

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 26 February 2008**

Case Number: T 1982/07 - 3.3.08

Application Number: 98922963.8

Publication Number: 0983349

IPC: C12N 15/10

Language of the proceedings: EN

Title of invention:

Nucleic acid binding polypeptide library

Applicant:

Gendaq Limited

Headword:

Polypeptide Library/GENDAQ

Relevant legal provisions (EPC 1973):

EPC Art. 113(2), 123(1)

EPC R. 86(3)

Keyword:

"Refusal of amendments as a substantial procedural violation
(yes)"

Decisions cited:

G 0007/93

Catchword:

See in particular point 4 of the Reasons.



Case Number: T 1982/07 - 3.3.08

DECISION
of the Technical Board of Appeal 3.3.08
of 26 February 2008

Appellant: Gendaq Limited
c/o Hale and Dorr
Alder Castle
10 Noble Street
London EC2V 7QJ (GB)

Representative: Weiss, Wolfgang
Weickmann & Weickmann
Patentanwälte
Kopernikusstrasse 9
D-81679 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 June 2007
refusing European application No. 98922963.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: C. Heath
F. Davison-Brunel

Summary of Facts and Submissions

- I. The appeal lies against the decision of the examining division of 27 June 2007 to refuse the European patent application 98922963.8 in the name of Gendaq Limited. Reason for the refusal was the fact that there was no approved request on file, Article 113(2) EPC, no consent having been given under Rule 86(3) EPC 1973 to the filing of amended claims.
- II. The priority application with the title "Nucleic Acid Binding Proteins" was filed with the British Patent Office on 23 May 1997. The subsequent PCT application of 26 May 1998 carried the title "Nucleic Acid Binding Polypeptide Library". The international search report cited three documents of which one was a document published prior to the international filing date but later than the priority date claimed. The PCT preliminary examination report mentioned certain shortcomings of the application, *inter alia* unclear wording of claims 7 to 25, and a possible lack of inventive activity of claims 1 to 6 with respect to Chu et al. (D1). After entry into the European phase, the first communication under Article 96(2) EPC merely made reference to the European search and examination reports and requested the applicant to file amendments accordingly. In response thereto, the applicant amended claim 7 and took the view that D1 did not disclose anything that would render the claimed invention obvious. In the following communication on 5 February 2004, the examining division drew the applicant's attention to the discrepancies between the priority and the PCT filings, and mentioned Islan et al (D2) as a document possibly destroying novelty or inventive step

for the subject-matter newly introduced by the PCT filing, namely the concept of a "library". In its response, the applicant argued that D2 did not anticipate any subject-matter now claimed.

III. In the next communication of 25 June 2004, the examining division introduced three new documents, D3-D5, and, *inter alia*, wrote the following:

"2. An extensive list of various documents exist in the prior art which deal with the preparation of zinc finger libraries. When taking into account that the feature which now should constitute the distinguishing or essential feature of claim 1 did not even form part of the original set of claims, it was certainly not possible for the search examiner to cite all relevant documents. Therefore it is necessary to introduce further relevant documents not yet cited in the Search report which are the following: [...] [...]"

3. The examining division would further like to draw Applicant's attention to the fact, that, in accordance with Rule 86(3) EPC, the introduction of features from the description into any independent claim will not (or no longer) be allowed."

The applicant in its response of 5 November 2004 particularly acknowledged the relevance of the newly introduced document D3 and in order to overcome novelty or inventive step objections in relation thereto, filed new claims 1 to 24 with the following justification:

"The amendments now made to new claims 1 to 24 filed herewith, are a proper and necessary response to the

highly relevant prior art document D3 which the Applicant only just became aware through further citation by the examiner in said Office Action. The Applicant, therefore, was only at the present stage in a position to request said amendments."

The examining division in its reply of 17 January 2005 refused leave to introduce these amendments under Rule 86(3) EPC 1973 and did not carry out a further examination based on these requests. However, it made some remarks regarding the amended claims in view of D3. On 27 May 2005, the applicant submitted new claims 1 to 22 of which 3 to 22 corresponded to claims 4 and 7 to 25 as originally filed. In the examining division's communication of 15 June 2005, leave to introduce these new claims was again refused under Rule 86(3) EPC 1973. The examining division further made some comments about the lack of unity, which new claims 2 and 3 would give if admitted and stated inter alia:

"However, in the present application, in accordance with item 3 of our letter dated 25 June 2004, only a (true) combination of the claims then on file will be allowed."

On 18 October 2005, the applicant submitted a new set of claims 1 to 24 and gave some explanations about these amendments, which concerned essentially only claim 1. Again, in further communication of 18 November 2005, leave for introducing new claims was refused by the examining division. In a further communication on 24 May 2006, the examining division maintained its position that "a prosecution on the basis of this set

of claims in the present application would not be accepted by the examination division under Rule 86(3) EPC." Said communication also summarised the proceedings so far. Once more, the examining division stressed the difference between what was claimed in the priority document and the PCT application. Thereupon, with letter of 18 August 2006, the applicant withdrew its request for oral proceedings and asked for a "decision with regard to the patentability of the present application based on claims 1 to 24 presently on file." As a consequence, the decision to refuse the application was issued on 27 June 2007.

IV. On 14 August 2007, the applicant filed an appeal and paid the corresponding appeal fee. The grounds of appeal were filed on 7 November 2007 and requested the decision under appeal to be set aside and the patent to be granted on the basis of claims 1 to 24 as filed on 18 October 2005, in the auxiliary to remit the case to the first instance to continue prosecution based on claims 1 to 24 as filed on 18 October 2005. Oral proceedings were requested in case neither the main nor the auxiliary request could be entertained. Apart from going into technical details of the documents D1-D3, the appellant noted "that the Examination Proceedings was not conducted on a fair basis, because the Applicant was not given a chance to amend the claims according to his discretion when confronted with three new prior art references." Based on this allegation of a substantial procedural violation, the appellant also requested reimbursement of the appeal fee.

V. On 16 November 2007, the examining division decided not to rectify the decision pursuant to Art. 109(1) EPC,

and the appeal was referred to the Boards of Appeal pursuant to Art. 109(2) EPC.

Reasons for the Decision

1. The appeal is admissible and well-founded.

2. The decision under appeal was based on the fact that no agreed text of the application was on file, Article 113(2) EPC. This was due to the examining division's refusal under Rule 86(3) EPC 1973 to give consent to the admission of further amendments to the claims. Under Article 123(1) EPC, a European patent application or a European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. Of the Implementing Regulations, Rule 86(3) EPC 1973 (now Rule 137(3) EPC 2000) is of particular relevance. Under this rule, "after receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend once the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division." The last sentence is of particular relevance here, since the applicant did indeed amend the application in the European phase. Thus, the amendments refused by the examining division were amendments under Rule 86(3) last sentence which depended upon the examining division's consent. In giving or withholding such consent, the examining division has to exercise its discretion responsibly and in accordance with the principles as set out in the

decision **G 7/93**, OJ EPO 1994, 775 which, although made in relation to amendments made in the pre-grant stage, are of general validity. As pointed out in point 2.5 of the Reasons for the decision, "in the exercise of its discretion under Rule 86(3) EPC, in the Enlarged Board's judgement an Examining Division is required to consider all relevant factors which arise in a case. In particular, it must consider both the applicant's interest in obtaining a patent which is legally valid in all of these designated States, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent, and must balance these interests against one another."

3. In the case at issue, the applicant was admonished for having made substantial amendments to the patent application. In fact, this was one of the main reasons why further amendments were not admitted. On a closer look, however, the substantial amendment was made between the priority application and the PCT application, rather than at any later stage. Already the PCT application claimed a "zinc finger library", and the PCT search and preliminary examination was based thereupon. The Board therefore finds it difficult to understand that the applicant is admonished for a change that was made before any examination had taken place. Thus, the "newly introduced feature" as mentioned by the decision under appeal (point 1.3 of the reasons) was not introduced after the PCT search and examination or after the entry into the European phase, but was present already in the PCT application.
4. But be this as it may, it is fundamental to the principles of a fair trial that, in examination, the

applicant when confronted with new prior art documents is not only given the right to be heard, but also the right to react thereto by amending the claims in order to overcome the prior art references. In the case at issue, both the examining division and the applicant took the view that the newly introduced document D3 was highly relevant prior art likely to prejudice the patentability of the application. When being confronted with such a highly relevant document, it would have been necessary to give the applicant the opportunity to amend the claims, if need be by introducing features of the description. It was therefore erroneous of the examining division to exercise its discretion in the way it did, as this did not allow the applicant to react appropriately, but rather tied its hands to an extent that was neither mandated by procedural efficiency nor justified in the light of the prior art documents cited. The examining division thus exercised its discretion in an unduly restrictive manner, thereby committing a substantial procedural violation.

5. Against this background, it would have been incumbent on the examining division to rectify the decision pursuant to Art. 109(1) EPC, and the Board has some difficulties in understanding why this was not done.

6. Claims 1 to 24 as filed on 18 October 2005 have not been examined as to unity, novelty, inventive step or any other requirements of patentability. For that reason, the Board finds it appropriate to remit the case back to the first instance for further prosecution. In view of the previous findings and for reasons of procedural fairness and impartiality, the Board orders

a remittal to an examining division that has not previously dealt with this case.

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, in particular to an examination division that has not previously dealt with this case, with the order to continue prosecution based on the set of claims 1 to 24 as filed on 18 October 2005.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani