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**Datasheet for the decision
of 29 June 2012**

Case Number: T 1839/11 - 3.3.09

Application Number: 05785170.1

Publication Number: 1804592

IPC: A23K 1/00, A23K 1/165

Language of the proceedings: EN

Title of invention:

Enzyme granules

Patentee:

Novozymes A/S

Opponent:

DANISCO A/S

Headword:

-

Relevant legal provisions:

EPC Art. 128(4)

EPC R. 144(d)

RPBA Art. 13(1)(3)

Art. 1(2) of the decision of the President of the EPO dated
12 July 2007

Keyword:

"Admissibility of new requests (no)"

"Exclusion from file inspection"

Decisions cited:

G 0001/03, G 0002/10, J 0023/10, T 0379/01, T 1401/05,
T 1049/08, T 2464/10

Headnote:

1. A document filed in proceedings and which serves the purpose of informing the public about the patent may not ordinarily be excluded from file inspection under Rule 144 EPC and Article 1(2) of the Decision of the President dated 12 July 2007 even though such inspection would be prejudicial to the legitimate personal or economic interests of natural or legal persons (Points 3.2 - 3.6).
2. Where a filed document contains information, some of which serves the purpose of informing the public about the patent but some of which does not, the filing of a version of the document in a form from which the latter information has been redacted may form the proper basis for an order excluding the unredacted document from file inspection under Rule 144 EPC, the redacted version being open to file inspection (Points 3.8 and 3.11).



Case Number: T 1839/11 - 3.3.09

D E C I S I O N
of the Technical Board of Appeal 3.3.09
of 29 June 2012

Appellant:
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Decision under appeal: Decision of the Opposition Division of the European Patent Office posted 5 August 2011 revoking European patent No. 1804592 pursuant to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: W. Sieber
Members: N. Perakis
K. Garnett

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 1 804 592, which had been filed as international application PCT/DK2005/000610 on 27 September 2005 in the name of Novozymes A/S, was published on 11 November 2009 (Bulletin 2009/46). The patent was granted with 26 claims, claims 1, 5 and 7 reading as follows:

"1. A method for manufacturing a feed composition comprising the steps of:

- i. mixing feed components with granules comprising a core and a coating, wherein the core comprises an enzyme,
- ii. steam treating said composition (i), and
- iii. pelleting said composition (ii),

characterized in that the coating comprises a salt which has a constant humidity at 20°C which is above 60%."

"5. The method of any of claims 1-4, wherein the salt in the coating is selected from the group consisting of NaCl, Na₂CO₃, NaNO₃, Na₂HPO₄, Na₃PO₄, NH₄Cl, (NH₄)₂HPO₄, NH₄H₂PO₄, (NH₄)SO₄, KCl, K₂HPO₄, KH₂PO₄, KNO₃, Na₂SO₄, K₂SO₄, KHSO₄, MgSO₄, ZnSO₄, CuSO₄ and sodium citrate."

"7. The method of any of claims 1-4, wherein the salt in the coating is Na₂SO₄".

II. On 30 March 2010 a notice of opposition was filed by Danisco A/S requesting revocation of the patent in its entirety on the basis of Article 100(a) EPC (lack of

novelty and lack of inventive step) Article 100(b) EPC (insufficiency of disclosure) and Article 100(c) EPC (the subject-matter of the patent extends beyond the content of the application as filed).

Documents filed during the opposition proceedings included:

D1: WO 92/12645 A1;

D3: WO 00/01793 A1;

D4: WO 98/54980 A2, and

D17A: Experimental Report - Residual activities after steam pelleting of various phytase granules.

III. By a decision announced orally on 7 July 2011 and issued in writing on 5 August 2011 the opposition division revoked the patent because none of the then requests for maintenance of the patent was allowable. Of these requests, only auxiliary request 2A is relevant for the purposes of this appeal. It contained a set of four claims, claims 1 and 3 reading as follows:

"1. A method for manufacturing a feed composition comprising the steps of:

- i. mixing feed components with granules comprising a core and a coating, wherein the core comprises an enzyme,
- ii. steam treating said composition (i), and
- iii. pelleting said composition(ii),

characterized in that the coating comprises a salt which has a constant humidity at 20°C which is above 60%, wherein the salt in the coating is selected from

the group consisting of NaCl, Na₂CO₃, NaNO₃, Na₂HPO₄, Na₃PO₄, NH₄Cl, (NH₄)₂HPO₄, NH₄H₂PO₄, (NH₄)SO₄, KCl, K₂HPO₄, KH₂PO₄, KNO₃, Na₂SO₄, K₂SO₄, KHSO₄, MgSO₄, ZnSO₄ and sodium citrate."

"3. The method of claim 1, wherein the salt in the coating is Na₂SO₄".

The opposition division considered that the subject-matter of claim 1 of this request lacked an inventive step in view of the combination of D1 with D3.

- IV. On 8 July 2011 and in advance of the written decision being issued, the patent proprietor (in the following: the appellant) filed an appeal and on the same day paid the appeal fee. The appellant requested that the decision be cancelled in its entirety to the extent that it was adversely affected by it and that the patent be maintained in the form of the main request filed before the opposition division. Accelerated processing of the appeal was also requested in view of pending litigation in several countries.
- V. With a letter dated 14 September 2011 the opponent (in the following: the respondent) requested that the appeal be dismissed and for the same reason as the appellant requested that the appeal proceedings be accelerated.
- VI. On 5 December 2011 the appellant filed the statement of the grounds of appeal including sixteen auxiliary requests. Auxiliary request 2 was identical to auxiliary request 2A before the opposition division. The appellant argued that the subject-matter of claim 1

of this request was not obvious in view of the disclosure of D1 and D3. This was supported by secondary indicia such as commercial success and a long-felt need.

VII. On 7 December 2011 the board summoned the parties to oral proceedings to take place on 28 and 29 June 2012.

VIII. In the course of proceedings between the present parties before the High Court of England and Wales (Patents Court) concerning the validity and infringement of the opposed patent (Action HC10C 02358, hereafter: "the English Proceedings"), the respondent had obtained from the appellant, as part of the English process of disclosure, various documents relating to the results of trials and research programmes conducted by the appellant ("the Disclosure Documents"). For reasons which it is not necessary to go into, following a decision of the English Court dated 9 March 2012 ([2012] EWHC 696 (Pat)) the respondent was permitted by the English Court to use the Disclosure Documents in the present appeal proceedings.

The terms on which the respondent was allowed to use them are set out in the order of the English Court dated 9 March 2012 ("the English Court Order"), by which *inter alia*:

- (a) The appellant undertook that it would not resist the introduction of the Disclosure Documents into the present appeal proceedings;
- (b) The respondent was given permission to use the Disclosure Documents in these appeal proceedings;
- (c) Both the appellant and the respondent were ordered to use their best endeavours to keep the

Disclosure Documents confidential to the extent that the various jurisdictions concerned so allowed (but the absence of any such provisions (whether existing in law or applied by the relevant court or tribunal) allowing confidence in the Disclosure Documents to be kept would not prevent their use);

- (d) The Disclosure Documents were to remain confidential and might only be used for the purposes of *inter alia* the present appeal proceedings and were to be subject to the obligations set out in the paragraph (c) above.

IX. With a letter dated 3 April 2012 and in advance of its reply to the grounds of appeal the respondent filed various documents, including:

- [-] The respondent's Submissions on the Disclosure Documents;
- D44:** Patentee's Pelleting Trials Results Table (2003-2005);
- D45:** Summary of the Patentee's Second Research Program (2007-2011);
- D46:** The Disclosure Documents;
- D47:** Patents Court Judgment of 9 March 2012 (Mr. Justice Mann); and
- D48:** Patents Court Order of 9 March 2012 (Mr. Justice Mann) [the English Court Order].

Pursuant to the English Court Order, the respondent requested that its submissions and documents D44, D45 and D46 be excluded from file inspection in accordance with Article 1(3) of the President's decision of 12 July 2007 (OJ EPO Special 2007, edition No.3, p.125).

X. With its letter dated 19 April 2012 the respondent filed a reply to the grounds of appeal, in redacted and unredacted versions, together with various documents including:

Annex A: Calculation of Measurement of Errors relating to the propagation of error calculations, in redacted and unredacted versions; and
D49: DE 199 29 257 A1.

The respondent requested that the unredacted versions of its reply and of Annex A be excluded from file inspection.

XI. The appellant filed a letter dated 16 May 2012, in redacted and unredacted versions, containing submissions, together with the following documents:

D46A: e-mail exchange in the Danish language;
D46B: English translation of D46A;
D55: Witness Statement of Beth Gail Fryksdale dated 16 June 2011;
D56: Witness Statement of Nathaniel Todd Becker dated June 2011; and
D57: Summary of Appellant's Research 2003-2011 Response to Respondent's Allegations in the 3 April 2012 Correspondence.

The appellant requested that the unredacted versions of its letter, and the above documents, be excluded from file inspection.

- XII. With a letter dated 25 May 2012, in an unredacted version and (as subsequently filed) a redacted version, the appellant filed further submissions and withdrew its main request and auxiliary requests 1 and 3, so that:
- its former auxiliary request 2 (identical to auxiliary request 2A before the opposition division - see point III above) became its new main request;
 - the remaining requests were renumbered as auxiliary requests 1 to 13.

The appellant requested that the unredacted version of its letter be excluded from file inspection.

- XIII. With a letter dated 8 June 2012, in redacted and unredacted versions, the respondent filed further submissions and *inter alia* the following documents:

D46R: Redacted version of D46, with additional comments by the respondent;

D55R: Redacted version of D55;

D56R: Redacted version of D56;

The respondent requested that the unredacted versions of its letter, and D46R, D55R and D56R, be excluded from file inspection.

- XIV. As regards the various requests for exclusion of documents from file inspection referred to above, the end-result of communications issued by the board was that these requests were directed to be dealt with at the forthcoming oral proceedings and that meanwhile all these documents were ordered to be provisionally excluded from file inspection.

XV. Oral proceedings were duly held on 28 and 29 June 2012.

XVI. At the beginning of these oral proceedings the board indicated its view as to the proper basis for an order for exclusion of documents from file inspection, namely, that documents could only be so excluded if, *inter alia*, they did not serve the purpose of informing the public about the patent. As to this, it appeared that many of the documents which were the subject of the requests did in fact serve such a purpose. Subject to what the parties said, the board therefore intended to hear the submissions on the substantive issues in the case, including submissions on inventive step and sufficiency, such submissions to include references to the documents which were the subject of requests for exclusion from file inspection. After the board had indicated its views on these substantive issues, the board would then hear the parties on any requests for exclusion of documents from file inspection. No objections were raised by the parties against this proposed way of proceeding.

XVII. The board then heard argument on two of the respondent's objections to the appellant's main request, namely those concerning Article 123(2) EPC and lack of inventive step. After hearing the parties on the first issue, the board indicated its conclusion that the subject-matter of claims 1 and 3 of the main request did not infringe the provisions of Article 123(2) EPC. Inventive step was then discussed, limited to the attack starting from D1 as the closest prior and combining it with D3 (a full list of the documents

which were referred to in this regard can be found in the minutes of the oral proceedings).

XVIII. As to this inventive step attack, the starting point was that D1 disclosed a method for the production of pelletized fodder wherein a mixture of enzyme granules and fodder components are steam treated and subsequently pelletized. The granules consist of an enzyme-containing core which is coated with a wax. Claim 1 of the main request did not exclude the presence of a wax coating and the essential difference of the claimed subject-matter over D1 was the use of a specific salt coating (with or without an additional wax coating). After deliberation, the board indicated its conclusion that the subject-matter of claim 1 was not inventive in view of D1 combined with D3, particularly having regard to the evidence summarized in part 1 of D46R concerning the additional salt coating on top of the wax coating of D1. The board also expressed its doubts that the remaining auxiliary requests overcame this inventive step objection.

XIX. At the start of the second day and in direct response to this indication, the appellant withdrew all existing requests on file for maintenance of the patent and replaced them by a new main request and two auxiliary requests, as follows:

- (a) The new main request was based upon previous auxiliary request 6. Claim 1 reads as follows (amendments over previous auxiliary request 6 in bold):

"1. A method for manufacturing a feed composition comprising the steps of:

- i. mixing feed components with granules comprising a core and a coating, wherein the core comprises an enzyme,
- ii. stem treating said composition (i), and
- iii. pelletting said composition(ii),

characterized in that the coating comprises a salt which has a constant humidity at 20°C which is above 60%, wherein the salt in the coating is **Na₂SO₄ and the granules do not comprise a wax coating.**"

- (b) Auxiliary request 1 was based on previous auxiliary request 7 and differed from the new main request in its characterising part, as follows (amendments over previous auxiliary request 7 in bold):

"characterized in that the coating comprises a salt which has a constant humidity at 20°C which is above 60%, wherein the coating comprises at least 90% w/w of the salt, the salt in the coating is **Na₂SO₄ and the granules do not comprise a wax coating.**"

- (c) Auxiliary request 2 was based on previous auxiliary request 11 and differed from the new main request in its characterising part, as follows (amendments over previous auxiliary request 11 in bold):

"characterized in that the coating comprises a salt which has a constant humidity at 20°C which is above 60% wherein the coating is applied onto the core by atomization onto the core in a fluid bed, wherein the salt in the coating is Na₂SO₄ **and the core is: a homogeneous blend of an enzyme, an inert particle with an enzyme applied onto it, or a homogeneous blend of an enzyme, and optionally materials which act as binders, which is coated with an enzyme.**"

XX. The relevant arguments put forward by the appellant in favour of the admission of these new requests may be summarised as follows:

- The new main request and new auxiliary requests 1 and 2 were based on requests previously filed during the appeal proceedings.
- The new requests were filed in reaction to the arguments presented by the respondent on the issue of inventive step of the subject matter of the previous main request and the conclusion of the board that the method involving a granule with a wax coating and a salt coating on top of it lacked an inventive step.
- These requests should not be considered late-filed as the appellant had had no time to reply to the respondent's arguments submitted only three weeks before the oral proceedings and raising various issues including insufficiency objections directed to 11 specified non-working embodiments (see letter of 8 June 2012, page 16 of the unredacted version).

- The argument of lack of inventive step raised before the opposition division had been based on D1, D3 and D17A only, whereas in the appeal proceedings the respondent based its objections on documents D44, D45 and D46 (letters dated 3 April 2012 and 19 April 2012). Even various other documents had been taken as closest prior art, namely D49, D3 and D4.
 - The amendments to the claimed subject-matter now meant that the claims were focused on the heart of the invention and did not bring about any substantial change. This could not come as a surprise to the respondent.
 - The amendment in the main request and auxiliary request 1, which introduced a disclaimer excluding disclosed subject-matter, should be allowed in view of G 2/10. Following G 2/10, such amendments had been admitted in cases such as T 1049/08 and T 2464/10. The proposed amendment in the present case was not as complex as suggested by the respondent.
 - The new requests clearly fulfilled the requirements of Articles 123(2), 84 and 83 EPC.
- XXI. The relevant arguments put forward by the respondent against the admission of the new requests may be summarised as follows:
- These requests should not be admitted because they were late-filed without any valid excuse.

- The respondent had raised the objection of lack of inventive step against the method involving a granule having a salt core over a wax core with its letter dated 19 April 2012 (see page 13), i.e. before the appellant had submitted the requests which were discussed during the oral proceedings and then withdrawn. These requests were filed with the letter of 25 May 2012 as a reaction to the respondent's objections, which objections did not change during the oral proceedings before the board. If at all, the new requests should have been filed at that stage of the proceedings.
- Moreover, both parties had requested accelerated proceedings and the appellant should have done its best to ensure that its requests were in order at the beginning of the oral proceedings.
- The new requests were *prima facie* not allowable. They raised new issues, namely added subject-matter, lack of clarity and insufficiency of disclosure. Furthermore, *prima facie* the new requests did not overcome the lack of inventive step in view also of the other cited documents, namely D4 and D49.
- Contrary to the appellant's assertion, the decision of the Enlarged Board in G 2/10 did not mean that the disclaimer introduced into the main request and auxiliary request 1 was allowable, as this decision did not give the appellant such a "carte blanche" when amending the claimed subject-matter. In particular, such a disclaimer was not allowable as means of overcoming a lack of inventive step objection. The introduction of the disclaimer

required a detailed analysis and review of the legal background. This complex issue could not be dealt with quickly.

XXII. After deliberation the board announced that the new requests were not admitted into the proceedings.

XXIII. As regards the original requests to exclude various documents from file inspection (the complete list of these documents can be found as an annex to the minutes of the oral proceedings):

- (a) The appellant's general argument was that (D55 and D56 apart) these documents related to its own, internal pelleting trials and research programmes. Its economic interests would be prejudiced if its competitors were allowed access to the documents. Firstly, the documents would provide a third party with a springboard into this area by showing the research and development work that had been carried out by the appellant. Secondly, the documents would provide third parties not only with the results of the appellant's research and development work in connection with this specific matter but also with the methodology, techniques and strategies followed by the appellant in a more general sense. The documents were so closely interrelated that they it was necessary for them to be excluded as a whole.
- (b) For its part, and apart from D55 and D56, the respondent did not argue that file inspection of the documents would be harmful to its own economic interests. Rather, its position was that it had

obtained these documents in the English Proceedings under an obligation of confidence and had been granted permission to use them in the present appeal proceedings subject to an order of the English Court to use its best endeavours to keep the information contained within the documents confidential. D46R, which it had filed, had been produced by removing information from D46 which it did not need to make use of in its attack on the patent, with the addition of some commentary.

- (c) As to D55 and D56, these were confidential witness statements served by the respondent in the course of the English Proceedings which contained information concerning its business, the publication of which would be prejudicial to its economic interests. The respondent had filed redacted versions, D55R and D56R, from which such information had been removed.
- XXIV. In the light the indication which the board had given at the outset of the oral proceedings (see paragraph XVI, above), and no doubt appreciating the reality of the situation, towards the end of the oral proceedings the appellant filed **D46R(2)**, being a redacted version of D46R. The appellant put it forward as a basis for the requests for exclusion from file inspection of documents and written submissions arising out of D46. It had been produced from D46R by removing further information which, it submitted, did not serve the purpose of informing the public about the patent but the publication of which would harm its economic interests.

XXV. A point of dispute between the parties was that the respondent argued that some of the passages which had been removed by the appellant from D46R to obtain D46R(2) contained information which, even if it was prejudicial to economic interests of the appellant, did in fact serve the purpose of informing the public about the patent. In particular, this information related to the capacity of the appellant's plant and (so the respondent argued) rebutted the appellant's assertion that the reason why it had abandoned pelleting trials was because it had insufficient capacity to carry on the trials and not because it could not get the invention to work. The appellant argued that such information had nothing to do with the patent itself.

XXVI. After hearing argument on this issue, the board indicated its willingness to accept D46R(2) as a suitably redacted version of D46R and to make an order excluding D46, D46R, D55 and D56 from public file inspection on this basis.

XXVII. At the end of the oral proceedings the final requests of the parties were stated to be as follows:

- (1) The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main, first or second auxiliary requests filed during the oral proceedings on 29 July 2012.
- (2) The respondent requested that the appeal be dismissed.

- (3) Both parties requested that the following documents be excluded from public inspection under Rule 144(d) EPC:
- (a) D46, appellant's disclosure documents, filed by the respondent on 3 April 2012;
 - (b) D46R, redacted version of D46, with commentary, filed by the respondent on 8 June 2012;
 - (c) D55, witness statement of Beth Fryksdale, filed by the appellant on 16 May 2012;
 - (d) D56, witness statement of Nathaniel Becker, filed by the appellant on 16 May 2012.

Reasons for the Decision

1. The appeals are admissible.
2. *Admissibility of new requests*
 - 2.1 As set out in paragraph XIX, above, on the second day of oral proceedings the appellant filed a new main and two auxiliary requests, replacing all existing requests on file. These were very-late filed requests and were only admissible at the discretion of the board (Articles 13(1) and (3) of the Rules of Procedure of the Boards of Appeal).
 - 2.2 Since the appellant's previous requests were withdrawn it is not necessary or indeed appropriate for the board to set out the reasons why it had indicated that these previous requests were not allowable, i.e. for lack of inventive step. Nevertheless, the new requests were filed in direct reaction to this indication, and this

circumstance forms part of factual matrix in which the issue of admissibility must be considered. As to this, the objection which lead to the board's indication turned on the difference of the claimed subject-matter of the then main request over D1, namely the use of a specific salt coating, coupled with the fact that claim 1 of this request did not exclude the presence of a wax coating in addition to the salt coating. In fact, the patent in suit explicitly encompasses such an embodiment (see paragraphs [0150] - [0152] of the patent specification). Hence the importance of the disclaimer introduced into the new main and first auxiliary requests excluding a wax coating.

2.3 The board in the exercise of its discretion decided not to admit these requests for the following reasons:

- (a) The objection which lead to the board's indication was raised clearly by the respondent at an appropriate stage of the appeal proceedings, namely with the reply to the statement of grounds of appeal.
- (b) The appellant had had an opportunity to respond to this and other objections in good time, and chose to do so by rearranging its requests already on file and by putting forward arguments against the various attacks in this reply, including this one, rather than by filing new requests such as the ones currently under discussion.
- (c) The board's conclusion on this objection, while no doubt very disappointing to the appellant, cannot have come out of the blue.

- (d) There might well have been a basis for the disclaimer in the application as filed. Nevertheless the amendment was not straightforward and raised possible issues about the interplay of the two decisions of the Enlarged Board in G 2/10 and G 1/03. The fact that other Boards of Appeal may have allowed similar amendments, for example in T 1049/08 and T 2464/10, is not conclusive. It is simply not appropriate for a board to be bounced into being required to make an immediate decision on what may be a difficult point, particular when the requesting party has had sufficient opportunity and reason to file requests raising the issue at an earlier stage.
- (e) This is even more so in the present case, where the board, at the request of the parties, has accelerated the appeal proceedings. One of the main purposes of accelerated proceedings is for the board to come to a decision reasonably quickly for the benefit of the parties. In these circumstances it is incumbent on a party to put its requests on the table at the earliest opportunity.
- (f) The subject-matter of the second auxiliary request, while not containing the disclaimer objected to, is based on withdrawn auxiliary request 11 but including further features concerning the core taken from the description (application as filed, page 4, lines 28-34). The respondent was justified in saying that the taking

of features from the description took it by surprise and *prima facie* raised also new issues under Article 123(2) EPC.

2.4 Since the new requests were not admitted and there are no other requests for the maintenance of the patent on file, the appeal has to be dismissed.

3. *Exclusion from file inspection.*

3.1 Article 128(4) EPC provides that:

"After the publication of the European patent application, the files relating to the application and the resulting European patent may be inspected on request, subject to the restrictions laid down in the Implementing Regulations."

Rule 144 EPC provides that:

"The parts of the file excluded from inspection under Article 128, paragraph 4, shall be:

...

(d) any ... document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the European patent."

Article 1(2) of the Decision of the President dated 12 July 2007 (OJ EPO, 2007, Special edition No. 3, p.125) provides that:

"Documents or parts thereof ... (a) shall be excluded from file inspection at the reasoned request of a party or his representative if their inspection would be prejudicial to the legitimate personal or economic interest of natural or legal persons".

- 3.2 Prejudice to the economic interests of a party is therefore a necessary requirement for exclusion from file inspection in a case such as the present but is not of itself a sufficient requirement. The overreaching principle is set out in Rule 144(d) EPC, to which the President's Decision must read as being subject, namely, that documents may be withheld from public inspection (only) if such inspection would not serve the purpose of informing the public about the patent. To this may be added the following two comments:
- (a) The provisions making an exception from the general principle of public access to the file are to be construed narrowly (see T 379/01, point 6.1 of the decision).
- (b) One of the purposes of file inspection is to enable the public to obtain information about the patent, being information to which it is entitled in return for the exclusive monopoly rights which the patent confers (indeed, this is the "paramount" purpose of file inspection according to the Board in T 1401/05 - see point 5 of the decision).
- 3.3 Examples where file inspection would not have served the purpose of informing the public about the patent are to be found in the decisions T 379/01, T 1401/05

and J 23/10. In each of these cases the material which was the subject of a request for exclusion from file inspection had no relevance to the subject matter of the patent.

- 3.4 In the board's view, much of the information in the documents which were the subject of the parties' original requests for exclusion from file inspection clearly served the purpose of informing the public about the patent in the sense of Rule 144(d) EPC. In particular it provided information about whether the subject matter of the patent was inventive and/or sufficiently disclosed. Thus, D46R was extensively referred to in the course of the submissions of the parties on inventive step and these references were taken into account by the board in reaching its conclusions (see paragraph XVIII, above). The same was potentially true of the documents D55 and D56 which had been filed by the appellant, although these documents were not in the event relied on. The various written submissions of the parties referring to these materials and which were also the subject of requests for exclusion from file inspection *a fortiori* served this purpose.
- 3.5 It is also the case that if it had been necessary for the board to have given written reasons for a decision on the substantive issues concerning the requests for maintenance of the patent (in particular on inventive step and sufficiency) such reasons, which would have been published, would inevitably have contained references to these materials as they concerned the validity of the patent.

- 3.6 It was for these reasons that the board indicated its view during oral proceedings (see paragraph XVI, above) that the original requests for exclusion from file inspection were unlikely to be granted in such a wide form. The board did not see that it had the power to make such an order.
- 3.7 The situation is unusual and, so far as the board is aware, unique in proceedings before the Office, in that the respondent has obtained these documents from the appellant as part of the English disclosure system but subject to an obligation of confidence and before it was known whether the respondent would be released from this obligation after a trial in the English Proceedings. The board also acknowledges that both parties have been ordered by the English Court to use their best endeavours to keep the Disclosure Documents confidential to the extent that *inter alia* the EPC allows. Nevertheless, the respondent was not prevented from making use of the documents in these appeal proceedings, and indeed was expressly allowed to do so. The board is therefore not concerned about a case in which the documents filed were in some way improperly obtained and does not need to consider what the powers of the EPO might be in such a case.
- 3.8 In the light of the board's indication, the parties sensibly modified their requests in the course of oral proceedings (see paragraph XXIV, above). As to the documents which are now sought to be excluded from public file inspection, the board accepts that in part they contain information which does not serve the purpose of informing the public about the patent and also that their publication would be likely to

prejudice the economic interests of the appellant and the respondent respectively. So far as concerns the appellant, the board accepts the appellant's submission that this information would give a competitor a potential springboard by showing the research and development work that it had carried out. The documents would also potentially provide third parties with information about the methodology, techniques and strategies followed by the appellant in a more general sense. So far as concerns the respondent, D55 and D56 also in part contain commercially sensitive information which concerns its business but which has nothing to do with the patent.

- 3.9 The one remaining point of dispute between the parties was that the respondent argued that some of the passages which had been removed by the appellant from D46R to obtain D46R(2) contained information which, even if it was prejudicial to economic interests of the appellant, did in fact serve the purpose of informing the public about the patent. This information for the most part related to the capacity of the appellant's plant and rebutted the appellant's assertion that the reason why it had abandoned pelleting trials was because it had insufficient capacity to carry on the trials and not because it could not get the invention to work.
- 3.10 While this information may have been relevant to understanding the reasons why the appellant at one stage abandoned pelleting trials, the board considers that such information serves no purpose of informing the public about the patent itself. The same applies to other information that the respondent said should not

be redacted. For this reason the board rejected the argument of the respondent on this issue.

- 3.11 The information contained in these documents which serves to inform the public about the patent is available in the various redacted versions of the documents, which will be available for file inspection. The interests of the public are therefore preserved and the board will accordingly make the order requested.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The following documents are ordered to be excluded from file inspection pursuant to Article 128 EPC, paragraph 4, and Rule 144(d) EPC:
 - (a) D46, appellant's disclosure documents, filed by the respondent on 3 April 2012;
 - (b) D46R, redacted version of D46 with commentary, filed by the respondent on 8 June 2012;
 - (c) D55, witness statement of Beth Fryksdale, filed by the appellant on 16 May 2012;
 - (d) D56, witness statement of Nathaniel Becker, filed by the appellant on 16 May 2012.

The Registrar:

L. Fernández Gómez

The Chairman:

W. Sieber