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**Datasheet for the decision
of 7 April 2015**

Case Number: T 0177/15 - 3.3.08

Application Number: 08866069.1

Publication Number: 2252689

IPC: C12N15/11

Language of the proceedings: EN

Title of invention:

Use of anti-connexin polynucleotides for the treatment of surgical adhesions

Applicant:

CODA THERAPEUTICS, INC.

Headword:

Anti-connexin/CODA THERAPEUTICS

Relevant legal provisions:

EPC Art. 111(1)
EPC R. 103(1)(a), 111(2)
RPBA Art. 11

Keyword:

Decision according to the state of the file reasoned within the meaning of Rule 111(2)EPC (no)
Violation of the right to be heard (yes)
Substantial procedural violation (yes)
Remittal (yes)
Reimbursement of the appeal fee (yes)

Decisions cited:

T 0292/90, T 0522/90, T 0652/97, T 0278/00, T 0897/03,
T 1182/05, T 1356/05, T 1612/07, T 0246/08, T 1442/09,
T 2366/11, T 0405/12

Catchword:



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Case Number: T 0177/15 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 7 April 2015

Appellant: Coda Therapeutics, Inc.
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CA 92130 (US)

Representative: Tuxworth, Pamela M.
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 15 July 2014
refusing European patent application No.
08866069.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Wieser
Members: M. R. Vega Laso
D. Rogers

Summary of Facts and Submissions

- I. The appeal lies from a decision of an examining division of the European Patent Office (EPO) issued in writing on 15 July 2014, by which the European patent application No. 08866069.1 with the title "Treatment of surgical adhesions" was refused under Article 97(2) EPC. The application was filed as an international application under the Patent Cooperation Treaty and published as WO 2009/085273.
- II. The application was filed with 52 claims and entered the European phase with a set of amended claims (claims 1 to 15).
- III. In a first communication under Article 94(3) EPC dated 18 September 2012, the examining division raised an objection of lack of novelty (Article 54 EPC) to claims 9 to 15 directed to compositions comprising an anti-connexin polynucleotide and methods of making the compositions. Novelty was acknowledged for the subject-matter of claims 1 to 8 directed to an anti-connexin polynucleotide for a specific therapeutic use, but inventive step denied on the grounds that the technical effect underlying the purported technical problem had not been demonstrated over the whole scope of the claims, and that the examples were purely hypothetical. The examining division held that, if a less ambitious technical problem were formulated, the solution would be obvious (see point 4 of the communication). Additionally, three objections under Article 84 EPC were raised, in particular to the wording "*preferably*" and "*optionally*" in claims 4, 8, 10 and 15, the wording "*instructions for use...*" in claims 11 to 13, and the presence of "*too many independent claims*" (see point 5 of the communication).

- IV. On 12 July 2013, the applicant replied to the communication and submitted a new set of amended claims (claims 1 to 20) which replaced the claims previously on file and addressed the objections raised by the examining division. The applicant put forward arguments in support of inventive step and requested that, if any matters had remained outstanding, the examining division should issue a further communication or telephone the representative. As a subsidiary request, the applicant requested oral proceedings.
- V. Summons to oral proceedings were dispatched on 15 January 2014. In a communication attached to the summons, the examining division raised two new objections under Article 84 EPC, in particular to the wording of the claims depending from claim 1 and/or 11 (see point 2.1 of the communication), and to claims 10 and 16 (see point 2.2 of the communication). The examining division acknowledged novelty and, as regards inventive step, observed that the applicant had not commented on the fact that the claims were directed to the use of inhibitors of any type of connexin, and that no technical effect had been shown in the application (see point 4 of the communication).
- VI. On 8 April 2014, the applicant replied to the communication accompanying the summons and submitted two sets of amended claims as, respectively, main request and auxiliary request, which replaced the claims previously on file. Claims 1 to 19 of the main request were limited to an anti-connexin 43 polynucleotide, compositions comprising the polynucleotide for specific therapeutic uses, and uses of the compositions, while claims 1 to 19 of the auxiliary request included an additional limitation to

a specific group of patients. In its reply, the applicant addressed the issues raised by the examining division, and suggested that, if minor amendments were needed, the examining division should contact the representative. The request for oral proceedings was maintained, but the representative expressed the intention to telephone the first examiner within the following week, hoping that any outstanding issues could be resolved by telephone.

VII. On 2 May 2014, a letter of the representative of the applicant with the following wording was received:

"Thank you for the telephone call from the Examiner. We hereby withdraw our request for Oral Proceedings and request a written decision on the basis of the current file"

There is no record of a telephone conversation between the examiner and the representative of the applicant on file.

VIII. The grounds of the examining division's decision were as follows:

"In the communication(s) dated 15.01.2014 ,18.09.2012 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 2 May 2014.

The application must therefore be refused."

- IX. The applicant (appellant) lodged an appeal against the refusal and, together with the statement of grounds of appeal, re-filed the two sets of claims submitted in examination proceedings by letter of 8 April 2014. Additionally, a scientific publication was filed in support of its case on inventive step.
- X. The appellant requested that the decision under appeal be set aside and "... examination of this application be continued ..." on the basis of the claims of the main and auxiliary request. As a subsidiary request, oral proceedings were requested.
- XI. Since the examining division did not rectify its decision, the appeal was remitted to the board (Article 109 EPC).

Reasons for the Decision

1. Even though the appellant has not impugned the decision of the examining division on the grounds of a substantial procedural violation, the board is entitled to examine whether or not such a violation occurred in examination proceedings (see decision T 405/12 of 5 June 2014, point 3 of the Reasons).

Rule 111(2) EPC

2. Pursuant to Rule 111(2) EPC (and Rule 68(2) EPC 1973), decisions of the European Patent Office which are open to appeal must be reasoned. According to the established jurisprudence of the Boards of Appeal, the reasoning given in a decision open to appeal must

enable the appellant and the board of appeal to examine whether or not the decision was justified. Therefore, the grounds upon which the decision is based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision (see T 0278/00, OJ 2003, 546; T 1182/05 of 19 February 2008 and T 2366/11 of 26 March 2012). The duty to provide reasons in administrative decisions enshrined in Rule 111(2) EPC is considered to be a fundamental principle in all Contracting States, and is also indispensable from the point of view of the practical functioning of the appeal system envisaged in the EPC (see decision T 1356/05 of 16 February 2006, point 17 of the Reasons).

3. In the present case, the decision under appeal neither specifies the grounds upon which it is based, nor sets out any facts, evidence or arguments that may justify the refusal of the application. The appealed decision solely refers to reasons given in two communications issued in the course of the examination of the application.

4. Each of these communications deal with a different set of claims filed by the appellant in response to the respective preceding communication (see sections III and V above). Hence, in order for the board to be in the position of reviewing the decision under appeal, it would have to examine both communications for facts, evidence and arguments that may have justified the refusal of the application. The decision under appeal thus leaves it to the board - and the appellant - to speculate as to which specific reasons given by the examining division in the two communications would still apply to either the main request or the auxiliary request on file at the time the decision was taken, and

would also be essential to the decision to refuse the application. It is to be noted that neither of the two communications mentioned in the decision under appeal deals with the amendments introduced into the set of claims according to the auxiliary request, as this set of claims was submitted only in reply to the communication accompanying the summons to oral proceedings.

5. This is clearly at odds with the principle that, for a decision to be reasoned within the meaning of Rule 111(2) EPC, it must be self-contained, i.e. it must include all and each of the facts, evidence and arguments that are essential to the decision, and the chain of reasoning in the decision must be complete (see, e.g., decisions T 292/90 of 16 November 1992, T 652/97 of 16 June 1999 and T 278/00, *supra*). This principle is well-established in the jurisprudence of the Boards of Appeal and applies also to decisions of the department of first instance "on the file as it stands" which are reasoned by reference to one or more previous communications (see decisions T 897/03 of 16 March 2004, T 1356/05 of 16 February 2006, T 1182/05 of 19 February 2008, T 1612/07 of 5 May 2009 and T 1442/09 of 3 November 2010). In order for such decisions to meet the requirement of Rule 111(2) EPC, the decisive reasons must be clear to the party and the board from the communications to which the decision refers. For the reasons given above, this requirement is not fulfilled in the present case.

6. Absent a record on file of the telephone conversation to which the applicant refers in its letter of 2 May 2014 (see section VII above), the board can only speculate whether the applicant was informed of the grounds for the refusal of the application during that

conversation. Even if this were the case, the board holds that a department of first instance issuing a decision open to appeal cannot be dispensed of the requirement of a reasoned decision, i.e. a decision specifying clearly the decisive facts, evidence and arguments that allows the Boards of Appeal to examine whether or not the decision under appeal was justified.

7. For these reasons, the board judges that the decision under appeal does not fulfil the legal requirement for a reasoned decision under Rule 111(2) EPC. According to the jurisprudence of the Boards of Appeal, this amounts to a substantial procedural violation of a basic principle under the EPC (see, e.g., decisions T 292/90 of 16 November 1992, T 1442/09 of 3 November 2010).

Article 113(1) EPC

8. The examining division's failure to take into due account the submissions made by the applicant in its letter dated 8 April 2014 contravenes Article 113(1) EPC and constitutes a further procedural violation.
9. In the decision under appeal, the examining division stated that the applicant had filed no comments or amendments in reply to the latest communication (see section VIII above). This is factually incorrect. As apparent from the file, by letter dated 8 April 2014 the applicant replied to the communication accompanying the summons to oral proceedings and submitted two sets of amended claims as main and auxiliary request, respectively. It also put forward arguments that addressed the objections raised by the examining division in the previous communication.

10. The decision under appeal contains no reference whatsoever to the new requests and the arguments submitted by the applicant. Hence, the examining division failed to take into account the applicant's submissions and, consequently, deprived the applicant of its right to be heard (see decisions T 1182/05 of 19 February 2008 and T 246/08 of 14 August 2008).

Remittal to the examining division (Article 11 RPBA)

11. According to Article 11 of the Rules of Procedure of the Boards of Appeal and in line with numerous decisions of the Boards of Appeal (see, e.g., T 292/90 of 16 November 1992; T 522/90 of 8 September 1993 and T 278/00, *supra*), a board will remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.
12. In the present case, no special reasons are apparent. The appellant filed its notice of appeal on 12 September 2014, and the statement setting out the grounds of appeal on 25 November 2014. Since the case is remitted to the examining division scarcely five months later, the remittal will not entail a substantial lengthening of the proceedings.
13. Thus, the board decides to remit the case to the examining division in accordance with Article 111(1) EPC and Rule 11 RPBA.

Reimbursement of the appeal fee (Rule 103(1)(a) EPC)

14. The appeal is allowable. Even though the appellant has not requested that the appeal fee be reimbursed, the

board holds a reimbursement of the appeal fee to be equitable by reason of the substantial procedural violations incurred, and the fact that the appellant was obliged to file the appeal to ensure that its submissions are duly considered.

Subsidiary request for oral proceedings

15. Since the appellant's request that the decision under appeal be set aside and examination be continued is granted, there is no need to hold oral proceedings before the board in accordance with the appellant's subsidiary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated