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**Datasheet for the decision
of 20 November 2023**

Case Number: T 2719/19 - 3.3.04

Application Number: 16160321.2

Publication Number: 3056218

IPC: A61K39/395, C07K16/18

Language of the proceedings: EN

Title of invention:

Prolongation of survival of an allograft by inhibiting complement activity

Applicant:

Alexion Pharmaceuticals, Inc.

Headword:

Allograft survival/ALEXION

Relevant legal provisions:

EPC Art. 87(1), 54

Keyword:

Priority - (yes)

Novelty - (yes)

Decisions cited:

G 0001/22, G 0002/22

Catchword:



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Case Number: T 2719/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 20 November 2023

Appellant: Alexion Pharmaceuticals, Inc.
(Applicant) 352 Knotter Drive
Cheshire, CT 06410 (US)

Representative: Soames, Candida Jane
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 11 April 2019
refusing European patent application No.
16160321.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman M. Pregetter
Members: A. Chakravarty
A. Bacchin

Summary of Facts and Submissions

- I. The appeal lies from the interlocutory decision of the examining division refusing European patent application No. 16 160 321.2 ("the application in suit"). This patent application is a divisional application of the earlier application EP 14 177 646.8, which in turn is a divisional application of the parent application EP 05 779 924.9, filed as international application PCT/US2005/017048, the "PCT application". The parent application gave rise to European patent EP 1 755 674, which is the subject of opposition appeal proceedings before this board as case T 1513/17.
- II. The patent application claims priority on the basis of the US provisional patent application No. 60/571,444 (the "priority application").
- III. In the proceedings before the examining division, the appellant requested *inter alia* that EPO Form 1200 be corrected to indicate that the applicants for the application were the appellant and H. Wang and Z. Zhong.
- IV. Also in the proceedings before the examining division, third party observations pursuant to Article 115 EPC were filed with a letter dated 28 March 2017. Attention was drawn to the decision of the opposition division at the oral proceedings relating to the patent deriving from the parent application (i.e. the patent being the subject of the appeal proceedings T 1513/17, see above), namely to refuse the requested correction of the applicants' names and to revoke the patent.

- V. In its communication of 12 June 2017, the examining division preliminarily agreed with the decision of the opposition division in the parent case to refuse the requested correction and concluded that also in the present case the claimed priority was invalid. Consequently, documents D20 and D21 were prior art and the subject-matter of claim 1 of the patent application was not novel in the light of the disclosure in these documents.
- VI. In its letter dated 1 May 2018, the appellant argued that the entitlement to priority was not dependent on the requested correction.
- VII. In its communication of 20 July 2018, the examining division reiterated its agreement with the decision of the opposition division in the parent case to refuse the requested correction. It furthermore did not acknowledge the validity of the priority claim because the appellant was the sole applicant of the patent application, but was not applicant of the priority application.
- VIII. The priority claim being invalid, the examining division reiterated its view that the subject-matter of claim 1 of the present application was anticipated by the disclosure of documents D20 and D21.
- IX. The appellant was summoned to oral proceedings, but informed the examining division that they would not attend. They requested a decision based on the written submissions. The subsequent decision of the examining division refers to the communication of 20 July 2018 for the grounds.

- X. In the appeal proceedings the applicant (appellant) maintained its view that the priority claim was valid. The decision of the examining division to refuse the requested correction was not disputed.
- XI. The board appointed oral proceedings for 8 December 2021 and with the summons, issued a communication pursuant to Article 15(1) RPBA setting out its preliminary opinion concerning matters relevant for the decision to be taken.
- XII. Oral proceedings took place as scheduled. Appeal case T 1513/17 and the appeal case T 2719/19 were heard in parallel. At the hearing the board decided to deal with both appeal cases in consolidated proceedings pursuant to Article 10(2) RPBA. At the end of the hearing the chair announced that the board was seriously contemplating referring questions to the Enlarged Board of Appeal concerning issues related to the entitlement to priority.
- XIII. The board subsequently issued an interlocutory decision as a joint decision in cases T 1513/17 and T 2719/19 on 28 January 2022. The board found (both) appeals to be admissible.

The following questions were referred to the Enlarged Board of Appeal (EBA):

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1) (b) EPC?

II. If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC

in the case where

1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

XIV. The EBA answered these (reformulated) questions by decisions G 0001/22 and G 0002/22 dated 10 October 2023, as follows.

"I. The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.

There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.

II. The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).

In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary".

XV. The following documents are referred to in this decision.

D20: Wang H. *et al.*, Transplantation (2004), 78(2) supplement 1, Abstract 0190;

D21: Wang H. *et al.*, American Transplant Congress (2005), p556, Abstract No. 1571.

XVI. The arguments of the appellant on priority entitlement were set out in the interlocutory (referring) decision in this case (see Section IX) and are not repeated here. Since the priority claim was valid, nothing stood in the way of the grant of the patent.

XVII. The appellant requests that the decision under appeal be set aside and that the application remitted to the examining division with an order for grant on the basis of the claims considered by the examining division, filed on 8 November 2016; or in the alternative that the case be remitted to the examining division in case any other issue than the validity of the priority right would be considered pertinent. Oral proceedings are requested if the former request cannot be granted.

Reasons for the Decision

Claim 1

Novelty (Article 54 EPC)

1. The examining division's decision to refuse refers to its communication dated 20 July 2018 for the reasons. In this communication the subject-matter of claim 1 of the main request filed on 8 November 2016 was considered as lacking novelty over the disclosure in documents D20 and D21. These documents were considered to be prior art because there was no valid priority claim (Article 87(1) EPC). No other objections were raised in this communication, nor in the one preceding it, dated 12 June 2017.

2. In the interlocutory decision in consolidated proceedings T 1513/17 and T 2719/19, it was established that the key question in the case(s) concerned the validity of the priority right, since only if this was not valid were the cited documents state of the art for the claimed subject-matter.

Summary of filings and applicants

3. European patent application No. 16 160 321.2 (the "application in suit") was filed as a divisional application of an earlier divisional application derived from application EP 05 779 924.9. This latter patent application was based on a PCT application, published as international application WO 2005/110481 with the filing date of 16 May 2005 (the "PCT application"). It claims priority of the US provisional patent application No. 60/571,444, filed on 14 May 2004

(the "priority application"). The priority application was filed in the name of R.P. Rother, H. Wang and Z. Zhong, the inventors. The PCT application names the three inventors as inventors and as applicants for the United States of America (US) only. For all designated States except the US, it names Alexion Pharmaceuticals, Inc. and the University of Western Ontario as applicants. Since the University of Western Ontario had assigned their right to the patent application to Alexion Pharmaceuticals, Inc. in 2007, the parent patent names the latter as the sole patent proprietor and R.P. Rother, H. Wang and Z. Zhong as inventors. The same applies for the patent application.

4. The EBA has decided that there is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority and that this presumption also applies in the factual situation of the case at hand, i.e. where the European patent application derives from a PCT application and where the priority applicant(s) are not identical with the subsequent applicant(s).

5. Moreover, the EBA ruled that in the situation of the present case where the PCT application (here WO 2005/110481) with the filing date of 16 May 2005 was jointly filed by parties A (here R.P. Rother, H. Wang and Z. Zhong, as inventors and as applicants for the United States of America (US) only) and B (here Alexion Pharmaceuticals, Inc. and the University of Western Ontario for all designated States except the US), and claiming priority from an earlier patent application (here US provisional patent application No. 60/571,444) designating parties A as the applicant, the joint

filing implies an agreement between parties A and B, allowing parties B to rely on the priority, unless there are substantial factual indications to the contrary (G 1/21 and G 2/22, Order II).

6. No substantial factual indications to the contrary were mentioned in the decision under appeal nor is the board aware of any.

Remittal (Article 111(1) EPC)

7. The decision under appeal does not address any of the other requirements of the EPC, except for that of Article 123(2) EPC. The board notes that the examining division did not refer to further need to examine the application, in case the priority were found to be validly claimed. In view of this, the appeal is allowable and, since no other objections have been raised in the decision under appeal or in the communications of the examining division leading up to the decision, the board sees no reason not to remit the case with the order to grant a patent based on the set of claims filed 8 November 2016, on which the decision of the examining division was based.

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 with the order to grant a patent based on the set of claims filed 8 November 2016, with the description and drawings to be adapted thereto, as necessary.

The Registrar:

The Chairwoman:



I. Aperribay

M. Pregetter

Decision electronically authenticated