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**Datasheet for the decision
of 21 July 2009**

Case Number: T 0219/08 - 3.3.10

Application Number: 02749270.1

Publication Number: 1423082

IPC: A61L 27/22

Language of the proceedings: EN

Title of invention:

Plasma protein matrices and methods for their preparation

Applicant:

ProChon Biotech Ltd.

Opponent:

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Headword:

Plasma protein matrices / PROCHON

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Remittal (yes): claims substantially amended on appeal"

Decisions cited:

G 0010/93

Catchword:

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Case Number: T 0219/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 21 July 2009

Appellant: ProChon Biotech Ltd.
P.O. Box 1482
76114 Rehovot (IL)

Representative: Becker Kurig Straus
Patentanwälte
Bavariastraße 7
D-80336 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 17 July 2007
refusing European patent application
No. 02749270.1 pursuant to Article
97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: J.-C. Schmid
F. Blumer

Summary of Facts and Submissions

- I. The appeal lodged on 17 September 2007 lies from the decision of the Examining Division dated 17 July 2007 refusing European patent application No. 02 749 270.1.
- II. The sole ground for the refusal of the application by the Examining Division was that the feature "less than 1 mM of organic chelating agents" incorporated into the claims of the then pending main, first and second auxiliary requests had no support in the application as filed, contrary to the requirement of Article 123(2) EPC.
- III. With the letter stating the grounds of appeal filed on 22 November 2007, the Appellant (Applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of a main request or, subsidiarily, on the basis of auxiliary requests 1 to 8, all requests being filed with that letter, the reimbursement of the appeal fee in view of the circumstances of the present case, and to set a date for oral proceedings in case none of the above requests was followed on the basis of the written submissions alone.
- IV. With a communication dated 8 April 2009, the Board indicated that the subject-matter of those claims comprising the feature "less than 1 mM of organic chelating agents" may extend beyond the content of the application as filed, contrary to the requirement of Article 123(2) EPC.

- V. With a letter dated 29 April 2009, the Appellant withdrew its former main and auxiliary requests 1 to 5, as well as its requests for oral proceedings and for reimbursement of the appeal fee.

Claim 1 of auxiliary request 6 reads as follows:

"1. A freeze dried biocompatible porous matrix comprising plasma proteins, the plasma proteins comprising fibrin, and at least one anti fibrinolytic agent, with uniform pores in the size range of 50-300 microns, devoid of organic chelating agents and having residual moisture below 3%, useful as a scaffold for growing cells."

- VI. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of auxiliary requests 6 to 8 filed on 22 November 2007.

Reasons for the Decision

1. The appeal is admissible.

2. *Scope of examination on appeal*

While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in *ex-parte* proceedings where the application has been refused on other grounds, proceedings before the Boards of Appeal in *ex-parte* cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other objections normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance.

Auxiliary requests 6 to 8

3. None of the claims of these requests comprises the feature "having less than 1mM of organic chelating agents". The presence of this feature in the claims of the then pending requests was the sole reason in the decision under appeal for refusing the application. Hence, the Board considers that the amendment made to the claims of auxiliary requests 6 to 8 by omitting this feature objected to in the decision under appeal has the effect that the sole ground for refusing the present application no longer applies, with the consequence that the appeal is well founded.

4. *Remittal*

Having so decided, the Board has not taken a decision on the substantive matter since the decision under appeal was solely based on the violation of Article 123(2) EPC. As the Examining Division has not yet ruled on the requirements for patentability and the Appellant having requested remittal, the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of auxiliary requests 6 to 8 filed on 22 November 2007, in order to enable the first instance to decide on the outstanding issues.

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 auxiliary requests 6 to 8.

The Registrar:

The Chairman:

A. Counillon

R. Freimuth