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**Datasheet for the decision
of 30 September 2013**

Case Number: T 2557/12 - 3.4.01

Application Number: 07839621.5

Publication Number: 2066399

IPC: A61N 1/32

Language of the proceedings: EN

Title of invention:

Electroporation devices and methods of using same for
electroporation of cells in mammals

Applicant:

VGX PHARMACEUTICALS, INC.

Headword:

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Relevant legal provisions:

EPC Art. 116, 113 (1)

EPC R. 103(1)(a)

Keyword:

"Substantive procedural violation (yes)"

Decisions cited:

T 0299/86, T 0528/96, T 1136/10

Catchword:

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Case Number: T 2557/12 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 30 September 2013

Appellant: VGX PHARMACEUTICALS, INC.
(Applicant) 450 Sentry Parkway
Blue Bell, PA 19422 (US)

Representative: Bassil, Nicholas Charles
Kilburn & Strode LLP
20 Red Lion Street
London WC1R 4PJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 25 April 2012
refusing European patent application
No. 07839621.5 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: P. Fontenay
Members: H. Wolfrum
C. Schmidt

Summary of Facts and Submissions

- I. In a communication dated 30 September 2009 the examining division had raised a number of objections under various Articles of the EPC, including an objection as to lack of inventive step, against the claims then on file.
- II. The applicant had replied to this communication by a letter of 7 April 2010 by filing a new set of claims. The letter ended with the following phrase :
"In the case of the Examining division would decide to reject the application, an oral proceedings would be requested pursuant to article 116 EPC."
- III. Without any further communication with the applicant, the application was refused by a decision of the examining division dispatched on 25 April 2012, on the grounds of added subject-matter (Article 123(2) EPC) and of lack of inventive step (Articles 52(1) and 56 EPC 1973) of the subject-matter of claim 1 of the appellant's request then on file. In its decision the examining division noted that the concluding phrase of the applicant's letter did not constitute a request for oral proceedings.
- IV. The applicant lodged an appeal against the decision and paid the prescribed fee on 25 June 2012. On 4 September 2012 a statement of grounds of appeal was filed.

The appellant saw a substantial procedural violation in the fact that the examining division ignored an allegedly valid request for oral proceedings and

requested, by way of a main request, that the decision of the examining division be cancelled and a summons to attend oral proceedings before the examining division be issued. As a first auxiliary request grant of a patent was requested on the basis of newly filed application documents. In either case, refund of the appeal fee was requested. Moreover, an auxiliary request for oral proceedings was made in the event that the Board was not willing to grant the main request or the auxiliary request.

- V. By a communication of 9 July 2013 pursuant to Rule 100(2) EPC the Board indicated that it was minded to comply with the appellant's main request so that the decision under appeal would be set aside and the case remitted to the examining division for oral proceedings under Article 116 EPC to take place. Moreover, it appeared equitable that the appeal fee should be reimbursed pursuant to Rule 103(1)(a) EPC.

The appellant was invited to express, within a time period of four months, its consent with the proposed course of action.

- VI. By letter of 22 August 2013, the appellant consented with the Board's proposal as regards the course of actions to be taken.

Reasons for the Decision

1. In the following reference is made to the provisions of the EPC 2000, which entered into force as of 13 December 2007, unless the former provisions of the EPC 1973 still apply to pending applications.
2. The appeal complies with the requirements of Articles 106 to 108 EPC and Rule 99 EPC and is, therefore, admissible.
3. Substantive procedural violation
 - 3.1 In the appellant's view, the phrase "In the case of the Examining division would decide to reject the application, an oral proceeding would be requested pursuant to article 116 EPC." concluding the applicant's reply to the examining division's communication constituted a valid request for oral proceedings. Thus, by refusing the application without summoning to oral proceedings, the examining division committed substantial procedural violations in the following respects :
 - (i) the examining division's decision was based on a perverse and illogical interpretation of a request, and contravened the principle of legitimate expectations;
 - (ii) the decision violated the applicant's fundamental right to be heard;
 - (iii) the examining division ignored the EPO' obligation to warn applicants if errors or omissions would lead to a loss of rights;
 - (iv) the case law relied on by the examining division was not relevant to the present case.

3.2 In the contested decision, the examining division noted that the applicant had not requested oral proceedings pursuant to Article 116 EPC (paragraph 4 of the contested decision) because the cited phrase, due to the use of the subjunctive form "*would be requested*", did not constitute a request for oral proceedings. Reference was made in this respect to decisions T 528/96 and T 299/86. Consequently, instead of issuing a further communication or a summons to oral proceedings, the examining division issued its decision to refuse the application.

3.3 In the Board's view, the examining division's interpretation is not altogether unreasonable and thus cannot be qualified as "*perverse*" or "*illogic*". After all, the appellant itself takes into consideration the possibility of "*errors and omissions*" (point 4.4 of the statement of grounds of appeal). Moreover, as a matter of principle, it lies in a party's responsibility to file its requests in an unambiguous manner. In this context, it is added that, up to the decision taken, there is no action apparent on the part of the examining division which could have nurtured any legitimate expectations on the applicant's side as to a positive outcome of the examination proceedings.

3.4 On the other hand, the examining division's categorical position that there was no valid request for oral proceedings is not tenable. Notwithstanding its inherent ambiguity due to the use of the subjunctive formulation, the phrase in question leaves little doubt about the applicant's intention to avoid an immediate refusal of its application.

In this situation, any risk of procedural deviance could have been easily avoided if the examining division had sought respective clarification from the applicant before issuing its decision.

In fact, in the Board 's understanding the phrase in question should be considered more likely as a request for oral proceedings than not.

- 3.5 The examining division saw analogies in its interpretation to the factual situations underlying decisions T 528/96 and T 299/86.

The Board disagrees because the statements made in these cases could not reasonably be interpreted as actual requests for oral proceedings.

In case T 528/96 (not published in the OJ) a patentee had stated in its response to the opposition "Should the opposition division feel that further information is required, the patentee will be pleased to respond in due course, either in writing or during the oral hearing". The then deciding board did not consider the reference in this statement to an "oral hearing" to constitute a formal request for oral proceedings according to Article 116 EPC (T 528/96 : point 2 of the "Reasons").

In case T 299/86 (not published) the deciding board held in its interlocutory decision of 23 September 1987 that the phrase "*I reserve my right to request oral proceedings under Article 116 EPC*" is not in itself an actual request for oral proceedings since a clear

distinction has to be made between actually "making a request for oral proceedings" and "reserving the right to make a request for oral proceedings" (T 299/86 : point 4 of the "Reasons").

3.6 Instead, given the circumstances of the present case, the Board sees considerable similarities to the facts underlying case T 1136/10 (not published), where an applicant had stated "*... should the Examiner feel disposed to reject the application at any time, we would request Oral Proceedings, purely as a precautionary measure, so as to avoid such a rejection*".

3.7 In view of the above observations, the Board has come to the conclusion that the phrase concluding the applicant's letter of 7 April 2010 should have been understood as a valid request for oral proceedings in case the examining division considered a rejection of the application. Ignoring this request constitutes a substantial procedural violation on the part of the examining division since it deprived the applicant of its right to oral proceedings (Article 116 EPC) and of its right to be heard (Article 113(1) EPC).

Therefore, the Board complies with the appellant's main request by setting the decision under appeal aside and remitting the case to the examining division for oral proceedings under Article 116 EPC to take place.

Moreover, it is equitable that the appeal fee should be reimbursed pursuant to 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 examining division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

R. Schumacher

P. Fontenay