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Aktenzeichen / Case Number / N° du recours : T 381/87 - 3.3.1
Anmeldenummer / Filing No / N° de la demande : 83 900 154.2
Veröffentlichungs-Nr. / Publication No / N° de la publication : WO 83/01897
Bezeichnung der Erfindung: Leukotriene analogues
Title of invention:
Titre de l'invention :
Klassifikation / Classification / Classement : A 61 K 31/06

ENTSCHEIDUNG / DECISION
vom / of / du 10 November 1988

Anmelder / Applicant / Demandeur : Research Corporation
Patentinhaber / Proprietor of the patent /
Titulaire du brevet :
Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Publication/Research Association

EPÜ / EPC / CBE Art. 54, 111

Schlagwort / Keyword / Mot clé : "Article describing invention sent for publication to Chemical Society" - "in confidence until published" - "When made available to the public" - "evidence from Librarian" - "balance of probabilities" - "exercise of discretion to admit amended claim for consideration by first instance".
Leitsatz / Headnote / Sommaire

I. A document is not "made available to the public" merely by being addressed to a member of the public and placed in a post-box. It is only "made available to the public" by its delivery to the addressee (see Reasons 4(2)).

II. In relation to an issue of fact (here: when a document was first made available to the public), the EPO must decide what happened, having regard to the available evidence, on the balance of probabilities: i.e. it must decide what is more likely than not to have happened (see Reasons 4(4)).

.../...

III. If a document in a library "would have been available to anyone who requested to see it" on a particular day, such fact is sufficient to establish that the document was "made available to the public" on that day: it is not necessary as a matter of law (i) that any member of the public would have been aware that the document was available on that day, whether by means of an index or otherwise, or (ii) that any member of the public actually asked for the document on that day (see Reasons 4(4)(b)).

IV. Where during examination of an application it should be clear to the Applicant that the only set of claims under consideration could well be refused, any auxiliary request(s) in respect of alternative claims should be made to the Examining Division, taking into account the reason given for the likely refusal. The Examining Division should then examine and decide upon the main request and, if this is not allowed, upon any such auxiliary request (subject to the exercise of its discretion under Rule 86(3) EPC) in its decision. If such an auxiliary request is not made until a late stage of appeal proceedings (e.g. during oral proceedings), the request may be refused in the exercise of the Board's discretion, following Decision T 153/85 "Alternative claims/Amoco" (OJ EPO 1988,1 see Reasons 5).

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Boards of Appeal

Chambres de recours

Case Number : T 381/87 - 3.3.1



D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 10 November 1988

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Decision under appeal : Decision of Examining Division 001 of the European Patent Office dated 19 May 1987 refusing European patent application No. 83 900 154.2 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K. Jahn
Members : G.D. Paterson
R. Andrews

Summary of Facts and Submissions

- I. European patent application No. 83 900 154.2 was filed on 29 November 1982, and claimed priority from an application filed in the United States on 27 November 1981. During examination of the application, an article by the three named inventors of the invention which is the subject-matter of the application was cited by the Examining Division. The article was published in the Journal of the Chemical Society, "Chemical Communications", Volume 22 (1981), at pages 1195 to 1196, hereafter referred to as document (A). The Examining Division pointed out in a communication dated 10 July 1985 that a note at the end of the article indicated that it had been received by the Chemical Society on 12 August 1981, and asked for evidence to show that document (A) had not been made available to the public before 27 November 1981.

- II. In a reply dated 16 December 1985 the Appellant's representative submitted evidence in the form of a signed letter by a European patent attorney in a professional corporation in the United Kingdom, in which the following was stated:
 - A. "I have spoken by telephone with the distribution department of the Royal Society of Chemistry who are the publishers of the reference of interest. The date of despatch to subscribers was the afternoon of Wednesday 25th November, 1981 by second class mail. One would normally assume at least two days for delivery but it is possible that local subscribers could have received the journal on the 26th."

The letter went on to refer to evidence to the effect that the copyright deposit copy of document (A) was first

received by The British Library on 7 January 1982, and made available to the public at the Science Reference Library on 11 January 1982. Furthermore, the National Lending Library received a copy of document (A) on 30 November 1981.

It was also stated that "The Library copy of the Chemical Society Library was not dated."

The letter ended by stating:

B. "I believe it probable that some private subscribers to the journal might have received their copy on 26th November but this would be quite unprovable. It is highly unlikely that private subscribers would date their copy on receipt. I think you will have to accept the remote possibility that such a person might be able to oppose within the nine-month post-grant opposition period if he can prove date of receipt."

III. In a communication dated 3 April 1986, the Examining Division indicated that because document (A) had been dispatched to subscribers on 25 November 1981, it considered that such date constituted the date on which document (A) was made available to the public. On this basis it was not necessary to consider whether publication had occurred on 12 August 1981. In a reply dated 31 July 1986 the Appellant challenged the legal basis for considering that the day of dispatch of document (A) was the date on which it was made available to the public, and contended that mail does not become available to the public upon dispatch, but upon delivery.

IV. A Decision of the Examining Division was issued on 19 May 1987, in which it was held that because the publishers of document (A), the Chemical Society, lost control over the dissemination of their publication when it was dispatched

on 25 November 1981, that constituted the publication date. The Decision stated in paragraph 4:-

"There is no doubt whatsoever that members of the public had access to document (A) as early as on 25 November 1981, e.g. by purchasing a copy of said publication at the publisher's office."

It was also stated in the Decision that "the date of publication is an objective matter of fact" and that "assumptions and expectations about the normal time for delivery (of mail) are irrelevant and have no legal effects". Furthermore, on the basis of quotation B in paragraph II above, the Decision also stated in paragraph 6 that the date of delivery was prima facie 26 November 1981, and could even be 25 November 1981 for local subscribers.

The patent application was therefore refused on the ground of lack of novelty.

- V. A notice of appeal was filed on 6 July 1987, and the appeal fee duly paid. A statement of grounds of appeal was filed on 31 August 1987, in which the grounds of the Decision were contested.

By letter dated 16 March 1988, the rapporteur asked the Librarian of the Royal Society of Chemistry on what date document (A) was first placed on the shelves of the Library of the Society.

In a communication dated 17 March 1988, the Appellant was invited to file evidence showing whether the contents of document (A) had been received by The Chemical Society on 12 August 1981 in confidence.

In reply to the letter dated 16 March 1988 from the rapporteur, the Librarian of The Royal Society of Chemistry stated in a letter dated 25 March 1988 that document (A) "was placed on the shelves of the Society's Library on the 26th November 1981". This letter was communicated by the rapporteur to the Appellant on 25 April 1988, and it was stated that the letter appeared to establish that document (A) became part of the state of the art on 26 November 1981. The Appellant's observations were invited.

VI. In reply, the Appellant filed further evidence essentially as follows:

- (a) No Library other than that at the Royal Society of Chemistry had received a copy of document (A) before 30 November 1981 (according to extensive enquiries which had been made on behalf of the Appellant).
- (b) According to a publication issued by the Royal Society of Chemistry entitled "Refereeing Procedure and Policy", a paper received by the Society for assessment by a referee with a view to its publication should be treated as confidential material. The publication also states in paragraph 1.3.3 that "Information acquired by a referee from such a paper is not available for citation until the paper is published".
- (c) As to the single copy of document (A) which was destined for the Library at the Royal Society of Chemistry, this copy would have been brought by road on 26 November 1981 to the Library and would have reached there about midday. On arrival, this copy would have been date stamped with the date of receipt.

In reply to a request to amplify his letter dated 25 March 1988, the Librarian stated in a letter dated 11 July 1988 as follows:

"We attach a photocopy of the record showing that the issue of Journal of the Chemical Society Chemical Communications, Number 22 (1981) was processed into the Library on 26 November 1981.

Normally a journal would be placed on the open shelves on the same day but, of course, we cannot absolutely guarantee that this was done. However, the journal would have been available on that day to anyone who requested to see it. I hope this clarifies the situation."

VII. An oral hearing was held on 10 November 1988. In relation to the evidence set out in paragraph VI(c) above essentially the following submissions were made on behalf of the Appellant, in writing and orally:

- (a) From the letters of the Librarian, it is clear that no record is kept of the date on which document (A) was actually placed on the shelves of the Library.

The record card showing the date of processing into the Library has only a handwritten entry for document (A) of 26 November 1981, in contrast to most other issues of Chemical Communications, where a date stamp has been used. The fact that the relevant entry is in handwriting creates uncertainty. It is equally probable that document (A) was not available in the Library until 27 November 1981, and that the handwritten entry was back-dated.

- (b) Although the Librarian states that document (A) would have been available on 26 November 1981 to anyone who

requested to see it, nobody would have been aware on that day that it was available because on that day it had not been indexed.

- (c) The statements in the Librarian's letters should not be accepted by the Board as necessarily accurate, because the Librarian would tend to state what should have happened, and he would not have known what actually did happen.
- (d) In all the circumstances, the patent application should not be "sentenced to death" having regard to the available evidence.
- (e) A Decision of the German Federal Patents Court, 12. Senat, 6 December 1983, was relied on in support of the Appellant's case (reported in "Mitteilungen der deutschen Patentanwälte, 1984, 148).

As his main request, the Appellant requested the grant of a patent in the form considered by the Examining Division.

For the first time during the oral hearing the Appellant made an auxiliary request to the effect that a patent should be granted with an amended main claim excluding the specific compounds disclosed in Document (A).

At the end of the oral proceedings the decision was announced that the appeal in respect of the main request was dismissed, and that the case was remitted to the Examining Division for further prosecution in relation to the auxiliary request.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. The main question to be decided in this appeal is whether or not document (A) formed "part of the state of the art" within the meaning of Article 54(1) EPC, before 27 November 1981. "The state of the art" is defined in Article 54(2) EPC as comprising "everything made available to the public by means of a written or oral description ..., before the date of filing of the European patent application". The question is therefore, in turn, whether document (A), being a written description, was "made available to the public" before 27 November 1981.
3. In accordance with the evidence in the case, there are potentially four ways in which document (A) could be considered to have been made available to the public before 27 November 1981:-
 - (1) As a consequence of the article which is the subject-matter of document (A) having been sent to the Royal Society of Chemistry, and received there on 12 August 1981, with a view to its publication in one of the journals published by the Royal Society. This point was raised by the Examining Division in its communications dated 10 July 1985 and 3 April 1986, but not decided.
 - (2) As a consequence of document (A) having been dispatched by (second class) mail by the Royal Society to its subscribers on 25 November 1981. As stated in paragraph IV above, it was on this basis that the Examining Division held that document (A) had been published on 25 November 1981.

(3) As a consequence of one or more subscribers having received a copy of document (A) before 27 November 1981, as a result of the dispatch by second class mail on 25 November 1981. As also stated in paragraph IV above, this was a subsidiary ground for the Decision of the Examining Division.

(4) As a consequence of the single copy of document (A) having been delivered to and processed into the Library of the Royal Society of Chemistry on 26 November 1981, as discussed in paragraphs V and VI above.

4 Each of these possibilities will be discussed in turn.

4(1) Having regard to the evidence filed on behalf of the Appellant and referred to in paragraph VI(b) above, the Board has no doubt that the article was received by the Royal Society of Chemistry in confidence, and that the Royal Society was obliged to keep the contents of the article secret prior to any publication as discussed below.

4(2) In the Board's view a document is not "made available to the public" for the purpose of Article 54(2) EPC merely by being addressed to a member of the public and placed in a post-box. It is quite clear that while such a document remains in the post-box, and at all times prior to its delivery to the person to whom it is addressed, it is not "available to the public". Accordingly, in the Board's judgement, the Examining Division was wrong to hold that document (A) was made available to the public on the day when it was posted to subscribers, i.e. 25 November 1981.

4(3) In the Board's view, it is clearly possible that a copy of document (A) was delivered by mail to a subscriber on the

day after it was posted by second class mail in the United Kingdom, i.e. on 26 November 1981. However, having regard to the evidence referred to in paragraph II above, the normal time taken for delivery of second class mail within the United Kingdom is at least two days from posting, i.e. not before 27 November 1981. Accordingly, the Board is not satisfied that, on the balance of probabilities, any copy of document (A) was in fact delivered by mail to a subscriber before the priority date of 27 November 1981.

- 4(4) On this aspect of the appeal, having regard to the Appellant's submissions, the Board must first decide, having regard to the evidence, the facts that occurred on the balance of probabilities, and must then decide what are the legal consequences of such facts.

As to the facts, in the Board's view, the evidence from the Librarian of the Royal Society of Chemistry set out in paragraph V above, is really quite clear. In his letter dated 25 March 1988 he stated that document (A) "was placed on the shelves of the Society's Library on the 26th November 1981". In his subsequent letter dated 11 July 1988 he stated that document (A) was processed into the Library on 26 November 1981, and that "normally a journal would be placed on the open shelves on the same day but, of course, we cannot absolutely guarantee that this was done". Both these letters were written in the context of the letter from the rapporteur dated 16 March 1988 (the first in direct reply), in which it was stated that "This information (when document (A) was first placed on the shelves of the Library) is requested in connection with legal proceedings within the EPO ...". The Board has no reason to doubt that these letters were written by the Librarian with full regard as to the potential serious nature of their contents.

- (a) As previously mentioned, in relation to an issue of fact such as in this case when a document was first made available to the public, the EPO (in this case the Board of Appeal) must decide what happened having regard to the available evidence, on the balance of probabilities: i.e. it must decide what is "more likely than not" to have happened. This is the normal standard of proof in proceedings of this nature. On the above evidence, in the Board's view it is clearly much more likely that document (A) was placed on the open shelves of the Library on 26 November 1981, than that it was not so placed. It is to be presumed, in the absence of evidence to the contrary, that what the librarian stated would "normally" happen did in fact happen. Any uncertainty in this respect, for example because of the handwritten entry on the record card, is of a minimal nature. The Board therefore holds that document (A) was placed on the shelves of the Library on that date. It follows as a legal consequence of that fact that document (A) formed part of the state of the art for the purpose of Article 54 EPC on 26 November 1981.
- (b) Furthermore, in his letter dated 11 July 1988 the Librarian went on to state that "the journal would have been available on that day to anyone who requested to see it", and the Board further holds that on the balance of probabilities this is a true statement of fact. In the Board's judgement, such fact is also sufficient to establish that document (A) was "made available to the public" for the purpose of Article 54(2) EPC on 26 November 1981. It is not necessary as a matter of law that any members of the public would have been aware that the document was available upon request on that day, whether by means of an index in the Library or otherwise. It is

sufficient if the document was in fact available to the public on that day, whether or not any member of the public actually knew it was available, and whether or not any member of the public actually asked to see it. In the Board's view, that is the proper interpretation of Article 54(2) EPC.

As to the Decision of the Federal Patents Court, identified in paragraph VII(e) above, in the Board's view, that case should be distinguished from the present case for the following reasons:

- (i) In the first place, it appears that the Decision was made under the provisions of the German Patent Law of 1968, which differ in wording considerably from the provisions of the current German Patent Law of 1981 (which correspond exactly to the provisions of the EPC).
- (ii) Furthermore, the case should be distinguished on its facts. In that case, the document in question was a thesis, which had been placed in the archives of a library a few days before the relevant priority date. The archives of a library are, of course, a part of a library which is not open to the public. The thesis had not been indexed before the priority date, and so no member of the public could have asked for it to be produced from the archives before the priority date. In these circumstances, it was held as a finding of fact that the document had not been published before the priority date.

In contrast, in the present case, document A is an issue of the journal "Chemical Communications" which is issued regularly, and which "is intended as a forum for preliminary accounts of original and

significant work, in any area of chemistry that is likely to prove of wide general appeal or exceptional specialist interest" (from paragraph 2.0 of the paper "Refereeing Procedure and Policy" mentioned in paragraph V(a) above). This paper also states in the same paragraph that papers should only be accepted for publication in this journal if the content "is of such urgency that rapid publication will be advantageous to the progress of chemical research".

In these circumstances, it was clearly possible for an interested member of the public to ask for the latest issue of Chemical Communications, i.e. document (A), on 26 November 1981.

Furthermore, and most significantly, as stated previously, document (A) was in fact available to the public before the priority date.

For the above reasons, in the Board's judgement the appeal must fail in respect of the main request.

Auxiliary request

5. As stated in paragraph VII above, the Appellant's request that a patent should alternatively be granted on the basis of an amended main claim in which the compounds disclosed in document (A) are excluded was first made at the oral hearing before this Board. This was in spite of the fact that the Examining Division, before issuing its Decision dated 19 May 1987, had expressed its view that the claims which it was being asked to examine (albeit for reasons not upheld by the Board) could not validly form the basis for a patent (see paragraphs II and III above). Thus, at least since April 1986, the grant of a European patent on the

basis of the claims which are the subject of the main request was seriously in doubt.

In Decision T 153/85 "Alternative claims/Amoco" (OJ EPO 1988, 1), the Board stated the "normal rule" in relation to the filing of alternative claims during appeal proceedings as follows:

"If an appellant wishes that the allowability of the alternative set of claims, which differ in subject-matter from those considered at first instance, should be considered (both in relation to Article 123 EPC and otherwise) by the Board of Appeal when deciding on the appeal, such alternative sets of claims should be filed with the grounds of appeal, or as soon as possible thereafter.

When deciding on an appeal during oral proceedings, a Board may justifiably refuse to consider alternative claims which have been filed at a very late stage, for example during the oral proceedings, if such alternative claims are not clearly allowable."

The reasons for this normal rule are also set out - see paragraph 2.1.

As follows from what is stated in paragraph VII above, the Board in the exercise of its discretion under Article 111 EPC decided at the oral hearing to admit the auxiliary request into the proceedings and to remit the case to the Examining Division for further prosecution in relation to the auxiliary request. The main reason why the Board took this course was because, in the particular circumstances of this case, the subject-matter of the claims forming the basis of the auxiliary request was not clearly unallowable, and the question of inventive step of such subject-matter

had not been considered by the Examining Division in its Decision dated 19 May 1987.

However, it should be stated that the course adopted by the Board (at the request of the Appellant) is contrary to the public interest, because the result of it is that there is inevitably a further delay in the making of a final decision as to whether or not a European patent may be granted on this application. Such a further delay, while the Examining Division examines and decides upon the application in relation to inventive step, could be in the interest of an applicant (the possibility of a patent being granted being a commercially valuable asset), and contrary to the interest of other potential workers in the same field.

In the Board's view, in a case such as the present, where it should have been clear to the Appellant during the proceedings before the Examining Division that the only set of claims before it could well be refused, any auxiliary request should have been made before the Examining Division taking into account the reason for the likely refusal (here, in view of the prior publication of document (A)). Following the filing of such an auxiliary request (corresponding to the auxiliary request now before the Board), the Examining Division should examine and decide upon the main request and, if this is not allowed, upon any such auxiliary request (subject to the exercise of its discretion under Rule 86(3) EPC) in its decision.

If such an auxiliary request is not made until a late stage of appeal proceedings (e.g. during oral proceedings) the request may be refused in the exercise of the Board's discretion, in accordance with the principles set out in Decision T 153/85 identified above.

In the present case, the Board notes that in its communication dated 3 April 1986, the Examining Division expressed its view as to the lack of inventive step in Claims 4, 6, 13, 15 and 19, but that the Decision dated 19 May 1987 makes no finding in this respect, there having been no auxiliary request before it.

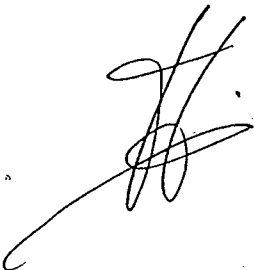
The Examining Division should now examine and decide upon the application, upon the basis of the claims which are the subject of the present auxiliary request before the Board.

Order

For the above reasons, it is decided that:

1. The decision of the Examining Division dated 19 May 1987 is set aside.
2. The appeal in respect of the main request is dismissed.
3. The case is remitted to the Examining Division in order that it should examine and decide upon the application with claims based upon the auxiliary request filed during the oral proceedings held on 10 November 1988.

The Registrar



The Chairman

