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**Datasheet for the decision
of 14 July 2016**

Case Number: T 0184/15 - 3.3.04

Application Number: 08868457.6

Publication Number: 2252320

IPC: A61K38/17, C12N15/11,
A61L24/00, A61P17/02, A61P43/00

Language of the proceedings: EN

Title of invention:

Use of anti-connexin polynucleotides and peptides for the treatment of abnormal or excessive scars

Applicant:

Coda Therapeutics, Inc.

Headword:

Anti-connexin/CODA

Relevant legal provisions:

EPC Art. 111(1), 113(1)
EPC R. 103(1) (a)
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 0278/00, T 1366/05, T 1709/06, T 0546/10, T 2375/10,

T 2393/11, T 0405/12, T 0177/15

Catchword:



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Case Number: T 0184/15 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 14 July 2016

Appellant: Coda Therapeutics, Inc.
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 9 July 2014 refusing European patent application No. 08868457.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman G. Alt
Members: A. Chakravarty
M.-B. Tardo-Dino

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse the European patent application No. 08868457.
- II. In the procedure leading to the refusal, the examining division issued a communication pursuant to Article 94(3) EPC, on 18 September 2012 and a communication together with a summons to oral proceedings pursuant to Article 115(1) EPC, on 15 January 2014. The applicant (appellant) responded to these communications with letters dated 12 July 2013 and 9 April 2014, respectively. Both of these letters contained comments and arguments and both were accompanied by amended claims. In particular, a main and two auxiliary claim requests were filed with the letter of 9 April 2014, which replaced the requests previously on file.
- III. Following a telephone call from the examiner, the content of which is not part of the file, the appellant withdrew its request for oral proceedings on 2 May 2014 and requested "*a written decision on the basis of the current file*". The contested decision sent by post on 9 July 2014 was a decision "*according to the state of the file*" and was done using EPO Form 2061. The grounds of the examining division's decision were as follows:
- "In the communication(s) dated 15.01.2014, 04.08.2009 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 European patent application is therefore refused on the basis of Article 97(2) EPC."

- IV. Together with the statement of grounds of appeal, the appellant re-submitted the main and the two auxiliary claim requests originally filed during the examination proceedings with the letter of 9 April 2014.
- V. The appellant requested that the decision under appeal be set aside and "*that examination of this application be continued...*" on the basis of the main or auxiliary requests.

Reasons for the Decision

1. Although the appellant did not object to the decision under appeal on the grounds of a substantial procedural violation or fundamental deficiencies, he did protest about the failure of the examining division to take submissions into account when deciding the case, stating: "*Several of the amendments made in the Main Request in our final written submissions dated 9 April 2014 (which is identical to the current Main Request) were intended to directly address those objections*".
2. Pursuant to Article 11 RPBA, the board is entitled to examine whether fundamental deficiencies are apparent in the first instance proceedings, here those before the examining division, which would justify remitting the case (see decision T 405/12, 5 June 2014, point 3 of the Reasons).

3. The decision under appeal justifies the refusal of the application, by reference to reasons given in two communications issued in the course of the examination of the application for the facts, evidence, arguments and the grounds upon which it is based (see section III, above). However, each of these communications dealt with a different set of claims filed by the appellant, none of them being those pending at the time when the decision was taken. The first communication referred to, dated 4 August 2009, even predates the start of the procedure before EPO and appears to be the written opinion of the International Searching Authority.
4. Furthermore, in its decision the examining division stated that the applicant had filed no comments or amendments in reply to the latest communication (see section III above). This is factually incorrect, as the applicant replied to the communication accompanying the summons to oral proceedings by letter dated 9 April 2014, putting forward arguments that addressed the objections raised by the examining division in the previous communication and also submitted amended claims as main and auxiliary requests 1 and 2.
5. The decision "*according to the state of the file*" therefore ignored the final requests filed by the appellant without giving any reason for so doing. The substance of the telephone call between the applicant and the rapporteur after the filing of the latest requests is not known, but as the same claim requests were refiled on appeal, it must be concluded that, when requesting "*a written decision on the basis of the current file*", the appellant could only have intended to refer to the most recent requests. There is nothing

on file that could lead to the conclusion that those requests had been abandoned during the telephone call.

6. The failure to take the applicant's submissions into account deprived the applicant of the right to be heard and constitutes a substantial procedural violation (Article 113(1) and Rule 103(1)(a) EPC) and also amounts to a fundamental deficiency in the first instance proceedings (Article 11 RPBA; see e.g. T 1709/06 of 30 May 2008 point 1.1.5 of the Reasons, T 546/10 of 29 August 2011, points 1 to 9 of the Reasons and T 2393/11 of 13 May 2014, point 7 of the Reasons).
7. Rule 111(2) EPC provides that decisions of the European Patent Office which are open to appeal (including decisions "*according to the state of the file*") 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 the decision.
8. As a consequence of the fundamental deficiency in the proceedings before the examining division (point 6 above), the decision under appeal contains no reasoning at all that pertains to the appellant's actual claim requests. The requirements of Rule 111(2) EPC cannot be construed in such a way that it is up to the board or the appellant to speculate to which extent the reasons given in the appealed decision might apply to those requests. In other words, missing or deficient reasoning cannot be compensated for by the speculative

interpretation of the appellant or guess work by the board of appeal (see e.g. T 278/00 of 11 February 2003, point 3 of the Reasons). Therefore, in the board's judgement, the reasoning presented by the first instance must be taken as it stands.

9. The failure to provide a reasoned decision thus amounts to a breach of Rule 111(2) EPC, which is a further fundamental deficiency in the procedure before the examining division.
10. It follows from the above that two fundamental deficiencies, i.e. violation of Article 113(1) EPC and Rule 111(2) EPC occurred in the procedure before the examining division.

Remittal following substantial procedural violations

11. Article 11 RPBA provides that "*A Board shall 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. Thus, the board decides to remit the case to the examining division in accordance with Article 111(1) EPC and Article 11 RPBA.

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

13. 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 in view of the above mentioned substantial procedural violations and of the fact that the

appellant was obliged to file an appeal to ensure that its submissions are duly considered.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated