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**D E C I S I O N**  
of 20 December 2000

**Case Number:** J 0016/98 - 3.1.1

**Application Number:** 86900400.2

**Publication Number:** 0209539

**IPC:** C07K 7/10

**Language of the proceedings:** EN

**Title of invention:**  
Homogeneous erythropoietin

**Patentee:**  
GENETICS INSTITUTE, INC.

**Opponent:**  
-

**Headword:**  
Revision of appeal decision/GENETICS INSTITUTE, INC.

**Relevant legal provisions:**  
EPC Art. 20, 21, 122, 125  
EPC R. 92

**Keyword:**  
"Measure to be taken in response to requests based on alleged violation of a fundamental procedural principle and aimed at the revision of a final decision taken by a board of appeal"  
"Entry in the Register of European Patents"

**Decisions cited:**  
G 0001/97

**Catchword:**  
-



Case Number: J 0016/98 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 20 December 2000

**Appellant:** GENETICS INSTITUTE, INC.  
87 Cambridge Park Drive  
Cambridge  
Massachusetts 02140 (US)

**Representative:** Fischer, Bernhard, Dr.jur.  
Frohwitter et al.  
Patent- und Rechtsanwälte  
Possartstrasse 20  
D-81679 München (DE)

**Decision under appeal:** Decision of the Legal Division of the European  
Patent Office dated 19 May 1998 refusing requests  
for entries in the Register of European Patents  
concerning the European patent No. 0 209 539.

**Composition of the Board:**

**Chairman:** M. K. S. Aúz Castro  
**Members:** B. J. Schachenmann  
A. C. G. Lindqvist

## Summary of Facts and Submissions

I. The present appeal lies against the decision of the Legal Division of the European Patent Office delivered on 19 May 1998. It concerned the rejection of the appellant's requests to make certain entries in the Register of European Patents relating to their revoked European patent No. 0 209 539.

II. The patent had been revoked by decision T 749/94 dated 21 April 1997 of a Board of Appeal. On 5 January 1998 the patentee (appellant) filed an "application for re-establishment/appeal" against this decision.

The patentee requested that it be re-established into the right to further defend its patent on the basis of the requests pending before the Board of Appeal during the oral hearing of 5 and 6 February 1997 (request I). Should this request not be granted, it was requested that the case be referred to the Enlarged Board of Appeal (request II).

The patentee further requested that an entry in the Register of Patents recording the revocation of the patent be suspended until a final decision concerning the above requests was rendered (request III.1) or, if that was not possible, that a further entry be made to the effect that an application for re-establishment had been filed against the revocation decision and that revocation of the patent was suspended until a final decision was rendered in respect of the application for re-establishment (request III.2).

III. The patentee justified these requests by the submission that the Board which had decided the case had infringed its right to be heard which was a fundamental constitutional and/or procedural principle.

- IV. On 23 January 1998 the patentee was informed by the head of registry of the Boards of Appeal that the EPC did not mention any appeal against decisions of the Boards of Appeal nor any possibility to review such decisions.

As far as the requests relating to the entries in the Patent Register were concerned, they were rejected by the Legal Division in the decision under appeal. The Legal Division referred to the exhaustive catalogue of entries recordable in the Register of Patents not comprising any entry as requested by the patentee. It also pointed out that a final decision taken by a Board of Appeal had the legal effect that the procedure was no longer pending before the European Patent Office. The EPC did not provide for any legal remedy against such decisions and therefore did not allow for an entry in the Register indicating that the legal effect caused by a final decision of a Board of Appeal was suspended.

- V. In its appeal, filed on 20 July 1998, accompanied by the payment of the appropriate fee and the statement of the grounds, the patentee presented the following arguments:

Contrary to the findings of the Legal Division, the EPC contained a legal basis for the requested entries into the Register of European patents, namely in Rule 92(1)u) in connection with Rule 92(1)r) EPC. As re-establishment of rights was requested on the basis of Article 122 EPC, a corresponding entry could be made in accordance with the provisions referred to above. The same was true for re-establishment of rights requested under Article 125 EPC in connection with the procedural means provided by the Contracting States.

Irrespective of these considerations the EPC did not

support the statement of the Legal Division that the entries to be made in the Patent Register were exclusively set out in Rule 92(1) EPC and the notices of the President under Rule 92(2) EPC. This was all the more so in cases where a predominant interest of the patentee and the legal certainty called for an entry. The admissibility of the requested entries into the Register required an evaluation, by the Legal Division, of the admissibility of the application for re-establishment/appeal of 5 January 1998. The Legal Division, however, did not deal with the legal considerations submitted by the appellants in this connection. It only argued with an assumed "res iudicata effect" of decisions taken by the Boards of Appeal without considering the legal standards of the Contracting States, when fundamental rights are in question, as established in the appellants' submissions. These submissions were fully sufficient to justify a suspension of the decision T 749/94. Further, it was a legal consequence of the application for re-establishment/appeal to suspend the revocation of the European patent No. 0 209 539.

VI. With letter dated 10 March 1999 the appellant pointed to the fact that in case G 1/97 oral proceedings before the Enlarged Board were scheduled for 11 May 1999 and asked the Board to take an isolated decision to the effect that the present case be referred to the Enlarged Board and combined with case G 1/97.

VII. On 30 March 1999 the Legal Board of Appeal informed the appellant that, in view of the advanced stage of the proceedings in case G 1/97, the Board intended to defer the present proceedings until the Enlarged Board had given its decision. A new referral of the same question would, at such a late stage, further delay the proceedings before the Enlarged Board. A consolidation of the cases therefore appeared to be unlikely. The

appellant was pointed to the fact that it could still file statements as a third party in the proceedings G 1/97 and attend the public oral proceedings.

VIII. On 10 July 2000 the Board informed the appellant that the proceedings were resumed as, in the meantime, the Enlarged Board of Appeal had issued its decision G 1/97. It was pointed out that all the appellant's requests were aimed at a revision of the final decision T 749/94 of a Board of Appeal. Thus, as far the original requests I and II (see point II., supra) were concerned, it followed from decision G 1/97 that the Legal Board lacked jurisdiction in this respect.

On the other hand, the Legal Board of Appeal had the jurisdiction to decide on the requests arising from the appeal against the decision of the Legal Division. However, in the light of decision G 1/97 these requests could hardly have any prospect of success.

IX. The appellant's requests arising from the appeal are as follows:

1. The decision of the Legal Division dated 19 May 1998, be set aside.
2. An entry into the Register of European Patents be made to the effect that an application for re-establishment/appeal was filed against appeal decision T 749/94 revoking European patent No. 0 209 539.
3. An entry into the Register of European Patents be made to the effect that the revocation of the patent referred to above was suspended until a final decision was rendered in respect of the application for re-establishment/appeal.

## Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.
  
2. The jurisdiction of the Boards of Appeal is governed by Article 21 EPC. According to Article 21(2) EPC the Legal Board of Appeal shall *inter alia* decide on appeals from decisions of the Legal Division. In the decision under appeal the Legal Division correctly limited itself to decide on the requested entries in the Register of European Patents (Article 20 EPC). The Legal Board of Appeal which, in the present proceedings, may exercise any power within the competence of the Legal Division (Article 111 EPC), has therefore the jurisdiction to consider the appellant's requests 1 to 3 (see point IX., supra).

On the other hand, the original requests I and II on which the Legal Division did not decide, fall outside the jurisdiction of the Legal Board in the present proceedings and are therefore not dealt with by this Board (see also point 5 of the reasons).

3. The appellant's requests 1 to 3 concern certain entries to be made in the European Patent Register.
  
- 3.1 According to point 8 of decision G 1/97 of the Enlarged Board of Appeal the Legal Division must refrain from ordering that an entry of requests be made in the Register of European Patents if the requests, **in whatever form**, are in fact based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a Board of Appeal.

3.2 In the circumstances of the present case the entry according to request 2 refers to the fact that an "application for re-establishment/appeal" was filed against appeal decision T 749/94 revoking European patent No. 0 209 539. The entry according to request 3 concerns an indication to the effect that the revocation of the patent referred to above was suspended until a final decision was rendered in respect of the "application for re-establishment/appeal". Both entries are therefore related to requests ("re-establishment/appeal" and "suspension of revocation", respectively) which, independently of their form, were aimed at the revision of decision T 749/94 of a Board of Appeal and, as follows from the appellant's submissions, were based on the alleged violation of a fundamental procedural principle (see point V., supra).

Thus, according to the principles set out in decision G 1/97, the Legal Division correctly rejected the appellant's requests to make such entries in the Register of European Patents.

4. Since the Enlarged Board of Appeal, in its decision G 1/97, has dealt with all the questions raised by the appellant in connection with the present case, the Board has no reason to refer the same questions to the Enlarged Board of Appeal again. The appellant's request concerning referral (see point VI., supra) was only meaningful for the time when the case G 1/97 was still pending.

Since it is not the intention of the Legal Board of Appeal to deviate from the interpretation and explanation of the Convention given by the Enlarged Board of Appeal in its decision G 1/97, no new referral to the Enlarged Board of Appeal is required for the Legal Board of Appeal to decide on the present case.




5. As far as the original requests I and II are concerned, they have been refused by an administrative measure (see point IV., supra). Even if, in future, a responsibility for hearing such requests will lie with the Board of Appeal which took the contested decision (see decision G 1/97 at point 6), this does not apply to requests bearing a date before that of decision G 1/97, i.e. 10 December 1999 (see Headnote III. of decision G 1/97). In the present case these requests were filed on 5 January 1998. It is therefore not necessary for the Legal Board to transmit the file to the Board of Appeal which took the contested decision.

**Order**

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

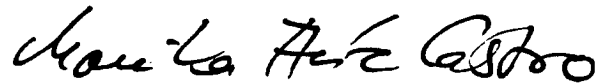
The appeal is dismissed.

The Registrar:



M. Beer

The Chairperson:



M. Aúz Castro