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**Datasheet for the decision  
of 27 April 2007**

**Case Number:** T 0265/03 - 3.3.02

**Application Number:** 96924081.1

**Publication Number:** 0840610

**IPC:** A61K 31/445

**Language of the proceedings:** EN

**Title of invention:**

Composition comprising D-threo-methylphenidate and another drug

**Applicant:**

Celltech Pharma Europe Limited

**Opponent:**

-

**Headword:**

Pharmaceutical composition/CELLTECH PHARMA EUROPE LIMITED

**Relevant legal provisions:**

EPC Art. 67, 68(2)

**Keyword:**

"Decision on the state of the file (no)"  
"Substantial procedural violation (yes)"  
"Reimbursement of appeal fee (yes)"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0265/03 - 3.3.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.02  
of 27 April 2007

**Appellant:** Celltech Pharma Europe Limited  
208 Bath Road  
Slough,  
Berkshire SL1 3WE (GB)

**Representative:** Perry, Robert Edward  
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7 Eldon Street  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 10 October 2002  
refusing European application No. 96924081.1  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** J. Riolo  
J. Willems

## Summary of Facts and Submissions

I. This is an appeal from the refusal of European patent application 96 924 081.1.

II. The relevant first instance file history can be summarised as follows:

(a) In a first communication issued pursuant to Article 96(2) EPC and dated 4 October 1999 the Examining Division raised objections under Articles 52(4), 52(2), 56 and 84 EPC with respect to the set of 11 claims as published to which the applicant replied with counterarguments by its letter dated 28 April 2000 and accepted that claims 10 and 11, relating to a method a treatment be deleted.

(b) In a second communication dated 14 September 2000 the Article 52(4) EPC objection was dropped, but the objections under Articles 54 and 56 EPC, and under Article 84 were maintained.

(c) The applicant was summoned by the Examining Division on 3 May 2002 to attend oral proceedings scheduled for 12 September 2002 in order to deal with the objections raised by the Examining Division in the September communication towards claims 1 to 9 of the set of claims as published.

(d) On 7 August 2002 the applicant filed a main request corresponding to claims 1 to 9 as published and seven auxiliary requests numbered 1 to 7. On the basis of supporting arguments he maintained that the amended application could be allowed and requested a decision

based on the state of the file. It also informed the Examining Division that it would not be represented at the oral proceedings.

(e) On 12 September 2002, oral proceedings were held before the Examining Division in the absence of the applicant and the Examining Division decided to reject the application.

III. The grounds for the decision of the examining division read in full:

"In the communication(s) dated 14.09.2000, 20.09.2002 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 07.08.2002.

The application must therefore be refused."

The communication dated 20.09.2002 is in fact a copy of the minutes of the oral proceedings of 12 September 2002, it appears that, during the oral proceedings, the main request was considered unclear under Article 84 EPC and that the Examining Division considered auxiliary requests 1 to 5 to be novel but not inventive. Auxiliary requests 6 and 7 were not examined.

- IV. The appellant lodged an appeal against this decision and relied on the arguments presented with its letter dated 7 August 2002.
- V. By its letter dated 26 March 2007, the appellant withdrew its request for oral proceedings.
- VI. By a communication dated 24 April 2007, the Board informed the appellant that the oral proceedings were maintained.
- VII. Oral proceedings were held on 27 April 2007 before the Board.
- VIII. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the main request or alternatively, one of the auxiliary requests 1 to 7, all filed with letter dated 5 February 2003.

### **Reasons for the Decision**

- 1. The appeal is admissible.
- 2. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first instance department. A reasoned decision issued by the first instance department meeting the requirements of Rule 68(2) EPC is accordingly a prerequisite for the examination of the appeal pursuant to Article 108 EPC.

3. In the present case the examining division refused the application in response to a request for a decision "on the status of the file". The Guidelines for Examination in the EPO (June 2005) E-X 4.4, state: "Applicants may request a decision 'on the file as it stands' or 'according to the state of the file', eg when all arguments have been sufficiently put forward (sic) in the proceedings and the applicant is interested in a speedy appealable decision. In such a case, the decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision."
  
4. In the present case it is clear that the applicant's request of 7 August 2002 for a decision "on the status of the file" was only a waiver of his right under Article 113(1) EPC to an opportunity to present comments on the reasons for a likely refusal, such waiver being in accordance with his expressed intention not to comply with the summons to oral proceedings.
  
5. The dates inserted by the Examining Division in the form text of the decision under appeal here are those of the communication from 14 September 2000 and the communication dated 20.09.02 corresponding to the minutes of the oral proceedings of 12 September 2002.

The minutes of the oral proceedings do however not mention auxiliary requests 6 and 7 at all. The decision of the examining division cannot therefore be considered to be a reasoned decision within the meaning of Rule 68(2) EPC, in the sense that it was not reasoned in relation to the subject-matter **on file**, ie the applicant's latest request.

6. The applicant requested a decision on the state of the file. Such a request is not to be construed as a waiver of the right to a fully reasoned first instance decision. As a matter of fact, the "state of the file" is not restricted to those documents on file which were issued by the EPO, but also includes all those documents and arguments which were filed by the applicant prior to (or even simultaneously with) his request for a decision "on the status of the file".

Therefore, it is clear that the request of the applicant encompassed all the requests 1 to 7 which were filed with the letter of 7 August 2002.

7. In the judgement of the board, neither did any other statement of the applicant imply a waiver of his right to a reasoned decision for all its requests and against all its arguments, and in any case the Examining Division would have been under no obligation to comply with such a request, even if it contained an explicit waiver. The examining division was in particular not obliged to restrict itself to a decision by reference refusing the "standard form" when the necessary reasons in relation to the latest filed claims had not been formulated in any document on file. The examining division was however obliged by Rule 68(2) EPC to issue a decision presenting all the legal and factual reasons for refusing the application.
8. The duty to provide reasons in administrative decisions is a fundamental principle in all contracting States, Rule 68(2) EPC being simply an expression of this principle. Further, from the point of view of the

practical functioning of the system envisaged in the EPC, absent a reasoned decision within the meaning of Rule 68(2) EPC the Board cannot examine the appeal (Article 110 EPC).

9. In accordance with the established jurisprudence of the Boards of appeal, the case is remitted to the department of first instance for further prosecution.

The appeal is allowed insofar as the decision under appeal is set aside and the appeal fee is reimbursed pursuant to Rule 67 EPC by reason of the substantial procedural violation constituted by non-compliance with Rule 68(2) EPC. Indeed it would be inequitable to make the appellant pay a fee to appeal against a decision which is to be treated as never having been made since not all auxiliary requests have been dealt with.



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

A. Townend

U. Oswald