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**Datasheet for the decision
of 1 February 2008**

Case Number: T 0278/07 - 3.3.02

Application Number: 02007128.8

Publication Number: 1243272

IPC: A61K 31/66

Language of the proceedings: EN

Title of invention:

Crystalline amifostine compositions and methods for the
preparation and use of same

Applicant:

Medimmune Oncology, Inc.

Opponent:

-

Headword:

Amifostine compositions/MEDIMMUNE ONCOLOGY, INC.

Relevant legal provisions:

EPC Art. 110
EPC R. 111(2), 103

Relevant legal provisions (EPC 1973):

EPC Art.

Keyword:

"Procedural violation - yes: objection not substantiated"
"Reimbursement of appeal fee - yes"

Decisions cited:

-

Catchword:

-



Case Number: T 0278/07 - 3.3.02

DECISION
of the Technical Board of Appeal 3.3.02
of 1 February 2008

Appellant: Medimmune Oncology, Inc.
One Tower Bridge
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West Conshohocken, PA 19428 (US)

Representative: Elend, Almut Susanne
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 September 2006
refusing European application No. 02007128.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
J. Van Moer

Summary of Facts and Submissions

I. This is an appeal from the refusal of European patent application 02 007 128.8, which is a divisional application from the earliest European application No. 93 918 552.6 (in the following this application will be referred to as the parent application), on the grounds that this divisional application contained subject-matter which had already been granted in the parent application.

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 22 April 2005 the Examining Division raised objections with respect to the set of 28 claims as filed.

This communication reads:

"1. The present application is a divisional application of EP-B-O 655 917.

Reference is made to the Guidelines C-VI, 9.6. The subject-matter which has already been granted should be removed from the present application, whilst ensuring that no subject-matter is added with respect to the present filing and the parent filing (Art. 76 and 123(2) EPC).

2. Reference is also made to the objections raised during the prosecution of EP-A-0655 917 against the presently-claimed subject-matter: these objections are upheld."

The applicant replied by letter of 9 February 2006. In its letter it requested the Examining Division "to clarify its objection and to indicate exactly which subject-matter the Examining Division considers to be present in the claims of the present divisional application and in the claims of the parent patent".

It further observed that the "objections raised during the prosecution of EP-A-0655 917 against the presently-claimed subject-matter" were not further elaborated in the Examining Division's communication. Therefore the appellant assumed that they might concern lack of clarity against claim 1, and it filed four pages of arguments in that respect.

(b) In a second communication dated 24 March 2006, the applicant was summoned to attend oral proceedings scheduled for 14 September 2006 in order to deal with the objections raised by the Examining Division in the April 2005 communication. In this communication, the Examining Division expressed its view as to the legal basis for refusing double patenting.

(d) On 11 September 2006, the appellant informed the Examining Division that it would not be attending the oral proceedings and requested a decision on the applicant's written submissions.

(e) On 15 September 2006, the Examining Division issued the decision to reject the application.

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

"In the communication(s) dated 22.04.2005, 24.03.2006 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 11.09.2006.

The application must therefore be refused."

- IV. The appellant lodged an appeal against this decision.

- V. The appellant requested that the Examining Division's decision be set aside and that the case be remitted to the Examining Division. It also requested a refund of the appeal fee and oral proceedings in the event that the Board did not intend to allow its requests.

Finally, it requested that the question of double patenting be referred to the Enlarged Board of Appeal in the event that the Board envisaged maintaining the Examining Division's refusal of the present application for double patenting.

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 111(2) EPC is accordingly mandatory.

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', e.g. 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. The examining division however remains obliged by Rule 111(2) EPC to issue a decision presenting all the legal and factual reasons for refusing the application.

This includes the obligation to provide an adequate and complete answer to all submissions.

In that respect, the Board observes that the first communication of the Examining Division dated 22 April 2005 does not in any way define the subject-matter which leads to double patenting (see point II.a) above).

Despite the appellant's invitation to do so (see appellant's reply dated 9 February 2006, page 2, first paragraph), the second communication of the Examining Division dated 24 March 2006 does not contain any information in that respect either.

This second communication is moreover also deficient because it does not provide any reasoning whatsoever as to why the extensive argumentation of the appellant with respect to the assumed clarity objection might or might not be correct (see point II.a) above, last paragraph).

5. The duty to provide reasons in administrative decisions is a fundamental principle in all contracting states, Rule 111(2) EPC simply being an expression of that principle. Further, from the point of view of the practical functioning of the system envisaged in the EPC, in the absence of an adequately reasoned decision within the meaning of Rule 111(2) EPC the Board cannot examine the appeal as to its merits (Article 110 EPC).
6. In accordance with the established case law of the boards of appeal, the case is remitted to the department of first instance for further prosecution.

The appeal is allowed to the extent that the decision under appeal is set aside and the appeal fee is reimbursed pursuant to Rule 103 EPC on account of the substantial procedural violation constituted by non-compliance with Rule 111(2) EPC.

7. Under these circumstances, the appellant's request that the question of double patenting be referred to the Enlarged Board of Appeal in the event that the Board envisages maintaining the Examining Division's refusal of the present application for double patenting is not relevant.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

A. Townend

U. Oswald