

Veröffentlichung im Amtsblatt	Ja/Yes
Publication in the Official Journal	Yes
Publication au Journal Officiel	Oui

Aktenzeichen / Case Number / N° du recours : J 12/83

Anmeldenummer / Filing No / N° de la demande : 81104560.8

Publikations-Nr. / Publication No / N° de la publication : 0042162

Bezeichnung der Erfindung: Compositions for treating diseases in
Title of invention: circulatory organs
Titre de l'invention :

ENTSCHEIDUNG / DECISION
vom / of / du 9 November 1984

Anmelder/Patentinhaber: CHUGAI SEIYAKU KABUSHIKI KAISHA
Applicant/Proprietor of the patent:
Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence : Inadmissible appeal / CHUGAI SEIYAKU

EPO / EPC / CBE Article 97(2) (a), 107, 167(2) Rule 51(4)
"Party adversely affected"

Leitsatz / Headnote / Sommaire

1. An applicant for a European patent may be "adversely affected" within the meaning of Article 107 EPC by a decision to grant the patent, if it is granted with a text not approved by the applicant in accordance with Article 97(2) (a) and Rule 51(4) EPC.
2. For a European patent to be granted, no positive approval of the text by the applicant is required. For examination to be resumed in accordance with the last sentence of Rule 51(4) EPC, disapproval must actually be communicated.

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number: J 12 / 83

DECISION
of the Legal Board of Appeal

of 9 November 1984

Appellant: CHUGAI SEIYAKU KABUSHIKI KAISHA
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Tokyo (JP)

Representative: VOSSIUS, VOSSIUS, TAUCHNER, HEUNEMANN, RAUH
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Decision under appeal: Decision of the Formalities Officer of Directorate General 2 of the European Patent Office dated 29 September 1983 to grant European Patent N°. 0042162 with the title and the supporting documents indicated in the communication under Rule 51(4) EPC dated 13 May 1983.

Composition of the Board:

Chairman: R. Singer
Member: P. Ford
Member: O. Bossung

SUMMARY OF FACTS AND SUBMISSIONS

- I. On 11 June 1981, the appellant filed a European patent application under N°.81104560.8, claiming priority from a Japanese national patent application made on 13 June 1980.
- Ten Contracting States, including Austria, were designated in the European patent application. All claims of the application as filed were directed to compositions for treating diseases in circulatory organs. The title of the application also indicated that it related to such compositions.
- II. Under Article 167(2) EPC, Austria has reserved the right to provide in its national law that European patents, in so far as they confer protection on pharmaceutical products as such; shall in accordance with the provisions applicable to national patents, be ineffective or revocable.
- III. The European search report was sent to the appellant's representative in January 1982 and the request for examination was filed on 16 April 1982. On 19 December 1982, an Examiner acting for the Examining Division consulted the appellant's representative by telephone concerning minor amendments to Claim 1, which were agreed.
- IV. Thereafter, on 16 February 1983, advance notice of intention to grant a European patent was issued and the appellant was given a period of two months within which to submit any desired amendments. None were submitted. Then, on 13 May 1983, the Examining Division issued a Communication under Rule 51(4) and (5) EPC indicating that it was intended to grant the patent in the text previously submitted, subject to the agreed amendments to Claim 1.

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- V . On 12 August 1983, the appellant's representative responded to the Communication under Rule 51(4) and (5) EPC by filing translations of the accepted claims and paying the grant and printing fees. On 19 September 1983, the appellant's representative requested correction of an obvious error in the description, a correction which was subsequently made by the printer.
- VI. On 29 September 1983, the Formalities Officer acting for Directorate General 2 of the EPO issued the decision to grant the patent, which would take effect from 23 November 1983, pursuant to Article 97(4) EPC.
- VII. On 11 November 1983, the appellant filed the present appeal against the decision to grant the patent, requesting that the decision be rectified or that the decision be revoked and the grant of the patent be allowed with the separate set of process claims for Austria which was enclosed with the Notice of Appeal. The notice of Appeal incorporated a Statement of Grounds of the appeal. The appeal fee was duly paid.
- VIII. At the appellant's request, oral proceedings were appointed for 30 May 1984. In a Communication before Oral Proceedings, the Legal Board of Appeal drew attention to (1) the difficulty of accepting that, in the legal sense, the appellant was adversely affected by the decision under appeal, which was necessary if the appeal were to be held admissible and (2) the difficulty in allowing the appeal, having regard to the true effect of Article 167(2)EPC, if the appeal were admissible.

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- IX. In the course of the oral proceedings, the appellant's representative submitted inter alia that it was the practice of at least some Examining Divisions of the EPO to draw the attention of applicants to any lack of process claims in pharmaceutical patent applications for which Austria was a designated State and to transform product claims into process claims. It was submitted that the appellants had not been given equal treatment with other applicants. The Board decided that it was necessary to investigate EPO office practice in this matter and that, in the special circumstances, the proceedings should be continued in writing unless the representative asked for a further hearing.
- X. After the hearing, the appellant was notified in writing by the Board that investigation had shown that there was no established practice of EPO Examining Divisions whereby product claims for pharmaceutical compositions were automatically transformed into process-claims for Austria.
- XI. By letter dated 27 August 1984, the appellant's representative drew attention to a specific case, not previously drawn to the Board's attention, in which an Examiner had reminded an applicant that Austria had made a reservation under Article 167(2) EPC. The representative further argued that the appellant was adversely affected by the decision to grant the patent since no valid claims for Austria were granted with the patent. The request that a patent be granted for Austria had never been renounced and it was self-evident that the appellant had the intention of obtaining a valid and enforceable patent for Austria. The representative also contended that the patent had been granted on the basis of a text to which the appellant had not declared its approval. Further, if it was considered that the payment of the granting fee was tacit consent, it should be possible to rescind

the decision given as there was error in the giving of consent which contradicted the original request for grant. Rescission or supplementing of the decision under appeal was requested.

- XII. In a letter dated 5 November 1984 the appellant's representative mentioned another specific case in which an applicant's attention had been drawn to the fact that Austria had made a reservation under Article 167(2)EPC.

REASONS FOR THE DECISION

1. In order for an appeal to be admissible, it must comply with the provisions of Articles 106-108 and Rule 64(b) EPC (and, in opposition proceedings, also with Rule 1(1) EPC).
An appeal that does not comply with these Articles and Rules has to be rejected as inadmissible unless any deficiency has been remedied before the relevant time limit laid down in Article 108 has expired: Rule 65(1) EPC.
2. In the present case, the Legal Board of Appeal has raised the objection that the appellant is not a party "adversely affected" by the decision to grant the European patent to the appellant, within the meaning of Article 107 EPC.
3. The Board accepts that, in some circumstances, an applicant for a European patent can be "adversely affected", within the meaning of Article 107 EPC, by a decision to grant the patent. This would clearly be so, for example, if the patent were granted with a text not approved by the applicant, contrary to Article 97(2)(a)EPC.

However, approval, for the purposes of that Article, has to be established "in accordance with the provisions of the Implementing Regulations", Rule 51(4) of which provides, in effect, that approval is given if disapproval is not communicated within the period provided by the Rule.

.../...

In the present case, no disapproval was communicated and it is clear from the facts summarised above that the decision to grant the patent was made on the basis of the description, drawings and claims submitted by the appellant, subject only to minor amendments to Claim 1 proposed by the Examining Division and agreed to by the appellant's representative and also to the correction of a clerical error requested at the last moment by the representative.

4. In these circumstances, the Board does not accept the appellant's argument that the patent was granted on the basis of a text to which the appellant had not declared its approval.
5. The appellant has argued (paragraph 3a of the letter dated 27 August 1984) that payment of fees and submission of translated claims is accepted as evidence of approval as a matter of Office practice and that, in the present case, this Office practice worked an injustice and that accordingly the appellant is "adversely affected". In the considered opinion of the Board, having regard to the provisions of Article 97(2)(a) and Rule 51(4)EPC considered above, this argument is also unacceptable. No positive approval is required: positive disapproval is required to ensure that examination is resumed.
6. In the same letter, the appellant has further argued that there should be rescission of consent due to error on the part of the representative in failing to observe that no pharmaceutical process claims had been filed for Austria. As no express-consent was required, or given in a document, the Board can see no basis for rescission.

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7. It follows that the Legal Board of Appeal is not satisfied that the appellant is a party "adversely affected" by the decision to grant the European patent, within the meaning of Article 107 EPC. Accordingly the appeal must be rejected as inadmissible, in accordance with Rule 65(1) EPC.

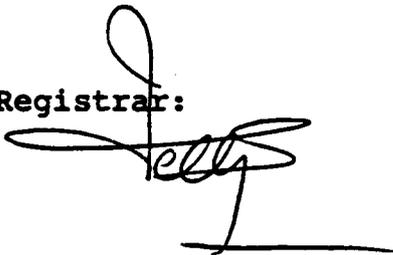
O R D E R

For the foregoing reasons,

It is decided that:

The appeal against the decision dated 29 September 1983 is rejected as inadmissible.

PF.
B2
Registrar:



Chairman:

