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**Datasheet for the decision
of 5 July 2013**

Case Number: J 0005/12 - 3.1.01

Application Number: 06824918.4

Publication Number: 1934608

IPC: G06F 7/00

Language of the proceedings: EN

Title of invention:

Targeted identification of immunogenic peptides

Applicant:

Henry M. Jackson Foundation for the Advancement of Military
Medicine, Inc.

Opponent:

-

Headword:

Correction of application/JACKSON FOUNDATION

Relevant legal provisions:

EPC Art. 106(2), 123(2)
EPC R. 70a(2), 137(2), 139

Keyword:

"Correction of application - need for technical examination"
"Competence of Receiving Section (no)"
"Merely incidental issue (yes)"

Decisions cited:

G 0011/91, J 0004/85, J 0033/89, J 0007/97

Catchword:

See points 7 to 10 of the reasons.



Case Number: J 0005/12 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 5 July 2013

Appellant:
(Applicant) Henry M. Jackson Foundation for
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Decision under appeal: **Decision of the Receiving Section of the
European Patent Office posted on
21 October 2011.**

Composition of the Board:

Chairman: B. Günzel
Members: R. Moufang
R. Cramer

Summary of Facts and Submissions

- I. The present application, which claims the priority of the US application 60/714865 of 8 September 2005, was filed as international application PCT/US2006/035171 with the USPTO as Receiving Office on 8 September 2006 and was published as WO 2007/030771 A2 on 15 March 2007.
- II. The priority application contained a description (= pages 1-12 of the certified copy of the priority document), claims 1 to 17 (= pages 13-14), an abstract (= page 15) and an Attachment A. On page 12, lines 22-23, 25-26, the description refers to the attachment in the following way: "Appendix A "Immunotherapy: Novel Vaccine Discovery and Treatment" is a presentation directed to the embodiments described herein. [...] Appendix A is attached as related examples, tables and figures of embodiments of the present invention."
- III. The international application did not include Attachment A of the priority application, nor did its description contain an explicit reference to it. It contained 17 claims which were identical to the claims of the priority application. It did not contain any figures or sequence listings. On page 1, second paragraph, and on page 12 of the published application (fourth full paragraph, second sentence), the following statements were made:

"Reference to Related Applications

This application claims priority to United States Provisional Application No. 60/714,865 entitled
"Targeted Identification of Immunogenic Peptides"

filed September 8, 2005, the entirety of which is hereby incorporated by reference."

"All references cited herein, including all patents and publications that are cited for any reason, including U.S. Provisional Application No. 60/714,865, on which priority is based, are specifically and entirely incorporated by reference."

- IV. During the international phase on 7 March 2008 the applicant submitted a notice under Rule 20.6 PCT to the USPTO as Receiving Office for incorporation by reference of a portion of the description and of figures (= page 5, line 12 to page 6, line 4 and page 13, line 22 to page 14, line 18 of an amended description, and newly filed figures 1 to 8), which were said to constitute elements of the priority application, referred to in Article 11(1)(iii)(d) PCT. On the same day the applicant also submitted to the USPTO substitute new sheets which contained added claims 18 to 37. In this context it relied on Article 19 PCT and pointed out that the amended claims found support in the specification, which had incorporated elements from the priority application by reference. The added claims 18 to 37 were published later (on 31 December 2008) by the International Bureau as an A4 publication.
- V. The applicant entered the regional phase before the EPO on 31 March 2008. By crossing the corresponding box on Form 1200, it declared that the proceedings before the EPO were to be based on the application documents published by the International Bureau (with all claims,

description and drawings), where applicable with amended claims under Article 19 PCT unless replaced by the amendments attached. The appellant attached two sets of claims 1 to 19, one set showing the amendments with respect to the originally filed claims 1 to 17 of the international application, the other set being a clean copy. No other amendments were submitted.

VI. The international search was completed on 17 June 2008 by the USPTO as International Searching Authority. The international search report was mailed on 12 August 2008 and published in the A3 publication WO 2007/030771 on 20 November 2008. Furthermore, on 28 October 2008 the International Bureau of WIPO issued an international preliminary report on patentability (Chapter I of the PCT) based on a written opinion of the International Searching Authority. Both reports refer to claims 1 to 37.

VII. On 15 December 2008 the Receiving Section of the EPO issued a communication pursuant to Rules 161 and 162 EPC (EPO Form 1226) which contained *inter alia* the following information:

"The claims applicable on expiry of the above time limit, i.e. those filed on entry into the European phase or in response to the present communication, will form the basis for [...] any supplementary search to be carried out under Article 153(7) EPC (R. 161 EPC)."

No reply was filed by the applicant within the one-month time limit stated in the communication.

- VIII. With letter dated 17 December 2009 the applicant submitted a substitute amended specification including claims 1 to 37 and figures 1 to 8, a sequence listing (both in paper and in computer-readable form) and a certified copy of the priority document. Copies of various documents relating to the international phase were also submitted. The applicant argued that the application documents pending before the EPO were incomplete and incorrect. It requested that further substantive examination be based on the substitute amended specification as filed with the USPTO as Receiving Office on 7 March 2008 and that, prior to establishing the supplementary European search report, a new communication pursuant to Rules 161 and 162 EPC be issued in order to give the applicant the opportunity to amend the claims.
- IX. The Receiving Section informed the applicant about its preliminary view on the issues involved by means of a telephone conversation and a written communication. After the applicant submitted further arguments, the Receiving Section took a decision which was dispatched on 21 October 2011.
- X. The Order of the decision read as follows:
- "In the matter of European patent application no. 06824918.4 it is decided as follows:
1. The request to accept the amended application documents (description, claims, drawings) as filed with letter dated 17.12.2009 (received by the EPO on 21.12.2009) as a basis for the supplementary European search report cannot be allowed.

2. Concerning the application documents forming the basis for substantive examination, your attention is drawn to Rule 137(2) EPC.
3. The request to issue a further communication pursuant to Rules 161 and 162 EPC cannot be allowed."

The decision stated that it was open to appeal.

XI. In the reasons for the decision (points 8 and 9) the Receiving Section noted that the amendments could not even be introduced by way of a correction of the original application documents under Rule 139, second sentence, EPC and explained why, in its view, the requirements of this provision were not fulfilled in the present case.

XII. The applicant (appellant) appealed the above decision. The statement of grounds of appeal contained the following requests:

"It is hereby requested that the contested decision be set aside, a European search be performed and a European patent be granted on the basis of the Main Request.

Main Request

It is requested that the European regional phase before the European patent Office is based on the correct A4 publication (WO 2007/030771 A4) and the international search report (ESR) as well as the written opinion and the international preliminary report on patentability

(IPRP), respectively, which has been established on the basis of the claims of the WO A4 publication, and copies of which are held in the file at the European Patent Office.

It is further requested that substantive examination be based on the amended specification of the international application as filed by the applicant on March 07, 2008 with the USPTO as Receiving Office and which was attached to the letter of December 17, 2009 of the applicant.

[...]"

The appellant furthermore requested, as auxiliary request 1, that a new communication pursuant to Rules 161 and 162 EPC be issued. As auxiliary request 2, it conditionally requested oral proceedings.

XIII. The arguments submitted by the appellant in the first-instance proceedings and in its grounds of appeal in support of the above requests may be summarised as follows:

- The added claims 18 to 37 had been validly filed in the international phase under Article 19 in conjunction with Rule 46(1) PCT. The international search report, the written opinion and the international preliminary report on patentability had been drawn up on the basis not only of originally filed claims 1 to 17 but also of added claims 18 to 37 which had been subsequently published in the A4 publication of the International Bureau. No objections had been raised under Article 19(2) PCT.

- The further amendments filed in the international phase under Rule 20(6) PCT had been accepted by the USPTO as Receiving Office. They constituted missing parts incorporated by reference in the application.

- In addition, Article 34 in conjunction with Rules 66.1(b) and 66.4bis PCT provided for a further opportunity for filing amendments in the international phase. For these amendments, no publication was foreseen. Article 34 PCT should be taken into account since nowadays the international preliminary examination report corresponded to the international preliminary report on patentability.

- The errors which had occurred with the application in the international phase had been caused partly by the transmittal of an incomplete priority document by the USPTO to the International Bureau of WIPO. These errors had been dealt with by the USPTO, and the EPO should not reach a conclusion different from that of the USPTO. In neither the corresponding national continuation application before the USPTO nor the national phase before the Australian Intellectual Property Office had any objections been raised against the amendments introduced by the applicant in the international phase.

- The amendments did not contravene Article 123(2) EPC and were allowable under Rule 139 EPC. The international application incorporated by reference the complete disclosure of the priority application, including its Appendix A. The skilled person would have immediately noticed that the examples and drawings of this appendix were missing from the application, and

that the necessary disclosure content had to be supplemented from the priority document. The case law of the boards of appeal acknowledged that another document could be incorporated by reference into the original application.

- Accepting the amendments would not jeopardise legal certainty and the public interest since, in view of the international search report and the A4 publication, the public was well aware that missing parts had been added to the A2 publication.

XIV. The board summoned the appellant for oral proceedings. In a communication annexed to the summons the board set out its preliminary opinion on the issues arising from the appeal. Point 4 of this communication read as follows:

"The board understands the essence of appellant's main request to be that the board determines that the European grant procedure should be based at the current stage (i.e. before the drawing up of the supplementary European search report) on claims 1 to 37 as published in WO 2007/030771 A2 (claims 1 to 17) and in WO 2007/030771 A4 (claims 18 to 37) as well as on the amended specification (consisting of an amended description and drawings) as filed with the Receiving Office (USPTO) on 7 March 2008 and submitted to the EPO with the letter dated 17 December 2009. While the appellant has formulated its requests more broadly ("**a European patent be granted** on the basis of the Main Request"; "the **substantive examination** be based on the amended specification [...]"), the scope of the present appeal appears to be limited by the subject-matter

decided by the contested decision. Thus the board cannot decide on a request to grant a patent (no substantive examination has been carried out so far) nor determine on which documents the substantive examination has to be based (such a determination would be premature since the applicant will have an opportunity to amend his application after the drawing up of the supplementary European search report, see Rules 70a(2) and 137(2) EPC). **The appellant is therefore invited to clarify its requests."**

XV. According to the communication, the crucial issue of the appeal was to determine the documents on the basis of which the supplementary European search report was to be drawn up. The board explained in detail why, in view of the explicit statements made by the appellant when entering the regional phase and in view of the fact that the appellant had not replied to the communication under Rule 161 EPC, the Receiving Section appeared to have been correct in not accepting the appellant's view on this issue.

XVI. The board's communication furthermore contained a passage (= points 16 and 17) entitled "*Issues not to be determined in the present appeal*" which read as follows:

"Even if the present appeal were to be dismissed, the appellant will, as already noted above (see point 4), still have an opportunity to amend its application after the drawing up of the supplementary European search report (Rules 70a(2) and 137(2) EPC). Whether or not any future amendment by which the appellant may seek to introduce the same amendments as submitted in the international phase on 7 March 2008 will give rise

to objections under Article 123(2) EPC, is a hypothetical issue and not a matter to be decided by the board in the framework of the present appeal.

When deciding on an appeal, the board may exercise any power within the competence of the department which was responsible for the decision appealed (see Article 111(1) EPC). The contested decision was taken by the Receiving Section whose duties do, however, not include the raising of objections under Article 123(2) EPC requiring a technical examination. It is also not within the Receiving Section's competence to decide on a request for correction necessitating such a technical examination (see J 4/85, OJ EPO 1986, 205; J 33/89, OJ EPO 1991, 288; J 7/97 of 11 December 1997). The outcome of the present appeal therefore has no influence on any possible future decision eventually to be taken by the Examining Division relating to appellant's request under Rule 139 EPC."

XVII. In response to the summons, the appellant reformulated its requests and submitted further arguments. It now requested that the contested decision be set aside "concerning the Receiving Section's decision in section 1 of the contested decision in that (a) the introduction of the amended application documents (description, claims, drawings) as filed with letter dated December 17, 2009 is not allowable under Article 123(2) EPC and Rule 139 EPC as stated in section 8, 9 and 13 of the reasons of the decision; and (b) the missing parts of the descriptions [sic] and drawings, in particular sequence listing are not considered for the supplementary European search." The

appellant furthermore requested that the appeal fee be reimbursed.

XVIII. Oral proceedings took place on 5 July 2013. The appellant explained that it no longer disputed the contested decision's conclusion concerning the application documents on the basis of which the supplementary European search report was to be established. Nevertheless, it took the view that the decision had to be set aside in so far as it had rejected its request for correction under Rule 139 EPC, since the Receiving Section lacked competence in this respect.

XIX. The appellant requested that the decision under appeal be set aside to the extent that the request for incorporation of the amended application documents (description, claims, drawings) as filed with letter dated 17 December 2009 be remitted to the Examining Division. It also requested that the appeal fee be reimbursed.

Reasons for the decision

General

1. These appeal proceedings are part of the appellant's attempt to remedy two deficiencies potentially caused by oversights. The first occurred at the beginning of the international phase and was the omission, from the application documents, of the text of Attachment A of the priority document (see Sections II and III above). The second occurred at the beginning of the regional

phase and was the failure to indicate the documents filed in the international phase on 7 March 2008 as those on which the procedure before the EPO should be based (see Sections IV, V and VII above).

Admissibility of the appeal

2. The appealed decision did not terminate the examination proceedings concerning the patent application in suit. Pursuant to Article 106(2) EPC, it is therefore an admissibility requirement for the present appeal that the decision allowed a separate appeal. The board considers that the formulation "This decision is open to appeal" has to be interpreted as, at least implicitly, allowing a **separate** appeal. The appeal therefore complies with Article 106(2) EPC. All the other admissibility requirements laid down in Articles 106 to 108 and Rule 99 EPC were likewise met by the notice of appeal and the grounds of appeal.

The appellant's requests

3. The final requests made by the appellant at the oral proceedings before the board (see Section XIX above) differ considerably from those submitted in the grounds of appeal at the beginning of the appeal proceedings. They are nevertheless admitted into the proceedings by the board in the exercise of its discretion under Article 13(1) Rules of the Procedure of the Boards of Appeal (RPBA), because they are regarded as a reaction to the board's communication and can be assessed without giving rise to any difficulty or delay.

4. According to point 1 of the order of the appealed decision (see Section X above), the Receiving Section refused the request that it accept the amended application documents filed with the letter dated 17 December 2009 as a basis for the supplementary European search report. In point 3 of the order it furthermore refused the request that it issue a further communication pursuant to Rules 161 and 162 EPC. The appellant no longer challenges those rulings, and now accepts that the supplementary European search report has to be established on the basis of the documents indicated at the entry of the regional phase before the EPO. Therefore, the board does not have to take a decision on this issue, which was addressed in detail in the communication annexed to the summons (see point XV above).
5. The appellant's challenge of the contested decision is now restricted to those parts finding that the amendments sought could not be introduced by way of a correction of the original application documents under Rule 139 EPC. Relying on the preliminary view expressed by the board in its communication, the appellant argues that the Receiving Section had no competence to deal with this issue, which required a technical examination. The Receiving Section should therefore have refrained from deciding it at all, and the corresponding request should still be considered as pending so that it can be dealt with by the examining division at a later stage of the proceedings. It was necessary to set the decision aside in this respect in order to avoid the examining division considering itself bound by the Receiving Section's negative ruling on the issue. The appellant's request that the decision under appeal be

set aside "to the extent that the request for incorporating the amended application documents (description, claims, drawings) as filed with letter dated 17 December 2009 be remitted to the Examining Division" (see Section XIX above) has to be understood in the light of these arguments.

6. As the formulation of the above request indicates, the appellant appears to acknowledge that at the present stage of the proceedings it is not yet possible to finally determine on which documents the substantive examination has to be based. Doing so would indeed be premature, since the appellant still has an opportunity to amend its application after the supplementary European search report has been drawn up (see Rules 70a(2) and 137(2) EPC). The Receiving Section was therefore correct, with respect to the application documents forming the basis for substantive examination, to draw the appellant's attention to Rule 137(2) EPC (in point 2 of the Order of the decision, see Section X above).

Remaining subject-matter of the appeal

7. The board is aware of the appellant's concerns that, when trying to amend its application at a later stage by introducing the documents filed with the letter dated 17 December 2009, it may face objections under Article 123(2) EPC. It is apparently the appellant's position that it may then rely on the statements made in the original description to the effect that the priority application was to be incorporated in its entirety by reference (see Section III above), but that its procedural position would furthermore be improved

if the request for correction under Rule 139 EPC were considered to be still pending and to be decided upon by the examining division. The board is not wholly convinced of the logic of the latter proposition, since the requirements of Article 123(2) EPC must be fulfilled not only by amendments to a pending application but also by a correction of the originally filed application documents (see Enlarged Board decision G 11/91, OJ EPO 1993, 125). The board is nevertheless prepared to assume, for the sake of argument, that the appellant has an interest in seeking clarification that the Receiving Section had no power to refuse a correction under Rule 139 EPC in the present case and that its findings to that effect in the contested decision are not binding on the examining division.

8. According to the established case law it is not within the Receiving Section's competence to decide on a request for correction necessitating a technical examination (see J 4/85, OJ EPO 1986, 205; J 33/89, OJ EPO 1991, 288; J 7/97 of 11 December 1997). In the present case, the correction sought with respect to the description and the drawings is aimed in essence at incorporating technical information contained in Attachment A of the priority application. In order to decide whether this correction can be granted, it has to be ascertained what the skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application documents as filed (G 11/91, point 1 of the Order). However, in particular in view of the "incorporation statements" made in the original description (see

Section III and point 7 above), such an assessment does not appear to be so straightforward that it could be done without a technical examination. The board therefore accepts the appellant's view that the Receiving Section should have refrained from dealing with this issue at all.

9. The board nevertheless considers it neither necessary nor appropriate to formally set aside the contested decision in this respect. It is noted that the Receiving Section's findings with which the appellant takes issue do not form part of the order of the decision but only appear in the reasons for the decision. The board's understanding of the contested decision is that these passages relate to an incidental issue which the Receiving Section considered when deciding not to allow the appellant's request that the amended application documents be accepted as the basis for the supplementary European search report. The Receiving Section's refusal of the correction sought was therefore not a final decision binding on the examining division.

10. As a general principle, a board will not set aside an appealed decision which is correct as such, even if some or all of the reasons given for it are incorrect. This principle also applies in the present case, where the appellant is no longer challenging the decision's order as such (see points 4 and 6 above). The appeal therefore has to be dismissed.

Reimbursement of the appeal fee

11. One of the conditions for reimbursing the appeal fee under Rule 103(1) (a) EPC is that the appeal is deemed to be allowable. Since the present appeal has to be dismissed, the request for reimbursement of the appeal fee has to be rejected as well.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

C. Eickhoff

B. Günzel