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**Datasheet for the decision
of - 26 March 2012**

Case Number: T 2366/11 - 3.3.08
Application Number: 04731585.8
Publication Number: 1623021
IPC: C12N 5/06, G01N 33/50,
A61K 9/127
Language of the proceedings: EN

Title of invention:
Method for storing tumor cells

Applicant:
Oncoscience AG

Headword:
Storing cells/ONCOSCIENCE

Relevant legal provisions:
EPC Art. 111(1)
EPC R. 103(1)(a), 111(2)
RPBA Art. 11

Keyword:
"Decision sufficiently reasoned (no)"
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:
T 0278/00, T 0963/02, T 0897/03, T 0583/04, T 0763/04,
T 0511/07, T 1547/07, T 1612/07, T 1997/08

Catchword:
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Case Number: T 2366/11 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of -

Appellant: Oncoscience AG
(Applicant) Hafenstrasse 32
D-22880 Wedel (DE)

Representative: v. Menges, A.
UEXKÜLL & STOLBERG
Patentanwälte
Beselerstrasse 4
D-22607 Hamburg (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 March 2011
refusing European patent application
No. 04731585.8 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: M. Wieser
Members: B. Stolz
D. S. Rogers

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division to refuse European Patent Application EP No. 04731585 pursuant to Article 97(2) EPC.

II. The subject matter of the patent application is a method for the storing of tumour cells.

III. The following documents are referred to in this decision:

D1: EP 0377582, 18 July 1990

D7: US 6 528 641, 4 March 2003

D8: Piperno-Neumann S. et al., 2003, BBA BIOMEMBRANES, vol. 1611(1-2):131-139

D9: Ehrhart F. et al., 2009, CRYOBIOLOGY., vol. 58(2):119-127

D10: Meryman HT., 2007, TRANSFUSION, vol. 47(5):935-945

D11: Heim M. et al., A new oxygen enriched medium (Liforlab-solution) adequate for tumor tissue preservation, Preprint

D12: Hilger R.A. et al., 2006, 97th Annual Meeting of the American-Association-for-Cancer-Research (AACR); Proceedings of the American Association for Cancer Research Annual Meeting, vol. 47:306-307

D13: Heim M et al., 2004, Int. J. Clinical Pharmacology and Therapeutics, vol. 43(12):586-587.

D14: Heim M. et al., 2004, Int. J. Clinical Pharmacology and Therapeutics, vol. 42(11):659-660.

- IV. With letter dated 1 October 2007, the examining division issued a first communication, addressing issues under Article 52(4) EPC 1973, and under Article 84 EPC.
- V. With its response, dated 9 April 2009, the applicant filed amended claims replacing the claims then on file, amended pages of the description, and reasons why it considered the new claims to meet the requirements of the EPC.
- VI. In a telephone conversation, held on 1 July 2009, the examining division informed the applicant of deficiencies of some of the claims on file with regard to the provisions of Articles 53(a) and 53(c) EPC 2000 (formerly Article 52(4) EPC 1973).
- VII. With its response, dated 21 July 2009, the applicant filed amended claims 1 to 23 replacing the claims then on file, an amended page of the description, and explained why it considered the objections raised by the examining division to be overcome.
- VIII. In a further communication, dated 15 February 2010, the examining division introduced new prior art documents D7 and D8, and raised objections under Articles 83 and 84 EPC against all claims. It also raised new novelty objections against claims 20 to 23, and new inventive

- step objections against claims 1 to 19 as far as they related to subject matter which the examining division considered unsupported and insufficiently disclosed.
- IX. With its response, dated 25 August 2010, the applicant filed a main request with claims 1 to 22, replacing the claims then on file, an auxiliary request I with claims 1 to 20, and addressed the issues raised by the examining division.
- X. A summons to oral proceedings to be held on 14 March 2011 was dispatched on 20 December 2010, accompanied by a communication introducing two new prior art documents D9 and D10. In addition to objections under Articles 83 and 84 EPC that had previously been raised, the communication also raised new objections: a new objection under Article 84 EPC was raised against the term "tumour biopsy" in amended claim 20, and a new inventive step objection was raised against claims 1 to 19 in view of documents D1 and D7.
- XI. At the request of the appellant, oral proceedings were postponed to 30 March 2011.
- XII. In response to the summons to oral proceedings, the applicant filed a letter of 15 pages, dated 10 February 2011, and provided detailed arguments that sought to counter the examining division's objections under Articles 83, 84 and 56 EPC. It submitted an unpublished manuscript as document D11 in support of its arguments that the requirements of Article 83 EPC were met, and filed auxiliary requests II and III.

XIII. In a telephone conversation held on 17 February 2011, the examiner introduced new prior art documents D12 to D14, and informed the applicant that it considered auxiliary requests II and III to be unallowable because they did not meet the requirements of Articles 83 and 84 EPC. The telephone conversation was summarized in a communication that was sent to the appellant on 25 February 2011.

XIV. With letter dated 28 February 2011, the applicant withdrew its request for oral proceedings and requested that a decision be issued on the basis of the current status of the file.

XV. The decision to refuse the application was issued on EPO Form 2061 and dispatched on 28 March 2011.

XVI. A notice of appeal was filed on 1 June 2011 and the grounds of appeal were submitted on 8 August 2011. The appellant's arguments, as far as relevant for this decision, are:

The decision issued by the examining division did not contain substantive grounds for the decision.

The decision generally stated that the applicant failed to provide comments on objections raised in the Communications dated 20 December 2010 and 25 February 2011. This was not correct, as a detailed submission including further requests and evidence had been made on 15 February 2011 in response to the Communication from December 2010.

In response to this detailed submission, the examiner had telephoned the applicant's representative, raised

new objections, maintained some of the older objections and summarized these objections in a communication dated 25 February 2011.

This could not replace substantive grounds for a decision refusing the application.

XVII. In a telephone conversation held on 1 March 2012, the board contacted the representative in order to clarify the requests on file.

XVIII. With letter dated 16 March 2012, the appellant requested that the decision under appeal be set aside and the application be remitted to the first instance for further prosecution and that the appeal fee be refunded. As an auxiliary measure it requested that a patent be granted on the basis of its main request or auxiliary requests I to III, all filed under cover of its written statement of grounds of appeal dated 8 August 2011.

Reasons for the decision

1. Rule 111(2) EPC stipulates that decisions of the European Patent Office which are open to appeal shall be reasoned.

The boards of appeal have consistently decided that a decision must contain a logical sequence of arguments and that all facts, evidence and arguments essential to the decision must be discussed in detail in order to meet these legal requirements (see for instance T 278/00 OJ EPO 2003, 546; T 763/04 of 22 June 2007,

point 4; T 1612/07 of 5 May 2009; T 1997/08 of 1 July 2009).

2. It follows that, if a decision is reasoned by reference to one or more previous communications, the requirement of Rule 111(2) EPC is only met if the referenced communications themselves fulfil the above mentioned requirements. The decisive reasons for refusal must be clear to the party and to the board of appeal from the reference. The referenced communications must address the arguments presented by the party. It must not be left to the board and the appellant to speculate as to which of the reasons given in preceding communications might be essential to the decision to refuse the application (see T 963/02 of 29 Sept 2004, point 2).

Hence, the communications referred to in the decision on EPO Form 2061 must contain a fully reasoned exposition of the examining division's objections to the current application text and refutation of any rebuttal by the applicant (see T 583/04 of 6 June 2006, points 4-6). Examples of decisions where this was the case include decisions T 1547/07 of 29 September 2009 (see point 2), and T 511/07 of 4 May 2010 (see point 2.4).

3. It remains to be established if the decision under appeal meets these requirements.
4. With its communication accompanying the summons to oral proceedings, dated 20 December 2010, the examining division informed the applicant for the first time of its opinion that the main request and auxiliary request I before it lacked an inventive step in view of

documents D1 and D7. It also added further new arguments why said requests did not meet the requirements of Articles 83 and 84 EPC.

5. With its reply, dated 10 February 2011, the applicant submitted document D11 and provided detailed reasons why it considered that the main request as well as auxiliary request I met all requirements of Articles 83, 84 EPC as well as those of Article 56 EPC. As a measure of precaution it submitted new auxiliary requests II and III in the event that the examining division was not inclined to grant a patent on the basis of the preceding requests.

6. In response to the appellant's submissions, the examiner entrusted with examination of the application held a telephone conversation with the applicant's representative. A communication summarizing this conversation was dispatched on 25 February 2011.

According to this summary, the examiner explained why auxiliary requests II and III were not considered to meet the requirements of Articles 83 and 84 EPC. The conversation also included an evaluation of document D11, and an evaluation of documents D12 to D14 newly introduced at this point by the examiner. The applicant was encouraged to file a new set of claims taking into account the comments made in relation to auxiliary requests II and III.

The summary of the telephone conversation makes no mention of the objection under Article 56 EPC against the main request and auxiliary request I nor of

applicant's counter arguments submitted with its reply of 10 February 2010.

7. In reply to this communication summarizing the telephone conversation, the applicant withdrew its request for oral proceedings and requested a decision "on the basis of the current status of the file".
8. Following this request, the examining division refused the application using EPO Form 2061. The reasons indicated on this form are the following:

"In the communication(s) dated 25.02.2011, 20.12.2010 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 28.02.2011.

The application must therefore be refused."

9. The second paragraph on Form 2061, stating that no comments or amendments have been filed in reply to the latest communication, may have misled the examining division into believing that, apart from filling in Form 2061, no further action from its side was needed.

However, as mentioned in points 1 and 2 above, the use of standard Form 2061 is only appropriate where the examining division fully expressed and reasoned its

objections to the current requests in the preceding communications taking into account all the arguments brought forward by the applicant and doing so in a manner which does not leave it to the board and the appellant to speculate as to which of the reasons given in preceding communications might be essential to the decision to refuse the application (see T 897/03 of 16 March 2004, point 3 et seq.).

While it is true that no comments were filed in reply to the last communication of the examining division dated 25 February 2011, the appellant had filed a response to the previous communication mentioned on EPO Form 2061. Since the examining division did not address in its communications mentioned on EPO Form 2061 the appellant's arguments submitted with its response of 10 February 2011, the appellant and the board are left in the dark as to whether consideration was paid to these submissions, and if it was, as to the basis upon which the applicant's requests were refused.

In particular, the failure of the examining division to give any indication as to why it found unconvincing the appellant's arguments against the inventive step objections raised for the first time in the communication annexed to the summons to oral proceedings, dated 20 December 2010, is contrary to the requirements of Rule 111(2) EPC.

10. This failure constitutes a substantial procedural violation which requires that the decision under appeal be set aside and that the case be remitted to the first instance in accordance with Article 111(1) EPC and Article 11 RPBA.

For reasons of equity the substantial procedural violation justifies the reimbursement of the appeal fees (Rule 103(1)(a) EPC).

Order:

For these reasons it is decided that:

1. The decision under appeal is set aside and the case is remitted to the first instance for further prosecution.
2. The appeal fee is reimbursed.

The Registrar

The Chairman

A. Wolinski

M. Wieser