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**Datasheet for the decision
of 29 July 2021**

Case Number: T 2896/18 - 3.3.04

Application Number: 03795400.5

Publication Number: 1561756

IPC: C07K16/06, C07K14/52,
C07K16/26, C07K16/28,
C07K16/30, C07K1/22, C07K1/32,
C07K1/34, C07K14/535

Language of the proceedings: EN

Title of invention:
Method of purifying protein

Patent Proprietor:
CHUGAI SEIYAKU KABUSHIKI KAISHA

Opponents:

1. Glaxo Group Limited
2. Hoffmann Eitle
3. Strawman Limited
4. Maiwald Patent- und Rechtsanwalts-gesellschaft mbH
5. Graf von Stosch Patentanwalts-gesellschaft mbH
6. Baxalta GmbH
7. Taormino, Joseph Paul

Headword:
Purifying protein / CHUGAI SEIYAKU KABUSHIKI KAISHA

Relevant legal provisions:

EPC Art. 113(2)

Keyword:

Basis of decision - text or agreement to text withdrawn by patent proprietor

Decisions cited:

T 0073/84, T 0795/19

Catchword:

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2896/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 29 July 2021

Appellant I: CHUGAI SEIYAKU KABUSHIKI KAISHA
(Patent Proprietor) 5-1, Ukima 5-chome,
Kita-ku
Tokyo, 115-8543 (JP)

Representative: Vossius & Partner
Patentanwälte Rechtsanwälte mbB
Siebertstrasse 3
81675 München (DE)

Appellant II: Baxalta GmbH
(Opponent 6) Thurgauerstrasse 130
8152 Glattpark (Opfikon) (CH)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Party as of right: Glaxo Group Limited
(Opponent 1) 980 Great West Road
Brentford Middlesex TW8 9GS (GB)

Representative: Knight, Lucie Viktoria
GlaxoSmithKline
Global Patents (CN925.1)
980 Great West Road
Brentford, Middlesex TW8 9GS (GB)

Respondent: Hoffmann Eitle
(Opponent 2) Patent- und Rechtsanwälte PartmbB
Arabellastrasse 30
81925 München (DE)

Respondent: Strawman Limited
(Opponent 3) Orchard Lea
Horns Lane
Combe, Witney
Oxfordshire OX29 8NH (GB)

Representative: Plasseraud IP
66, rue de la Chaussée d'Antin
75440 Paris Cedex 09 (FR)

Respondent: Maiwald Patent- und Rechtsanwalts-gesellschaft mbH
(Opponent 4) Elisenhof, Elisenstrasse 3
80335 München (DE)

Representative: Huenges, Martin
Maiwald Patentanwalts- und
Rechtsanwalts-gesellschaft mbH
Elisenhof
Elisenstraße 3
80335 München (DE)

Respondent: Graf von Stosch
(Opponent 5) Patentanwaltsgesellschaft mbH
Prinzregentenstrasse 22
80538 München (DE)

Representative: Maiwald Patent- und Rechtsanwalts-gesellschaft mbH
Elisenhof
Elisenstraße 3
80335 München (DE)

Respondent: Taormino, Joseph Paul
(Opponent 7) c/o Hoffmann Eitle Patent - und
Rechtsanwälte PartmbB
Arabellastrasse 30
81925 Munich (DE)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
4 October 2018 concerning maintenance of the
European Patent No. 1561756 in amended form.**

Composition of the Board:

Chairwoman	G. Alt
Members:	B. Claes
	A. Bacchin

Summary of Facts and Submissions

- I. Appeals were lodged by the patent proprietor (appellant I) and by opponent 6 (appellant II) against the interlocutory decision of the opposition division that the patent, amended in accordance with auxiliary request 144 filed during the oral proceedings and the invention to which it related, met the requirements of the EPC.

- II. In the decision under appeal the opposition division held further that claim 1 of the main request and of all the auxiliary requests which had been filed before the oral proceedings and were upheld by the patent proprietor during those oral proceedings and which were higher ranking than auxiliary request 137, did not comply with the requirements of Article 123(2) EPC. Claim 3 of all the other auxiliary requests which had been filed before the oral proceedings and were upheld by the patent proprietor during the oral proceedings (auxiliary requests 137, 139, 141 and 143) was found to lack clarity (Article 84 EPC).

- III. With their statement of grounds of appeal appellant I requested that the decision under appeal be set aside and the patent be maintained on the basis of the claims of a main request or, alternatively, on the basis of the claims of one of auxiliary requests 1 to 16 (all filed with their statement of grounds of appeal and being identical to the main request and auxiliary requests 12, 36, 44, 68, 76, 100, 108, 129, 131, 133, 135, 137, 139, 141, 143 and 144, respectively, dealt with in the decision under appeal). They requested oral proceedings on a conditional basis.

- IV. Appellant II (opponent 6) requested that the decision under appeal be set aside and the patent be revoked. They requested oral proceedings on a conditional basis.
- V. The board summoned the parties to oral proceedings to be held on 24 and 25 August 2021 and informed them of its preliminary opinion in a communication pursuant to Article 15(1) Rules of Procedure of the Boards of Appeal (RPBA 2020), dated 17 November 2020.
- VI. With a communication of 7 July 2021 the board refused the request for postponement of the oral proceedings filed by opponent 3 and confirmed that these were taking place as planned in person.
- VII. In a letter dated 13 July 2021 appellant I declared as follows
- "Patentee herewith withdraws all claim requests on file (i.e., the Main Request as well as Auxiliary Requests 1 to 16 filed with our Grounds of Appeal on February 19, 2019).*
- Moreover, Patentee does no longer approve to the text of the patent as granted as well as the text of the patent as maintained in amended form (based on the Opposition Division's interlocutory decision of October 4, 2018).*
- Finally, we herewith withdraw our previous request for oral proceedings."*
- VIII. The board thereafter cancelled the oral proceedings.
- IX. In a letter dated 29 July 2021 appellant I further declared that they *"confirm that the Patentee will not submit an amended text of the patent."*

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is admissible.
2. Pursuant to the principle of party disposition established by Article 113(2) EPC the EPO shall decide upon the European patent only in the text submitted to it, or agreed, by the proprietor of the patent. This principle equally applies in opposition and opposition-appeal proceedings.
3. Such an agreement cannot be deemed to exist if the patent proprietor - as in the present case - expressly declares that they no longer approve the text in which the patent was granted, that they no longer approve the text of the patent in the form as held by the opposition division to comply with the requirements of the EPC and that they will not submit an amended text (see sections VI and VIII).
4. There is therefore no text of the patent on the basis of which the board can consider the appeal. In these circumstances, the proceedings are to be terminated by a decision ordering revocation of the patent, without examination of the appeal on its merits (see decision T 73/84, OJ EPO 1985, 241, and Case Law of the Boards of Appeal of the European Patent Office, 9th Edition 2019, IV.D.2).
5. Revocation of the patent is equally the request of appellant II and also complies with the requests of respondents II (opponent 2), III (opponent 3), IV (opponent 4), V (opponent 5) and VII (opponent 7).

There are also no remaining issues that need to be dealt with by the board in the present appeal case. The decision in the present appeal case can therefore be taken without holding oral proceedings.

Reimbursement of the appeal fee

6. Appellant I withdrew their request for oral proceedings with the letter of 13 July 2021 and thus within one month of notification of the communication dated 7 July 2021, issued by the board in preparation of the oral proceedings.
7. The decision of the board is handed down in writing, without oral proceedings being held. Therefore, the requirements of Rule 103(4)(c) EPC for a partial reimbursement of the appeal fee paid by appellant I are met.
8. The active withdrawal of the request for oral proceedings by appellant I however does not automatically lead to a partial reimbursement of the appeal fee paid by appellant II (see also decision T 795/19, reasons 4.6 and 4.9).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The appeal fee paid by appellant I is reimbursed at 25%.

The Registrar:

The Chair:



I. Aperribay

G. Alt

Decision electronically authenticated