

Internal distribution code:

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

**Datasheet for the decision
of 23 February 2012**

Case Number: T 0061/09 - 3.3.08

Application Number: 98952476.4

Publication Number: 1032662

IPC: C12N 15/12

Language of the proceedings: EN

Title of invention:

Methods and compositions for immunomodulation

Patentee:

Trillium Therapeutics Inc.

Opponent:

Alexion Pharmaceuticals, Inc.

Headword:

Immodulation/TRILLIUM

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Sole request on file: part of the factual and legal frame of
the appeal (no)"

"Remittal with the order to maintain the patent (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0061/09 - 3.3.08

DECISION
of the Technical Board of Appeal 3.3.08
of 23 February 2012

Appellant I: Trillium Therapeutics Inc.
(Patent Proprietor) 96 Skyway Avenue
Toronto
Ontario M9W 4Y9 (CA)

Representative: Bösl, Raphael Konrad
Isenbruck Bösl Hörschler LLP
Patentanwälte
Prinzregentenstrasse 68
D-81675 München (DE)

Appellant II: Alexion Pharmaceuticals, Inc.
(Opponent) 352 Knotter Drive
Cheshire, CT 06410 (US)

Representative: Dempster, Robert
D Young & Co LLP
120 Holborn
London EC1N 2DY (GB)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
on 17 November 2008 concerning maintenance of
European patent No. 1032662 in amended form.

Composition of the Board:

Chairman: C. Heath
Members: T. J. H. Mennessier
P. Julià

Summary of Facts and Submissions

- I. The patent proprietor (appellant I) and the opponent (appellant II) each lodged an appeal against the interlocutory decision of the opposition division dated 17 November 2008, whereby European patent No. 1 032 662, granted on European patent application No. 98 952 476.4 (published as the international application WO 99/24565) was maintained on the basis of auxiliary request 3 (claims 1 to 17) as filed at the oral proceedings held on 23 July 1998.
- II. The opposition was filed only against granted claims 14 to 17 and 20 on the grounds that the claimed subject-matter was not patentable under Article 100 EPC for reasons of lack of novelty (Articles 52(1) and 54 EPC), lack of inventive step (Articles 52(1) and 56 EPC), lack of industrial application (Article 52(4) EPC) and insufficient disclosure (Article 83 EPC).
- III. The statements of grounds of appeal were filed. Together therewith, appellant I filed a main and five auxiliary requests to replace the requests then on file. The main request corresponded to the auxiliary request 1 filed at the oral proceedings and not admitted into the opposition proceedings by the opposition division. The 1st and 2nd auxiliary requests were new requests which had never been considered by the opposition division. The 3rd, 4th and 5th auxiliary requests corresponded, respectively, to auxiliary requests 2, 3 (on the basis of which the patent had been maintained) and 4 of the contested decision.

- IV. Each appellant replied to the other appellant's statement of grounds.
- V. In its reply, appellant II argued that neither the main request nor any of the 1st, 2nd, 3rd and 4th auxiliary requests complied with the requirements of the EPC. No comments were made with respect to the 5th auxiliary request.
- VI. A communication under Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), presenting some preliminary, non-binding views of the Board was sent to the parties on 28 September 2011. In this communication, the Board noted that in all of appellant I's claim requests, claim 6 was dependent on claim 1 whereas in the set of claims as granted claim 6 was dependent on claim 5.
- VII. With its reply to the Board's communication filed on 16 January 2012, appellant I withdrew all its previous claim requests and replaced them by a new and sole claim request. This request differed from the previous 5th auxiliary request in that claim 6 was dependent on claim 5 instead of claim 1, as was claim 6 as granted. Furthermore, in its reply, appellant I made conditional its request for oral proceedings.
- VIII. The new request consisted of 15 claims with independent claims 1 and 14 reading as follows:
- "1. A use of an OX-2 protein or a nucleic acid sequence encoding an OX-2 protein for the manufacture of a medicament for suppressing an immune response."

"14. A process for preparing a medicament for suppressing an immune response, comprising formulating an OX-2 protein or a nucleic acid sequence encoding an OX-2 protein into such a medicament."

Claims 2 to 13 were dependent on claim 1 while claim 15 was dependent on claim 14.

Claims 1 to 13 were identical to claims 1 to 13 as granted, i.e. in particular with claim 6 dependent on claim 5.

Similarly claim 14 was identical to claim 18 as granted and claim 15 corresponded to claim 19 as granted.

- IX. On 18 January 2012, appellant II informed the Board that it had no objection to the maintenance of the patent on the basis of the newly filed claim request and conditionally withdrew its request for oral proceedings.
- X. With a communication dated 31 January 2012, the Board informed the parties that the scheduled oral proceedings were cancelled.
- XI. On 14 February 2012, appellant I informed the Board that it withdrew its request for reimbursement of the appeal fee.
- XII. Appellant I (patentee) requests that the decision under appeal be set aside and that the patent be maintained on the basis of the claim request filed on 16 January 2012.

XIII. Appellant II (opponent) agrees to the request of appellant I.

Reasons for the Decision

1. The sole claim request on file consists of 15 claims. Claims 1 to 13 are identical to claims 1 to 13 as granted, independent claim 14 is identical to independent claim 18 as granted, and dependent claim 15 is identical to claim 19 as granted, except for an adapted dependency.
2. Appellant II did not raise any objections against granted claims 1 to 13, 18 and 19 in the written reasoned statement filed with its notice of opposition. Furthermore, the validity of these claims was not challenged during the opposition proceedings. Therefore, said claims, i.e. present claims 1 to 15, were not part of the legal and factual framework on which the decision under appeal and the appeal itself were based.
3. Therefore, the Board under the provisions of Article 111(1) EPC has no reason for refusing appellant I's request that the patent be maintained on the basis of claims 1 to 15 of the request filed on 16 January 2012.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent on the basis of claims 1 to 15 of the request filed under cover of the letter of 16 January 2012, a description to be adapted thereto and the figures of the patent specification.

The Registrar

The Chairman

A. Wolinski

C. Heath