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**Datasheet for the decision  
of 11 July 2008**

**Case Number:** T 1526/06 - 3.3.04

**Application Number:** 98123225.9

**Publication Number:** 0920873

**IPC:** A61K 38/29

**Language of the proceedings:** EN

**Title of invention:**  
Stabilized teriparatide solutions

**Patentee:**  
ELI LILLY AND COMPANY

**Opponent:**  
NPS Pharmaceuticals

**Headword:**  
Teriparatide solutions/ELI LILLY

**Relevant legal provisions:**  
EPC Art. 101, 113(2)  
EPC R. 82  
Legal Advice of the EPO, No. 11/82  
RPBA Art. 15(5)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**  
"Withdrawal of the approval to the text of the patent as granted"

**Decisions cited:**  
T 0073/84, T 0186/84, T 0237/86, T 0459/88, T 0595/90,  
T 0655/01

**Catchword:**

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Case Number: T 1526/06 - 3.3.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.04  
of 11 July 2008

**Appellant I:**  
(Patent Proprietor)

ELI LILLY AND COMPANY  
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and

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**Appellant II:**  
(Opponent)

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**Decision under appeal:**

**Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
25 July 2006 concerning maintenance of European  
patent No. 0920873 in amended form.**

**Composition of the Board:**

**Chair:** U. Kinkeldey  
**Members:** M. Wieser  
D. S. Rogers

## Summary of Facts and Submissions

- I. Appeals were lodged by the Patent Proprietor (Appellant I) and by the Opponent (Appellant II) against the interlocutory decision of the Opposition Division, posted 25 July 2006, according to which the European patent No. 0 920 873 could be maintained in amended form (Article 102(3) EPC 1973).
- II. The Board expressed its preliminary opinion in a communication dated 23 January 2008. The parties were duly summoned to oral proceedings before the Board.
- Oral proceedings were held on 10 July 2008.
- III. The requests presented by Appellant I at the oral proceedings were that the decision under appeal be set aside and that the patent be maintained on the basis of:
- as a main request, claims 1 to 13 of the second auxiliary request filed with a letter dated 9 May 2008; or
  - as a first auxiliary request, claims 1 to 11 of the sixth auxiliary request filed with a letter dated 9 May 2008, or
  - as a second auxiliary request, claims 1 to 9 filed at the oral proceedings.
- Appellant II requested to set aside the decision under appeal and to revoke the patent.

- IV. At the oral proceedings the Chair stated that the Board would announce its decision on the requests before it. At this point Appellant I informed the Board that he no longer approved the text of the patent as granted and that he considered the opposition proceedings as terminated.
- V. The Chair declared the debate to be closed and closed the oral proceedings.
- VI. On 11 July 2008 the Board received a letter dated 8 July 2008 of Appellant II submitted by FAX, containing a further request.

### **Reasons for the Decision**

1. Appellant I, during the oral proceedings before the Board of Appeal, withdrew its approval of the text of the patent as granted during the appeal proceedings and at the same time stated that it considered the opposition proceedings as terminated. There is therefore no text of the patent on the basis of which the Board can consider the appeal.

Under Article 113(2) EPC the European Patent Office must consider and decide upon the European patent only in the text submitted to it, or agreed, by the Proprietor of the patent (requirement of approval).

This principle has to be strictly observed also in opposition and opposition appeal proceedings.

2. Since the text of the patent is at the disposition of the Patent Proprietor, a patent cannot be maintained against the Proprietor's will. If - as in the present case - the Patent Proprietor explicitly withdraws during appeal proceedings its approval, expressed before the first instance, of the text of the Patent as granted and declares that he considers the opposition proceedings as terminated, which means that he will not submit an amended text, it may be inferred that the Patent Proprietor wishes to prevent any text of the patent from being maintained.
  
3. However, the Patent Proprietor cannot terminate the proceedings by informing the EPO that he surrenders the European patent, since this is not provided for in the EPC. Thus, it would only be able, as far as national law permitted, to surrender the patent vis-à-vis the national patent offices of the designated Contracting States under the relevant national law (see e.g. Legal Advice No. 11/82 of the European Patent Office, OJ EPO 1982, 57).
  
4. At the same time, the proceedings ought to be terminated as quickly as possible in the interests of legal certainty. The only possibility in such a case is to revoke the Patent, as envisaged for other reasons in Article 101 EPC and Rule 82 EPC.
  
5. In decision T 73/84 (OJ EPO 1985, 241) the Board decided that, if the Proprietor of a European patent states in opposition or appeal proceedings, that he no longer approves the text in which the patent was granted and will not submit an amended text, the patent has to be revoked. This approach was confirmed *inter*

*alia* by decisions T 186/84 (OJ EPO 1986, 79), T 237/86 (OJ EPO 1988, 261), T 459/88 (OJ EPO, 1990, 425) and T 655/01 of 11 November 2005.

The Board, in the present case, has no reason to deviate from the case law developed by the Boards of Appeal in the decisions mentioned above.

6. As regards the further request of Appellant II contained in its letter dated 8 July 2008 but received on 11 July 2008, this was received after the Chair declared the debate closed.

The closure of the debate normally terminates the possibility of further submissions. Requests submitted thereafter can only be taken into account if the Board reopens the debate, which depends on its discretion (see decision T 595/90, OJ EPO 1994, 696; see also Article 15(5) Rules of Procedure of the Board of Appeal, OJ EPO 2007, 536). The Board does not see a reason to exercise its discretion to re-open the debate.

The Board will not therefore consider Appellant II's further request contained in his letter received 11 July 2008.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

Registrar:

Chair:

P. Cremona

U. Kinkeldey