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**Datasheet for the decision  
of 9 August 2010**

**Case Number:** T 0206/10 - 3.3.01

**Application Number:** 03768014.7

**Publication Number:** 1578748

**IPC:** C07D 471/04

**Language of the proceedings:** EN

**Title of invention:**

Tetrahydro-4h-pyrido[1,2-A]pyrimidines and related compounds  
usefuls as HIV integrase inhibitors

**Applicant:**

ISTITUTO DI RICERCHE DI BIOLOGIA MOLECOLARE P.

**Headword:**

Procedural violation/ISTITUTO DI RICERCHE BIOLOGIA MOLECOLARE  
P. ANGELETTI SPA

**Relevant legal provisions:**

EPC Art. 113(1)(2)  
EPC R. 71(3)

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

EPC Art. 106, 107, 108  
EPC R. 64, 67

**Keyword:**

"Reimbursement of appeal fee (yes)"  
"Substantial procedural violation (yes)"  
"Right to be heard"

**Decisions cited:**

G 0003/03, J 0010/07, J 0032/95, T 0630/08, T 0549/96,  
T 0763/04, T 0246/08, T 0666/90, T 0552/97, T 0355/03,  
T 0647/93

**Catchword:**

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Case Number: T 0206/10 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 9 August 2010

**Appellant:** ISTITUTO DI RICERCHE DI BIOLOGIA MOLECOLARE P.  
ANGELETTI S.P.A.  
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**Representative:** Man, Jocelyn  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 12 August 2009  
refusing European patent application  
No. 03768014.7 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman:** P. Ranguis  
**Members:** C.-P. Brandt  
C. M. Radke

## Summary of Facts and Submissions

- I. This appeal lies from the decision of the examining division dated 12 August 2009 refusing European patent application No. 03 768 014.7, originally filed as international patent application PCT/GB03/05536 on 18 December 2003 and published on 15 July 2004 as WO2004/058756.
- II. At the end of the oral proceedings before the examining division, which took place on 15 November 2007, it was announced that the main request was refused for lack of inventive step and that the grant of the patent would be proposed for the auxiliary request, filed during the oral proceedings. Subsequently, in a communication pursuant to Rule 51(4) EPC 1973 dated 30 November 2007, the applicant was asked to approve the specified text according to the auxiliary request.
- In a letter dated 17 March 2008 the applicant did not agree with the text proposed for grant (i.e. that of the auxiliary request) and requested an appealable decision on the main request.
- III. Since the examining division had been changed, and in order to respect the applicant's right to be heard, the applicant was summoned to oral proceedings again on 28 July 2009. As these oral proceedings were not to be considered as a continuation of the examining proceedings, it was pointed out that the subject-matter of the oral proceedings would be the main request, and no other requests would be admitted into the proceedings.

- IV. In a letter dated 4 June 2009 the applicant withdrew the main request "in favour of the Auxiliary Request". It was further submitted that "it is thus believed that the oral proceedings can be cancelled and that a fresh Rule 71(3) EPC Communication can be issued. It would be grateful if this could be confirmed."
- V. The applicant was informed by a "Brief Communication", dated 30 July 2009 but received by the applicant on 23 July 2009, that the date for oral proceedings on 28 July 2009 was maintained.
- VI. In a faxed letter dated 27 July 2009 the applicant referred to his letter dated 4 June 2009 and informed the examining division that he would not attend the oral proceedings. He added that he hoped "... a further Rule 71(3) EPC Communication can be issued on the basis of the claims and description previously agreed. Any other decision in these circumstances will run the risk of being a substantive procedural violation."
- VII. In its decision dated 12 August 2009 the examining division refused the patent application under Article 97(2) EPC and on the legal basis of Article 113(2) EPC. It held that there were two contradictory statements by the applicant, namely that he did not agree with the proposed text for grant (i.e. of the auxiliary request in the letter of 17 March 2008) and that he was withdrawing the main request in favour of the auxiliary request (faxed letter dated 4 June 2009). Though the first statement was regarded as an express disapproval of the auxiliary request, the second could not be regarded as a clear and express approval of the text (see T 549/96, Reasons 4.1).

Further, the examining division saw no legal basis for a "re-issuing" of a Rule 51(4) EPC 1973/Rule 71(3) EPC communication on the same unamended request.

VIII. A notice of appeal was filed by letter dated 14 September 2009. In his statement setting out the grounds of appeal filed by letter dated 22 December 2009 the applicant requested:

- the issuance of a Rule 71(3) EPC communication with a specification in the form in which he had previously received a Rule 51(4) EPC 1973 communication on 30 November 2007
- reimbursement of the appeal fee on the grounds that at least one substantive procedural violation had been committed by the examining division.

The applicant submitted that several substantive procedural violations had occurred in the course of the proceedings before the examining division, which had finally led to the refusal of the patent application.

IX. With a communication under Rule 71(3) EPC dated 16 February 2010 the examining division informed the applicant that it intended to grant a European patent on the basis of the auxiliary request that had been found to be allowable at the oral proceedings on 15 November 2007. To that extent the decision under appeal was rectified (interlocutory revision under Article 109(1)). Since the examining division did not allow the request for reimbursement of the appeal fee, the case was referred to the board of appeal for a decision on this request.

## **Reasons for the decision**

### *Admissibility and applicable law*

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 64 EPC 1973 and is therefore admissible. Regarding the applicability of EPC 1973 rather than EPC 2000, reference is made to decision J 10/07 of the Legal Board of Appeal (OJ 2008, 567, Reasons 1) and to T 0630/08 (Reasons 1, not published in the OJ).
  
2. In the board's understanding the applicable provision for the request for reimbursement of the appeal fee is Rule 67 EPC 1973, not the substantively identical Rule 103 of the revised EPC. Regarding the applicability of Rule 67 EPC 1973 rather than Rule 103 EPC 2000, reference is made to decision J 10/07 of the Legal Board of Appeal (OJ 2008, 567, Reasons 7) and to T 0630/08 (Reasons 1, not published in the OJ).

### *Competence of the technical board of appeal*

3. The present technical board of appeal is competent for the decision on the request for reimbursement of the appeal fee, which forms the sole subject-matter of the present appeal procedure after the examining division rectified its decision to refuse the patent application by way of interlocutory revision. Rule 67, second sentence, EPC 1973 states that in the event of interlocutory revision reimbursement is to be ordered by the department whose decision has been impugned and, in other cases, by the board of appeal. Decision

J 32/95 (OJ 1999, 713) held that if the department of first instance in the event of interlocutory revision considered the request for reimbursement of the appeal fee not to be well-founded, it had to remit the request to the board of appeal for a decision. In G 3/03 (OJ 2005, 344) the Enlarged Board of Appeal held that the board of appeal which would have been competent under Article 21 EPC to deal with the substantive issues of the appeal if no interlocutory revision had been granted was competent to decide on the request, i.e. the present technical board of appeal. This legal situation is now enshrined in Rule 103(2) EPC.

*Allowability*

4. The appeal is allowable. Rule 67, first sentence, EPC 1973 states that the reimbursement of appeal fees is to be ordered in the event of interlocutory revision if such reimbursement is equitable by reason of a substantial procedural violation.
5. There is no need to decide whether the indication in the summons dated 29 April 2009 to the new oral proceedings that "the issue to be discussed will be ... only whether the Main Request fulfils the requirement of patentability" at that stage of the grant proceedings constitutes a restriction depriving the applicant of a decision based on a text of his own choosing, as alleged by the appellant, thus contravening Article 113(2) EPC and constituting a substantial procedural violation.
6. In any case, there is a substantial procedural violation in the reasoning of the examining division in

its impugned decision dated 12 August 2009 that there are contradictory statements by the applicant in the letter dated 17 March 2008 on the one hand and in the letter dated 4 June 2009 on the other with respect to the auxiliary request and that there is therefore no clear and express approval of the text for grant according to the auxiliary request, so that the patent application is to be refused. A proper interpretation and reading of the applicant's letters dated 4 June 2009 and 27 July 2009 according to their wording and to the expressed intention cannot reasonably justify and substantiate the conclusion drawn by the examining division.

7. At first glance there can be no doubt, nor is it disputed, that the letter dated 17 March 2008 contains a clear and unambiguous statement that the text proposed for grant is not approved by the applicant and an appealable decision on the main request is requested.
  
8. However, the explicit declaration in the letter dated 4 June 2009 that the applicant "withdraw[s] the Main Request" is equally clear and unequivocal in its meaning as required e.g. in decision T 549/96 (Reasons 4.1), also cited in the decision under appeal. As a consequence, there was no longer any basis for a decision on the main request. The further statement that the main request is withdrawn "in favour of the Auxiliary Request" therefore on objective evaluation leaves no doubt that the applicant now seeks to have the auxiliary request granted, particularly when taking into account that only these two requests for grant, namely the main request and the (single) auxiliary request, were on file. In addition, this interpretation



is strongly supported by the second sentence of the said letter, which says that "it is thus believed that the oral proceedings can be cancelled and that a fresh Rule 71(3) EPC Communication can be issued." There appears to be no other explanation how this in combination with the foregoing declaration could be understood as the wish and request of the applicant that (now) the patent should be granted on the basis of the auxiliary request. Otherwise the request for a new Rule 71(3) EPC communication would have made no sense at all.

9. With regard to the content of the applicant's letter dated 4 June 2009, the procedural response of the examining division in sending the "Brief Communication" merely informing the applicant that the date for oral proceedings on 28 July 2009 was maintained constitutes a disregard of the applicant's submission and thus a procedural violation, in particular of the right to be heard under Article 113(1) EPC. This communication neither gives any reasons why the examining division refused the applicant's requests nor reveals that these declarations had at least been taken into consideration. According to the case law of the boards of appeal, it is not sufficient to observe Article 113(1) EPC merely formally by granting the applicant the procedural opportunity to present comments, as was the case here. This procedural step falls short of its legislative purpose and remains a pure formality if there is no trace in the file that such comments were indeed read and discussed on the merits, beyond a mere acknowledgment of their existence. In summary, Article 113(1) EPC does not merely require a party to be given an opportunity to voice comments; more

importantly, it requires the deciding instance to demonstrably hear and consider them (T 763/04, Reasons 4.4; T 246/08, Reasons 2.6).

Therefore in view of the clear declarations of the applicant, the examining division should have cancelled the date for oral proceedings, issued a new Rule 71(3) EPC communication or - if it still had doubts in respect of a clear approval of the text for grant - clarified the requests instead of merely informing the applicant that the date for oral proceedings was maintained, which is legally and procedurally an inadequate response under the given circumstances.

10. Even the applicant's faxed letter dated 27 July 2009, in which it referred to its letter dated 4 June 2009 and inter alia expressed the hope that "... a further Rule 71(3) EPC Communication can be issued on the basis of the claims and description previously agreed" and added that "Any other decision in these circumstances will run the risk of being a substantive procedural violation", obviously did not cause the examining division to reconsider the unequivocally declared consent of the applicant to the grant of a patent according to the auxiliary request already previously agreed and to reverse its own decision to maintain the date of the oral proceedings.
  
11. At the latest after the filing of the letter dated 27 July 2009 the requirements for a new Rule 71(3) EPC communication were met, since in it the applicant again expressed his approval for the granting of a patent on the basis of the auxiliary request previously agreed sufficiently clearly and beyond any reasonable doubt.

At that stage at the latest, if the examining division felt that there still were "contradictory statements", according to the case law of the boards of appeal (T 666/90, T 552/97, T 355/03) it was obliged to rectify the misunderstanding and clarify the applicant's true intention, instead of merely informing the applicant that the date for oral proceedings was maintained and finally issuing the decision which is under appeal. This applies all the more because the applicant had already explicitly asked for confirmation of his declarations in his letter dated 4 June 2009.

The fact that the appellant did not attend the oral proceedings on 28 July 2009 is immaterial for the present decision, because the relevant substantial procedural violation occurred before the oral proceedings were held and furthermore the applicant could only have declared the same as he had already done in a sufficiently clear manner in his letters dated 4 June 2009 and 27 July 2009.

12. Under Article 113(2) EPC the European Patent Office may examine and decide upon the European patent application only in the text submitted to it by the applicant. Article 113(2) EPC is considered a fundamental procedural principle, being part of the right to be heard (see Case Law of the Boards of Appeal of the European Patent Office, 5th edition, VI.B.4.). According to this case law the said procedural principle is of such fundamental importance that any infringement of it, even as the result of a mistaken interpretation of a request, has to be considered to be a substantial procedural violation (T 552/97; T 647/93, OJ EPO 1995, 132).

13. Under these circumstances the requirements of Article 67 EPC 1973 are met. The examining division rectified its decision by means of interlocutory revision. The above-mentioned substantial procedural violation led to the contested decision (refusal of the patent application) of the examining division. In order to overturn this decision the applicant had to file an effective appeal, including the payment of the associated appeal fee. Hence, it appears equitable to reimburse the appeal fee.
  
14. By communication under Rule 71(3) EPC dated 16 February 2010 the examining division correctly and in accordance with the EPC informed the applicant that it intended to grant a European patent on the basis of the (unamended) auxiliary request already agreed in the course of the grant procedure after receipt of a Rule 51(4) EPC 1973 communication. Obviously the examining decision did not uphold the further ground for the refusal of the patent application indicated in the decision under appeal that the "re-issuing of a Rule 71(3) EPC communication on the same unamended request is neither foreseen nor justified".
  
15. Even though it is not decisive for the decision in the present appeal proceedings, the sole subject-matter of which is the request for reimbursement of the appeal fee for reasons of equity, the board considers it appropriate to make the following additional remark. Contrary to the said ruling of the examining division in the decision under appeal, the crucial question to be raised is not whether the EPC provides a basis for the re-issuing of a Rule 71(3) EPC communication on the

same unamended request, but rather whether it provides a proper legal basis for the decision to refuse a request for such a re-issuing. From the legal point of view the refusal of a request for re-issuing of a Rule 71(3) EPC communication on the same unamended patent application, as in the present case, constitutes an administrative act detrimental to the applicant. In order to be effective, such an administrative act requires a legal basis either in terms of an explicit legislative provision in the EPC providing for the respective legal consequence under the particular facts and circumstances or, in the absence of such a regulation, the existence of a general principle of law, developed and stated by case law or the presence of other higher-ranking legitimate interests of the parties to the proceedings or of the public overriding the interest of the applicant in getting a re-issued Rule 71(3) EPC communication. However, no such legal basis has been indicated by the examining division, nor is such a basis obvious or discernible.

**Order**

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

The appeal fee is to be reimbursed.

The Registrar

The Chairman

C. Eickhoff

P. Ranguis