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**Datasheet for the decision
of 25 October 2013**

Case Number: T 0674/12 - 3.3.01

Application Number: 07733847.3

Publication Number: 2013188

IPC: C07D239/42, A61K31/505,
A61P3/06

Language of the proceedings: EN

Title of invention:
ROSUVASTATIN ZINC SALT

Applicant:
Egis Gyógyszergyár Nyilvánosan Működő
Részvénytársaság

Headword:
Rosuvastin zinc salt/EGIS

Relevant legal provisions:
EPC Art. 113(2), 111(1)
EPC R. 103(1)(a), 71(3), 71(4), 71(5)

Keyword:
Substantial procedural violation - opportunity to comment (no)
Reimbursement of appeal fee - (no)

Decisions cited:
T 1854/08, T 0996/12

Catchword:



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Case Number: T 0674/12 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 25 October 2013

Appellant:
(Applicant)

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Representative:

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Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 13 December
2011 refusing European patent application No.
07733847.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: L. Bühler
Members: J.-B. Ousset
G. Seufert

Summary of Facts and Submissions

- I. The appeal lies against the decision of the examining division refusing European patent application No. 07733847.3
- II. The facts relevant for the present decision can be summarised as follows:
- a) At the oral proceedings held on 15 June 2010, the examining division decided that the main request was not patentable. Auxiliary requests I and II, both filed during the oral proceedings, were also found not allowable. A third auxiliary request, also filed during the oral proceedings, was found patentable.
 - b) A communication according to Rule 71(3) EPC (OJ EPO 11/2008, 513) conveying the examining division's intention to grant was sent on 19 July 2010. Reasons were given in the annex as to why the higher-ranking requests were not patentable. The communication sent together with the annex, informed the applicant that it might reply within the time limit set that it maintained the main or a higher-ranking request which was not allowable, in which case the application would be refused. The applicant (appellant) was also informed that if it filed amendments, they had to be identified and the basis for them in the application as filed had to be indicated.
 - c) In a letter of 18 November 2010, the appellant said it did not agree with this proposal of grant

(see page 1, point 1 under "I Request"). Point 2 of the same chapter reads as follows:

"The ground is that already the documents according to the main request of May 12, 2010, filed on June 15, 2010, with the amendments carried out in the Oral Hearing of June 15, 2010, fulfil the requirements of the EPC and so also the inventive step according to Article 56. For the sake of clarity enclosed herewith are the Claims of the Main Request (Note: These are not new claims but the previous claims with the amendments requested by the Examining Division in the Oral Hearing of June 15, 2010)."

On the last paragraph of this letter (see page 23), the appellant requested the grant of a patent based on auxiliary request I filed during oral proceedings if the main request was not considered patentable.

- d) A notification of loss of right, according to Rule 112(1) EPC was sent by the EPO on 17 December 2010.
- e) On 15 February 2011, the appellant filed an appeal against the communication under Rule 71(3) EPC of 19 July 2010 and the notice of loss of rights of 17 December 2010. In this appeal, it requested that the notification of loss of rights according to Rule 112(1) EPC be set aside and that a patent be granted either on the basis of the main request filed on 15 June 2010 or, alternatively, on the basis of one of auxiliary requests I and II, both filed on 15 June 2010 (see page 2, chapter I). In parallel, the appellant filed a request for a

decision under Rule 112(2) EPC. It requested a decision "affirming the patentability" and made reference to its submission of 18 November 2010, i.e. the reply to the intention to grant. No specific claim request was mentioned.

- f) A communication according to Rule 112(2) EPC was sent on 30 June 2011 informing the applicant that the notification of 17 December 2010 pursuant to Rule 112(1) EPC was set aside. On the same day, a communication was sent by the EPO stating that the communication under Rule 71(3) EPC of 19 July 2010 was set aside and that in accordance with Part C-VI, 14.5 of the Guidelines for Examination of the European Patent Office substantive examination was to be resumed because one of the exceptions of said Guidelines (see Part C-VI, 14.4.1) applied.
- g) On 13 December 2011, a decision of the examining division refusing the patent application based on the main request and on auxiliary requests I and II was sent. The non-patentable requests were annexed to this decision. On the first page of the main request annexed to the decision of the examining division appears the date of 12 May 2010.

III. The main request filed by the appellant with its letter of 18 November 2010 contains 14 claims, whereas the main request annexed to the contested decision of the examining division encompasses 19 claims. Claim 9 of the set of claims sent with letter dated 18 November 2010 mentions that the isolation of the salt of formula (I) is carried out by precipitation, whereas claim 11 of the main request appended to the contested decision mentions precipitation and extraction. The

wording of claim 2 is substantially different in both requests.

IV. The appellant's arguments relevant for the decision can be summarised as follows:

- The examining division had committed a substantial procedural violation. Therefore the appeal fee should be reimbursed and the case remitted to the department of first instance.
- The main request filed on 12 May 2010 and the one filed on 18 November 2010 in response to the proposal of grant according to Rule 71(3) EPC (OJ EPO 11/2008, 513) were not identical.
- The EPO had not been justified in issuing a notification of loss of rights according to Rule 112(1) EPC.
- A new main request had been submitted with the letter of 18 November 2010. A decision of refusal should not have been issued without a further communication (Rule 71(5) EPC, OJ EPO 11/2008, 513).

V. The appellant requested that the decision under appeal be set aside, that the case be remitted to the department of first instance for further prosecution and that the appeal fee be reimbursed. Alternatively, it requested that a patent be granted on the basis of one of auxiliary requests I to IV, all filed with letter of 25 September 2013.

VI. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. Procedural violation
 - 2.1 The European Patent Office can only decide upon a European patent application on the basis of a text submitted to it and agreed by the applicant (Article 113(2) EPC).
 - 2.1.1 At the oral proceedings of 15 June 2010, the examining division proposed to grant a patent on the basis of auxiliary request III filed during these proceedings. In the "opinion on the grant of a patent", explaining why the higher-ranking requests were not patentable, the examining division referred to a "re-filed main request" (see page 1, paragraph 1), whose written version is not on file. The minutes of the oral proceedings mention on page 1, point 1, that the applicant had requested the grant of a patent on the basis of the main request which had been submitted on 12 May 2010. In view of the fact that this discrepancy has never been contested by the appellant, the board can reasonably assume that the main request filed by the appellant during the oral proceedings of 15 June 2010 was identical to the main request filed on 12 May 2010.
 - 2.1.2 The examining division refused the application by decision of 13 December 2011, after setting aside its previous notification of loss of rights dated 17 December 2010 (see point III d) to f)). The examining division based its decision on the main

request as well as auxiliary requests I and II, all filed during oral proceedings of 15 June 2010 (see page 4, last paragraph, and copies of the requests attached to the said decision). However, with its letter of 18 November 2010 under Rule 71(4) EPC the appellant had declined to approve the text proposed for grant, had filed a main request, and had requested that a patent be granted on the basis of this main request or of auxiliary request I (see point II c)). The main request on which the decision of refusal is based differs from the main request submitted with the appellant's letter of 18 November 2010 (see point III, above).

2.1.3 Although the examining division pointed out in its decision (see page 4, point 3, fourth paragraph) that it was not clear which requests were maintained after the appellant declined to approve its proposal for grant, no further communication was issued to clarify the appellant's requests. As a consequence, the examining division decided upon requests whose text was no longer agreed by the appellant. This contravenes Article 113(2) EPC and amounts to a substantial procedural violation (see T 1854/08, point 2.1 of the reasons and T 996/12, point 4, both not published) justifying remittal of the case to the department of first instance for further prosecution (Article 111(1) EPC).

3. Refund of the appeal fees

3.1 The appeal fee shall be reimbursed where a board of appeal deems an appeal to be allowable, if such refund is equitable by reason of a procedural violation (Rule 103(1) (a) EPC).

3.1.1 The present appeal is allowable by reason of a substantial procedural violation (see points 1 and 2 above). The issue is therefore whether reimbursement is equitable in the circumstances of this case. Although the letter of 18 November 2010 is clear and unambiguous in that the appellant said it did not approve the grant of a patent on the basis of the third auxiliary request, it does not indicate without any doubt how the appellant intended to proceed. On the one hand, its paragraph 2 seems to be arguing that the main request of 12 May 2010, re-filed during oral proceedings on 15 June 2010, was inventive. The appellant attached a version of this request to its letter and stressed that it did not include new claims. On the other hand, the appellant referred to amendments "carried out in the Oral Hearing" of 15 June 2010 and "requested by the Examining Division in the Oral Hearing". However, neither the minutes nor the communication pursuant to Rule 71(3) EPC conveying the examining division's intention to grant a patent mention that amendments to the main request of 12 May 2010 had been submitted by the appellant or proposed by the examining division during oral proceedings. Amendments had only been requested with respect to the third auxiliary request (see minutes, page 3, point 4.2). It was therefore not clear whether the appellant was maintaining its main request of 12 May 2010, which had been found not to be allowable, or whether it was submitting an amended main request replacing its main request of 12 May 2010. The last paragraph of the appellant's reply to the communication under Rule 71(3) EPC also failed to remove this ambiguity (see point II c) above), since it merely refers to the main request, without any further explanation. Indeed, the appellant neither identified any amendment in the main request filed as an annex to its letter of 18 November 2010, nor indicated the basis

for such amendment in the application as filed. Moreover, the appellant did not file a translation of the amended claims as required by Rule 71(4) EPC. Instead, the appellant argued that no decision had been taken by the examining division with respect to the main request, that the deciding body had committed a procedural violation because it had not informed the appellant of the possibility of maintaining its main request which was considered not to be allowable, and that it should be given the opportunity to submit its observations on the examining division's objections before a decision was taken. There is no need for the board to rule on the legal and factual merits of the appellant's submissions. It is sufficient to note that the appellant failed to submit with its letter of 18 November 2010 clear requests which conformed with the procedural options available in reply to a communication pursuant to Rule 71(3) EPC.

- 3.1.2 Moreover, the appellant failed to clarify in its further submissions whether it was maintaining its main request of 12 May 2010 which had been found not to be allowable, or whether it was submitting an amended main request replacing that of 12 May 2010. In its appeal against the notification of loss of rights pursuant to Rule 112(1) EPC, sent on 17 December 2010, the appellant formulated diverging requests (see page 2, point I of the letter of 15 February 2011). It requested the grant of a patent on the basis of the main request filed during oral proceedings of 15 June 2010, or on the basis of one of auxiliary requests I and II, both submitted during these oral proceedings. The latter request, namely a grant on the basis of auxiliary request II, was not presented in its letter of 18 November 2010.

3.1.3 In view of the foregoing, the examining division should have clarified the requests on file before issuing a decision (e.g. by sending a further communication according to Rule 71(5) EPC or by summoning the appellant to further oral proceedings). However, by filing different unclear requests, which represented the framework of its case, the appellant did not help to expedite the proceedings and contributed to the fact that the decision of the examining division was based on a request which was no longer in the proceedings. Thus, the reimbursement of the appeal fee would not be equitable in the present case.

3.2 The appeal fee is not reimbursed (Rule 103(1)(a) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:



M. Schalow

L. Bühler

Decision electronically authenticated