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**Datasheet for the decision  
of 14 April 2011**

**Case Number:** T 0646/08 - 3.3.02

**Application Number:** 99203198.9

**Publication Number:** 972526

**IPC:** A61K 49/00

**Language of the proceedings:** EN

**Title of invention:**

Preparation of diagnostic agents

**Patentee:**

Quadrant Drug Delivery Limited

**Opponents:**

Eli Lilly and Company  
Advanced Inhalation Research Inc

**Headword:**

Conflicting procedural statements

**Relevant legal provisions:**

EPC Art. 68, 105a(2), 111(1), 113(2)  
EPC R. 82, 84(1)

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

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**Keyword:**

"Simultaneous withdrawal of the appeal and of the approval of the text of the patent as maintained - termination of appeal proceedings"

**Decisions cited:**

G 0008/91, G 0008/93, T 0073/84, T 0186/84, T 0237/86,  
T 0459/88, T 1544/07

**Catchword:**

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Case Number: T 0646/08 - 3.3.02

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.02**  
**of 14 April 2011**

**Appellant:** Quadrant Drug Delivery Limited  
(Patent Proprietor) 1 Mere Way,  
1 Ruddington  
Nottingham, NG11 6JS (GB)

**Representative:** Bassett, Richard Simon  
Potter Clarkson LLP  
Park View House  
58 The Ropewalk  
Nottingham, NG1 5DD (GB)

**Respondent 01:** Eli Lilly and Company  
(Opponent 01) Lilly Corporate Center  
Indianapolis IN 46285 (US)

**Representative:** Hiscock, Ian James  
Eli Lilly and Company Limited  
Lilly Research Centre  
Erl Wood Manor  
Sunninghill Road  
Windlesham, Surrey GU20 6PH (GB)

**Respondent 02:** Advanced Inhalation Research Inc  
(Opponent 02) 88 Sidney Street Cambridge  
Massachusetts 02139 (US)

**Representative:** Chapman, Paul William  
Kilburn & Strode LLP  
20 Red Lion Street  
London, WC1R 4PJ (GB)

**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
on 25 January 2008 concerning maintenance of  
European patent No. 0972526 in amended form.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** A. Lindner  
L. Bühler

## **Summary of Facts and Submissions**

- I. The patent proprietor lodged an appeal against the interlocutory decision of the opposition division posted on 25 January 2008 maintaining the European patent No. 0972526 in amended form.
- II. The notice of appeal was filed on 22 March 2008 with letter dated 20 March 2008. The appeal fee was paid on the same day.
- III. With the statement of the grounds of appeal dated 2 June 2008, the appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request), or, in the alternative, as amended according to one of the auxiliary requests 1 to 10.
- IV. The opponents did not appeal the interlocutory decision of the opposition division posted on 25 January 2008. With letter of 27 November 2008 respondent/opponent 02 requested that the appeal be dismissed.
- V. Summons to oral proceedings were despatched on 17 January 2011.
- VI. With letter dated 22 February 2011, the appellant withdrew the appeal. At the same time, it withdrew its approval of the text of the patent as maintained by the opposition division in its interlocutory decision. The appellant further stated that it did not intend to submit an amended text as a replacement and that it abandoned the patent.

## Reasons for the Decision

1. The appeal is admissible.
2. The filing of a statement withdrawing at the same time the appeal and the approval of the text of the patent as maintained by the opposition division results in a situation where there are two conflicting procedural acts to be considered:
3. Withdrawal of an appeal by the sole appellant immediately and automatically terminates the appeal proceedings in respect of all substantive issues (see G 8/91, OJ EPO 1993, 346, Reasons point 12; G 8/93, OJ EPO 1994, 887, Reasons point 2). The appeal's suspensive effect under Article 106(1) EPC then lapses, and the opposition division's decision becomes final for the substantive issues. From that point on, the board of appeal has no power to consider the patent within the meaning of Article 113(2) EPC (see G 8/91, OJ EPO 1993, 346, Reasons point 11.2).

Thus, in accordance with these principles, the present appeal proceedings have to be regarded as terminated by virtue of the appellant's statement of withdrawal of appeal. The interlocutory decision of the opposition division posted on 25 January 2008 maintaining European patent No. 0972526 in amended form then becomes effective. The opposition division resumes power to consider the patent within the meaning of Article 113(2) EPC. It will thus proceed according to Rule 82 EPC. In view of the appellant no longer agreeing to the text of the patent as maintained, this will probably but not

necessarily (see point 5) lead to the revocation of the patent by the opposition division with retroactive effect (G 1/90, OJ EPO 1991, 275, Reasons points 7, 8 and 18). However, withdrawing the appeal in the circumstances of the present case implies in the first place the maintenance of the patent according to the interlocutory decision of the opposition division posted on 25 January 2008.

4. Pursuant to Article 113(2) EPC a patent may be maintained only in a version approved by the patent proprietor. The absence of an approved text of the patent in opposition and appeal proceedings precludes any substantive examination as to whether the grounds for opposition laid down in Article 100 EPC prejudice the maintenance of the patent. In such a situation, the boards of appeal, in the exercise of their powers under Article 111(1) EPC, have decided in many cases to terminate appeal proceedings by a decision ordering revocation, without going into the substantive issues (see inter alia T 73/84, OJ EPO 1985, 241, T 186/84, OJ EPO 1986, 79, T 237/86, OJ EPO 1988, 261, and T 459/88, OJ EPO 1990, 425). This jurisprudence has also been confirmed under the revised EPC (see inter alia T 735/08 of 11 May 2010, T 124/08 of 22 June 2010, T 1111/10 of 8 September 2010, and T 307/08 of 7 October 2010). This is well founded, since revocation of the patent with retroactive effect under the newly introduced limitation or revocation procedures (Articles 105a to 105c EPC) is not available during pending opposition and opposition appeal proceedings (Article 105a(2) EPC).

The board is not aware of a decision pertaining to

circumstances similar to the present case in which the proprietor as sole appellant withdrew his approval to the text of the patent as maintained in the interlocutory decision under appeal. Nevertheless, the board finds no reasons to depart from the well-established case law under these circumstances. The prohibition of *reformatio in peius* is not a bar to revocation of the patent in the absence of an agreed text, since the right protecting the appellant against an outcome that puts it in a worse position than if it had not appealed may be waived (T 1544/07 of 19 August 2010, Reasons point 2.5). In the present case a waiver could be assumed, since the sole appellant who is the proprietor of the patent, without submitting an amended text of claims improving its position, expressly stated that it no longer approved the text in which the patent was maintained.

Thus, in accordance with the above-mentioned constant jurisprudence, the withdrawal by the appellant of the approval of the text as maintained by the opposition division calls as such for a decision by the board setting aside the decision under appeal and revoking the patent.

5. It would, in the opinion of the board, be formalistic to consider the conflicting statements in the order in which they appear in the appellant's letter dated 22 February 2011 and to give the withdrawal of the appeal precedence over the disapproval of the text of the patent as maintained. Rather, the objective content of said letter has to be evaluated.

As the patent proprietor withdrew his approval,

expressed before the first instance, of the text of the patent as maintained and declared that it did not intend to submit an amended text, it may be inferred that it wished to prevent any text whatsoever of the patent from being maintained. This is confirmed by the statement that the appellant is "abandoning the patent". This statement makes it perfectly clear that the patent proprietor is no longer interested in the maintenance of the patent as requested in its statement of grounds of appeal.

However, it should not be overlooked that abandonment is simply taking no action and thus allowing the patent to fall by failure to take the necessary procedural steps. In case of expiry of the term of protection of a patent or its lapse or surrender in all the designated states, continuation of opposition and opposition appeal proceedings depends on a request under Rule 84(1) EPC being allowed. It goes without saying that there is a significant difference in the patent's fate whether, in the exercise of the discretionary powers under said rule, a decision is taken on the merits of the case or the proceedings are simply terminated. Thus, the statement that the appellant is "abandoning the patent" is as such not necessarily equivalent to accepting or requesting the revocation of the patent with the consequences specified in Article 68 EPC. Moreover, the circumstances of the present case urge caution in inferring, from the statements of the appellant, an unequivocal request for revocation. First, the interlocutory decision has not been appealed by the opponents. Thus, no request for revocation to which the proprietor could be said to have agreed was to be considered in the present appeal proceedings. Second,



the patent in suit will expire on 10 April 2012. Thus, the appellant's letter received on 22 February 2011 is open to a more limited interpretation that the appellant no longer was interested in the outcome of the opposition appeal proceedings which would result in the maintenance of the patent.

6. Although it cannot be in either the parties' or the public's interest to maintain a patent against the proprietor's will, the board considers that the appellant's letter received on 22 February 2011 does not enable the board under Article 111(1) EPC to set aside the contested decision and to revoke the patent, since it does not contain an unequivocal statement of the proprietor that he accepts the revocation of the patent with the consequences specified in Article 68 EPC. Moreover, termination of the appeal proceedings in accordance with the statement of withdrawal of the appeal enables the appellant to make a conscious choice as to the legal consequences to be achieved. The rights of the respondents (opponents) in the opposition proceedings that will resume with termination of the appeal proceedings are preserved by Rule 84(1) EPC.

**Order**

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

The appeal proceedings are terminated.

The Registrar:

The Chairman:

N. Maslin

U. Oswald