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D E C I S I O N
of 7 September 2005

Case Number: T 0241/05 - 3.3.1

Application Number: 93308040.0

Publication Number: -

IPC: C07D 498/00

Language of the proceedings: EN

Title of invention:
Carbamates of Rapamycin

Applicant:
WYETH PHARMACEUTICALS

Opponent:
-

Headword:
Rapamycine compounds/WYETH

Relevant legal provisions:
EPC Art. 96(2), 97, 109(1), 113, 116(1)
EPC R. 51, 67, 68

Keyword:
"Reimbursement of the appeal fee after interlocutory revision
(no) - no procedural violation"

Decisions cited:
G 0003/03

Catchword:
-



Case Number: T 0241/05 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 7 September 2005

Appellant:

WYETH PHARMACEUTICALS
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Madison
New Jersey 07940874 (US)

Representative:

Wileman, David Franics, Dr.
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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 18 July 2002
refusing European application No. 93308040.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Nuss
Members: J. Jonk
J. Van Moer

Summary of Facts and Submissions

- I. European patent application 93 308 040.0 (publication number 0 593 227) was refused by the Examining Division with its decision posted 18 July 2002.

The Examining Division held in its decision that the subject-matter of claim 1 relating to rapamycine compounds, submitted by the applicant as part of a set of claims 1 to 5 filed as his sole request on 6 June 2002, lacked inventive step, but that a restricted group of rapamycine compounds for which an improved LAF IC₅₀ activity had been made plausible could be considered to involve the required inventive step. However, in the absence of an auxiliary request, the application had to be refused.

- II. A notice of appeal against this decision was filed on 28 August 2002 and the appeal fee was paid at the same date.

The appellant requested that a patent be granted on the basis of the claims according to the main request or to one of the auxiliary requests 1 and 2 all filed on 15 November 2002.

He also requested refund of the appeal fee (Rule 67 EPC).

- III. With a communication posted on 6 December 2002 the Examining Division rectified the decision under appeal (Article 109(1) EPC) indicating that the impugned decision was set aside and that the proceedings were continued on the basis of the first auxiliary request.

In this communication the Examining Division also indicated that the appellant's request for reimbursement of the appeal fee could not be allowed and would be forwarded to the Board of Appeal for a decision.

Reasons for the Decision

1. The appeal is admissible.
2. Furthermore, according to the decision of the Enlarged Board of Appeal G 3/03 (OJ EPO 2005, 344) the present Board is also the competent one to decide on the request. The Enlarged Board of Appeal held in said decision that, in the event of an interlocutory revision under Article 109(1) EPC, the department of the first instance whose decision has been appealed does not have the competence to refuse a request of the appellant for reimbursement of the appeal fee, but that rather that Board of Appeal is competent to decide which would have been the competent instance to deal with the substantive issues of the appeal if no interlocutory revision had been granted.
3. The appellant's request for reimbursement of the appeal fee can only be granted if, in arriving at its decision of refusal of the application in suit, the Examining Division had committed a substantial procedural violation rendering the reimbursement equitable (Rule 67 EPC).

4. During the examination proceedings, the Examining Division issued several communications indicating the grounds against the grant of a patent on the basis of the requests then on file and giving the applicant (now appellant) each time the opportunity to comment and to file amendments to meet the objections raised.

Furthermore, the Examining Division duly invited the applicant to attend oral proceedings in accordance with Article 116(1) EPC, but the applicant informed the Examining Division by facsimile that he would not attend the oral proceedings and requested to continue the proceedings on the basis of the claims filed on 6 June 2002 as his sole request.

Finally, the Examining Division refused the application at the end of the oral proceedings and subsequently issued a reasoned decision in writing to the applicant indicating the reasons why his request was not allowable.

Therefore, the Board finds that the examination by the Examining Division complied with Article 96(2) and Rule 51(1), (2) and (3) EPC and its decision to refuse the application met the requirements of Article 113(1), Article 97 and Rule 68 EPC.

5. In view of these considerations, the Board concludes that the conduct of the Examining Division does not amount to any substantial procedural violation justifying reimbursement of the appeal fee within the meaning of Rule 67 EPC. In fact, the Examining Division did not have another choice than to refuse the present application on the basis of the applicant's sole

request, since pursuant to Article 113(2) EPC a decision of an Examining Division may only be based on a text submitted to it, or agreed by the applicant.

Order

For these reasons it is decided that:

The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

N. Maslin

A. Nuss