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Datum/Date
30.07.21

Zeichen/Reference/Référence	
SM1095P-EP	/ APPR
Anmeldung Nr./Application No./Demande n°//Patent Nr./Patent No./Brevet n°	12002626.5 / 2484209
Anmelder/Applicant/Demandeur//Patentinhaber/Proprietor/Titulaire	
Sumitomo Chemical Company, Limited	

Appeal number: T0116/18-3.3.02

Please find enclosed a copy of the minutes of the oral proceedings of 22.07.21.

The Registrar N. Maslin
Tel.: 089 / 2399 - 3321

Annex(es):

Registered letter

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Appeal number T0116/18-3.3.02

Patent No.: 2484209
Patent Proprietor: Sumitomo Chemical Company, Limited
Opponent: SYNGENTA LIMITED

Minutes of the oral proceedings

of 22 July 2021

Composition of the Board:

Chairman: M. O. Müller
Members: A. Lenzen
P. de Heij

Start of oral proceedings: 09:20 hours
End of oral proceedings: 17:10 hours

The oral proceedings were held by videoconference.

Present on behalf of the appellant (opponent) :
Mr A. Krebs, Mr D. Trösch and Mr F. de Corte, professional representatives.

Present on behalf of the respondent (patent proprietor):
Mr K. Hasegawa and Mr J. Kaiser, professional representatives.

The chairman declared the oral proceedings open. He summarised the relevant facts as they appeared from the file.

The chairman ascertained the parties' opening requests.

The appellant requested:
-that the decision under appeal be set aside and the patent in suit be revoked in its entirety;
-that documents D21 and D22 not be taken into account to prove the alleged synergy;

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-that auxiliary request 1, filed with the letter dated 26 October 2016, and auxiliary requests 2 and 3, filed with the letter dated 22 June 2021, not be admitted into the proceedings;
-that document D24 not be admitted into the proceedings.

The respondent requested:
-that the appeal be dismissed, implying that the patent in suit be maintained as granted (main request);
-that, provided the main request is not allowable, the case be remitted to the opposition division for further prosecution;
-alternatively, that the patent in suit be maintained in amended form based on the sets of claims of the first auxiliary request, filed with the letter dated 26 October 2016, or the second or third auxiliary request, filed with the letter dated 22 June 2021;
-that figures 1 and 2, shown in the statement of grounds of appeal, as well as the discussion relating thereto, not be admitted into the appeal proceedings;
-that documents D21 and D22 be taken into account to prove the alleged synergy;
-that document D23 (in appeal denoted A023) not be admitted into the appeal proceedings;
-that document D24 be admitted into the appeal proceedings.

The respondent was invited to present their arguments concerning the issue of admission of figures 1 and 2 shown in the statement of grounds of appeal and the discussion relating thereto. The respondent referred to their written submissions and stated they did not have further comments. The chairman stated that the board had decided to admit figures 1 and 2, shown in the statement of grounds of appeal, and the discussion relating thereto into the proceedings.

Admission of document D23 was discussed. The appellant argued that the document was filed in response to the criticism of the opposition division of the data in document D9 and D10 and in response to the respondent's documents D21 and D22. The appellant underlined that carrying out the required experiments took considerable time and effort. The respondent argued that document

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D23 could have been filed in first instance and that the respondent had criticized the data in document D9 and D10 already in their letter dated 11 September 2017.

After a break for deliberation by the board, the chairman stated that the board had decided to admit document D23 into the proceedings.

The chairman turned to the respondent's request to admit document D24 into the proceedings. The appellant argued that no justification for filing the document at such a late stage of the proceedings was given, that the document was not relevant and that the respondent had not indicated the relevant passages. It also put forward that D24 was a post-published document and that its title strongly suggested that objections based thereon had to be driven by hindsight. The respondent referred to the justification on page 9 of their letter of 22 June 2021. The relevant parts of document D24 concerned figures 5 and 6.

After a break for deliberation by the board, the chairman stated that the board had decided not to admit document D24 into the proceedings.

The chairman stated that the appellant had explicitly stated in its statement of grounds of appeal that it did not wish the findings of the opposition division under Article 100(c) EPC to be reviewed in appeal. The appellant had nothing to add.

The chairman asked the appellant to present their arguments regarding the alleged lack of novelty of the claimed subject-matter of claim 1 of the main request in the light of documents D4 and D8. The appellant referred to their written submissions. The chairman then expressed the view of the board that the claimed subject-matter was novel.

The appellant was asked for their arguments concerning sufficiency of disclosure of the claimed subject-matter. The appellant again referred to their written submissions. The chairman then expressed

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the view of the board that Article 100(b) EPC did not prejudice the maintenance of the patent as granted.

The chairman subsequently turned to the issue of inventive step of the subject-matter of claim 1 of the main request, starting from document D4 as the closest prior art. The chairman stated that, now that the appellant had requested that the data in documents D21 and D22 not be taken into account for the assessment of the alleged synergistic effect, it seemed first of all relevant to decide on whether the data in documents D21 and D22 were decisive for the outcome of the present case. However, the parties were free to also discuss further aspects concerning intentive step. The appellant requested a short adjournment for deliberation, which was allowed.

The appellant argued in essence that the data in the patent and, if taken into account, in documents D21 and D22 were insufficient to make a synergistic effect over the full ambit of the claim credible. This was even more so in view of the experimental results reported in documents D9, D10 and D23. As thus the respondent could not rely on the alleged synergistic effect, the objective technical problem was no more than the provision of an alternative insecticide composition. The solution, the combination of two components, both known in the prior art to have insecticidal activity, was not inventive. Even if the board considered documents D21 and D22 of relevance, they could not be taken into account for the assessment of inventive step because the data in the application as filed did not make it plausible that a synergistic effect occurred over the extremely broad scope of the claim.

The respondent argued in essence that there was no scientific reason to doubt the synergistic effect of the composition over the full scope of the claim. The data in documents D21 and D22 corroborated this effect. It was up to the appellant to prove that the effect was not achieved over the full scope of the claim. The data in documents D9, D10 and D23 were invalid and insufficient to provide such proof. The experiments of the appellant only concerned certain specific insects. The appellant had not tested the claimed composition against *Chilo suppressalis*, for which species

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synergistic activity was shown in experiment 4 in document D21. The objective technical problem had therefore in any case to take into account a synergistic effect. Even if the objective technical problem was the provision of an alternative, the solution of the patent was still not obvious.

In the course of their submissions, the respondent presented a spreadsheet containing data reported in document D23 to show that allegedly similar concentrations of test compounds resulted in very different death rates. The appellant requested not to admit the defence based on this spreadsheet into the proceedings for the reason that it should have been filed earlier. The respondent argued that the defence was admissible as it concerned only a further argument and no new facts were introduced.

After a break, the chairman noted that as far as the species that was tested in experiment 4 of document D21 was concerned, no counter-evidence was provided and that also the species of test example 2 in the patent seemed to not have been tested by the appellant. Taking D21 and D22 into account, the objective technical problem could therefore possibly be considered as the provision of a composition that showed synergistic effect against the particular species.

The parties were invited to make further observations. The appellant argued that the specific species of test example 2 had not been available when setting up the experiments but that a very closely related species was used.

The chairman announced a break for deliberation by the board concerning inventive step and the possible need for a referral to the Enlarged Board of Appeal (further: EBA) as announced in the board's communication. Both parties requested the board to indeed refer questions concerning the disputed requirement of the plausibility of a certain technical effect in the patent application.

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After resumption, the chairman expressed the view of the board that the respondent's defence that the data of document D23 showed very different results for similar amounts of test compounds was not convincing. There was therefore no need to decide on the admission of the respondent's defence. Furthermore, the issue of whether the data in post-published documents D21 and/or D22 could be taken into account for the assessment of inventive step was decisive for the decision on allowability of the main request. The board agreed with the parties that there was a need to refer questions to the EBA.

Next the chairman presented the following provisionally formulated questions to the parties:

If for acknowledgement of inventive step the patent proprietor relies on a technical effect and has submitted data or other evidence to proof such effect, such data or other evidence having been generated only after the priority or filing date of the patent (post-published data):

1. *Should an exception to the principle of free evaluation of evidence (see e.g. G 1/12 reasons 31) be accepted in that the post-published data must be disregarded on the ground that the proof of the effect rests **exclusively** on such post-published data?*

2. *If the answer is yes (post published data must be disregarded if the proof of the effect rests exclusively on these data): can post-published data be taken into consideration if based on the information in the patent application the skilled person at the relevant date would have considered the effect plausible (ab initio plausibility)?*

3. *If the answer to the first question is yes (post published data must be disregarded if the proof of the effect rests exclusively on these data): can post-published data be taken into consideration if based on the information in the patent application the skilled person at the relevant date would*

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have seen no reason to consider the effect implausible (ab initio implausibility)?

After a break to allow the parties to consider these questions, the chairman asked the parties for their views. The appellant suggested that the questions should define the effective date more clearly, for example in case of the patent invoking the right to priority. It also had to be clarified that the effect on which the patent proprietor relied concerned the full ambit of the claim. The respondent suggested that an additional question should address the burden of proof of the occurrence or absence of the technical effect.

The chairman stated that the proceedings would be continued in writing and that the board would consider the points the parties had raised regarding the questions to be referred. The next step in the proceedings would most likely be the written decision referring questions to the EBA. The chairman noted that the board could not exclude that the answers to the questions could be relevant also to the issue of whether the data in document A023 (D23) could be taken into account. However, after the decision of the EBA, the parties would be given the opportunity to address the consequences of the decision for the present case.

Asked by the chairman, the parties confirmed their opening requests.

The chairman asked the parties if they had any further comments or observations. They had none.

The chairman then closed the debate and the oral proceedings.

The Minute Writer: The Chairman:

P. de Heij M. O. Müller

Minutes electronically authenticated

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