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Aktenzeichen / Case Number / N° du recours : J 08/87, J 09/87

Anmeldenummer / Filing No / N° de la demande : 85 101 009.0

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 155 476

Bezeichnung der Erfindung: Production of polypeptides in insect cells

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C12N 15/00

### ENTSCHEIDUNG / DECISION

vom / of / du 30 November 1987

Anmelder / Applicant / Demandeur : IDAHO RESEARCH FOUNDATION

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Submitting culture deposit information/IDAHO

EPO / EPC / CBE Articles 83, 122, Rules 9(3), 28, 38(3), 67

Kennwort / Keyword / Mot clé : "Deficiency" - "Restitutio in integrum" -  
"Substantial procedural violation"

#### Leitsatz / Headnote / Sommaire

As an applicant may submit the information relating to a culture deposit (Rule 28(1)(c) EPC) at any time before the end of the sixteenth month after the date of priority, there is only a deficiency, which he must be given an invitation to correct, when that period has expired.

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours

Case Number : J 08/87, J 09/87



**D E C I S I O N**  
of the Legal Board of Appeal  
of 30 November 1987

**Appellant :** Idaho Research Foundation  
Moscow, Idaho  
USA

**Representative :** Dipl.-Ing. Schwabe  
Dr. Dr. Sandmair  
Dr. Marx  
Stuntzstrasse 16  
D-8000 München 80

**Decision under appeal :** Decision of the Formalities Section  
of the European Patent Office dated  
24 September 1986 refusing request  
for restitutio in integrum and  
Decision of the Formalities Section  
of the European Patent Office dated  
24 September 1986 refusing request  
for correction of the description

**Composition of the Board :**

**Chairman :** P. Ford  
**Members :** F. Benussi  
C. Payraudeau

## Summary of Facts and Submissions

- I. European patent application No. 85 101 009.0 was filed in the name of the Appellants on 31 January 1985, claiming priority from a national application filed in the United States on 31 January 1984.
- II. The invention concerns the use of a micro-organism and on page 26 of the description the Appellants stated that a micro-organism had been filed with the American Type Culture Collection (ATCC) but did not indicate the file number of the culture deposit, which had still not been submitted to the EPO on 31 May 1985, when the 16-month period under Rule 28(2) EPC expired. It was only submitted by a letter received at the EPO on 31 July 1985.
- III. By a Communication dated 31 July 1985 which crossed in the post with the previously mentioned letter of the Appellants' representative, the Receiving Section informed him that the technical preparations for publication of the European patent application in question had been completed and that the application would be published on 25 September 1985.
- IV. By a further Communication dated 23 August 1985, the Receiving Section informed the Appellants that the information referred to in Rule 28(1)(c) EPC had not been submitted within the period prescribed in Rule 28(2) EPC.

The Receiving Section noted that if the micro-organism is not available to the public or if it is not described in the application in such manner as to enable the invention to be carried out by a person skilled in the art, the application should be refused under Article 97(1) EPC in any examination procedure, on grounds of deficient disclosure (Article 83 and Rule 28 EPC).

- V. By telex of 12 September 1985 the Appellants' representative asked that the number of the culture deposit communicated to the EPO on 31 July 1985 be published together with the application on 25 September 1985 or inserted in the description of the application. Alternatively, the Appellants' representative asked that publication should be delayed until the submitted accession number could be added.
- VI. By telex of 3 September 1985 the EPO informed the Appellants' representative that since, on 31 July 1985, the technical preparations for the publication of the application had already been completed, it was therefore neither possible to insert the accession number nor to defer publication.
- VII. On 25 October 1985 the Appellants filed a request for re-establishment of rights (Article 122 EPC) into the time limit prescribed by Rule 28(2) EPC.
- VIII. In a Communication dated 3 February 1986, the Receiving Section informed the Appellants that in its opinion Article 122 EPC was excluded for the 16-month period of Rule 28(2) EPC, the deposit and the submission of the information about a depository institution and the file number of the deposit being a special form of disclosure within the meaning of Article 83 EPC. Therefore, the submission of the deposit number would be not merely a

procedural act but affected a separate precondition for patentability, i.e. sufficient disclosure.

- IX. On 30 July 1986 the Appellants presented to the EPO a request for correction pursuant to Rule 88 EPC of the description of the patent application by including the deposit number of the micro-organism.

The Appellants supported their request by the argument that in similar cases the Legal Board of Appeal had allowed the later correction of originally omitted designated States or later claims to priorities originally omitted. In the present case, in the opinion of the Appellants, adding the omitted deposit number would mean only a completion of information already contained in the original application documents and the public interest would not be adversely affected by allowing the correction since in fact the micro-organism had already been deposited with the ATCC on 31 January 1984 and a third party wishing to request a sample of the deposit organism could have obtained the accession number in question from the depository institution and, from the date of publication of the European patent application, by inspection of the file.

- X. On 24 September 1986, the Head of the Formalities Section of DG 2 issued the two Decisions under appeal rejecting the application for restitutio in integrum and the request for correction under Rule 88 EPC.
- XI. On 20 November 1986 the Appellants filed Notices of Appeal against both Decisions of the Head of the Formalities Section of DG 2. The Appellants paid both appeal fees on the same day.

- XII. On 30 January 1987 the Appellants filed separate statements of Grounds of Appeal.

As appeals had been filed from two separate decisions but both appeals concerned the same European patent application and the same object, and had been allocated to the same Board in the same composition, the Appellants were asked whether they consented to the two appeals being dealt with in consolidated proceedings. The Appellants' representative consented to such consolidation in a letter dated 3 September 1987. Accordingly, pursuant to Article 9(2) of the Rules of Procedure of the Boards of Appeal, the Board proceeded to deal with both appeals in consolidated proceedings.

#### Reasons for the Decision

1. The consolidated appeals comply with Articles 106 to 108 and Rule 64 EPC and are therefore admissible.

#### Application under Article 122 EPC

2. The first question to be decided is whether the Appellants have suffered any loss of rights which could be the subject of an application under Article 122 EPC.
  - 2.1 According to Rule 28 EPC, if an invention concerns a microbiological process or the product thereof and involves the use of a micro-organism which is not available to the public and which cannot be described in the European Patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Article 83 EPC if specified information

concerning the micro-organism is submitted to the EPO within a given time limit.

The file number of the culture deposit has to be submitted within a period of 16-months after the date of filing of the application or, if priority is claimed, after the priority date (Rule 28(2)(a) EPC).

- 2.2 In a case in which certified copies of priority documents had not been filed within the 16 months period provided in Rule 38(3) EPC, the Legal Board of Appeal has stated that the applicant must be given an opportunity to remedy that deficiency within a further period (J 01/80 Official Journal EPO, 1980, 28: cf. paragraph 3 of the decision). The Board recognised that there could only be a loss of rights if the applicant did not then take advantage of this opportunity.
- 2.3 In the opinion of the Board, there is an analogy between that situation and the present one, because in both cases the deficiency exists only at the expiration of the time limit. The Board considers therefore that a similar solution should be applied in both cases.

The fact that the period of the time provided in Rule 28(2)(a) EPC is not mentioned in Article 91 EPC does not exclude this possibility because at the time when the Convention was signed, Rule 28 EPC was not worded as it is now.

- 2.4 Furthermore, according to the Guidelines for Examination Part A, Ch. IV, No. 4.2, the Receiving Section has to notify the applicant when the information to be furnished pursuant to Rule 28(1) EPC is deficient or is not supplied within the specified period.

In the present case, the Appellants did not receive any kind of communication informing them of the relevant deficiency so that they were never given an opportunity to remedy it. It follows that they never lost their rights.

- 2.5 Hence, the Formalities Section was wrong to consider the application for the re-establishment of rights that had never been lost. It also follows that the fee paid for restitutio in integrum was wrongly accepted by the EPO and must be refunded to the Appellants together with the corresponding appeal fee (Rule 67 EPC).

Request for correction under Rule 88 EPC

3. In view of the above considerations, there was no need for the EPO to examine this request and the corresponding decision to refuse the correction should therefore be set aside and the appeal fee reimbursed (Rule 67 EPC).

The Board also wishes to point out that the rendering of a decision which relates to correction of the description of a European patent application is excluded from the tasks entrusted in application of Rule 9(3) EPC to Formalities Officers (see point 23 of Information from the European Patent Office, dated 15 June 1984, OJ 1984, 317).

**Order**

**For these reasons, it is decided that:**

1. The decision of the Head of Formalities of Directorate-General 2, dated 24 September 1986 rejecting the request for re-establishment of rights into the time limit for submitting the number of the culture deposit is set aside.

2. The fee for re-establishment of rights is to be reimbursed.
3. The decision of the Head of Formalities of Directorate-General 2, dated 24 September 1986 rejecting the request for correction of a mistake under Rule 88 EPC is set aside.
4. The specification of the European patent application No. 85 101 009.0 is to be amended by adding the number of the deposited culture (No. 39 590), on page 26, at line 22 of the description.
5. Both appeal fees are to be reimbursed.

The Registrar:

*J. Ibe*

The Chairman:

*Peeter Lind*