statement setting out the grounds of appeal, the appellant contested the reasoning of the opposition division and submitted that the subject-matter of claim 5 according to the main request submitted to the first instance was not sufficiently disclosed and that the subject-matter of the claims of this request did not involve an inventive step in view of D1 or D5 as the closest prior art. It submitted:

D15 Årsberetning Annual Report 2001

D16 EP 0 580 533 A2

- V. In its reply to the statement setting out the grounds of appeal the patent proprietor (hereinafter "respondent") submitted the following document:

D17 Emails between respondent and Ashland regarding availability of Agrimer AL10 LC.

The respondent filed a new main request and auxiliary requests 1 to 6. In a further letter, dated 25 August 2016, these requests were replaced with a new main request and new auxiliary requests 1 to 6.

- VI. With the letter of 14 October 2016, the appellant submitted that the amendments for correcting clarity issues in each claim request did not fulfil the requirements of Rule 80 EPC and that claim 10 of the main request and the corresponding claims of the

auxiliary requests filed with the reply to the grounds of appeal contravened Article 123(2) and (3) EPC and Rule 139 EPC. The appellant requested that the requests filed with the reply to the statement of grounds of appeal dated 22 August 2016 not be admitted into the proceedings.

VII. In its communication pursuant to Article 15(1) RPBA 2007 the board considered, *inter alia*, that claim 10 of the main request infringed Article 123(2) EPC. The board also observed that the appellant's objections under Rule 80 and Article 123(2) and (3) EPC were not relevant to the question as to whether the respondent's claim requests could be admitted.

VIII. By letter dated 5 November 2019, the respondent submitted additional claim requests: a main request, version "a" or MRa, and auxiliary requests AR1a, AR2a, AR3a and AR6a.

IX. Oral proceedings before the board were held on 14 November 2019.

X. The appellant's arguments, where relevant to the present decision, may be summarised as follows:

Admittance of the claim requests:

- Rule 80 EPC in combination with Rule 100 (1) EPC, according to which amendments may only be occasioned by a ground of opposition, may not be used to remove ambiguities in the claims. These arguments also applied to the main request, version "a" and auxiliary requests filed with the letter dated 5 November 2019.

Admittance of D15-D16:

- D15 and D16, disclosing the use of thiametoxam to control house flies (*Musca domestica*), were submitted in response to the opposition division's finding that D6 disclosed the use of thiametoxam to control only whiteflies (plant-sucking insects), not house flies.

Inventive step:

- The distinguishing features of claim 1 in view of in particular example 18 of D5 were the presence of thiametoxam instead of resmethrin and the presence of the specific mixture of saccharose with glucose, lactose or maltose. No effect was linked to the distinguishing features. The technical problem was to provide an alternative granule bait. The mixture of saccharose with glucose, lactose or maltose was obvious from D5 and thiametoxam was obvious in view of D6, which disclosed its use as an insect-controlling agent against whiteflies.
- The distinguishing feature with regard to the closest prior art document D1 was the use of thiametoxam instead of dimetilan. No particular effect was linked to this distinguishing feature and the objective technical problem was thus the provision of an alternative bait which is suitable for the control of house flies. The claimed solution was obvious for the reasons given with regard to D5.

Sufficiency of disclosure:

- The term "Agrimer" was not defined in claim 5. D10, which has no publication date, did not clarify the product used in the examples.

XI. The respondent's arguments, where relevant to the present decision, may be summarised as follows:

Admittance of the claim requests:

- The subject-matter claimed in the requests was derived from the claims in the requests already on file.

Admittance of D15-D16:

- The opposed patent had always been limited to a granule bait for the control of house flies. D6 which disclosed insecticides for crop protection against pests did not relate to house flies. Furthermore, the specific insecticide of claim 1 (thiametoxam) of the main request, version "a" was already mentioned in granted claim 5. The appellant did not submit any arguments on the amendments made in claim 1 of the main request submitted by the respondent with the reply to the notice of opposition, i.e. on the fact that the insect controlling agent was thiametoxam. In its summons to attend oral proceedings, the opposition division considered that the subject-matter of claim 1 of the main request then on file referring to thiametoxam involved an inventive step, considering document D5 as the closest prior art. In view of the opposition division's preliminary opinion, the appellant should have considered that D6 did not

provide any hint as to why the skilled person would have to change the bait composition of D5. Hence, the appellant could not have been taken by surprise by the opposition division's finding that D6 did not relate to house flies.

Inventive step:

- D5 was the closest prior art, not D1. D5 did not disclose bait formulations comprising thiametoxam. The technical problem was to provide an alternative granule bait. There was nothing in D6 to suggest that thiametoxam was suitable for use in killing flies in any context, let alone house flies, nor was there anything to suggest that it was suitable for use in a bait formulation along with an attractant and a foodstuff. D6 was concerned with the protection of plants against sap sucking insects. The requirements of bait compositions were different from those for protecting plants. The granular form referred to in D6 was not the form in which thiametoxam was administered to the plants. The skilled person would not have considered D6 when faced with the technical problem to be solved.
- The claimed subject-matter involved an inventive step.

Sufficiency of disclosure:

- The material Agrimer AL10LC was a known commercial product at the filing date of the patent. D17 showed that Agrimer AL 10 LC had been sold since 2001.

XII. The parties' final requests were the following:

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request, version "a" filed by letter dated 5 November 2019, one of auxiliary requests 1 to 6, all filed by letter dated 25 August 2016, or one of auxiliary requests 1a, 2a, 3a, or 6a, all filed by letter dated 5 November 2019.

Reasons for the Decision

Admittance

1. Admittance of the main request, version "a"

The present decision is based on the main request, version "a". This request was filed on 5 November 2019. The appellant requested that it not be admitted into the proceedings. The appellant's request was based solely on objections under Rule 80, and Article 123(2) and (3) EPC. As set out in the board's preliminary opinion in its communication pursuant to Article 15(1) RPBA 2007, these types of objections relate to the allowability of the claim requests rather than to their admittance. Furthermore, these objections under Rule 80 and Article 123(2) and (3) EPC were no longer raised against the main request, version "a". For these reasons the board decided to admit the main request, version "a" into the proceedings pursuant to Article 13(1) and (3) EPC 2007.

2. Admittance of D15 and D16
 - 2.1 The respondent requested that D15 and D16 not be admitted into the proceedings.
 - 2.2 D15 and D16 were filed by the appellant with its statement setting out the grounds of appeal to support its objection that the subject-matter of claim 1 lacked inventive step. Claim 1 refers to a granule bait for the control of house flies. The appellant argued that D15 and D16, which disclosed the use of thiametoxam to control **house flies** ("*Musca domestica*"), were submitted in response to the opposition division's finding that D6 (submitted with the notice of opposition) disclosed the use of thiametoxam only to control **whiteflies** (plant-sucking insects), not house flies. Furthermore, D16 was cited in D6.
 - 2.3 As submitted by the appellant, the finding of the opposition division with regard to document D6 (point 3.4.2 of the decision) that "*The indication that thiametoxam is used for the control of whiteflies does not mean that this neonicotinoid compound can also be applied for the control of house flies*" appears to have been discussed with regard to inventive step for the first time during oral proceedings before the opposition division. However, as argued by the respondent, the submission of D15 and D16 is not a direct reaction to the argument that whiteflies and house flies are different, in particular in respect of their feeding characteristics, since neither document establishes what the similarities between both insects would be or that thiametoxam can be used to control **both** house flies and whiteflies. In the absence of such evidence, D15 and D16 do not represent a reaction to the opposition division's finding in its decision.

Moreover, in its summons to attend oral proceedings the opposition division issued a positive opinion regarding the inventive step of the claims according to the main request submitted with the reply to the notice of opposition. The insect-controlling agent of claim 1 of this main request was already restricted to thiametoxam, and at that time the claim already referred to the control of house flies. The positive opinion on inventive step implicitly meant that D6 did not prompt the skilled person to change the bait composition of D5. Therefore, the appellant should have taken the opportunity to respond to the positive opinion and should have submitted further documents dealing with the control of house flies before the oral proceedings before the opposition division. Therefore, it could have filed D15 and D16 in the first instance.

For these reasons, the board decided not to admit D15 and D16 into the proceedings under Article 12(4) RPBA 2007.

3. Main request, version "a" - inventive step

3.1 The invention

The invention as defined in claim 1 of the main request concerns a granulate bait encompassing thiametoxam as an insect-controlling agent, one or more specific lures, one or more specific foods and a specific filling material.

The aim of the invention is to control house flies inside houses and animal stalls, fodder stores and sanitary installations (paragraph [0001] of the patent). More specifically, the claimed granule bait simultaneously attracts and kills flies so as to reduce their number.

3.2 The appellant's only objection against the main request, version "a" was that the claimed subject-matter lacked inventive step.

3.3 The closest prior art

The appellant indicated D1 or D5 as the closest prior art for the subject-matter of claim 1 of the main request. Particular reference was made to the composition of experiment A in D1 and the composition of example 18 in D5 as the compositions which come closest to the composition of claim 1 of the main request.

In the same way as the patent, D1 and D5 aim at providing an attractant-bait composition for attracting flies very effectively to completely control them (column 2, lines 2-15 in D1 ; column 1, lines 29-34 in D5). Examples of flies are "*Musca domestica*", i.e house flies (column 7, lines 14-17 in D1; column 8, lines 22-25 in D5). The board thus sees no reasons to deviate from the parties' position.

3.4 D5 as the closest prior art

3.4.1 Distinguishing features in view of the disclosure of D5

Example 18 of D5 discloses a granular bait comprising *inter alia* (5-benzyl-3-furyl)methyl d-cis/-trans chrysanthemate, cis-9-tricosene, sugar powder and pupal powder.

It was common ground between the parties that the subject-matter of claim 1 at issue differs from the composition of example 18 of D5 at least on account of the presence of thiametoxam.

3.4.2 Formulation of the technical problem in view of D5

It was further common ground between the parties that no effect was achieved by the distinguishing feature identified above.

The objective technical problem in view of D5 is thus the provision of an alternative granular bait, as formulated by the parties. This alternative granular bait is intended to both attract and kill house flies (see point 3.1 above).

3.4.3 Obviousness of the solution

In order to solve the technical problem and arrive at the subject-matter of claim 1, the skilled person would be required to incorporate thiametoxam as an insect-controlling agent into the composition of example 18 of D5.

In the passage of column 4, line 37 to column 5, line 13, D5 teaches that the desirable insecticides are pyrethroid, organic phosphorus and carbamate insecticides. In claim 6 of D5 and in the passage of column 5, lines 14-15, the preferred insecticidal compound is a pyrethroid compound. In the passage of column 6, lines 39-54, D5 defines the requirements to be met by the bait composition. Two of the requirements are that the insecticidal component should be least repellent to flies and that the bait must be taken in by the fly at a sufficient lethal dose.

Thiametoxam is an insecticide in the class of neonicotinoids. It is not an insecticide in the class of pyrethroids, organic phosphorus compounds or carbamate compounds, referred to in D5 (column 5, lines 14-15) as the desirable insecticides. For that reason,

the skilled person reading D5 would not consider thiametoxam to represent a desirable candidate.

Furthermore, the skilled person would not know whether a bait containing sufficient thiametoxam to kill house flies would still attract them. Consequently, the skilled person would not be inclined to incorporate thiametoxam as the insecticide compound in the bait composition disclosed in D5 in the hope of both attracting and killing house flies.

Consequently, the subject-matter of claim 1 is inventive over D5 taken alone.

In its inventive step objection, the appellant relied on a combination of D5 with D6.

D6 is a pesticide manual disclosing various pesticides, among which thiametoxam (section 751) is listed, and their application in crop protection. Section 751 of D6 teaches that thiametoxam is an insecticidal compound acting as an agonist of the nicotinic acetylcholine receptor and affecting the synapses in the insect central nervous system. The mode of action of the insecticide is with contact, stomach and systemic activity. The insecticide is rapidly taken up into the plant and transported acropetally in the xylem. The insects referred to are aphids, whiteflies, thrips, ricehoppers, ricebugs, mealybugs, white grubs, Colorado potato beetles, wireworms, ground beetles, leaf miners and some lepidopterous species.

D6 is in a completely different technical field from the opposed patent. More specifically, D6 refers to crop protection while the opposed patent is in the field of controlling house flies in houses and animal stalls, fodder stores and sanitary installations.

Furthermore, the type of insect is different, in particular their feeding characteristics, which was not disputed by the appellant. The feeding behaviour of whiteflies and other aphids involves sucking sap from plants and is different from the feeding behaviour of house flies (decaying matter, sugar, flower nectar, etc.). Lastly, the mechanism of action in D6 is completely different. Crop protection as referred to in D6 does not involve any bait, since the aim in that document is not to attract insects. Faced with the problem to be solved, the skilled person starting from D5 would have therefore disregarded D6.

The appellant argued that D6 represented common general knowledge disclosing broad-brand insecticides and that thiametoxam could be formulated in a water granular form, and had a melting point of 139.1°C and a water solubility of 4.1 g/l, rendering the insecticide suitable for a bait formulation. D6 comprised no hint that thiametoxam would not be suitable for a bait formulation. The patent in suit did not teach that the insecticide was essential.

The appellant's argument is unconvincing. Firstly, it is not true that D6 represents common general knowledge on broad-brand insecticides. As set out above, it may at best be accepted that D6 represents common general knowledge in the field of insecticides suitable for crop protection. As also set out above, the feeding characteristics of the pest which also involve specific control methods in this field is completely different from the one underlying the opposed patent. The fact that thiametoxam would have the required melting point and/or water solubility and could be formulated in granular form is based on an ex post facto analysis because it extends the disclosure of a granule (GR) or

water dispersible granule (WG) as a formulation of thiametoxam for foliar and soil treatments to the formulation of a granule bait ready for use in knowledge of the invention.

- 3.5 The same as set out above for D5 as the closest prior art would apply if D1 were the closest prior art. Experiment A of D1 discloses a granular bait comprising *inter alia* 1-dimethylcarbonyl-5-methyl-pyrazol-3-yl N,N-dimethylcarbamate, cis-9-tricosene, sugar powder and a hydrolysis product of vegetable proteins. In the same way as for D5, it was common ground between the parties that D1 does not disclose thiametoxam as the insect-controlling agent. Hence, the distinguishing feature is the same and the above considerations with regard to D5 apply equally when considering D1 as the closest prior art.
- 3.6 For the reasons expressed above, the subject-matter of claim 1 and, by extension, of all remaining claims of the main request, version "a", involves an inventive step.
4. Sufficiency of disclosure (Article 100(b) EPC) - main request, version "a"
- 4.1 The appellant asserted a lack of sufficiency of disclosure in relation to claim 5.
- 4.2 Claim 5 refers to a granule bait which comprises *inter alia* a tenside, with this tenside being "Agrimer". In the description of the opposed patent, in particular the table in column 6 and in paragraph [0038], reference is made to "Agrimer AL-10 LC" or "Agrimer" as a preferred tenside. During opposition proceedings, the respondent submitted D10. This document, which appears

to have no date, is a document dedicated to "AGRIMER AL".

- 4.3 The appellant argued that the term "Agrimer" was not defined in claim 5 and that D10, which has no publication date, did not clarify the product used in the examples.
- 4.4 As already set out in the board's preliminary opinion, this issue is a matter of Article 84 EPC rather than Article 83 EPC. The term "Agrimer" refers to a tenside (granted claim 7, paragraph [0038]). The fact that the tenside could not be identified by the skilled person implies that the intended limitation in claim 5 by using this specific tenside is not clear and that the subject-matter for which protection is sought is not clearly defined. This thus represents a question of clarity (Article 84 EPC) and not sufficiency of disclosure (Article 83 EPC). Since the term "Agrimer" was present in granted claim 7, this issue can not be dealt with in opposition proceedings or, therefore, in the present appeal proceedings (G 3/14, OJ EPO 2015, A102, order).
- 4.5 Therefore, the ground under Article 100(b) EPC does not prejudice the maintenance of the patent on the basis of the main request, version "a".
5. Following from the above, the board holds that the main request, version "a" is allowable.

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 with the following claims and a description to be adapted thereto: claims 1 to 10 of the main request, version "a", filed by letter dated 5 November 2019.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated