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**Datasheet for the decision  
of 25 March 2010**

**Case Number:** T 1226/07 - 3.3.02

**Application Number:** 01204601.7

**Publication Number:** 1213017

**IPC:** A61K 31/00

**Language of the proceedings:** EN

**Title of invention:**

Use of a 5-HT<sub>2C</sub> receptor agonist for the treatment of hot  
flushes

**Applicant:**

N.V. Organon

**Opponent:**

-

**Headword:**

5-HT<sub>2C</sub> receptor agonist for hot flushes/ORGANON

**Relevant legal provisions:**

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**Relevant legal provisions (EPC 1973):**

EPC Art. 106(1), 113(2)

EPC R. 51(4), 67

**Keyword:**

"Appealable decision (no)"

"Reimbursement of appeal fee (yes), appeal at the utmost  
premature"

**Decisions cited:**

T 1181/04, T 0560/05

**Catchword:**

With respect to a communication under Rule 51(4) EPC 1973 dated 13 February 2007 and referring to EPO form 2004 01.06CSX instead of former EPO form 2004 07.02CSX, the board applies decision T 1181/04 of 31 January 2005, OJ EPO 2005, 312. The corresponding statement of T 1181/04 that a communication under Rule 51(4) EPC 1973 (now Rule 71(3) EPC 2000) is not intended to terminate the examination procedure but is rather a preparatory action and is therefore as such not appealable and consequently that an appeal against such a communication is normally to be considered inadmissible is confirmed (see point 1 of the decision).



Case Number: T 1226/07 - 3.3.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.02  
of 25 March 2010

**Applicant:** N.V. Organon  
Kloosterstraat 6  
NL-5349 AB Oss (NL)

**Representative:** Kraak, Hajo  
N.V. Organon  
Global Patent Department  
P.O. Box 20  
NL-5340 BH Oss (NL)

**Decision under appeal:** Communication under Rule 51(4) EPC 1973 of the  
Examining Division of the European Patent  
Office posted 13 February 2007.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** H. Kellner  
J.-P. Seitz

## Summary of Facts and Submissions

I. In an annex to a communication under Rule 51(4) EPC 1973, dated 13 February 2007, on EPO form 2004 01.06CSX, the examining division indicated that the main request based on European patent application No. 01 204 601.7 would be refused for lack of inventive step (Article 56 EPC).

The intention to grant a European patent concerned the auxiliary request submitted during oral proceedings of 3 October 2006.

II. By letter of 13 April 2007, the applicant lodged an appeal against the supposed decision of the examining division and filed grounds of appeal maintaining the main request and the auxiliary request as filed in the proceedings before the examining division. The appeal fee was duly paid on the same date.

III. Together with the summons to oral proceedings, dated 20 December 2009, the board set out its preliminary opinion with respect to Articles 83, 84, 54 and 56 EPC. With letter of 21 January 2010, the applicant filed four new sets of claims as main request and as first to third auxiliary requests replacing all previously filed requests.

Oral proceedings were scheduled to take place on 30 March 2010.

IV. In a further communication dated 17 March 2010, the attention of the applicant was drawn to the fact, that admissibility of an appeal fell to be assessed at any stage of the proceedings and that the board noted that the current appeal actually constituted a reply to a communication under Rule 51(4) EPC which under regular conditions did not constitute a final decision open to appeal (see decisions of the boards of appeal T 1181/04, OJ EPO 2005, 312 and T 560/05 of 31 July 2007, not published in the Official Journal).

It appeared to the board that the "notice of appeal" dated 13 April 2007 was to be understood as the applicant's reply that the main request was maintained - according to the third paragraph under the line "Total amount 750.00" on sheet 2 of the communication under Rule 51(4) EPC - and that the division consequently should have issued an appealable final decision based on non approval of the text of the auxiliary request being implicit.

V. With letter of 19 March 2010 the applicant requested referral of the application to the examining division in order to redress at least the formal defects in the decision. In addition, the applicant withdrew its request for oral proceedings before the board of appeal and informed the board that it would not attend oral proceedings on 30 March 2010.

VI. The applicant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution or that the proceedings before the board of appeal be continued in writing.

## Reasons for the Decision

### 1. *Admissibility of the appeal*

- 1.1 The communication of the examining division under Rule 51(4) EPC 1973, dated 13 February 2007, and the notice of appeal, dated 13 April 2007, were both issued before entry into force of EPC 2000 on 13 December 2007; therefore only the EPC 1973 is pertinent.

Rule 51 EPC 1973 implements the examination procedure established under Articles 96 and 97 EPC 1973. In particular, Rule 51(4) EPC 1973 stipulates that the examining division has to communicate to the applicant the text in which it intends to grant the patent and invite him to pay the fees and file the translation. According to the last sentence of this provision, the payment of the fees and the filing of the translation is considered to be implicit approval of the text proposed by the examining division.

The function of a communication under Rule 51(4) EPC 1973 is therefore to establish whether the applicant approves the proposed text of the patent as foreseen in Article 97(2)(a) and Article 113(2) EPC 1973.

If, after receiving the communication under Rule 51(4) EPC 1973, the applicant approves the version of the patent proposed by the examining division and fulfils the formal requirements for grant, the examining division issues a decision to grant according to Article 97(2) EPC 1973. If the applicant does not approve the text, the application is to be refused

according to Article 97(1) EPC 1973, since the EPC does not provide any other sanction in this case.

The way in which Rule 51(4) and Article 97(1) and (2) EPC 1973 operate indicates that a communication under Rule 51(4) EPC 1973 is not intended to terminate the examination procedure but is rather a preparatory action and is therefore as such not appealable. An appeal against a communication under Rule 51(4) EPC 1973 is therefore normally to be considered inadmissible (see T 1181/04 of 31 January 2005, OJ EPO 2005, 314, paragraphs 3 to 6).

- 1.2 In case the communication under Rule 51(4) EPC 1973 refers to an auxiliary request and, in an annex, the reasons why the main request or a higher ranking auxiliary request does not fulfil the provisions of the EPC are set out, the boards of appeal have acknowledged admissibility of an appeal, when EPO form 2004 07.02CSX was used (see decisions of the boards of appeal T 1181/04, OJ EPO 2005, 312, and T 560/05 of 31 July 2007, not published in the Official Journal).

The reasons were that in this form, the EPO removed from the appellant the possibility of influencing the procedure and obtaining a decision on the refusal of his higher ranking requests and of filing an appeal against it (see T 1181/04 of 31 January 2005, OJ EPO 2005, 322, paragraph 2, first sentence).

- 1.3 In the current case, however, decision T 1181/04 of 31 January 2005, was already more than two years old and thus deemed to be known, and EPO form 2004 01.06CSX was used which advised the applicant "If this

communication is based upon an auxiliary request, and you reply within the time limit set that you maintain the main or a higher ranking request that is not allowable, the application will be refused (Article 97(1) EPC, see also Legal Advice 15/05 (rev. 02), OJ EPO 6/2005, 357)".

Further it was set out that in other cases, **except those of this cited paragraph and one other paragraph**, if the relevant fees were not paid or the translation not filed in due time, the European patent application would be deemed to be withdrawn (emphasis added by the board).

Thus, in the case in suit the provisions covering exceptional admissibility of an appeal as reply to a communication under Rule 51(4) EPC 1973 are not fulfilled. In addition, the applicant has not raised any objection to the board's interpretation of events. Therefore, the board comes to the conclusion that the appeal is not admissible but rather premature.

## 2. *Reimbursement of the appeal fee*

- 2.1 Since the applicant, on 13 April 2007 filed a reply to the communication under Rule 51(4) EPC 1973 of 13 February 2007 setting out *inter alia* that it was requested to grant the patent according to the main request, it is clear that the provision expressed in the communication under Rule 51(4) EPC 1973 (see point 1.3 above) is fulfilled and the applicant is entitled to be notified by an appealable decision on its main request. Disapproval of the text of the auxiliary request as proposed for grant by the examining division is deemed to have been declared.



2.2 Consequently, proceedings before the examination division have to be continued on the basis of the applicant's letter of 13 April 2007. No formal decision adversely affecting the applicant was actually given. The appeal was therefore not necessary but at the utmost premature. Hence reimbursement of the appeal fee under Rule 67 EPC 1973 shall be ordered.

## **Order**

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

1. The appeal is rejected as inadmissible.
2. The case is remitted to the first instance for further prosecution on the basis of the reply of the applicant.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

N. Maslin

U. Oswald