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**D E C I S I O N**  
**of 13 September 2004**

**Case Number:** T 0431/04 - 3.3.8

**Application Number:** 91903051.0

**Publication Number:** 0505500

**IPC:** C12N 15/67

**Language of the proceedings:** EN

**Title of invention:**

Endogenous gene expression modification with regulatory element by way of homologous recombination

**Patentee:**

Applied Research Systems ARS Holding N.V.

**Opponents:**

Gruppo Lepetit SpA  
Cell Genesys, Inc.

**Headword:**

Endogenous gene expression/APPLIED RESEARCH SYS

**Relevant legal provisions:**

EPC Art. 106, 125

**Keyword:**

"Appeal against a decision of a board of appeal - inadmissible"

**Decisions cited:**

G 0001/97, T 0315/97, T 0397/02

**Catchword:**

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Case Number: T 0431/04 - 3.3.8

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.8  
of 13 September 2004

**Appellants:**  
(Proprietors of the  
patent)

Applied Research Systems ARS Holding N.V.  
Pietermaai 1  
Curacao (AN)

**Representative:**

Renes, Johan  
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Nieuwe Parklaan 97  
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**Respondent I:**  
(Opponent 1)

Gruppo Lepetit SpA  
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**Representative:**

Bizley, Richard Edward  
Hepworth, Lawrence, Bryer & Bizley  
Merlin House  
Falconry Court  
Baker's Lane  
Epping  
Essex CM16 5DQ (GB)

**Respondent II:**  
(Opponent 2)

Cell Genesys, Inc.  
322 Lakeside Drive  
Foster City, California 94404 (US)

**Representative:**

Hallybone, Huw George  
Carpmaels and Ransford  
43 Bloomsbury Square  
London WC1A 2RA (GB)

**Intervener:** Transkaryotic Therapies Inc.  
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**Representative:** Bizley, Richard Edward  
Hepworth, Lawrence, Bryer & Bizley  
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**Decision under appeal:** Decision T 0397/02 dated 10 October 2003 of the board of appeal 3.3.8 of the European Patent Office posted 19 December 2003 dismissing the appeal.

**Composition of the Board:**

**Chairman:** L. Galligani  
**Members:** F. L. Davison-Brunel  
V. Di Cerbo

## Summary of Facts and Submissions

- I. Against European patent No. 0 505 500 entitled "Endogenous gene expression modification with regulatory element by way of homologous recombination" two oppositions had been filed.
  
- II. The Opposition Division revoked the patent for the reason that the requirements of Article 83 EPC were not fulfilled. Against this decision, the appellants (patent proprietors) filed an admissible appeal bearing the number T 397/02 - 3.3.8. During pending appeal proceedings, a notice of intervention was filed which was considered admissible by the board. With decision T 397/02 dated 10 October 2003 and dispatched on 19 December 2003, the board of appeal dismissed the appeal.
  
- III. On 19 February 2004, the patent proprietors filed a notice of appeal against the said decision T 397/02 and paid the appeal fee. On 19 April 2004, they filed a statement of grounds of appeal setting out their case and requests. Their requests were based on an alleged violation of substantial and procedural law. They argued that, according to decision G 1/97 (OJ EPO 2000, 322) a *lacuna* in the EPC could be remedied by an appeal to Article 125 EPC under certain circumstances and that such circumstances were present in their case.
  
- IV. The patent proprietors requested that the decision of the board of appeal be set aside and that the patent be maintained as granted. As an auxiliary request, they requested that the decision of the board of appeal be set aside and that the proceedings in appeal T 397/02

be reopened. As a further auxiliary request, they requested a review of the decision. They also requested oral proceedings under Article 116 EPC, in case the board intended to refuse their requests.

### **Reasons for the Decision**

1. The patent proprietors were adversely affected by the decision T 397/02 (supra) as their appeal was dismissed.
2. The time limits and form of appeal set by the European Patent Convention (cf Article 108 and Rule 64 EPC) for filing an appeal against said decision were complied with. However, Article 106 EPC does not specify that an appeal shall lie from decisions of the boards of appeal. As stated in decision G 1/97 of the Enlarged Board of Appeal (supra), the boards of appeal do not have the power to review their own decision.
3. The said decision G 1/97 indicates in particular that:
  - (a) In the context of the EPC, requests which are aimed at the revision of a final decision of a board of appeal and based on the alleged violation of a fundamental principle **cannot be validly submitted** (see point 6, first paragraph) because they are based on a remedy which is **non-existent** (see point 6, last paragraph);
  - (b) The responsibility for hearing such requests lies with the board of appeal which took the contested decision, **not** with any other board or with the

Enlarged Board of Appeal (see point 6, paragraph 4; cf also decision T 315/97 dated 2 October 2002).

- (c) Since said requests cannot be validly filed and must be refused as inadmissible, the board concerned is able to consider a request aimed at the revision of its own decision **immediately and without any further procedural formalities** (eg right of the other parties to comment; the right to request oral proceedings; the observation of minimum time limits) (cf point 6, last paragraph).
- (d) No special remedy can be created by judicial means on the basis of Article 125 EPC (see point 9 first sentence).

4. In view of the above, this board - in the same composition of the board which took the decision which forms the subject of the request for revision - can refuse immediately and without further procedural formalities all requests by the appellants as inadmissible, including those aimed at obtaining oral proceedings.

**Order**

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

The requests filed with letters dated 19 February 2004 (notice of appeal) and 19 April 2004 (statement of grounds) are refused as inadmissible.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani