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**Datasheet for the decision
of 27 August 2014**

Case Number: T 1173/10 - 3.3.02

Application Number: 02748354.4

Publication Number: 1406644

IPC: A61K35/78, A61K38/16,
A61K39/395, C12N15/09,
C12N15/29, C12N15/62,
C12N15/63, C12N15/64

Language of the proceedings: EN

Title of invention:
MODIFIED PROTEINS, DESIGNER TOXINS, AND METHODS OF MAKING
THEREOF

Applicant:
RESEARCH DEVELOPMENT FOUNDATION

Headword:
Modified gelonin/RESEARCH DEVELOPMENT FOUNDATION

Relevant legal provisions:
EPC Art. 109(1), 111(1), 123(2)
EPC R. 103(1)(a)

Keyword:
Added subject-matter - main request (no, after amendment)
Obligation to grant interlocutory revision (yes)
Immediate remittal to department of first instance (yes)
Reimbursement of the appeal fee (no)

Decisions cited:
T 0139/87, T 0219/93, T 0180/95, T 1060/10, T 1500/12

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 1173/10 - 3.3.02

**D E C I S I O N
of Technical Board of Appeal 3.3.02
of 27 August 2014**

Appellant: RESEARCH DEVELOPMENT FOUNDATION
(Applicant) 402 North Division Street
Carson City, Nevada 89703 (US)

Representative: Heaton, Joanne Marie
Stevens, Hewlett & Perkins
1 St. Augustine's Place
Bristol BS1 4UD (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 11 January 2010
refusing European patent application No.
02748354.4 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman U. Oswald
Members: K. Giebeler
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. European patent application No. 02 748 354.4, entitled "Modified proteins, designer toxins, and methods of making thereof", was published as WO 02/069886.

- II. After issuing three official communications, the examining division summoned the applicant to oral proceedings to be held on 25 November 2009. The final date set for making written submissions under Rule 116 EPC was 23 October 2009. In an annex to the summons, the examining division raised objections under Articles 123(2), 83 and 84 EPC.

On 23 October 2009, the applicant filed a new main request and three auxiliary requests as well as arguments relating to Articles 123(2), 83 and 84 EPC.

The applicant was informed by telefax of 19 November 2009 that the examining division maintained the date fixed for oral proceedings.

With telefax of 23 November 2009, the applicant informed the EPO that it would not be represented at the oral proceedings on 25 November 2009.

Oral proceedings before the examining division were held on 25 November 2009 in the absence of the applicant. At the end of the oral proceedings, the application was refused by the examining division pursuant to Article 97(2) EPC.

In its written decision issued on 11 January 2010, the examining division held that neither the main request nor any of auxiliary requests 1 to 3 met the requirements of Article 123(2) EPC. In particular, the

examining division stated that claim 11 of the main request, claims 1, 13 and 14 of the first auxiliary request, claim 11 of the second auxiliary request, and claims 1, 13 and 14 of the third auxiliary request had no basis in the application as originally filed, contrary to Article 123(2) EPC.

III. With the statement of grounds of appeal dated 11 May 2010, the applicant (hereafter appellant) filed new claims according to a main request and a first and second auxiliary request, and submitted arguments as to why the requirements of Articles 123(2), 83, 84, 54 and 56 EPC were met for these claims.

In the statement of grounds of appeal, the appellant requested interlocutory revision under Article 109 EPC, and reimbursement of the appeal fee. It also requested that the board of appeal remit the application to the examining division for further examination.

The appellant did not request oral proceedings.

IV. By EPO Form 2701 of 20 May 2010, the examining division ordered that the decision under appeal would not be rectified and that the case was to be referred to the boards of appeal without delay.

Reasons for the Decision

1. The appeal is admissible.
2. *Obligation to grant interlocutory revision - Immediate remittal to the department of first instance*

2.1 *Main request*

The claims of the present main request differ from those of the main request underlying the appealed decision only in that claim 11 has been deleted.

With respect to the main request underlying the appealed decision, the examining division held solely that claim 11 did not meet the requirements of Article 123(2) EPC.

Following the deletion of said claim 11, the board concludes that this objection no longer applies and that the subject-matter of the main request does not extend beyond the content of the application as filed.

Therefore, the sole ground for refusing the main request underlying the appealed decision is considered to have been remedied by the present main request.

2.2 Article 109(1) EPC stipulates that, if the department whose decision is contested considers the appeal to be admissible and well founded, it **shall** rectify its decision. It is established case law of the boards of appeal that, if the appeal is objectively to be considered as admissible and well founded, the first-instance department is obliged to grant interlocutory revision, without room for discretion (see T 139/87, OJ EPO 1990, 68, point 4; T 180/95 of 2 December 1996, point 3; T 1060/10 of 16 December 2013, point 4.1). In this context, an appeal is to be considered "well founded" if at least the main request submitted with the appeal includes amendments which clearly meet the objections on which the decision relied, such that the first-instance department could reasonably be expected to recognise this and thus rectify its decision. That

there are other objections which have not been removed but which were not the subject of the contested decision cannot preclude the application of Article 109(1) EPC (see T 139/87, point 4; T 219/93 of 16 September 1993, point 4; T 1060/10, point 4.1).

2.3 In the present case, the main request overcomes the objections on which the decision under appeal is based. During the first-instance proceedings, the examining division had raised additional objections, which objections are however not part of the decision under appeal. Therefore, interlocutory revision should have been allowed.

2.4 Under these circumstances, the board considers it appropriate to set aside the decision under appeal and to remit the case immediately to the department of first instance for further prosecution.

3. *Reimbursement of the appeal fee*

3.1 The appellant has requested reimbursement of the appeal fee and submitted that it considered it to be "unjust" that the examining division refused the application at the end of the oral proceedings held in the appellant's absence on the grounds that all requests contravened Article 123(2) EPC.

3.2 Reimbursement of the appeal fee under Rule 103(1) (a) EPC is subject to three conditions:
i. the board considers the appeal to be allowable;
ii. a substantial procedural violation occurred during the proceedings before the first instance department;
iii. reimbursement is equitable.

- 3.3 The board notes that the appellant had been duly summoned to the oral proceeding before the examining division and that the appellant had not given any serious reasons for not attending the oral proceedings. Under these circumstances, the board cannot discern any misconduct whatsoever on the part of the examining division in refusing the application during the oral proceedings held in the appellant's absence. It is well-established case law of the boards of appeal that if a party decides not to attend oral proceedings, it chooses not to make use of the opportunity to comment at the oral proceedings on any of the objections raised during them; this applies also to situations where a party has submitted amended claims before the oral proceedings and no communication has been issued with respect to said claims (see T 1500/10 of 20 December 2012, point 3.4). Hence the board is convinced that no substantial procedural violation occurred before the first instance department.
- 3.4 The board therefore refuses the request for reimbursement of the appeal fee.

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 examination.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



S. Sánchez Chiquero

U. Oswald

Decision electronically authenticated