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D E C I S I O N
of 2 June 2006

Case Number: T 0079/04 - 3.3.04

Application Number: 92924777.3

Publication Number: 0616613

IPC: C07K 7/06

Language of the proceedings: EN

Title of invention:
Fragments of prion proteins

Patentee:
PROTEUS MOLECULAR DESIGN LIMITED

Opponents:
01 Prionics AG
02 ZLB Behring GmbH
03 Caprion Pharmaceuticals, Inc.
04 COMMISSARIAT A L'ENERGIE ATOMIQUE and PASTEUR SANOFI
DIAGNOSTICS

Headword:
Prion proteins/PROTEUS

Relevant legal provisions:
EPC Art. 123(2)(3), 111(1)

Keyword:
"Added subject-matter (no)"
"Remittal (yes)"

Decisions cited:
T 1091/00

Catchword:
-



Case Number: T 0079/04 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 2 June 2006

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 November 2003
revoking European patent No. 0616613 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chair: R. Moufang
Members: M. Wieser
R. Gramaglia

Summary of Facts and Submissions

- I. The appeal was lodged by the Patent Proprietor (Appellant) against the decision of the Opposition Division, whereby the European patent No. 0 616 613 was revoked according to Article 102(1) EPC.

The patent had been opposed by Opponents 01 to 04 (Respondents I to IV) under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC), lack of inventive step (Article 56 EPC) and lack of industrial applicability (Article 57 EPC), under Article 100(b) EPC on the ground of lack of sufficient disclosure (Article 83 EPC) and under Article 100(c) EPC on the ground of added subject-matter (Article 123(2) EPC).

- II. The Opposition Division had decided that the claims of the only request before them did not meet the requirements of Article 123(2) and 123(3) EPC.

- III. In the statement setting out the grounds of appeal, dated 15 March 2004, the Appellant requested to set aside this decision. He further requested to maintain the patent on the basis of a new main request or a new auxiliary request attached to this statement.

Respondents III and IV requested to dismiss the appeal. Respondents I and II did not file requests.

The Appellant and Respondents III and IV requested oral proceedings as auxiliary measure.

- IV. The Board expressed its preliminary opinion in a written communication dated 6 December 2005.

- V. In his letter of response, dated 3 April 2006, the Appellant withdrew the main and auxiliary requests, submitted on 15 March 2004, and filed a new main request (claims 1 to 3) and a new auxiliary request (claims 1 to 2).

Claims 1 to 3 of the main request read as follows:

"1. A method of detecting prion proteins or antibodies against prion proteins in a bovine sample which comprises incubating said sample with an antibody or antigen binding fragment thereof, which specifically binds to a synthetic polypeptide which has at least one antigenic site of a prion protein and is:

Seq.I.D.No:47

Gly-Gln-Gly-Gly-Ser-His-Ser-Gln-Trp-Asn-Lys-Pro-Ser-Lys-Pro-Lys-Thr-Asn-Met-Lys-His-Val-Gly-Cys.

2. A method of discriminating between PrP^c and PrP^{sc} in which a sample is contacted with antibodies raised against a synthetic polypeptide which has at least one antigenic site of a prion protein and is:

Seq.I.D.No:47

Gly-Gln-Gly-Gly-Ser-His-Ser-Gln-Trp-Asn-Lys-Pro-Ser-Lys-Pro-Lys-Thr-Asn-Met-Lys-His-Val-Gly-Cys

and the presence or absence of PrP^{sc} is determined.

3. A method as claimed in claim 2 wherein said synthetic peptide is linked to a carrier."

VI. The Board issued a further communication on 10 May 2006, wherein it expressed the preliminary view that claims 1 to 3 of Appellant's new main request met the requirements of Article 123(2) and 123(3) EPC. The Board suggested to remit the case to the department of first instance for further prosecution on the basis of these claims and asked the Appellant and Respondents III and IV whether they maintained their requests for oral proceedings.

VII. The Appellant, by FAX received on 16 May 2006, Respondent III, by FAX received on 18 May 2006 and Respondent IV, by FAX received on 18 May 2006, withdrew their requests for oral proceedings.

None of the Respondents has raised any objection under Articles 123(2) and 123(3) EPC with regard to the claims of the new main request.

Reasons for the decision

Amendments - Articles 123(2) and 123(3) EPC

1. Claim 1 of Appellant's main request is based on claims 24, 43 and 47 and on example 3, table II as originally filed. Claim 2 is based on claims 24 and 42, and claim 3 on claim 34 as originally filed.
2. The scope of protection of present independent claims 1 and 2 is narrower than the scope of protection of claims 45 and 40 as granted. Therefore, the claims have not been amended during opposition proceedings in such a way as to extend the protection conferred.

3. Therefore, claims 1 to 3 of Appellant's main request meet the requirements of Articles 123(2) and 123(3) EPC.

Remittal - Article 111(1) EPC

4. According to Article 111(1) EPC the Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to the department for further prosecution.

Remittal to the department of first instance is at the discretion of the board (cf decision T 1091/00, 2 July 2002).

Although Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should preferably be given the opportunity to have two readings of the important elements of the case. The essential function of appeal proceedings is to consider whether the decision which has been issued by the first instance department is correct. Hence, a case is normally remitted, if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the Boards in cases where a first instance department issues a decision solely upon one particular issue which is decisive for the case against a party and leaves other essential issues outstanding. If,

following appeal proceedings, the particular issue is decided in favour of the Appellant, the case is normally remitted to the first instance department for consideration of the undecided issues.

5. The Opposition Division in the decision under appeal has dealt with the requirements of Articles 123(2) and 123(3) EPC, without comprehensively touching any other substantial requirements of the EPC.

Thus, fundamental requirements for the maintenance of a patent have not yet been examined by the department of first instance. Consequently, the examination was not carried out in a way to put the Board in a position to decide now, on the basis of a comprehensive examination of the department of first instance, whether or not the substantial requirements of the EPC are met by the invention as presently claimed.

Therefore, at its discretion under Article 111(1) EPC, the Board decides to remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution on the basis of claims 1 to 3 of the new main request filed 3 April 2006.

Registrar:

Chair:

C. Eickhoff

R. Moufang