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**Datasheet for the decision  
of 12 May 2011**

**Case Number:** T 0606/10 - 3.3.08  
**Application Number:** 92201711.6  
**Publication Number:** 0518443  
**IPC:** C12N 15/10  
**Language of the proceedings:** EN

**Title of invention:**

Recombinant proteins of viruses associated with lymphadenopathy syndrome and/or acquired immune deficiency syndrome

**Patentee:**

Novartis Vaccines and Diagnostics, Inc.

**Opponent:**

Institut Pasteur

**Headword:**

AIDS proteins/NOVARTIS

**Relevant legal provisions:**

EPC Art. 68  
EPC R. 75, 84(1), 98

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

EPC Art. 99(3), 106(2)

**Keyword:**

"Respondent's main request - termination of the appeal proceedings (no)"  
"Common request of appellant and respondent - patent to be revoked (yes)"

**Decisions cited:**

T 0329/88, T 0762/89, T 0714/93, T 0165/95, T 0749/01,  
T 0436/02, T 0289/06, T 1128/07

**Catchword:**

see points 1.1 to 1.8 of the Reasons



Case Number: T 0606/10 - 3.3.08

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.08  
of 12 May 2011

**Appellant:** Institut Pasteur  
(Opponent) 25-28 rue du dr. Roux  
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**Representative:** Desaix, Anne  
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**Respondent:** Novartis Vaccines and Diagnostics, Inc.  
(Patent Proprietor) 4560 Horton Street  
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**Representative:** Hallybone, Huw George  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
15 January 2010 concerning maintenance of  
European patent No. 0518443 in amended form.

**Composition of the Board:**

**Chairman:** M. Wieser  
**Members:** P. Julià  
R. Moufang

## Summary of Facts and Submissions

- I. European patent no. 0 518 443 is based on European patent application no. 92201711.6 which was a divisional application of the earlier European patent application no. 85307860.8 filed on 30 October 1985. The mention of the grant of the patent was published on 18 May 2005, i.e. shortly before the patent expired on 30 October 2005.
  
- II. The patent was opposed by a notice of opposition submitted on 17 February 2006 (the opposition fee having been paid on 18 February 2006) which invoked the grounds as set forth in Articles 100(a), (b) and (c) EPC. The patent was maintained in amended form by an interlocutory decision of the opposition division dated 15 January 2010 on the basis of the proprietor's main request filed on 30 October 2007 at the oral proceedings before the opposition division.
  
- III. An appeal was lodged by the opponent (appellant) against the decision of the opposition division. In the statement setting out its grounds of appeal, the appellant requested to set aside the decision under appeal and to revoke the patent in its entirety.
  
- IV. In reply to the grounds of appeal, the patentee (respondent) requested as main request that the appeal proceedings be terminated and, as auxiliary request, that the patent be revoked. It furthermore indicated that it did not request oral proceedings.
  
- V. The board sent a communication to the parties under Rule 100(2) EPC and Article 17 of the Rules of

Procedure of the Boards of Appeal (RPBA) (OJ EPO Supplement to the Official Journal 1/2011, page 38), wherein they were informed of the board's preliminary, non-binding opinion on the requests of the parties. The parties were also informed that, in absence of further submissions and/or relevant requests, the board intended to issue a decision in accordance with the expressed opinion.

VI. The appellant and the respondent replied to the board's communication with letters of 28 February 2011 and 21 March 2011, respectively. Both parties maintained their previous requests.

VII. The appellant did not submit any arguments or comments regarding the respondent's main request to terminate the appeal proceedings.

VIII. The arguments of the respondent, as regards its main request to terminate the appeal proceedings, may be summarized as follows:

The parent patent was upheld in 2002 after opposition and appeal proceedings. The examination of the present divisional application was frozen during the parent opposition and appeal proceedings and resumed only in 2003. Thus, the present patent was granted as late as May 2005, only a few months before it expired in October 2005. Despite its expiry, an opposition was filed in February 2006. The patent was upheld at oral proceedings in October 2007 (precisely two years after its expiry) but a written decision was not issued until as late as January 2010. The present appeal was filed even though the patent expired nearly five years ago.

As the patent lapsed several years ago, in accordance with Rule 84(1) EPC and in line with decisions of the boards of appeal, such as T 329/88 of 22 June 1993, T 749/01 of 23 August 2002 and T 1128/07 of 30 June 2009, the present appeal proceedings should be terminated.

Rule 84(1) EPC did not make any distinction between oppositions filed before or after expiry of the patent. It referred to "opposition proceedings" in general, i.e. if the opposed patent had fully lapsed or surrendered then Rule 84(1) EPC applied. There was no reason to think that this lapse or surrender had had to occur after the opposition was filed. Nor did Rule 84 EPC suggest that its effect had to be modified depending on whether Rule 75 EPC applied. In addition, no appeal decision on Rule 84 EPC (or previous Rule 60 EPC 1973) could be identified that made a distinction between pre-expiry and post-expiry oppositions.

Therefore, it was not understood why Rule 84(1) EPC could not apply merely because the patent had already expired before the opposition proceedings began. Such oppositions were permitted under Rule 75 EPC, but there was no statutory basis for the view that Rule 84 EPC could be applied differently in these post-expiry circumstances.

## Reasons for the Decision

*Respondent's main request; Rules 75 and 84(1) EPC*

- 1.1 Pursuant to Article 63(1) and 76(1), second sentence, EPC 1973, the opposed patent had expired 20 years after the filing date of the parent application, i.e. on 30 October 2005 (see section I *supra*). Thus it had already lapsed before the opposition against it was filed in February 2006.
- 1.2 The respondent bases its main request that the appeal proceedings should be terminated on Rule 84(1) EPC. According to this provision, if the European patent has been surrendered in all the designated Contracting States or has lapsed in all those States, the opposition proceedings may be continued at the request of the opponent filed within a specified time limit. The respondent appears to deduce from this provision that, in the absence of a request by the appellant to continue the proceedings, the board may terminate the appeal proceedings in the present case.
- 1.3 In the case law of the boards of appeal, Rule 84(1) EPC and its predecessor Rule 60(1) EPC 1973 have been applied *per analogiam* in appeal opposition proceedings (see Rule 100(1) EPC and Rule 66(1) EPC 1973) when the opponent was the sole appellant. In a number of cases in which the opponent, following a notification by the board pursuant to Rule 60(1) EPC 1973, did not request the continuation of the proceedings, the appeal proceedings were terminated. This conclusion was reached not only where the appeal was directed against the rejection of the opposition by the first instance

(see T 329/88 of 22 June 1993; T 165/95 of 7 July 1997; T 749/01 of 23 August 2002; T 436/02 of 25 June 2004 and T 289/06 of 17 December 2007), but also where the appeal was directed against an interlocutory decision according to which the opposed patent could be maintained in amended form (see T 762/89 of 28 September 1992 and T 714/93 of 20 November 1995). In the latter context the further issue arises whether the board should terminate merely the appeal proceedings or both the opposition proceedings and the appeal proceedings.

1.4 However, none of the above cited cases nor the further decision T 1128/07 of 30 June 2009 referred to by the respondent dealt with the situation where - as in the present case - the patent had already lapsed prior to the filing of the opposition. The board observes that the EPC contains a separate legal provision dealing specifically with this situation: Rule 75 EPC (which corresponds to Article 99(3) EPC 1973) explicitly states that an opposition may be filed even if the opposed patent has been surrendered or has lapsed in all the designated Contracting States. With respect to appeals in opposition proceedings, a similar provision is contained in Rule 98 EPC (corresponding to previous Article 106(2) EPC 1973).

1.5 It is the board's understanding of this legislative framework that Rule 84(1) EPC does not apply to the situations regulated by the separate legal provisions of Rule 75 and 98 EPC. In those situations, the opponent when filing the opposition or the appeal will normally be very well aware that the patent has already lapsed so that the notice of opposition or appeal



clearly shows his interest in the revocation of the patent with retro-active effect (see Article 68 EPC). Thus, it is difficult to see any need for the mechanism provided for in Rule 84(1) EPC according to which the EPO has to inform the opponent of the lapse of the patent and the proceedings may be continued only after the filing of a corresponding request by the opponent.

- 1.6 The above understanding of the legislative framework finds support in the Travaux Préparatoires of the EPC 1973. During the Diplomatic Conference in Munich 1973 the Main Committee I examined a proposal submitted by the Member States of the European Communities according to which provisions for dealing with the consequences of lapse and surrender of a patent should be introduced in what later became Article 99, Article 106 EPC and Rule 60 EPC (see Doc. M/14 dated 12 April 1973, points 4, 6 and 16). The legislative motive underlying the proposed amendment to future Rule 60 EPC was explained in that document in the following way:

"This proposal supplements the proposal for the insertion of a new paragraph 2a in Article 98 [...]. The Member States of the European Communities considered that if any party interested is granted the right to institute proceedings against a European patent which has been surrendered or which has lapsed for all the designated States, it would logically be necessary to grant the opponent the right to have the opposition proceedings continued **where the European patent is surrendered or lapses whilst the proceedings are taking place.**" [emphasis added by the board]

1.7 The proposal was agreed on by the Main Committee I with very little discussion. The minutes of the proceedings record the following further explanation (See Minutes of the Munich Diplomatic Conference for the Setting Up of a European System for the Grant of Patents, page 94, point 2284):

"Speaking on behalf of those States, the delegation of the Federal Republic of Germany said that this amendment was merely the consequence of the acceptance of the proposal by the Member States of the European Communities concerning Article 98. It would therefore appear logical to recognise an opponent's right to have opposition proceedings continued where a European patent had been surrendered or had lapsed **while opposition proceedings were still in progress.**" [emphasis added by the board]

1.8 It can thus be deduced from the Travaux Préparatoires that the scope of application of Rule 60(1) EPC (now Rule 84(1) EPC) was intended to be limited to the situation where the opposed patent has been surrendered or has lapsed during on-going opposition proceedings.

1.9 Thus, in view of the foregoing considerations, the board cannot allow the respondent's main request.

*Respondent's auxiliary request and appellant's request*

2.1 The respondent's auxiliary request and the appellant's request are identical, namely to set aside the decision under appeal and to revoke the patent-in-suit in its entirety (cf. sections III, IV and VI *supra*).

2.2 It follows from the principle of party disposition in opposition appeal proceedings that a request by the patent proprietor for revocation of the opposed patent has to be granted. In this respect it is irrelevant whether the proprietor states that he no longer approves the text in which the patent was granted or maintained by the first instance and will not be submitting an amended text or whether he directly requests that the patent be revoked (see the decisions cited in "Case Law of the Boards of Appeal of the EPO", 6th edition 2010, page 738).

2.3 Therefore, the respondent's auxiliary request, which is identical to the appellant's request, namely to set aside the decision under appeal and to revoke the patent-in-suit in its entirety, is allowed.

## **Order**

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

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

The Registrar:

The Chairman:

A. Wolinski

M. Wieser