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D E C I S I O N
of 9 January 2006

Case Number: T 0482/04 - 3.3.08

Application Number: 96903446.1

Publication Number: 0955808

IPC: A01N

Language of the proceedings: EN

Title of invention:

Human G-protein Coupled Receptor

Applicant:

Human Genome Sciences, Inc.

Opponent:

-

Headword:

Human G-protein/HUMAN GENOME SCIENCE

Relevant legal provisions:

EPC Art. 111(1)

EPC R. 66(1), 68(2), 67, 86(3)

Keyword:

"- decision reasoned in the sense of Rule 68(2) EPC - (no) -"

"- substantial procedural violation - (yes) -"

"- reimbursement of appeal fee - (yes) -"

Decisions cited:

T 0278/00, T 0897/03, T 0276/04

Catchword:

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Case Number: T 0482/04 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 9 January 2006

Appellant:
(Applicant) HUMAN GENOME SCIENCES, INC.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 26 September 2003
refusing European application No. 96903446.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: F. Davison-Brunel
C. Rennie-Smith

Summary of Facts and Submissions

I. European application No. 96 903 446, published as international application WO 97/24929 (EP A 0 955 808) with the title "Human G-protein coupled receptor", was refused by the examining division by a decision pursuant to Article 97(1) EPC dated 26 September 2003. The claims then on file were claims 1 to 22 as filed by the applicant's representative with letter of 2 December 2002.

II. The grounds for the decision of the examining division read:

"In the communication(s) dated 29.07.2002, 26.05.2003 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 02.09.2003.

The European patent application must therefore be refused."

III. In its first communication dated 29 July 2002 the examining division had raised objections to claims 1 to 23 then on file on the grounds of Articles 123(2) EPC (claims 13 to 15, 17 and 18), 52(4) EPC (claims 19 and 20), 84 EPC (claims 1, 12, 21 and 22), 83 EPC (in relation to the subject-matter of claims 13 to 15, 19,

- 20 and 23), 54 EPC (claims 1 to 12, 21 and 22) and 56 EPC (all claims).
- IV. With its response to the communication of the examining division on 2 December 2002, the present appellant filed a new set of claims (claims 1 to 22) in which former claim 14 was deleted and claims 1, 12 and 13 as well as claims 14, 16 to 18 and 20 to 22 (corresponding to earlier claims 15, 17 to 19, 21 to 23) had been amended. The issues raised by the examining division in its communication were addressed in detail in the response.
- V. On 28 April 2003, a telephone conversation took place between the primary examiner and the appellant's representative the content of which is not recorded on file. From the appellant's submissions dated 29 April 2003, it can be inferred that at least the opportunity for appointing a date for oral proceedings was discussed.
- VI. In a second communication dated 26 May 2003, which was attached to the summons to attend oral proceedings pursuant to Rule 71(1) EPC, the examining division maintained the objections previously raised on the grounds of Article 123(2) EPC (claim 16), 52(4) EPC (claim 19), 83 and 84 EPC (claims 15, 17 to 19, 21 and 22), 56 EPC (all claims). New documents were attached to the communication.
- VII. In its letter dated 1 September 2003 the appellant withdrew its request for oral proceedings and requested a written decision on the basis of the submissions filed previously during the examination of the

- application. The examining division then issued a decision pursuant to Article 97(1) EPC refusing the application (see sections I and II supra).
- VIII. On 13 October 2003, the appellant lodged an appeal against the decision of the examining division. With the statement of grounds of appeal filed on 3 February 2004, the appellant submitted a new main request (claims 1 to 19). The essential difference from the claims on the basis of which the application had been refused was that previous claims 20 to 22 had been removed and claims 8, 9, 18 and 19 had been amended. It was requested that the decision of the examining division be set aside and a patent be granted on the basis of the new main request. Alternatively, oral proceedings were requested.
- IX. The examining division did not rectify the contested decision and referred the appeal to the board of appeal (Article 109 EPC).
- X. On 14 November 2005, the rapporteur informed the appellant of the board's preliminary opinion that the case may have to be sent back to the first instance by reason of a substantial procedural violation and asked whether under these circumstances the request for oral proceedings was maintained.
- XI. In a letter dated 16 November 2005 the appellant informed the board that, if the board's decision was to remit the case to the first instance because of a substantial procedural violation, the request for oral proceedings was withdrawn.

Reasons for the decision

1. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC. It is admissible.

2. Rule 68(2) EPC states that decisions of the European Patent Office which are open to appeal must be reasoned. In the present case the decision subject to appeal does not include any facts, evidence or arguments that justify the refusal of the application, but merely refers to the reasons provided in two communications issued by the examining division in the course of examination of the application. Each of these communications had as its basis a different set of claims respectively filed by the appellant upon entry into the regional phase and in answer to the first communication.

3. In decision T 897/03 of 16 March 2004 it was held that a decision which leaves it to the appeal board and the appellant to speculate as to which of the reasons given by the examining division in different communications might have been decisive for the refusal of the application, cannot be considered to meet the requirements of Rule 68(2) EPC. In the board's judgment, in order for a decision to be reasoned within the meaning of Rule 68(2)EPC it must clearly specify which of the claims - and, if necessary in which version - is considered to encompass subject-matter that does not fulfil the requirements of the EPC, and must also contain the grounds upon which the decision is based and a discussion of all decisive considerations in respect of the factual and legal aspects of the case

(see also T 276/04 of 24 June 2004 and T 278/00, OJ EPO 2003, 546).

4. Since the absence of reasoning in the appealed decision amounts to a substantial procedural violation (see decision T 897/03, supra), the decision under appeal must be set aside and the case remitted to the first instance in application of Article 111(1) EPC. Exercising its discretion under Rule 86(3) EPC, the board decides to admit into the proceedings the main request as filed by the appellant with the statement of grounds of appeal on 3 February 2004. The case is thus remitted to the examining division for further prosecution on this basis.
5. The appeal being deemed allowable, it is considered to be equitable by reason of the substantial procedural violation incurred to reimburse the appeal fee (Rule 67 EPC).
6. As the appellant withdrew its request for oral proceedings in the event that the case be sent back to the first instance for reason of substantial procedural violation (see Section XI supra), there is no need for oral proceedings to be held.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of claims 1 to 19 of the main request as filed on 3 February 2004.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani