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**Datasheet for the decision  
of 3 February 2009**

**Case Number:** T 2052/08 - 3.3.04

**Application Number:** 97923186.7

**Publication Number:** 0914469

**IPC:** C12Q 1/68

**Language of the proceedings:** EN

**Title of invention:**

Methods for identifying a mutation in a gene of interest

**Patentee:**

Ingenium Pharmaceuticals GmbH

**Headword:**

Appeal fee/INGENIUM

**Relevant legal provisions:**

EPC Art. 106, 108, 109, 111  
EPC R. 103(1)(a) and (b)

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

EPC Art. 109, 111  
EPC R. 67

**Keyword:**

"Transitional provisions of the EPC 2000"  
"Reimbursement of appeal fee pursuant to Rule 103(1)(b) EPC  
(yes)"

**Decisions cited:**

J 0010/07

**Catchword:**

see points 2 to 6 of the reasons



Case Number: T 2052/08 - 3.3.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.04  
of 3 February 2009

**Appellant:** Ingenium Pharmaceuticals GmbH  
Fraunhoferstrasse 13  
D-82152 Martinsried (DE)

**Representative:** HOFFMANN EITLÉ  
Patent- und Rechtsanwälte  
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D-81925 München (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 30 April 2008  
refusing European application No. 97923186.7  
pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chair:** U. Kinkeldey  
**Members:** R. Moufang  
M. Wieser

## **Summary of facts and submissions**

- I. With letter of 30 June 2008, received on the same day at the European Patent Office, the appellant filed a notice of appeal against the decision of the examining division dated 30 April 2008 and paid the appeal fee.
- II. No statement of grounds of appeal was filed.
- III. On 19 August 2008 the appellant withdrew its appeal.

## **Reasons for the decision**

- 1. The withdrawal of the sole appellant's appeal has the consequence of terminating the appeal proceedings as far as substantive issues are concerned. Nevertheless the board still has to decide on the reimbursement of the appeal fee as an ancillary matter.
- 2. According to Rule 103(1)(b) EPC the appeal fee shall be reimbursed if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the period for filing that statement has expired. Both conditions are fulfilled in the present case. It remains to be examined whether Rule 103(1)(b) EPC applies to the present case *ratione temporis*.
- 3. Rule 103(1)(b) EPC is part of the Implementing Regulations the text of which was adopted by the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 (OJ EPO Special Edition 1/2007, 89) and entered into force on 13 December 2007. Pursuant to the

transitional provision contained in Article 2 of this Decision, "[t]he Implementing Regulations to the EPC 2000 shall apply to all European patent applications ..., *in so far as* the foregoing are subject to the provisions of the EPC 2000." [emphasis added]. It thus has to be ascertained whether the present application is subject to a provision of the EPC 2000 which Rule 103(1)(b) EPC is intended to implement.

4. According to Article 1 No. 1 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000, Article 108 EPC in its new version shall apply to European patent applications pending at the time of its entry into force (13 December 2007), *i.e.* also to the present application. Article 108 EPC concerns the time limit and form of appeals and contains the requirements that a notice of appeal be filed within two months of notification of the appealed decision, that a fee for appeal be paid and that a statement setting out the grounds of appeal be filed within four months of notification of the decision.
  
5. The board takes the view that the conditions for the reimbursement of the appeal fee under Rule 103(1)(b) EPC (non-filing of statement of grounds of appeal and withdrawal of appeal before expiry of the period for filing the statement of grounds of appeal) are closely linked to and interrelated with these requirements of Article 108 EPC. Therefore Rule 103(1)(b) EPC has to be regarded as implementing Article 108 EPC and thus applies to the present application.

6. The board is aware of decision J 10/07 (OJ EPO 2008, 567) according to which Rule 103 EPC is linked to Articles 109 and 111 EPC and, since these articles are not mentioned in Article 1 No. 1, first sentence, of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions, should not be applied to appeal cases concerning patent applications filed before the entry into force of the EPC 2000 (see point 7 of the reasons). However, the decision J 10/07 was in fact considering the provisions of Rule 103(1)(a) EPC and Rule 67 EPC 1973 which concern the reimbursement of appeal fee in situations where a substantial procedural violation occurred in the first instance. Its conclusions should, in the view of this board, therefore not be taken as implying a statement on the applicability of Rule 103(1)(b) EPC. The board thus does not need to decide whether or not it would be prepared to follow the Legal Board of Appeal's further conclusion that Articles 109 and 111 EPC shall not be applied to European patent applications pending at the time of entry into force of the EPC 2000.
7. In the decision J 10/07 (point 1.2 of the reasons) it was furthermore held that Article 106 and 108 EPC should not be applied retroactively to an appeal where the time limits relating to the admissibility of an appeal had already expired at the time of entry into force of the revised EPC and the relevant legal consequences had already arisen. However, this exception does not apply in a case as the present one where all the procedural acts having relevance in the context of Article 108 and Rule 103(1)(b) EPC, *i.e.* the filing of the notice of the appeal, the payment of the

appeal fee and the withdrawal of the appeal) occurred after the entry into force of the revised EPC.

**Order**

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

1. The appeal fee is reimbursed.
2. The appeal proceedings are closed.

The Registrar:

The Chair:

P. Cremona

U. Kinkeldey