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D E C I S I O N
of 24 June 2004

Case Number: T 0276/04 - 3.3.8

Application Number: 95921454.5

Publication Number: 0833904

IPC: C12N 15/12

Language of the proceedings: EN

Title of invention:
Fibroblast growth factor-14

Applicant:
Human Genome Sciences, Inc.

Opponent:
-

Headword:
Fibroblast growth factor/Human Genome Science

Relevant legal provisions:
EPC Art. 111(1)
EPC R. 68(2), 67, 86(3)

Keyword:
"Decision reasoned in the sense of Rule 68(2) EPC (no)"
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:
T 0278/00, T 0897/03

Catchword:
-



Case Number: T 0276/04 - 3.3.8

D E C I S I O N
of the Technical Board of Appeal 3.3.8
of 24 June 2004

Appellant: Human Genome Sciences, Inc.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 September 2003
refusing European application No. 95921454.5
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: M. R. Vega Laso
S. C. Perryman

Summary of Facts and Submissions

I. European patent application No. 95 921 454, published as international application WO 96/39506 (EP A 0 833 904) with the title "Fibroblast growth factor-14", was refused by the examining division by a decision pursuant to Article 97(1) EPC dated 18 September 2003. The claims then on file were claims 1 to 23 as filed by the applicant's representative with letter of 8 November 2002.

II. The grounds for the decision of the examining division read:

"In the communication(s) dated 06.08.2001, 03.05.2002 and 29.04.2003 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 last communication but requested a decision according to the state of the file by a letter received in due time on 04.08.2003.

The application must therefore be refused."

III. In its first communication dated 6 August 2001, the examining division had raised objections to claims 1 to 22 as then on file on the grounds of Articles 123(2), 54, 83 (in combination with Article 84 EPC), 56, 57 and 84 EPC. Furthermore, the examining division indicated that the subject-matter of claims 13, 14, 18 and 22 (completely) and of claims 15 and 17 (partially) had

not been searched and that, therefore, no examination could be carried out for these claims.

- IV. With its response to the communication of the examining division the present appellant filed a new set of claims (claims 1 to 23) in which claims 1, 8, 9, 13 and 14 of the previous request had been amended and a new claim 23 introduced. The issues raised by the examining division in its communication were addressed in detail in the response.
- V. In a subsequent communication dated 3 May 2002, the examining division maintained its objection on the grounds of Article 123(2) EPC and provided additional arguments in support thereof. The previous objections under Articles 54, 83, 56 and 57 EPC were also maintained and reinforced by new arguments. With respect to the new claim 23, the examining division considered that the insufficient disclosure of the subject-matter of this claim did not allow a meaningful search, just as for claims 13 to 15, 17 to 18 and 22. With regard to Article 84 EPC, the objection raised in point 8.4. of the previous communication concerning claim 19 was maintained, but no explicit statement was made with respect to the objections raised in points 8.1. to 8.3. and point 8.5. of the previous communication, which affected *inter alia* claims that had not been amended in response to the first communication.
- VI. In reply to this communication, the appellant submitted with letter dated 8 November 2002 a new set of claims (claims 1 to 23) in which claim 14 had been deleted and new claims 18 and 19 based on the subject-matter of

previous claim 19 had been introduced. Additionally, claims 1, 13, 16, 22 and 23 (corresponding to previous claims 1, 13, 15, 17, 22 and 23) had been amended. New documents were filed in support of the case.

VII. In a third communication dated 29 April 2003, which was attached to the summons to attend oral proceedings pursuant to Rule 71(1) EPC, the examining division maintained the objections raised previously under Articles 123(2), 54, 83 (in combination with Article 84 EPC), 56 and 57 EPC, providing additional argumentative support. No specific objections on the grounds of Article 84 EPC were raised, but clarity issues were considered in connection with Article 54 EPC (novelty) and Article 83 EPC (sufficiency of disclosure).

VIII. With letter of 4 August 2003, the appellant withdrew its request for oral proceedings and requested a written decision on the basis of the submissions filed previously during the examination of the application. The examining division then issued a decision pursuant to Article 97(1) EPC refusing the application (see sections I and II *supra*).

IX. On 6 October 2003, the appellant lodged an appeal against the decision of the examining division. With the statement of grounds of appeal filed on 22 January 2004 the appellant submitted a new main request (claims 1 to 24) and, additionally, an auxiliary request (claims 1 to 22). Claims 1 to 24 of the main request differed from the claims on the basis of which the application had been refused, essentially in that claim 1 had been amended and a new claim 24

introduced. The auxiliary request differed from the main request in that claim 24 had been omitted and claims 22 and 23 replaced by a new claim 22.

- X. The appellant requested that the decision of the examining division be set aside and a patent be granted on the basis of the main request or the auxiliary request. As a subsidiary request oral proceedings were requested.

Reasons for the Decision

1. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC, and is admissible.
2. Rule 68(2) EPC states that decisions of the European Patent Office which are open to appeal must be reasoned. In the present case the decision subject to appeal does not include any facts, evidence or arguments that justify the refusal of the application, but merely refers to the reasons provided in three communications issued by the examining division in the course of the examination of the application. Each of these communications had as basis a different set of claims filed by the appellant in response to the respective preceding communication.
3. In decision T 0897/03 of 16 March 2004 it was held by this board that a decision that leaves it to the appeal board and the appellant to speculate as to which of the reasons given by the examining division in different communications might have been decisive for the refusal of the application, cannot be considered to meet the

requirements of Rule 68(2) EPC. In the board's judgement, in order for a decision to be reasoned within the meaning of Rule 68(2) EPC it must clearly specify which of the claims - and, if necessary, in which version - is considered to encompass subject-matter that does not fulfil the requirements of the EPC, and must also contain the grounds upon which the decision is based and a discussion of all decisive considerations in respect of the factual and legal aspects of the case (see also T 0278/00, OJ EPO 2003, 546).

4. Since the *de facto* absence of reasoning in the appealed decision amounts to a substantial procedural violation (see decision T 0897/03, *supra*), the decision under appeal must be set aside and the case remitted to the first instance in application of Article 111(1) EPC. Exercising its discretion under Rule 86(3) EPC, the board decides to admit into the proceedings the two sets of claims according to the main request and the auxiliary request as filed by the appellant with the statement of grounds of appeal on 22 January 2004. The case is thus remitted to the examining division for further prosecution on this basis.

5. The appeal being deemed allowable, it is considered to be equitable by reason of the substantial procedural violation incurred to reimburse the appeal fee (Rule 67 EPC). As the appellant's request that the appealed decision be set aside has been granted, there is no need to hold oral proceedings before the board in accordance with its subsidiary request.

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 on the basis of claims 1 to 24 of the main request and claims 1 to 22 of the auxiliary request as filed on 22 January 2004.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani