

Publication in the Official Journal Yes No

File Number: T 1/92 - 3.3.2

Application No.: 85 901 706.3

Publication No.: 0 174 366

Title of invention: T-cell Receptor-Specific for antigen Polypeptides and related polynucleotides

Classification: C12N 15/12

D E C I S I O N
of 27 April 1992

Applicant: THE BOARD OF TRUSTEES OF THE LELAND STANFORD JUNIOR
UNIVERSITY

Headword: Approval-disapproval/LELAND STANFORD

EPC Articles 97, 113; Rules 51(4), (5) and (6), 67 and 86(3)

Keyword: "Admissibility (yes) - Applicant adversely affected by decision to grant"
"No basis for decision - text not unambiguously agreed by the Applicant"
"Suspensive effect of appeal - premature publication cancelled"
"Violation of Article 113(1) EPC - reimbursement fo appeal fee"

Headnote follows



Case Number : T 1/92 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 27 April 1992

Appellant : THE BOARD OF TRUSTEES OF
THE LELAND STANFORD JUNIOR UNIVERSITY
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Decision under appeal : Decision of Examining Division of the European
Patent Office dated 19 August 1991 refusing
European patent application No. 85 901 706.3
pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : E.M.C. Holtz
U.M. Kinkeldey

Summary of Facts and Submissions

- I. The appeal by the patent proprietor lies against the decision of 19 August 1991 to grant European patent No. 0 174 366, based on International application No. PCT/US 8500367 (European application No. 85 901 706.3). The mention of the grant was published in the European Patent Bulletin 91/39 on 25 September 1991.
- II. The procedure before the Examining Division may be summarised as follows.

On 14 November 1990, the Examination Division of the EPO issued a Communication under Rule 51(4) EPC, requesting the Appellants to state their approval of the proposed text for grant within four months of the communication (EPO Form 2004, together with enclosed EPO Form 2056). On 14 March 1991, the EPO received a letter from the Appellants, giving approval of this text. This receipt was acknowledged in a communication of 27 March 1991 under Rule 51(6) EPC on EPO Form 2005, in which the Appellants were requested to pay the stipulated fees and to file translations of the claims within a non-extendable period of three months. They were further advised that in the case of late filing, the European patent application would be deemed to be withdrawn under Rule 51(8) EPC.

On 20 March 1991, within the period given in the Rule 51(4) EPC communication, and before the communication under Rule 51(6) EPC, the Appellants submitted requests by telecopy to disregard their approval of 14 March 1991 "if that letter has not been received" and to extend the time limit for responding to the Rule 51(4) invitation. The Formalities Officer of the Examining Division issued on 2 April 1991 a brief communication (EPO Form 2937),

informing the Appellants that amendments were no longer possible once approval had been given, referring to Part C, Chapter VI, 4.10 of the Guidelines for examination in the European Patent Office.

The Appellants filed the necessary translations of the claims and paid the grant and printing fees on 3 July 1991 in response to the Rule 51(6) communication of 27 March 1991.

On 9 August 1991, the Appellants filed a letter with the EPO, stating that they had discovered problems related to novelty and requesting that the Examiner "make a motion to resume the proceedings" to enable the Appellants to amend the claims.

On 19 August 1991, the Formalities Officer of the Examining Division issued a decision to grant a European patent pursuant to Article 97(2) EPC (EPO Form 2006). The certificate for the European patent was transmitted on 19 December 1991.

The Appellants filed their Notice of Appeal on 30 August 1991, together with payment of the appeal fee. The Statement of Grounds was filed on 11 September 1991.

III. The Appellants request that

- (a) the decision to grant be set aside,
- (b) the patent not be granted and its grant not be published at the foreseen date,
- (c) the application be remitted to the Examining Division for consideration of submissions made in the letter dated 9 August 1991,

(d) the appeal fee be reimbursed, and that

(e) oral proceedings be held before any decision other than to grant the previous requests is taken.

IV. In support of their requests, the Appellants have mainly submitted the following.

The basic issue is whether it was proper for the EPO to issue the decision to grant on 19 August 1991, notwithstanding the reasoned request filed on 9 August for resumption. This raises in turn the question of when a request for resumption has to be filed in order to be considered by the Examining Division.

Obligation to consider requests

The approval in response to a communication pursuant to Rule 51(4) EPC is binding, the only exception according to the Guidelines being that the Examining Division becomes aware of circumstances causing it of its own motion to resume the proceedings because these circumstances are such as to render non-patentable subject-matter claimed. This exceptional situation corresponds exactly to the Appellants' situation. Although it is recognised that the Examining Division has discretion in such a matter, the Appellants therefore submit that they were entitled to have their request considered, provided it was filed in due time. The concern in the present case is that the Examining Division was not given the opportunity to exercise its discretion.

Due time for a request for resumption

As to the question of due time for filing a request for resumption, the Appellants submit, with reference to the

Guidelines, C. VI. 4.10 (see above, point III), that the Examining Division is not precluded from action until despatch of the decision to grant. Paragraph 15.1.5 of C.VI likewise refers to the possibility of resumption "before the decision to grant is issued" and that paragraph 15.5 explains that the decision to grant is sent when the technical preparations for printing the patent specification have been completed. The Guidelines contain no suggestions that there is an earlier critical date after which the Examining Division would be unable to consider such a request.

A parallel may be drawn to corrections under Rule 88 EPC (Notice from the Vice-President of Directorate-General 2, OJ EPO 1-2 1989, page 43), which may be made until the technical preparations have been completed, but not after the decision to grant has been issued. The implication is that the possibility exists until issue of the decision to grant.

If any other practice was intended to apply, it should have been clearly advertised (cf. the statement by the President of the EPO in OJ EPO 1978, page 312, setting out the proper calculation of the termination of technical preparations).

The Appellants' request for resumption was filed only four days after the papers had been sent for publication, cf. the Guidelines C.VI.15.5a, where the willingness is expressed to try and prevent publication of an application, even if a withdrawal is not received until after termination of the technical preparations. In the present case the EPO did not comply with T 231/85 (OJ EPO 1989, 74), according to which parties must be able to rely

on material evidence being forwarded to the deciding authority within a few days of receipt.

Other possible remedies

In the ensuing discussions with various departments of the EPO, the possibility of self-opposition was raised. Such a procedure, however, would mean extra costs, as well as costs to meet national requirements of the designated states. It would also mean uncertainty for third parties for a substantial period. In the public interest the EPO should not knowingly grant patents whose validity is very seriously questioned.

Reasons for the Decision

1. Admissibility

The Notice of Appeal, appeal fee and the Statement of grounds have all been submitted in due time under Article 108 EPC.

For the purposes of Article 107 EPC, it has to be established whether or not the Appellants were adversely affected by the decision to grant the patent in question before the appeal can be declared admissible.

Under Article 107 EPC, any party to proceedings adversely affected by a decision may appeal. As the Appellants' requests that their approval be disregarded and that the time limit for response to the Rule 51(4) EPC communication be extended were filed within the four month period given in that communication; they were entitled, in accordance with Rule 51(5) EPC to make observations upon invitation by the Examining Division, should it not

consent to the proposed amendments. This means that in any circumstance the Appellants were entitled to a response dealing with their requests. Under Rule 51(4) EPC, last sentence, they were further automatically entitled to the requested extension.

The request of 20 March 1991 to disregard the approval, being on time, made it impossible for the EPO to establish as required by Rule 51(6) EPC that the approval still was maintained unambiguously. As the subsequent decision to grant could not be said to correspond to an unambiguous request as required by the consistent case-law of the Boards of Appeal (cf. i.a. J 12/85, OJ EPO 1986, 155) the Appellants are adversely affected for the purposes of Article 107 EPC.

The appeal is therefore admissible.

2. Allowability

Article 113(2) EPC provides that the EPO shall consider and decide upon the European patent application only in the text submitted to it, or agreed, by the applicant.

The Communication of 2 April 1991 sets out a restriction not laid down in the Convention, namely that amendments are no longer possible after an approval under Rule 51(4) EPC has been given. If this were true, there would be only one possible interpretation of this Rule, i.e. that a given approval is irrevocable. Such an interpretation would seem consistent with the Guidelines, Part C, VI, 4.10, which indicate that an approval is binding.

However, no part of Rule 51 EPC or any other provision of the Convention attaches such a preclusive effect to the approval. As the Boards of Appeal are not bound by the

Guidelines, but only by the Convention and its Implementing Regulations, the following considerations become relevant for the proper interpretation of the effect of an approval.

As already described in point 1, Rule 51(5) EPC expressly entitles the applicant to have a response from the Examining Division to a request for amendment, if this request is filed on time. As a result, no final decision may be taken until that time limit has expired, and only then if there is an unambiguous approval.

Rule 51(6) EPC requires the Office to establish (i.e. find beyond doubt) that the applicant approves the text as intended for grant, before proceeding any further. Only if such an approval was the only submission on file at the expiration of the time limit provided by Rule 51(4) would the interpretation as given in the above Communication be correct.

The travaux préparatoires to the 1987 amendment of Rule 51 EPC, in effect as of 1 September 1987, Doc CA/26/87 - XXVI, make no mention either of such a preclusive effect of the approval. The main object was to separate the procedure for approval from the subsequent formal requirements (fees for grant etc.) in order to safeguard the rights of applicants, depending on their reaction to the text proposed for grant. This was a result of decision J 22/86, OJ EPO 1987, 280, invalidating the former practice with interlocutory revision upon appeal.

The 1987 amendments do not change the basic principle of procedure that the latest request filed within a stipulated time limit, whereby earlier requests are withdrawn, is the one validly expressing the position of the party in question.

It follows from the above that an approval filed in response to a Rule 51(4) EPC communication is not absolutely binding and that a decision to grant thus cannot be issued, if, at the end of the time limit given in the communication, it cannot be established that the applicant still agrees unambiguously to the text intended for grant.

The conditional phrase of the 20 March request to disregard the approval, "if that letter has not been received", could be interpreted to imply that the approval would still be valid if already received by the EPO. But, as already noted above, the decisive factor is that the text upon which the EPO proceeded to grant could not be said to have been unambiguously approved within the time limit provided under Rule 51(4) EPC.

The indispensable basis as required by Article 113 EPC for a decision was thus not present.

Further, the request to have an extension under Rule 51(4) EPC should have been automatically granted.

The decision to grant the patent must therefore be set aside.

3. Procedural violations

3.1 Publication in spite of the appeal

The Notice of Appeal was filed on 30 August 1991 and the appeal fee was credited as paid on 5 September 1991. From the latter date there was thus an appeal in existence, which necessitated a decision by a Board of Appeal, even if the decision would only have been to declare the appeal inadmissible.

An appeal has suspensive effect (Article 106(1) EPC). Although not changing the date of the contested decision, this effect prevents it from having any legal consequences. It further means that the earliest date at which the decision under appeal could have any such consequences (provided it was upheld) would be the date of a decision by a Board of Appeal.

This should have led the EPO to stop the publication of the mention of the grant (cf. The Guidelines for the Examination in the EPO, E.XI.1, which presupposes that publication does not take place when an appeal has been filed). The reasons given according to the Appellants, that the preparations already were made and that in fact the manuscript had already been sent on 5 August 1991, are of secondary importance. Such practical considerations may not override the suspensive effect of the appeal, not even if the appeal should later be declared inadmissible.

By not observing this principle, the Examining Division committed a substantial procedural violation with wide-reaching effects.

First and foremost the time period for oppositions is calculated from the mention of the grant as published in the European Patent Bulletin. As the date of a decision under appeal does not change, but only its effects are suspended, it is self-evident that no measures must be taken when an appeal has been filed, in particular no measures which could render the appeal useless.

Secondly, the public, relying on the official information relating to the publication, could take steps to file oppositions. This would involve unnecessary oppositions at unnecessary costs, if the text later proved not to be valid. Significant economic losses could result, losses which might not necessarily be recoverable. The patent

proprietor could also be forced to oppose the patent.

In order to prevent such results, if possible, the Board decided to examine the appeal with priority.

The effects of the publication must be cancelled by a correcting notice in the European Patent Bulletin (cf. J 14/87, OJ EPO 1988, 295), to set off the starting date for the time period for opposition.

3.2 The 9 August request for resumption of proceedings

The fact that the Appellants never were informed about whether or not the Examining Division would consider the request filed on 9 August 1991 constitutes a further procedural violation, having regard to Article 113(1) EPC. This is an issue separate from the substantive issue already dealt with in point 2 above, which related to Article 113(2) EPC. Indeed, with regard to Article 113(1) EPC, the Guidelines, Part C, VI, 4.11, correctly indicate the need for the Examination Division to send a communication to the applicant, if it expects to refuse a request for amendments.

3.3 Reimbursement

In view of the substantial procedural violations and the allowability of the appeal, reimbursement of the appeal fee is warranted for reasons of equity.

4. Further issues

4.1 The effect of approvals under Rule 51(4) EPC

Reference is made in the Communication of 2 April 1991 to an enclosed copy of the Guidelines, Part C, VI, 4.10 where

the incorrect interpretation regarding the binding nature of an approval under Rule 51(4) EPC, is expressed. In said paragraph of the Guidelines reference is in turn made to Part C, VI, 15.1 of these Guidelines, where i.a. the proper procedure upon requests for amendments is laid out. Nowhere in this part of the Guidelines is it stated that an approval precludes a subsequent request for amendment filed on time. As already observed in point 2, neither the Convention, nor its Implementing Regulations imposes such an effect.

The Board would take this opportunity to remark that the Guidelines Part C, VI, 4.10 seem to need a qualifying amendment in order that all requests filed within the time period under a Rule 51(4) communication are duly taken into account by the Examining Division before proceeding under Rule 51(6) EPC.

Preparatory measures prejudicial to the appeal may not be undertaken before lapse of the time period for response to the Rule 51(4) communication (i.e. four or six months as the case may be). Only after having made sure at the end of this period that the approval has been irrevocably made, as required by Rule 51(6) EPC, is the Examining Division free to proceed to grant.

4.2 The discretion under Rule 86(3) EPC

Whether or not the Appellants should have their amendments considered is a matter of discretion under Rule 86(3) EPC. As the novelty question raised is one of substance, this discretion should be exercised by the Examining Division (cf. T 63/86, OJ EPO 1988, 224).

4.3 Remaining requests

Given the above outcome of the appeal, none of the remaining requests by the Appellants - regarding the merits of the request of 9 August 1991, the extent of the obligation of the Examining Division to consider requests for late filed amendments, the justification for a resumption of the proceedings in view of the particular facts, or the request for oral proceedings - comes under consideration by the Board.

Order

For these reasons, it is ordered that:

1. The decision of 19 August 1991 to grant European patent No. 0 174 366 is set aside.
2. A notice is to be published in the European Patent Bulletin, stating that the publication on 25 September 1991 of the mention of the grant of European patent No. 0 174 366 is to be disregarded and that the decision of 19 August 1991 to grant the same patent is without effect.
3. European patent application No. 85 901 706.3 is remitted to the Examining Division for further consideration.
4. The appeal fee is reimbursed.

The Registrar:

The Chairman:

P. Martorana

P.A.M. Lançon