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**Datasheet for the decision
of the Enlarged Board of Appeal
of 23 September 2009**

Case Number: R 0008/09
Appeal Number: T 0919/07 - 3.3.01
Application Number: 98907067.7
Publication Number: 0970050
IPC: C07D 211/44
Language of the proceedings: EN

Title of invention:

Process for the preparation of 10,11-dihydro-5H-dibenzo[a,d]cyclohept-5-enes and derivatives thereof

Patentee:

ROLABO S.L.

Opponents:

Medichem S.A.
Schering Corporation

Headword:

Fundamental violation of Article 113

Relevant legal provisions:

EPC Art. 112a, 113(1)
EPC R. 106

Relevant legal provisions (EPC 1973):

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Keyword:

"Petition for review - not clearly inadmissible - clearly unallowable"

Decisions cited:

T 0018/81

Catchword:

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Case Number: R 0008/09

D E C I S I O N
of the Enlarged Board of Appeal
of 23 September 2009

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Decision under review: **Decision of the Technical Board of Appeal**
3.3.01 of the European Patent Office of
13 January 2009.

Composition of the Board:

Chairman: P. Messerli
Members: M-B. Tardo-Dino
M. Ruggiu

Summary of Facts and Submissions

- I. The petition for review concerns the decision T 919/07 of 13 January 2009 - posted on 20 February 2009 - of the Board of Appeal 3.3.01 to maintain the European patent No. 0 970 050 ("the patent") based on application No. 98907067.7 in an amended form. The petition was filed on 4 May 2009 and the petition fee was paid on the same date. The petitioner was respondent 2 in the appeal proceedings (opponent II in the opposition proceedings).
- II. The invention relates to a process for preparing cyproheptadine related compounds, i.a. the antihistamine loratadine, using the McMurry reaction and TiCl_4/Zn .

The facts and procedural steps relevant for the present petition for review can be summarised as follows:

- (a) The appellant (patentee) filed an appeal against the decision of the Opposition Division revoking the patent.
- (b) In its decision the Board inter alia made the following findings.
- (i) The Board acknowledged D2 as the closest prior art (points 7.1.4 and 7.1.5) because it used a McMurry heterocoupling reaction.
- (ii) It identified the problem to be solved as the provision of an alternative process for making 4-(5,6-dihydro-11H-benzo[5,6]

cyclohepta[1,2-b] pyridin-11-ylidene)-N-substituted piperidines (point 7.2).

(iii) It stated that looking for this alternative implies trying to modify the McMurry reactions disclosed in D2 to yield a process as defined in the patent, and such a modification requires the use of an aromatic ketone containing a pyridyl ring as a starting material in the McMurry reaction (point 7.3.2).

(iv) It remarked that a McMurry reaction of an aromatic ketone containing a pyridyl ring is only disclosed in D28 and the review article D1 and that "D28 reports that phenyl(2-pyridyl)ketone will not couple with itself to yield the olefin expected as the product of the McMurry reaction, whereas phenyl(3-pyridyl) ketone does" (point 7.3.2).

(v) The Board concluded:
"As these two ketones are essentially identical in their sterical requirements, this difference in reactivity cannot be due to sterical reasons. The person skilled in the art would have realised that the diaryl ketones required to yield the desired 4-(5,6-dihydro-11H benzo[5,6] cyclohepta[1,2-b] pyridin-11-ylidene)-N- substituted piperidines, namely the ones of formula (I) depicted in claim 1, were very similar in structure as compared to phenyl(2-pyridyl) ketone used as a starting material according

to D28[...]. As the phenyl (2-pyridyl) ketone does not yield the expected McMurry product, the skilled person would suspect that also the structurally similar diaryl ketones of formula (I) of present claim 1 would not yield the respective olefin when used instead of the one of formula 4 according to Scheme 2 of document (D2).

It is to be noted that this conclusion was not based on prejudice but on the experimental evidence disclosed in document (D28)" (point 7.3.2).

- III. The petition contends that the conduct of the appeal proceedings on 13 January 2009 contained a fundamental violation of Article 113 EPC and "other fundamental procedural defects". The deficiencies (see section VI below) were only discovered when the written decision was issued and could not be raised during the oral proceedings according to Rule 106 EPC.
- IV. On 9 July 2009 the Board issued a communication accompanying the summons to oral proceedings which contained its provisional and non-binding opinion that, while the petition was not clearly inadmissible, it appeared to be clearly unallowable. The petitioner filed a response on 24 August 2009.
- V. Oral proceedings took place on 23 September 2009.
- VI. The petitioner's arguments as set out in its written submissions and developed at the oral proceedings can be summarised as follows.

D28 was a crucial document discussed during oral proceedings before the Board of Appeal in the same context of "prejudice" in which it had always been discussed, and not as "experimental evidence" as it was then regarded in the decision. A parallel was drawn with the decision T 18/81 where the right to be heard was deemed not to have been observed when a decision to refuse an application was based essentially on documents which, though supplied by the appellant in support of his case, were used against him to produce an effect on which he did not have an opportunity to make observations. In the present case the Board of Appeal decided to give D28 an effect (experimental evidence) on which the petitioner had no opportunity to make observations. Even though the facts under attack as well as the core of what was to be challenged - namely that there was no incentive for the skilled person - are the same, the approach is different depending on whether these facts are considered as "prejudice" or as "experimental evidence".

After the decision of the Opposition Division and in the absence of any warning from the Board of Appeal before the oral proceedings, the petitioner was given no chance to present the appropriate, more detailed arguments aimed not just at the general comment of D28 but at showing that its findings were wrong.

The decision of the Board of Appeal had to be considered in a chronological context. In this respect it was pointed out that D28 had never been mentioned by the Examining Division, that it was filed by the patentee during the opposition proceedings and that the

Opposition Division had found that D28 had no relevance to the unexpected heterocoupling reaction it was supposed to prove. It would have been expected that the Board of Appeal which reversed this decision would have drawn the petitioner's attention to the way it intended to use this document, particularly insofar as the heterocoupling/homocoupling reactions were involved, so that the petitioner would have reacted with a more elaborated defence and by providing the Board of Appeal with the relevant information.

While it is true that D28 was discussed (as mentioned in paragraphs 26 and 27 of the petition), that discussion took place in a different context which did not allow the comprehensive counter-attack which would have been appropriate for an issue of experimental evidence. It is also true that in paragraph 84 of the grounds of appeal the patentee mentioned "the experimental results described in D28", but that was to draw the conclusion in paragraph 86 that those results amounted to a prejudice. The petitioner admitted that the document D28 could not be regarded as establishing in this case a technical prejudice according to the concept of technical prejudice defined in the case law of the boards of appeal, but on the other hand, given the factual background of the case, it did not expect that it could be regarded as disclosing experimental results.

It had also been expected that the Board of Appeal would, during the oral proceedings, apply the same standard of assessment to D28 as it did regarding the experimental evidence in two other documents which were part of the proceedings.

- VII. The petitioner's requests as they stood at the end of the oral proceedings were
- that the decision T 919/07 be set aside and the proceedings be re-opened before the boards of appeal,
 - that the members who participated in taking the decision T 919/07 be replaced, and
 - that the fee for the petition for review be reimbursed in accordance with Rule 110 EPC.
- VIII. At the oral proceedings, the petitioner also made clear that, contrary to the petition, no other procedural defects than this fundamental violation of Article 113 EPC were alleged.
- IX. At the end of the oral proceedings the Enlarged Board announced its decision.

Reasons for the Decision

1. *Admissibility of the petition*

- 1.1 The petition was filed and the relevant fee paid on 4 May 2009, within the time limit of two months required by Article 112a EPC. The time limit, calculated as of the date of the notification of the decision by registered letter deemed to have been delivered on 2 March 2009 (Rule 126(2)EPC), expired on a day on which mail is not delivered (Saturday 2 May 2009): it was thus extended to the next day on which all the filing offices were open, namely Monday 4 May 2009 (Rule 134 EPC).

- 1.2 Rule 106 EPC requires, as a matter of admissibility of the petition under Article 112a EPC, that an objection in respect of the procedural defect be raised during the appeal proceedings and be dismissed by the Board , except where such objection could not be raised during the appeal proceedings.
- 1.3 The petitioner contends that during oral proceedings he was not aware, and could not foresee, that D28 would be regarded as experimental evidence in relation to the claims of the main and auxiliary requests rather than the strenuously argued possible prejudice. The only experimental evidence on file was that contained in two other documents filed by the patentee.
- 1.4 It is a matter of fact that the distinction on which the petition is based between D28 as evidence of "prejudice" and as "experimental evidence ", appeared for the first time in the decision. At least there is nothing leading the Enlarged Board to think that at some earlier point such a distinction was made. Thus, the exception mentioned in Rule 106 EPC seems to apply and this Board considers that the petition is at least not clearly inadmissible. The question whether the fact that the Board of Appeal stated that D28 was taken as experimental evidence and not as evidence of a prejudice deprived the opponent of an appropriate defence and violated its right to be heard is an issue regarding the substance and thus the allowability of the present petition.

2. *Allowability of the petition*

- 2.1 The petitioner contends that its right to be heard was violated and that the decision took it by surprise. In this respect, it relies on the assumption that its argumentation would have been different had the Board of Appeal, prior to or during the oral proceedings, drawn its attention to the fact that D28 would be regarded as experimental evidence and not as evidence of a prejudice. To dispute the merits of experimental evidence requires detailed arguments about the material facts which is not the case when the dispute is only about the existence or not of prejudice as a concept. The only arguments presented by both respondents in respect of D28 were related to its use as evidence of prejudice. In other words the petitioner alleges that the Board used D28 in an improper way and drew wrong information from it; this could have been avoided if the petitioner had known that D28 would be regarded as experimental evidence and been allowed to make the appropriate more detailed arguments.
- 2.2 However, the fact that the patentee considered D28 to be a crucial document was already clear from its grounds of appeal (see page 20 and seq), where it was discussed at length from paragraphs 72 to 84. In those paragraphs the patentee commented on the "detailed analysis of McMurry coupling reactions" described in D28, including the attempted heterocoupling of the 3-pyridyl ketone 14 and 15 yielding only 4% of the heterocoupled product. Respondent 1 replied at length, for instance on page 23 of its written submissions dated 21 December 2007 where i.a. it gave its view why

the heterocoupling reaction described in D28 was not surprising.

- 2.3 The question was also debated during the opposition proceedings. As the petitioner quoted in its petition (see paragraph 27), opponent I stated in its submissions of 4 August 2006 (page 14) that the examples cited by the patentee (in paragraphs 51 and 54 to 56 of its submissions of 1 August 2003) did not represent a prejudice because the reactions related to homocoupling and not to heterocoupling. It is also to be noted that in those paragraphs 51, 54 to 56 of its submissions of 1 August 2003, the patentee dealt with the reaction described in D28 (page 502) and explained in some detail why D28 suggests that the reaction would not proceed at all and why it was thus most surprising that the successful heterocoupling reaction occurs.
- 2.4 It is true that as a matter of vocabulary, the patentee used the word "prejudice". But it is equally true that it also submitted that what D28 was intended to prove was that the skilled person had no reasonable expectation of obtaining the McMurry reaction using the formula of the patent at issue. That D28 was discussed in detail under that angle is also evidenced by the fact that the patentee speaks of "the experimental results described in D28" (see paragraph 84 of the grounds of appeal).
- 2.5 Assuming for the sake of argument that D28 had been filed as evidence of technical prejudice in the meaning acknowledged by the case law (namely an opinion or a general preconceived idea widely and universally held by experts in that field), and that it was implicitly

obvious for the respondents that this could not be the case, it would none the less remain a fact that the document formed part of the debate, and was presented by the appellant as crucial.

Whatever the legal label allocated to this document, its contents were not a general concept but a description of a reaction which called for precise arguments- as was done in respondent 1's written submissions (see page 23 of its submissions dated 21 December 2007 and its previous submissions before the opposition division). Whatever D28 was called, challenging the correctness of its technical disclosure was a necessary step in order to dispute that its specific results could amount to an opinion generally shared by experts in this field. This approach was not inconceivable for the petitioner who objected to the fact that "the Patentee extends the specific results obtained by Newkome" to a prejudice against heterocoupling in general (see the last sentence of paragraph 26 of the petition). The fact that it might be obvious that the reaction in question did not amount to a technical prejudice did not mean that the evidence of the reaction as disclosed in D28 should not or could not have been challenged.

- 2.6 Because the change of the label put on D28 did not change the discussion to be held on it, the petitioner also cannot rely on T 18/81 (OJ 1985,166).
- 2.7 Insofar as the submissions of the petitioner may be understood as challenging the correctness of the decision of the Board of Appeal in its interpretation of D28 and in maintaining the patent in amended form as

a consequence of that interpretation, such a review would concern the question of the correct application of substantive law and is thus outside the scope of proceedings under Article 112a EPC.

3. It follows from the foregoing that it is evident that no fundamental violation of the right to be heard occurred during appeal proceedings. Since that was the only violation alleged, the petition has to be rejected as clearly unallowable.

For these reasons it is unanimously decided that:

The petition is rejected as clearly unallowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli