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**Datasheet for the decision
of the Enlarged Board of Appeal
of 29 August 2012**

Case Number: R 0003/12
Appeal Number: T 0626/08 - 3.3.02
Application Number: 01952097.2
Publication Number: 1401438
IPC: A61K 31/4355, A61P 35/00
Language of the proceedings: EN

Title of invention:

Use of cyclopamine in the treatment of basal cell carcinoma and other tumors

Patentee:

Tas, Sinan

Opponent:

Curis, Inc.

Headword:

-

Relevant legal provisions:

EPC Art. 21(4)a), 112a(2)c) and (4), 113
EPC R. 104, 106, 107(2), 109(2)a)
RPBA Art. 13

Keyword:

"Submissions with respect to Art. 113 EPC not substantiated"
"Petition for review clearly inadmissible"

Decisions cited:

R 0016/09, R 0010/09

Catchword:

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Case Number: R 0003/12

D E C I S I O N
of the Enlarged Board of Appeal
of 29 August 2012

Petitioner: Tas, Sinan
(Applicant) S.H. Tuncel Caddesi No. 36
Ahmet Kuddusi Mahallesi
Bor 51700 (TR)

Representative: -

Other Party: Curis, Inc.
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Representative: von Uexküll - Guldenband, Alexa
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Decision under review: **Decision of the Technical Board of Appeal
3.3.02 of the European Patent Office of
28 September 2011.**

Composition of the Board:

Chairman: W. Van der Eijk
Members: M. J. Vogel
A. S. Clelland

Summary of Facts and Submissions

- I. This petition for review lies from the decision of Technical Board of Appeal 3.3.02 in case T 626/08 given on 28 September 2011. By this decision the appeal of the proprietor of European patent No. 1 401 438 against the decision of the Opposition Division of 14 March 2008 revoking the patent inter alia because of added subject matter pursuant to Art. 123(2) EPC was dismissed. The title of the patent is "Use of cyclopamine in the treatment of basal cell carcinoma and other tumors". The contested decision was posted on 18 January 2012 and received on 31 January 2012. The petition was filed on 30 March 2012 and the prescribed fee paid on the same day.
- II. In the contested decision the Board held that the patent as granted and in the versions of auxiliary requests 1 to 3 contained subject-matter which extended beyond the content of the application as filed and therefore did not meet the requirements of Article 123(2) EPC. According to the established case law of the Boards of Appeal, Article 123(2) EPC stipulates that the European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the originally filed application. This content only encompasses what the skilled person can directly and unambiguously deduce from the explicit and implicit disclosure of the application as filed.
- III. According to the Board the feature "for obtaining decreased size ... of a tumor" did not appear in the original application, which mentioned only "clinical

regressions of the BCCs" and "rapid regressions of the cyclopamine-treated BCCs". These features were not however equivalent to the said feature in claim 1 of all requests. The feature "for obtaining decreased size ... of a tumor" had no basis in the application as filed insofar as the treatment described there, even if it were successful, did not necessarily result in a decreased size of the tumor, which was disclosed in the application as filed only in connection with BCCs.

The same was true with respect to the feature "for obtaining ... disappearance of a tumor" in claim 1, because the visual disappearance of several tumor areas was not equivalent to the disappearance of the tumor in toto, and said passage also concerned BCCs, which could not be directly and unambiguously generalised to any tumor employing hedgehog/smoothened signalling for the prevention of apoptosis and/or for the prevention of differentiation of tumor cells. Furthermore the application as filed did not provide a basis for that feature in figures 2A or 2B, because those figures related to a method of treatment comprising surgical excisions in combination with the administration of cyclopamine, which could not be directly and unambiguously extended to a method of treatment with cyclopamine without surgery.

The modifications made in the auxiliary requests 1 - 3 were mutatis mutandis not suitable to overcome the objections raised against the main request with the consequence that the Board dismissed the appeal.

IV. In the grounds of the petition for review the petitioner submits that the contested decision of the

Board is "clearly flawed and contravenes the directly pertaining scientific facts". As the Board failed to understand the technical issues pointed out during the appeal proceedings it arguably did not consist of two "technically qualified members" in the sense of Article 21(4)a) EPC. Therefore a fundamental procedural violation of Article 113 EPC occurred. In the reasoned statement of the petition, the petitioner argued in detail why the Board was wrong to hold that the patent in suit did not comply with the requirements of Article 123(2) EPC.

Reasons of the Decision

Admissibility

1. A petition for review pursuant to Article 112a(4) EPC shall be filed in a reasoned statement setting out the grounds within a time limit of two months after the notification of the contested decision if the petition is based on paragraph 2(a) to (d) of Article 112a EPC. This is the case here. The petitioner filed his petition based on the ground of a violation of his right to be heard according to Articles 112a(2)c) and 113 EPC on 30 March 2012 i.e. within two months after the notification of the decision under review on 31 January 2012.

2. Rule 107(2) EPC prescribes that the petition shall indicate the reasons for setting aside the decision of the Board of Appeal and the facts and evidence on which the petition is based. These requirements are not met for the following reasons.

2.1 The petitioner refers in his petition to Articles 112a(2)c) and 113 EPC as the ground for his petition. However, there is no reasoning in the grounds of his petition indicating why his right to be heard under Article 113 EPC has been violated and on which facts his objection is based. He only points out, obviously with respect to Rule 106 EPC, that he became aware of the grounds of the decision through the written decision of the Board of Appeal. Since in his view this decision is clearly flawed, he argues that he did not have any opportunity to explain why the Board erred in its decision, except through the current petition (p. 1 last para. of the petition).

He explains in some detail why in his view the decision under consideration was wrong. He also raises the objection that the apparent failure of the Board of Appeal to understand the scientific facts discussed during the appeal proceedings contravened the "technically qualified" requirement of Article 21(4)a) EPC.

2.2 It is established case law of the Enlarged Board of Appeal that a petition for review does not open a further instance of appeal, but only provides the right for a restricted judicial review founded on a limited number of grounds which are exhaustively defined in Article 112a(2) and Rule 104 EPC (see R 16/09 of 19 May 2010, points 2.3.5 and 2.3.6 of the reasons; and R 10/09 of 22 June 2010, point 2.4. of the Reasons).

2.3 Thus, a petition for review may not be filed on the ground that, as the petitioner submits, a decision is

wrong in substance or that a member of a Board did not understand the appellant's case and was therefore not qualified technically. According to the restricted number of grounds for a petition according to Article 112a EPC it is not the duty of the Enlarged Board to scrutinise the contested decision as to whether its reasoning is convincing or not.

2.4 Furthermore, even if for the sake of argument it were to be established that a decision was based on an imperfect understanding of the technical issues, this has no implications for the technical qualifications of the board members in the sense of Article 21 EPC, since this provision only implies a prescribed course of technical education of the members rather than providing a guarantee of an unquestionable understanding of a specific case.

2.5 Finally the Enlarged Board would state that after the closure of the debate before the Board of Appeal a violation of the right to be heard can only occur if the contested decision is based on new facts which have not been discussed during the appeal proceedings. In this case, however, the petitioner does not in fact argue that his right to be heard has been violated during the oral proceedings or that new facts have influenced the decision under review. On the contrary, he actually refers to the reasons pointed out during the appeal proceedings.

2.6 Thus, there are no facts whatsoever submitted in the grounds of the petition which could support the legal ground that the petitioner's right to be heard has been violated. The arguments with respect to the correct

understanding of the technical issues of the petitioner's invention and its possible misunderstanding by the Board of Appeal in the contested decision are not relevant in petition proceedings under Article 112a EPC. As further facts and arguments are excluded when filed after the two months time limit under Article 112a(4) EPC the petition has to be considered as not reasoned in the sense of said provision.

3. The Enlarged Board considers that the defect of the petition cannot be remedied. For that reason a communication pursuant to Article 13 of the Rules of Procedure of the Enlarged Board of Appeal is not expedient and, as oral proceedings were not requested, a decision in writing is appropriate.

Thus, the Enlarged Board in a composition according to Rule 109(2)a) EPC comes unanimously to the conclusion that the petition is to be rejected as clearly inadmissible.

Order

For these reasons it is decided that:

The petition for review is rejected as clearly inadmissible.

The Registrar:

The Chairman:

W. Crasborn

W. Van der Eijk