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**Datasheet for the decision  
of 14 January 2019**

**Case Number:** T 1161/17 - 3.3.01

**Application Number:** 10727317.9

**Publication Number:** 2442790

**IPC:** A61K31/498, A61K9/00,  
A61K31/335, A61K31/52,  
A61K31/542, A61K47/02,  
A61K47/10, A61K47/18,  
A61K47/32, A61P27/02, A61P27/06

**Language of the proceedings:** EN

**Title of invention:**

AQUEOUS PHARMACEUTICAL COMPOSITIONS CONTAINING BORATE-POLYOL  
COMPLEXES

**Patent Proprietor:**

Alcon Research, Ltd.

**Opponents:**

Teva Pharmaceutical Industries LTD.  
Generics [UK] Ltd (trading as Mylan)

**Relevant legal provisions:**

EPC Art. 113(2)

**Keyword:**

Basis of decision - text submitted or agreed by patent proprietor (no)

**Decisions cited:**

T 1244/08, T 2054/08, T 0203/12, T 0969/10



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
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Case Number: T 1161/17 - 3.3.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.01**  
**of 14 January 2019**

**Appellant:** Alcon Research, Ltd.  
(Patent Proprietor) 6201 South Freeway, Mail Code TB4-8  
Fort Worth, TX 76134-2099 (US)

**Representative:** Skødt, Henrik  
Novartis Pharma AG  
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**Respondent:** Teva Pharmaceutical Industries LTD.  
(Opponent 1) 5 Basel Street  
Petah Tiqva 49131 (IL)

**Representative:** Greiner, Elisabeth  
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Patentanwälte Rechtsanwälte PartG mbB  
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**Respondent:** Generics [UK] Ltd (trading as Mylan)  
(Opponent 2) Albany Gate  
Darkes Lane  
Potters Bar  
Hertfordshire EN6 1 AG (GB)

**Representative:** FRKelly  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 8 March 2017  
revoking European patent No. 2442790 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman**           A. Lindner  
**Members:**         R. Hauss  
                      L. Bühler

## Summary of Facts and Submissions

- I. Following the grant of European patent No. 2442790, two notices of opposition to that patent were validly filed. This appeal lies from the decision of the opposition division revoking the opposed patent.
- II. With its statement setting out the grounds of appeal, the patent proprietor (appellant) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request, or in the alternative, one of auxiliary requests 1 and 2 (all three requests submitted with the statement of grounds).
- III. In their respective replies to the appellant's statement of grounds, the respondents (opponents 1 and 2) requested that the decision under appeal be upheld (and hence, that the appeal be dismissed).
- IV. In a letter dated 12 December 2018, the appellant made the following statement:

*"The Proprietor hereby withdraws the approval under Rule 71 EPC of the text in which European patent No. 2442790 was granted. A replacement text will not be filed and all requests pending in the appeal proceedings are hereby withdrawn, including the request for oral proceedings.*

*In the absence of a text agreed by the Proprietor, the opposition/appeal proceedings relating to this patent are terminated following Article 113(2) EPC and the Patent must be revoked (see Guidelines D VI-2.2). In such situations, the opposition/appeal proceedings are terminated by a decision ordering the revocation of the patent without reference to the substantive issues (e.g. decision T 969/10)".*

### **Reasons for the Decision**

1. Under Article 113(2) EPC the European Patent Office shall examine, and decide upon, a European patent only in the text submitted to it, or agreed, by the patent proprietor.
2. As the patent proprietor withdrew all of its requests and no longer approves the text in which the patent was granted, it has to be inferred that it wishes to prevent any text whatever of the patent from being maintained.
3. According to established case law of the Boards of Appeal, the declaration of the appellant (see point IV above), as the proprietor of a patent that has been revoked by the opposition division, is to be interpreted as the withdrawal of its appeal (see *inter alia* decisions T 1244/08 of 7 July 2011, T 2054/08 of 13 June 2012, T 0203/12 of 11 August 2015).
4. As a consequence, the appeal proceedings are to be terminated, and the decision under appeal becomes final.
5. Making reference to decision T 0969/10 of 26 September 2011, the patent proprietor expressed the expectation that the patent would be revoked by the board (see point IV above). The situation in T 0969/10 was however a different one, since the decision under appeal was an interlocutory decision finding that the patent in an amended version met with the requirements of the EPC, and therefore the patent had not been

revoked in the proceedings at first instance. In the present case, the patent proprietor has appealed a decision of revocation (i.e. the patent was previously revoked by the opposition division) and the consequence of the patent proprietor's declaration must be the termination of the appeal proceedings, as set out in point 4 above, by which the revocation becomes final.

## Order

### **For these reasons it is decided that:**

The appeal proceedings are terminated.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated