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**Datasheet for the decision
of 15 October 2010**

Case Number: T 2103/09 - 3.3.08

Application Number: 97943887.6

Publication Number: 0951555

IPC: C12N 15/40

Language of the proceedings: EN

Title of invention:

Recombinant MVA virus expressing dengue virus antigens, and
the use thereof in vaccines

Applicants:

Bavarian Nordic A/S, et al

Headword:

MVA virus/BAVARIAN NORDIC

Relevant legal provisions:

EPC R. 103(1)(a), 111(2)
RPBA Art. 11

Relevant legal provisions (EPC 1973):

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Keyword:

"Substantial procedural violation (yes) - applicants' last
submissions not taken into consideration in the Reasons"
"Remittal to the first instance (yes)"
"Reimbursement of the appeal fee (yes)"

Decisions cited:

T 0921/94

Catchword:

-



Case Number: T 2103/09 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 15 October 2010

Appellants:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 28 April 2009
refusing European patent application
No. 97943887.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: T. J. H. Mennessier
R. Moufang

Summary of Facts and Submissions

- I. The applicants (appellants) lodged an appeal against the decision of the examining division dated 28 April 2009, whereby European patent application No. 97 943 887.6 with publication number 0 951 555 was refused. The application, entitled "*Recombinant MVA virus expressing dengue virus antigens, and the use thereof in vaccines*", originated from an international application published as WO 98/13500.
- II. After an exchange of communications and replies between the examining division and the appellants, on 30 September 2008, the examining division issued a summons to oral proceedings to take place on 26 March 2009. In a communication attached thereto, the preliminary opinion was expressed that the appellants should expect that the set of claims filed with letter of 23 August 2006 would be refused for reason of lack of inventive step in view of (i) any of documents D3 and D7 to D10 in combination with document D1, or (ii) document D6 alone (cf. Section IX, *infra*).
- III. In reply to the examining division's communication, the appellants filed a first letter on 5 March 2009 which was accompanied by four new documents (D13 to D16; cf. Section VII *infra*) that were argued to be particularly relevant for the assessment of inventive step. The examining division was invited to contact the representative of the appellants over the phone to resolve any outstanding issues so that oral proceedings could be avoided. However, the examining division informed the appellants on 11 March 2009 that the date fixed for oral proceedings was maintained. With a

second letter dated 24 March 2009, the appellants informed the examining division that they would not attend the oral proceedings and withdrew their request for oral proceedings. They also submitted a first auxiliary request.

- IV. With a communication of 1 April 2009, the appellants were informed that the oral proceedings had been cancelled and the procedure would be continued in writing.
- V. On 28 April 2009, the examining division issued its decision to refuse the application, which was based on the main request (claims 1 to 16) filed on 28 August 2006 and the first auxiliary request (claims 1 to 11) filed on 24 March 2009. The main request was refused for reason of lack of inventive step in view of either any of documents D3 and D7 to D10 in combination with document D1, or document D6 alone (cf. Section IX, *infra*).
- VI. Having filed in due time a notice of appeal, on 27 August 2009 the appellants filed a statement setting out the grounds of appeal which was accompanied by a new first auxiliary request (claims 1 to 13). The appellants argued further that a substantial procedural violation had been committed by the examination division and requested that accordingly the appeal fee be reimbursed.
- VII. The examining division did not rectify its decision and referred the appeal to the board of appeal (Article 109 EPC).

VIII. With letter of 21 September 2010, the appellants informed the board that they withdrew their request for oral proceedings provided that the case be remitted to the first instance for further prosecution and the appeal fee be reimbursed.

IX. The following documents are referred to in the present decision:

(D1): G. Sutter and B. Moss, *Dev. Biol. Stand.*,
Vol. 84, 1995, Pages 195 to 200

(D3): WO 90/01946 (published on 8 March 1990)

(D6): G. Sutter et al., *FEBS Letters*, Vol. 371, 1995,
Pages 9 to 12

(D7): B. A. L. Fonseca et al., *Vaccine*, Vol. 12,
No. 3, 1994, Pages 279 to 285

(D8): B. Falgout et al., *Journal of Virology*, Vol. 64,
No. 9, September 1990, Pages 4356 to 4363

(D9): M. Bray et al., *Journal of Virology*, Vol. 63,
No. 6, June 1989, Pages 2853 to 2856

(D10): US 5,494,671 (published on 27 February 1996)

(D13): J. Tartaglia et al., *Virology*, Vol. 188, 1992,
Pages 217 to 232

(D14): E. Paoletti, *Proc. Natl. Acad. Sci. USA*,
Vol. 93, October 1996, Pages 11349 to 11353

(D15): E. Paoletti et al., Dev. Biol. Stand., Vol. 84,
1995, Pages 159 to 163

(D16): T. J. Chambers et al., Vaccine, vol. 15, No. 14,
October 1997, Pages 1494 to 1502

- X. The submissions made by the appellants in respect of the issue of a substantial procedural violation may be summarised as follows:

The submissions of 5 March 2009 were filed in reaction to the communication attached to the summons to oral proceedings issued on 30 September 2008 in order to refute the arguments of the examining division as regards the objection of lack of inventive step. In those submissions four newly filed documents (D13 to D16) were discussed. All of them shed a new light on the prior art as used by the examining division to deny the presence of an inventive step for the subject-matter of claim 1 of the main request.

In the decision of the examining division, the appellants' new arguments which were merely summarised in the "Summary of facts and submissions" (see last sentence of the first full paragraph of page 6 of the decision) were not taken into consideration at all in the "Reasons for the decision".

Except for the above-mentioned summary, the decision under appeal was identical to the communication of 30 September 2008. Thus, while the examining division had without any doubt recognised that further documents and arguments based thereon had been submitted, their

relevance was simply not paid the attention that the appellants could have expected.

This refusal by the examining division to consider further facts and evidence as provided in the appellants' letter of 5 March 2009 constituted a substantial procedural violation, which justified the reimbursement of the appeal fee.

- XI. The appellants request that the decision of the examining division be set aside and a patent be granted on the basis of the main request of 23 August 2006 or, in the alternative, on the basis of the first auxiliary request filed with the statement of grounds of appeal on 27 August 2009. Additionally, the appellants request that the appeal fee be reimbursed.

Reasons for the Decision

Substantial procedural violation

1. In its communication of 30 September 2008 annexed to the summons to oral proceedings, the examining division discussed in depth, in two paragraphs numbered 1 and 2 under the heading "Objections" (see pages 5 to 7), the issue of inventive step as regards the subject-matter of claim 1 of the claim request of 23 August 2006, the only request then on file. Document D3, or alternatively any of documents D7 to D10, was considered to represent the most relevant state of the art. The technical problem was defined in view of this state of the art, document D1 was analysed, and then the conclusion was reached that in view of that

document the skilled person would arrive at the claimed invention without the exercise of inventive skill, using standard techniques only, with a reasonable expectation of success. An alternative reasoning was made on the basis of document D6 only, reaching the same conclusion. Thus, the presence of an inventive step was denied. It was also observed that there was no disclosure in the application at issue of any unexpected properties on the basis of which an inventive step might have been acknowledged.

2. In their letter of 5 March 2009, the appellants provided a detailed reply to the arguments put forward by the examining division and, in support of their view that the claimed subject-matter was inventive, they filed the additional documents D13 to D16. Therewith, the appellants hoped to convince the examining division and thus avoid oral proceedings which, however, with a communication sent by fax on 11 March 2009 containing no further comments, were confirmed.
3. In reply to the announcement by the appellants that they would not attend the oral proceedings and that the request for them was withdrawn, the examining division indicated that the procedure would be continued in writing. The next official action was the issuance of the decision to refuse the application.
4. In the decision under appeal, documents D13 to D16 are mentioned in the list of cited documents and later referred to once, namely at the last but one paragraph of part II of the "Summary of facts and submissions", in a sentence which, in relation to the appellants' letter of 5 March 2009 (wrongly referred to as "letter

dated 26.03.2009"), reads: "Applicant argues that, when starting from D3 + D1, the skilled person had more promising alternatives than MVA and makes reference to documents D13-D16, which in the applicant's opinion teach away from using the MVA strain" (see page 6 of the decision; emphasis added by the board).

5. The "Reasons" of the decision ignore completely documents D13 to D16, nothing being said about their admission into the proceedings (cf. Article 114(2) EPC) or about the validity of the arguments based thereupon put forward by the appellants in the framework of the inventive step issue. In respect of the main request, apart from the very last sentence which states that no surprising or unexpected effects were identified, the "Reasons" are a repetition word for word of the reasoning made in the communication of 30 September 2008 under the heading "Objections". As regards the auxiliary request then on file, a brief statement indicates that the objections raised for the main request also apply (cf. point 3 of the reasons).

6. According to Rule 111(2) EPC, decisions of the European Patent Office which are open to appeal shall be reasoned. The established jurisprudence (cf. Case Law of the Boards of Appeal of the European Patent Office, 6th Edition, VI.J.5.3) indicates that to ignore documents as well as lines of arguments developed by the appellants in support of a given issue (here: inventive step) on which the decision under appeal is based constitutes a violation of the right to be heard and an offence against Rule 111(2) EPC and thus a substantial procedural violation as well as a fundamental deficiency.

7. In the present case, merely formally acknowledging the appellants' submissions of 5 March 2009, without dealing with them in substance in the "Reasons", and without explaining why the allegedly given support by documents D13 to D16 were not regarded as convincing by the examining division, amounts to such a substantial procedural violation which justifies the reimbursement of the appeal fee (see also decision T 921/94 of 30 October 1998, point 6.2.3 of the Reasons).

Further prosecution of the case

8. In order to give the appellants the benefit of two levels of jurisdiction for a correct and fair assessment of inventive step taking into account documents D13 and D15 as part of the state of the art with the further support of expert opinions D14 and D16, the board, exercising the discretionary power conferred to it by Article 11 of the Rules of Procedure of the Boards of Appeal, considers it appropriate, although not requested by the appellants, to remit the case to the first instance for further prosecution.
9. In view of this, the board has not considered the substantive matters at all and makes no comment thereon.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of the main request of 23 August 2006.
3. The appeal fee is reimbursed.

The Registrar

The Chairman

A. Wolinski

L. Galligani