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**Datasheet for the decision
of 27 August 2012**

Case Number: T 1518/12 - 3.3.04

Application Number: 05756274.6

Publication Number: 1753775

IPC: C07K 5/08, C07D 417/14,
C07D 417/04, C07D 277/56,
C07C 217/84

Language of the proceedings: EN

Title of invention:
Process for preparing acyclic HCV protease inhibitors

Applicant:
Boehringer Ingelheim International GmbH

Headword:
-

Relevant legal provisions:
EPC R. 103(1)(a)

Keyword:
"Reimbursement of appeal fee (no)"

Decisions cited:
G 0003/03, R 0002/08, J 0032/95

Catchword:
-



Case Number: T 1518/12 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 27 August 2012

Appellant: Boehringer Ingelheim International GmbH
(Applicant) Binger Straße 173
D-55216 Ingelheim (DE)

Representative: Hammann, Heinz
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 15 December 2011
refusing European patent application
No. 05756274.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: C. Rennie-Smith
Members: R. Gramaglia
G. Alt

Summary of Facts and Submissions

- I. The appellant commenced the present appeal on 27 January 2012 by filing a letter which contained both its notice of appeal and its statement of grounds of appeal. The appeal fee was also paid on the same date. The appeal was against the decision of the Examining Division of 15 December 2011 to refuse European patent application No. 05756274.6, based on the published application WO 2005/116054 and entitled "Process for preparing acyclic HCV protease inhibitors". The application had been refused on the ground of lack of inventive step (Article 56 EPC).
- II. In a communication dated 4 September 2009, the Examining Division expressed the opinion that the requirements of Articles 83 and 84 EPC were not met, that the claimed subject-matter was novel (Article 54 EPC) but lacked an inventive step (Article 56 EPC). The communication stated (see page 3, point 6.1) that the application describes in general terms a synthetic route for the preparation of certain compounds but does not describe any example which would substantiate the success or feasibility of that route, and concluded that there was no substantiation that the technical problem had been solved (see pages 3 to 4, point 6.2).
- III. The appellant replied to the communication by a letter of 12 April 2010 with which it enclosed amended claims in response to the objections under Articles 83 and 84 EPC. As regards the objection of lack of specific examples to substantiate the feasibility of the claimed process, it referred to tables 1 and 2 on pages 43 to 49 of the application as filed (WO 2005/116054)

which list 55 compounds that may be prepared by the claimed process.

IV. In its written decision issued on 15 December 2011, the Examining Division found that the amended claims complied with Article 123(2) EPC and overcame the previous objections under Articles 83 and 84 EPC. As regards inventive step however, the decision repeated (see point 3.1 of the reasons) the view in the communication that the application describes in general terms a synthetic route for the preparation of certain compounds but does not describe any example which would substantiate the success or feasibility of that route. It referred to the appellant's argument based on pages 43 to 49 of the application as filed but, since it considered that those pages did not provide sufficiently specific information, maintained its view that the applicant had neither substantiated nor provided convincing arguments that the claimed process in fact solves the problem underlying the application (see point 3.3 of the reasons). The application was refused accordingly.

V. In its letter of 27 January 2012, the appellant referred to the reasons for the decision under appeal and pointed to examples 4, 5 and 6 of the first priority document (US 60/574,182) as descriptions of different possible routes of the claimed process. The appellant argued that these examples, which were present on the file, substantiate the solution of the problem underlying the present invention. In view of those explanations the appellant argued that the refusal of the application was not justified and suggested that the Examining Division rectify its

decision by interlocutory revision under Article 109 EPC. The appellant also enclosed with its letter certain replacement pages to adapt the description to the pending set of claims. Finally it requested that, if the Examining Division should decide to allow interlocutory revision, the appeal fee should be refunded, suggesting that the fee was not justified in view of the facts which were evident from the file.

- VI. By a decision dated 21 June 2012, the Examining Division allowed interlocutory revision, rectified its earlier decision and referred the request for reimbursement of the appeal fee to the Board.

Reasons for the Decision

1. The Examining Division has allowed the appeal which has been forwarded to the Board solely to decide on the appellant's request for reimbursement of the appeal fee. That has been done pursuant to Rule 103(2) EPC (see also J 32/95 OJ EPO 1999, 713 and G 3/03 OJ EPO 2005, 344).

2. The provision which the Board must consider is Rule 103(1)(a) EPC which, as relevant for the present case, reads:

"(1) The appeal fee shall be reimbursed
(a) in the event of interlocutory revision..., if such reimbursement is equitable by reason of a substantial procedural violation...."

There are thus three conditions to be satisfied - interlocutory revision must have been allowed, a substantial procedural violation must have occurred, and reimbursement because of that violation must be equitable. Interlocutory revision having been allowed, the Board is concerned only with the second and third conditions. Clearly, the second condition must be satisfied before the third condition needs to be considered.

3. The Board notes that the appellant does not allege a substantial procedural violation as such but only argues that the appeal fee should be reimbursed because the information put forward in its grounds of appeal - namely, the examples in the first priority document - was evident from the file (see section V above).
4. While that information certainly was on file, and while the Examining Division would no doubt have ascertained that information if it had, at the time of making its decision, had occasion to re-read the priority document, the Board cannot accept that not taking that step amounted to a substantial procedural violation. The mere presence of information somewhere in the file does not relieve a party of its duty to draw attention to it when necessary or to present arguments relying on such information at the appropriate time (see R 2/08 of 11 September 2008, Reasons, points 8.5 and 9.10). That did not happen in the present case.
5. When the Examining Division in its communication of 4 September 2009 expressed its view as to the absence of any substantiation that the technical problem had been solved (see section II above, page 3 of the

communication, point 6.2, third paragraph, and the decision under appeal, page 2, point 3), the appellant did not refer in its reply of 12 April 2010 to the examples in the first priority document which it later mentioned for the first time in its grounds of appeal. That response to the communication would however have been the appropriate time to have done so since, as the allowance of interlocutory revision clearly suggests, it might have resulted in a decision in the appellant's favour and avoided the need for an appeal. Instead the appellant presented an argument based on the tables at pages 43 to 49 of the application as filed which the Examining Division did not find convincing.

6. It is therefore clear that the need to pay the appeal fee arose not from any failure on the part of the Examining Division but from the manner in which the appellant chose to conduct its case. In the circumstances the Board finds there was no substantial procedural violation. Therefore the question whether reimbursement of the appeal fee would be equitable does not arise. The request for such reimbursement must be refused.

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

P. Cremona

C. Rennie-Smith