

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 9 March 2022**

Case Number: T 2710/19 - 3.3.07

Application Number: 10720107.1

Publication Number: 2391355

IPC: A61K47/26, A61K47/36, A61K9/48,
A61K31/454, A61K47/10

Language of the proceedings: EN

Title of invention:

FORMULATIONS OF 4-AMINO-2-(2,6-DIOXOPIPERIDINE-3-
YL) ISOINDOLINE-1,3-DIONE

Patent Proprietor:

Celgene Corporation

Opponents:

Teva Pharmaceutical Industries Ltd.
Generics [UK] Ltd
HGF Limited
STADA Arzneimittel AG
Hoffmann Eitle

Headword:

Formulations of Pomalidomide / CELGENE

Relevant legal provisions:

EPC Art. 113(2)

Keyword:

Basis of decision - text or agreement to text withdrawn by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



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 2710/19 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 9 March 2022

Appellant: Generics [UK] Ltd
(Opponent 2) Station Close
Potters Bar
Hertfordshire EN6 1TL (GB)

Representative: Elkington and Fife LLP
Prospect House
8 Pembroke Road
Sevenoaks, Kent TN13 1XR (GB)

Appellant: Hoffmann Eitle
(Opponent 5) Patent- und Rechtsanwälte PartmbB
Arabellastrasse 30
81925 München (DE)

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

Respondent: Celgene Corporation
(Patent Proprietor) 86 Morris Avenue
Summit, NJ 07901 (US)

Representative: Carpmaels & Ransford LLP
One Southampton Row
London WC1B 5HA (GB)

Party as of right: Teva Pharmaceutical Industries Ltd.
(Opponent 1) 124 Dvora HaNevi'a St.
6944020 Tel Aviv (IL)

Representative: Lederer & Keller Patentanwälte
Partnerschaft mbB
Unsöldstraße 2
80538 München (DE)

Party as of right: HGF Limited
(Opponent 3) 1 City Walk
Leeds Yorkshire LS11 9DX (GB)

Representative: HGF
HGF Limited
1 City Walk
Leeds LS11 9DX (GB)

Party as of right: STADA Arzneimittel AG
(Opponent 4) Stadastrasse 2-18
61118 Bad Vilbel (DE)

Representative: Hamm&Wittkopp Patentanwälte PartmbB
Jungfernstieg 38
20354 Hamburg (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 September 2019 concerning maintenance of the
European Patent No. 2391355 in amended form.**

Composition of the Board:

Chairman A. Usuelli
Members: E. Duval
A. Jimenez

Summary of Facts and Submissions

- I. European patent No. 2 391 355 (the patent) was granted on the basis of a set of 15 claims.
- II. The patent was opposed under Article 100 (a), (b) and (c) EPC, on the grounds that the subject-matter of the patent lacked novelty and inventive step, it was not sufficiently disclosed and it extended beyond the content of the application as filed.
- III. The present appeal by opponent O5 (the appellant) lies from the decision of the opposition division finding that the patent in amended form met the requirements of the EPC. Opponent O2 also lodged an appeal against the decision of the opposition division, but subsequently withdrew its opposition and its appeal.
- IV. By letter dated 4 March 2022, the patent proprietor (the respondent) stated that it withdrew its approval of the text in which the patent was granted, as well as all requests on file, and that no replacement text would be submitted. The respondent mentioned that it understood that the consequence would be revocation of the patent.

Reasons for the Decision

Pursuant to Article 113(2) EPC, the European Patent Office shall decide upon the European patent only in the text submitted to it, or agreed, by the proprietor of the patent.

Such agreement is not deemed to exist if the patent proprietor, as in the present case, has expressly

stated that it disapproved the text of the granted patent and stated that it would not submit an amended text.

There is therefore no text on the basis of which the board can maintain the patent. In these circumstances, the proceedings are to be terminated by a decision ordering revocation of the patent, without examination as to patentability.

Since the Board can grant the appellant's and respondent's request to revoke the patent, the oral proceedings were cancelled and the decision can be taken in written proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



B. Atienza Vivancos

A. Usuelli

Decision electronically authenticated