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**Datasheet for the decision
of 8 October 2009**

Case Number: T 0508/08 - 3.3.08

Application Number: 96925768.2

Publication Number: 0842273

IPC: C12N 15/12

Language of the proceedings: EN

Title of invention:
Receptor ligand VEGF-C

Patentee:
Vegenics Limited

Opponent:
Genentech, Inc.

Headword:
Admissibility/VEGENICS

Relevant legal provisions:
EPC Art. 107

Relevant legal provisions (EPC 1973):
EPC R. 76

Keyword:
"Obligation of opposition division to consider request to
correct minutes of oral proceedings"
"Admissibility of appeal (no)"

Decisions cited:
T 1198/97

Catchword:

When presented with a request for correction of the minutes, the first instance (in this case, the opposition division) should respond thereto. However, if the first instance sees fit to ignore this obligation, there is nothing the board can do in this respect. The board has no power to compel the opposition division to discharge its obligations.



Case Number: T 0508/08 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 8 October 2009

Appellant: Vegenics Limited
(Patent Proprietor) Level 1
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Toorak
Victoria 3142 (AU)

Representative: Marshall, Cameron John
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Appellant II: Genentech, Inc.
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Representative: Denison, Christopher Marcus
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
10 January 2008 concerning maintenance of
European patent No. 0842273 in amended form.

Composition of the Board:

Chairman: L. Galligani
Members: T. J. H. Mennessier
C. Rennie-Smith

Summary of Facts and Submissions

- I. Two appeals were lodged against the decision of the opposition division dated 10 January 2008, whereby European patent No. 0 842 273, which had been granted on the European application No. 96 925 768.2, published as the international application WO 97/05250, was maintained on the basis of a request filed during oral proceedings on 21 November 2007. One appeal was filed in the name of the two former patent proprietors whose assignment of the patent to the present proprietor (appellant I) was subsequently recorded (see section VIII below). The other appeal was filed by opponent 02 (appellant II). Opponent 01, which had withdrawn its opposition on 19 November 2007, is not a party to the appeal proceedings.
- II. The above-mentioned request was headed "Second amended main request - as amended during Oral Proceedings" and contained claims 1 to 30. According to the decision (see point 4 of the reasons), opponent 02 had no formal objections under Articles 123(2)(3) and 84 EPC to this request. The decision dealt only with the issue of novelty vis-à-vis documents D15 (WO 95/24473) and D20 (WO 96/39515), the objection thereto raised by opponent 02 being found unjustified.
- III. In two letters dated 28 January 2008 and 26 February 2008 and signed by both representatives who had attended the oral proceedings on its behalf, appellant I requested that the written decision of 10 January 2008 as well as paragraphs 19 and 20 of the accompanying minutes of the oral proceedings held on 21 November 2007 be corrected. It submitted that the

minutes were inaccurate by stating in paragraph 20 that, after discussion of the main request filed on 6 November 2006, "all requests on file" were withdrawn. This should have referred only to withdrawal of "all the auxiliary requests on file" since the main request filed on 6 November 2006 was not withdrawn but rather the subject of a decision rejecting it for failure to comply with Article 123(2) EPC. The errors in the decision were the omission of that rejection of the main request.

- IV. In a letter of 21 February 2008, appellant II also requested a correction of the reasons for the decision to include the reasons why the claim requests were considered to be entitled to priority. This request for correction was later withdrawn (see appellant II's letter of 27 May 2008) in view of the expiration of the deadline for filing the grounds of appeal.
- V. The opposition division has at no time reacted in any way to the appellants' requests for correction. In its statement of grounds of appeal of 20 May 2008, appellant I requested the board to defer consideration of its appeal until after the opposition division issued a decision. On 6 October 2008, appellant II wrote a letter to the opposition division requesting a decision on appellant I's request for corrections and observing that any contemporaneous evidence regarding the accuracy of the minutes which the opposition division could provide would benefit legal certainty.
- VI. Appellant I filed a notice of appeal and paid the appeal fee on 10 March 2008. Appellant II filed a notice of appeal and paid the appeal fee on 19 March

2008. Both appellants filed statements of grounds of appeal on 20 May 2008. With its statement of grounds of appeal appellant I filed a main and five auxiliary requests and a new document containing experimental data. The main request and auxiliary request 5 were said to correspond exactly to, respectively, the claims as granted and the request on the basis of which the patent had been maintained by the opposition division.

VII. In its statement of grounds of appeal, appellant II requested reimbursement of the appeal fee in accordance with Rule 103(1)(a) EPC by reason of a substantial procedural violation committed by the opposition division in its conduct at the oral proceedings on 21 November 2007. In its view, the violation originated from the accession by the opposition division to appellant I's request made at the oral proceedings that five declarations which it had filed itself on 8 November 2007 be held inadmissible when it transpired that their contents might be unfavourable to appellant I. Appellant II argued further that the request on which the patent had been maintained (i.e. the same claims as in auxiliary request 5 filed by appellant I with its statement of grounds) did not comply with the requirements of Articles 54, 56, 83, 84 and 123(2) EPC, and observed that the issue of entitlement to the first priority had not been addressed in the decision.

VIII. In a letter dated 15 July 2008, appellant I requested the recording in the Register of European Patents of a transfer of the ownership of the patent and enclosed copies of documents evidencing that transfer, namely an assignment by the previous proprietors and an

acceptance thereof by the new proprietor. The assignment of the patent in suit had been executed by the previous owners on various dates in December 2007, the last such date being 7 December 2007. The acceptance document, which was itself dated 25 March 2008, referred to 7 December 2007 as the date of the assignment. The assignment also recorded an earlier agreement between the parties of 25 April 2007 to assign the patent and other rights with an effective date of 2 April 2007 and stated that it was itself a retroactively effective document with an effective date of 2 April 2007.

IX. On 6 October 2008, appellant II filed a reply to appellant I's statement of grounds, in which it took position with respect to the main and auxiliary requests filed with appellant I's statement of grounds of appeal. It argued that appellant I's appeal was inadmissible because the opposition division's decision had been to maintain the patent in the form requested by appellant I which was not therefore adversely affected. It argued that reintroduction of the main request (said by appellant I to correspond to the claims as granted) on which, in appellant II's view, appellant I had deliberately avoided a decision, represented a clear abuse of procedure and consequently that request should be held inadmissible by the board. Appellant II contended further that auxiliary requests 1 to 4 should also not be admitted into the proceedings because they were closely based on the main request of 6 November 2006 which had been withdrawn at the oral proceedings. Moreover, in its view, all of the requests on file were objectionable under Articles 123(2), 83 (insofar as they comprised claims

reciting an ATCC accession number 97231), 54 and 56 EPC. The omission of the terms "in vitro" to qualify the method of claims 36 to 38 of the main request was also objected to (see point 12.1 of appellant II's reply of 6 October 2008 which appears to refer erroneously to claims 37 to 39 - instead of claims 36 to 38 - in this respect).

X. In a faxed letter of 1 October 2008, appellant I requested an extension of the time limit of two months from 6 October 2008 for filing its reply to appellant II's statement of grounds of appeal. The reasons given were that the new proprietor required more time to instruct the representative (who had not then changed) in view of the extreme complexity of the issues and had had to take over a large number of new matters at the same time as this appeal. The board did not allow the request because the new proprietor had been such since 7 December 2007, one month before the date of the decision under appeal, and had clearly been able to give instructions to appeal and to prepare and file the grounds of appeal and accompanying requests and additional evidence in time regardless of either any complexity or any volume of other matters. Even if this case was complex, that would not *per se* be so "exceptional" as to justify an extension of time and the volume of unrelated matters could never be so "exceptional" (see Article 12(1)(b) RPBA). Further, the request had been filed far too late for it to be dealt with before the time limit in question expired.

XI. On 22 December 2008, i.e. after the fixed time limit expired on 6 October 2008, appellant I filed a reply to the appellant II's statement of grounds. The letter,

from a newly instructed representative, was accompanied by a new auxiliary request 4, to replace the previous auxiliary request 4, and by three further auxiliary requests numbered, respectively, 6, 7 and 8.

Appellant II submitted that these late submissions of appellant I should be disregarded (see appellant II's letter of 17 November 2008 and its letter of 8 September 2009, pages 6 and 7).

- XII. On 2 April 2009, in an annex to the summons to oral proceedings, the board sent the parties a communication containing its provisional opinion on a number of issues. As regards the admissibility of appellant I's appeal, it appeared that, during the oral proceedings before the opposition division, the patent proprietors' strategy had been to file successive amended versions of the main request on file following the discussion of different issues, such that the request entitled "Second amended main request - as amended during Oral Proceedings" was the main request at the end of the debate. As this request was accepted by the opposition division, appellant I was not adversely affected and thus its appeal would appear to be inadmissible. The communication noted that the minutes had been contested by both parties which had requested corrections but none had been made by the opposition division. The board, whose duty was to revise the decision under appeal and not the minutes, could only take the minutes at face value. It was also noted that, since it would be rather bizarre to maintain several "main" requests during oral proceedings, the fact that the request accepted by the opposition division was marked as main request indicated that it was the first (and most important) request on which a decision had to be taken.

XIII. In the only substantive written response to the board's communication, appellant II in its letter of 8 September 2009 made further submissions on the admissibility of appellant I's appeal and gave an undertaking to withdraw its own appeal if appellant I's appeal should be held inadmissible.

XIV. The arguments of appellant I that its appeal is admissible can be summarised as follows.

In its decision at the oral proceedings on 21 November 2007 the opposition division refused the main request of 6 November 2006 for non-compliance with Article 123(2) EPC and thereafter maintained the patent on the basis of a further auxiliary request filed during the oral proceedings and headed "Second amended main request - as amended during Oral Proceedings". The rejection of the earlier request was not mentioned in the decision. Appellant I requested correction of the decision to include a reference to the decision to reject the main request of 6 November 2006 and correction of the minutes to reflect accurately the circumstances surrounding that rejection and to remove the inaccurate report of this request being withdrawn.

The word "concluded" in paragraph 19 of the minutes indicates a decision, compared with the use elsewhere in the minutes of the phrase "expressed the opinion that".

Appellant II is incorrect to say there is no evidence to support appellant I's request for corrections. That request was made very shortly after the decision and

minutes were issued in a letter of 28 January 2008 signed by both the representatives who attended the oral proceedings. Thus that letter provides the evidence of two persons present that the opposition division refused the main request of 6 November 2006, that only auxiliary requests on file were then withdrawn and that, in reply to a question from the chairman whether the main request was withdrawn, the response was that this request was maintained.

As regards the balance of the available evidence, the minutes should be put to one side since they are in dispute. As for the evidence of the parties' representatives, there were two representatives present for appellant I who both agree that the minutes are inaccurate. Since only one of those representatives was conducting the case, the other was free to make full notes. Appellant II only had one representative present and his account could be based on a misunderstanding, or his recollection could be wrong even when he made a contemporaneous report.

The opposition division should have responded to the request for corrections. It is obliged to do so - see T 1198/97 of 5 March 2001 (Reasons, point 7).

- XV. The arguments of appellant II that appellant I's appeal is inadmissible can be summarised as follows.

Appellant I was not adversely affected by the opposition division's decision since that was for maintenance of the patent in a form requested by appellant I which, in the oral proceedings at first instance, chose to amend its main request three times

rather than retain its main request of 6 November 2006 and file subsidiary or auxiliary requests. The minutes of the oral proceedings (see paragraphs 2, 19, 20, 38-40, 53-56 and 58) and the decision of the opposition division (see the form 2327 of 10 January 2008 and section VII of the "Facts and Submissions") both support this.

Appellant I's assertion that the opposition division refused its main request of 6 November 2006 is not correct. That request was withdrawn in favour of a different, replacement main request. Appellant I's request for corrections to reflect a different version of events contains mere assertions unsupported by evidence. By contrast, appellant II supplied extracts from its representative's letter to its client and enclosed report of the oral proceedings and the representative declared that these were accurate. They also accord with the decision and the minutes. Those extracts included the statement from the letter that

"the proprietor did not present a succession of auxiliary requests, but on each occasion amended the main request"

and the following statements from the report, of which the first three correspond to paragraphs 20, 40 and 56 respectively of the minutes:

"After a break, the proprietor submitted a revised main request (and a revised auxiliary request, though this was not discussed). These are enclosed, marked A and B, respectively."

"The proprietor then filed an amended main request (enclosed marked C) with the objected-to claims deleted or (in the case of antibody claim 33 (now 27)), limited to the specific 103-282 amino acid sequence."

"The OD formed the view that claim 1 was novel over D20 but that antibody claim 27 was not. The proprietor agreed to delete claims 27 and 28 to amend the description. I enclose a copy of the "second amended" main request (marked D) and of the amended page of the description (marked E) which I agreed."

"The Chairman checked that there was only the one request remaining in the proceedings and then announced the interlocutory decision to maintain the patent as amended." (*Emphasis added by appellant II in its letter of 21 February 2008.*)

Appellant II agreed that it was unfortunate that the opposition division had not reacted to appellant I's request for corrections.

- XVI. Oral proceedings were held before the board on 8 October 2009. The only issue discussed was the admissibility of appellant I's appeal. After the Board announced that it considered this appeal to be inadmissible, appellant II withdrew its own appeal.
- XVII. Appellant I (patentee) requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or one of auxiliary requests 1 to 3 filed with the statement of grounds of appeal or of auxiliary request 4 filed on 22 December 2008.

Reasons for the Decision

1. It is common ground between the parties that the opposition division should have responded to appellant I's requests for corrections of the minutes of the oral proceedings. The board also agrees. As was stated in the decision T 1198/97 of 5 March 2001 referred to by appellant I:

"Even when an appeal has been filed, only the department of first instance before which the oral proceedings took place is competent and at the same time also obliged to decide in first instance on a request concerning the contents of the minutes of oral proceedings held before it, firstly because it is their competence and duty under Rule 76 EPC to draw up the minutes correctly and completely and secondly because, if anybody, only the members of this department know what has happened and has been said or not during the oral proceedings before it." *(See Reasons, point 7. Emphasis added by the board. The equivalent of Rule 76 EPC 1973 is now Rule 124 EPC.)*

2. Unfortunately, if the first instance (in this case, the opposition division) sees fit to ignore its obligation, there is nothing the board can do in this respect. The board has no power to compel the opposition division to discharge its obligations. Appellant I requested that the board defer consideration of its appeal until after the opposition division dealt with the request for corrections but it would appear that, if the board had adopted that course, not only appellant I's appeal but

also appellant II's appeal could have been paralysed by the opposition division's permanent inactivity. Moreover, simply deferring all action in appeal proceedings would be contrary to the public interest in resolving disputes over the existence or extent of patent protection. Accordingly, while it is a matter of great regret that the opposition division did not react to the request for correction, the board must deal with the case as best it can in the absence of such reaction. In this connection, it goes without saying that, while the opposition division may be open to criticism for ignoring that request, such criticism must not prevent a wholly objective assessment of the evidence provided by the opposition division's decision and its minutes of the oral proceedings before it.

3. If, on the one hand, appellant I's assertions are correct, then the minutes of the first instance oral proceedings, even if uncorrected, cannot be relied on. Further, the opposition division's decision would be incomplete, in that it does not give reasons for the rejection of the main request of 6 November 2006. That would mean not only that appellant I's appeal - which is against the decision to reject that request - would be admissible but also that the deficiency in the first instance proceedings (namely, the absence of a wholly-reasoned decision) would require the board to remit the case to the first instance unless there are special reasons to do otherwise (see Article 11 RPBA). If, on the other hand, appellant II's assertions are correct, then the minutes and the decision under appeal would seem to be correct in having treated the main request of 6 November 2006 as withdrawn by appellant I. As a consequence, appellant I would have succeeded in

obtaining a decision in its favour on the main request in the form it wanted at the conclusion of the first instance proceedings; it would therefore not have been adversely affected by that decision and its appeal would be inadmissible (cf. Article 107 EPC). Quite clearly, in view of the starkly differing facts on which the parties base their assertions, only those of one party can be correct. The board must decide which party's account of the oral proceedings before the opposition division is, in the light of the available evidence, more likely to be correct.

4. Upon consideration of the available evidence, the board has no hesitation in finding appellant II's account of the relevant events the more likely. This requires no judgment as to the respective credibility of the persons in question. As already observed, the board must not allow its criticism of the opposition division's subsequent behaviour to detract from the value of the minutes and decision as evidence. The board also dismisses appellant I's submission that the minutes should be disregarded as evidence because they are in dispute - if that were correct, only undisputed evidence would ever be admissible with the result that most litigation would never take place.

5. Equally, the persons whose competing accounts of events are advanced on behalf of the parties, namely their representatives who attended the first instance oral proceedings, are to the best of the board's knowledge professional persons of unquestioned honesty and integrity who would not allow the interests of their clients to take precedence over the truth. While they have put forward different accounts of what happened,

the board has no doubt they have all done so from the best of their recollections. Since recollection is rarely if ever perfect, it is not a matter of great surprise that accounts may differ; it would probably be more surprising if they did not differ. It is just fortunate that such matters only rarely need to be decided. Appellant I submitted that appellant II's representative's evidence, even though contemporaneous, may be based on a misunderstanding or a wrong recollection: so it may, but equally so may the evidence of appellant I's former representatives, and possibly the more so for not being contemporaneous.

6. In weighing the evidence, the board begins with the minutes. While questioned by appellant I, they remain as issued and form the only account which is both contemporaneous and independent. Those minutes state categorically that the main request of 6 November 2006 was withdrawn after it was apparent that it would not be allowed - see paragraphs 19 and 20 which say:

"19. The Chairman concluded that the main request does not comply with Article 123(2) EPC and invited the P to file a new request.

The Proceedings were interrupted from 11:54-13:24.

20. The P withdrew all requests on file and submitted a new main request, hereinafter referred to as main request, wherein [...]".

7. The board notes that this records substantially the opposite of appellant I's account. The evidence of the minutes is that, after being invited to file a new

request (that is, one additional request), the patent proprietors filed **one** new request and withdrew **all** their previous requests. Appellant I's evidence is that the proprietors filed **two** new requests at this point and withdrew only **some** previous requests, namely auxiliary requests (see appellant I's letter of 28 January 2008). Appellant II's evidence confirms the account of the minutes (see its letter of 21 February 2008).

8. Those are the key items of evidence and, in the board's judgment, they show a clear preponderance of weight in favour of the account in the minutes, even before any other factors are taken into account. Appellant II's account is partly taken from and supported by its representative's almost contemporaneous account in a reporting letter to his client (said to be written partly on the day of and partly the day after the oral proceedings), passages of which are quoted and declared by the representative to be true. This evidence must accordingly be seen to stand virtually as a witness statement. However, even if it were of the same less formal quality as appellant I's evidence (see 9 below), it would still provide a contemporaneous account which corroborates the opposition division's own account.

9. The only different account is that of appellant I's representatives which was supplied on 28 January 2008. They are not of course to be criticised for not producing evidence in the same form as appellant II, if only because client communications remain private and privileged from disclosure unless or until voluntarily disclosed. None the less, the statements in appellant I's letter of 28 January 2008 are, even if

more than mere assertion as suggested by appellant II, both less detailed than appellant II's evidence and not contemporaneous. It is true that, as argued by appellant I's present representative, two representatives appeared for the patent proprietors in the first instance oral proceedings and both have signed the letter of 28 January 2008. The board cannot give this much weight - it would have made little difference if they had both written and signed separate letters, or both made witness statements, with the same content: the balance of evidence would still point the other way.

10. Though not of major significance, such other factors as appear from the file also point towards the minutes as being correct. First, the minutes record the same sequence of events - the withdrawal of a current main request after discussion and the introduction of a new main request - on two subsequent occasions (see paragraphs 39 and 40 and 55 and 56).
11. Second, the names or headings given to the requests, which used the expression "amended main request" rather than the words "auxiliary" or "subsidiary" which are normal if two or more requests are maintained simultaneously, are wholly consistent with that sequence of withdrawn and newly filed requests.
12. Third, while appellant I argued that no great weight should be placed on those names or headings, it sought to distinguish the use of "concluded" (suggesting "decision") in paragraph 19 of the minutes from "expressed the opinion that" in other passages. While the board doubts that a person taking detailed

contemporaneous notes which are then transcribed to produce ten pages of minutes would choose his or her exact vocabulary with a precision which allows of such distinctions, the board considers it to be of no significance. The word "concluded", which appears in paragraph 19, could refer either to an opinion or to a decision. Further, "concluded" does not appear in the description of similar events in paragraphs 39 and 55.

13. Lastly, the decision as issued is consistent with the minutes. As is common practice, it recites the request filed before the oral proceedings on 6 November 2006 (see section III on page 1), records that the proprietors filed a new main request during the oral proceedings (see point 4 on page 3) and then gives reasons for its decision on that request. The treatment of only one request in the decision is wholly consistent with the withdrawal during the oral proceedings, as described in the minutes, of the request of 6 November 2006 and all other requests including another version of the main request filed during the oral proceedings.
14. Accordingly the board concludes that, on the balance of the available evidence, the account of the oral proceedings in the minutes of the opposition division was correct. Therefore the decision is similarly correct, in which case appellant I was not adversely affected thereby (cf. Article 107 EPC) and its appeal must be dismissed.
15. Since the appeal of appellant II was withdrawn, no decision thereon is required.

Order

For these reasons it is decided that:

The appeal of appellant I is rejected as inadmissible.

The Registrar:

The Chairman:

M. Kiehl

L. Galligani