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A Relevant Subsidiary Business in a Corporate Group Should Oppose in its Own Name

The EPO Enlarged Board of Appeal has confirmed, in Decision G2/04, that where a subsidiary in a corporate group carries on the business to which an opposition relates, an opposition filed only in the name of the parent company of the group cannot be transferred out of the parent company's name when the subsidiary is sold.

In an earlier Decision (G4/88), the Enlarged Board held that an opposition cannot be freely transferred. However, as a specific exception to this principle, where (during opposition or appeal proceedings) an opponent splits off the relevant part of its business to a new entity, the new entity can **continue** with the opposition in its own name.

The question in G2/04 was therefore: does a further exception to the principle exist, so that transfer of an opposition can take place even when the intended final opponent existed and was available to oppose when the opposition was filed?

The Enlarged Board concluded that no such further exception to the rule exists or would be justified.

The lesson is that, when a corporate group wishes to oppose a European patent, any relevant subsidiary should be the named opponent (or one of them), if it is desired to have the power to transfer the opposition with any future sale of the subsidiary.

→ <http://legal.european-patent-office.org/dg3/pdf/g040002ex1.pdf>

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Viagra Opposition Concludes in the EPO Board of Appeal

The Viagra "second use" European patent (EP-B-0702555) has been finally revoked by EPO Board of Appeal 3.3.2 in Decision T 1212/01.

Followers of the Viagra litigations will be familiar with the essential inventive step issues in the case, and it is not necessary to report these in detail here. We highlight here two other points of interest in the pharmaceutical arena:

Firstly, the strict approach to "new matter" in the EPO led in this case to refusal, on that ground alone, of all of the patentee's claims to the use of cGMP PDE inhibitors, generally stated, for the manufacture of a medicament for the curative or prophylactic oral treatment of erectile dysfunction. On a careful analysis of the wording of the application as originally filed, the Board held that the oral route had been disclosed only in relation to the compounds of formula I and their salts, so that extension of that route to other compounds added new matter (Decision, Paragraphs 2.7 to 2.9).

Secondly, evidence of commercial success and accolades was analysed. Although the evidence was impressive at face value, the Board concluded that the patentee's evidence as presented had not clearly distinguished between success/accolades attributable to the underlying inventive step and success/accolades attributable to other (e.g. commercial) factors. The success/accolades could therefore not be used to counter the conclusion on technical grounds that the invention lacked an inventive step (Decision, Paragraph 6.8).

→ <http://legal.european-patent-office.org/dg3/pdf/t011212eu1.pdf>

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Biotech Patentability Questions to be Referred to EPO Enlarged Board

The Galligani Board of Appeal 3.3.8 has announced, in Oral Proceedings in Appeal T 1374/04 held on 18 November 2005 (European Patent Application No. 96903521.1; Wisconsin Alumni Research Foundation), that it will refer to the Enlarged Board of Appeal questions concerning the applicability and effect of Rules 23b to 23e of the European Patent Convention, which relate to patentability of biotech inventions.

The precise questions have not been announced yet, but will focus on whether the Rules, which were introduced in September 1999, apply to prior filed applications/patents and whether in particular Rule 23d(c) - which states that European patents shall not be granted in respect of biotechnological inventions which concern uses of human embryos for industrial and commercial purposes - prevents the patenting of cultures of human embryonic stem cells.

We will keep you informed as the referral progresses.

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Examples that Become Excluded by a Disclaimer are Relevant to Support the Claims

An interesting question that can arise in chemical, pharmaceutical and biotech cases is whether test data that become excluded from a claim after introduction of a disclaimer are still relevant as evidence to support the sufficiency (enablement) of the claim, even if they represent the sole experimental support.

In Decision T 175/03, EPO Board of Appeal 3.3.3 has answered the question favourably to patent applicants and patentees.

The Board stated (Decision, Paragraph 7.2.3):

"In view of these findings ... which require that the teaching of the invention ... must not be affected by the disclaimer, and the fact that Example 1 reaches directly to the limits of the amended independent claims ... the Board takes the view that the absence of experimental results in the remaining part of the claimed subject-matter after insertion of the disclaimer does not itself amount to a demonstration that the claimed subject-matter ... has not been disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art."

A corresponding favourable conclusion was reached on the related question of whether, for the purposes of analysing inventive step, the objective problem had been shown to be solved across the full scope of the claim (Decision, Paragraph 8.4).

→ <http://legal.european-patent-office.org/dg3/pdf/t030175eu1.pdf>

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Burden of Proof in Crystalline Form Cases Favourable to Applicants/Patentees

In a case that can usefully be compared with last year's UK House of Lords decision in *Synthon v. Smithkline Beecham* (see the November 2005 issue of this Newsletter), EPO Board of Appeal 3.3.1 has held, in Decision T 605/02, that a prior art document which disclosed, in respect of the same compound (here: Finasteride or Prozac), a similar crystallisation method to that used in the patent application does not anticipate a claim to one specific crystalline form in the absence of evidence as to the nature of the actual prior art crystalline form(s) obtained.

Furthermore, and importantly, the Board decided - in the specific context of another item of prior art that was held to be non-enabling - that there is no requirement for the applicant to file evidence of a lack of conformity between the prior art and the claimed form (Decision, Paragraph 3.2.1), the burden of proof being in principle on the Examining Division or other party asserting a lack of novelty.

The claims were held by the Board to be novel, and were remitted to the Examining Division for examination of inventive step and other matters.

The legal framework in Europe for examination of novelty in "crystalline form" cases is thus quite favourable to applicants/patentees, in that, in the absence of clear evidence of monomorphism (which was decisive in *Synthon*), it may be difficult for Examiners and third parties to establish conclusively what crystalline form was obtained in the prior art.

→ <http://legal.european-patent-office.org/dg3/pdf/t020605eu1.pdf>

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