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**Datasheet for the decision  
of 11 January 2019**

**Case Number:** T 0613/14 - 3.3.02

**Application Number:** 05730345.5

**Publication Number:** 1730151

**IPC:** C07D489/00, C07D489/08

**Language of the proceedings:** EN

**Title of invention:**

PROCESS FOR PREPARING OXYCODONE HYDROCHLORIDE HAVING LESS THAN  
25 PPM 14-HYDROXYCODEINONE

**Applicant:**

EURO-CELTIQUE S.A.

**Opponents:**

Elend, Almut Susanne  
Actavis Group PTC ehf  
Acino Pharma AG

**Headword:**

EURO-CELTIQUE / OXYCODONE HYDROCHLORIDE

**Relevant legal provisions:**

EPC R. 140

**Keyword:**

Reimbursement of appeal fee - (yes)

**Decisions cited:**

G 0008/91, G 0001/10, J 0012/85, J 0030/94, J 0037/97,  
J 0038/97, J 0017/04, T 0041/82, T 0838/92, T 0212/97,  
T 0231/99, T 0068/02, T 1063/02, T 0308/05, T 1785/15

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0613/14 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 11 January 2019**

**Appellant:** EURO-CELTIQUE S.A.  
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**Decision under appeal:**      **Communication of the Opposition Division of the  
European Patent Office posted on 13 January 2014  
rejecting the request for correction of the  
decision to revoke European patent EP 1 730 151  
and the minutes of the oral proceedings on  
19 September 2013**

**Composition of the Board:**

**Chairman**                    M. O. Müller  
**Members:**                    M. Maremonti  
                                      L. Bühler

## **Summary of Facts and Submissions**

- I. By letter dated 3 December 2013, the patent proprietor requested that the decision of the opposition division posted on 8 November 2013 on the revocation of European patent EP 1 730 151 be corrected. The patent proprietor further requested amendments to the minutes of the oral proceedings dated 8 November 2013.
- II. By communication posted on 13 January 2014, the opposition division stated that it did not wish to amend the decision or the minutes. The opposition division informed the patent proprietor that an appeal could be filed against its decision.
- III. By notice of appeal dated 12 March 2014, the patent proprietor lodged an appeal against the opposition division's rejection of the request to correct the decision to revoke European patent EP 1 730 151 and the minutes of the oral proceedings before the opposition division. This appeal was filed as a separate appeal to the previous appeal against the decision to revoke European patent EP 1 730 151 (which has case number T 69/14). The patent proprietor paid the appeal fee on the same day. A statement of the grounds of appeal was filed on 12 May 2014, including a request for reimbursement of the appeal fee.
- IV. Replies to the statement of grounds of appeal by opponent 3 (respondent 3) and opponent 1 (respondent 1) were received on 5 June 2014 and 26 September 2014, respectively.
- V. The parties were summoned to oral proceedings. In the communication accompanying the summons, the board

informed the parties of its preliminary opinion that the appeal appeared to be inadmissible.

VI. Oral proceedings were held on 11 January 2019 in the absence of the respondents. During the oral proceedings, the patent proprietor (appellant) withdrew the appeal but maintained the request for reimbursement of the appeal fee.

VII. The appellant's arguments with respect to the reimbursement of the appeal fee may be summarised as follows:

The appellant was misled by the opposition division's erroneous information that the rejection of the appellant's request to correct the decision to revoke European patent EP 1 730 151 and the minutes of the oral proceedings before the opposition division on 19 September 2013 constituted a decision open to appeal. This information gave rise to the appellant's legitimate expectation that a separate appeal would be found admissible and examined as to its substance. However, in its preliminary opinion of 18 September 2018, the board concluded that such a separate appeal was inadmissible. The circumstances were similar to those underlying decision T 1785/15. In this case, the appeal was not allowable. Nevertheless, the board allowed a request for reimbursement of the appeal fee in view of the fact that the applicant had filed the appeal based on incorrect advice from the Office. The basis for reimbursement was not Rule 103 EPC but a violation of the principle of the protection of legitimate expectations.

## **Reasons for the Decision**

1. Appeal procedures are terminated, as far as the substantive issues are concerned, when the sole appellant withdraws the appeal (G 8/91, OJ EPO 1993, 346). However, the boards of appeal, in the exercise of their inherent original jurisdiction, still have to decide on requests concerning procedural questions arising from the former proceedings (see e.g. T 41/82, OJ EPO 1982, 256, reasons, point 6; J 37/97 of 15 October 1998, reasons, point 2; T 308/05 of 27 February 2006, reasons, point 1).
2. The appellant withdrew its appeal but maintained its request for reimbursement of the appeal fee. In accordance with the above decisions, the procedural request for reimbursement has to be examined irrespective of the withdrawal of the appeal by the appellant.
3. The appellant no longer bases its request for reimbursement of the appeal fee on Rule 103 EPC. Indeed, reimbursement of the appeal fee according to that provision can only be ordered if the appeal is allowed. However, since the appellant withdrew its appeal, the proceedings have been terminated without decision on the substantive issues. Therefore, Rule 103 EPC provides no basis for ordering reimbursement.

Reimbursement can only be requested on a basis other than Rule 103 EPC. The appellant is of the opinion that the appeal fee should be reimbursed on the ground that it had filed the appeal based on misleading information provided by the opposition division. The appellant thus

invokes the principle of protection of legitimate expectations as a basis for reimbursement.

4. Requests for reimbursement of the appeal fee have exceptionally been allowed on the basis of the principle of protection of legitimate expectations in cases where Rule 103 EPC provided no basis for ordering reimbursement (see J 30/94 of 9 October 1995, reasons, point 3.3; J 38/97 of 22 June 1999, reasons, points 5.2 and 5.3; T 308/05 of 27 February 2006, reasons, points 5 and 6; T 1785/15 of 9 May 2016, reasons, points 2.2 to 2.4). Following this case law, the issue to be decided is whether the statement by the opposition division that the rejection of the appellant's request to correct the decision to revoke European patent EP 1 730 151 and the minutes of the oral proceedings before the opposition division on 19 September 2013 constituted a decision open to appeal and created a legitimate expectation that an appeal would be found admissible and examined as to its substance.
  
5. The initial appeal concerned two distinct procedural aspects, namely, the correction of the opposition division's decision posted on 8 November 2013 and the correction of the minutes of the oral proceedings of 19 September 2013, also posted on 8 November 2013.
  
6. *Correction of the minutes posted on 8 November 2013*
  
- 6.1 It is constant case law that the minutes of the oral proceedings are neither a decision nor part of the decision announced at the oral proceedings (T 838/92 of 10 January 1995, reasons, point 3; T 231/99 of 31 August 1999, reasons, points 1.1 and 1.2; T 212/97 of 8 June 1999, reasons, point 2.2; T 68/02 of



24 June 2006, reasons, point 6.2). Likewise, a correction of the minutes by the competent department before which oral proceedings had been held is not considered a decision within the meaning of Article 106(1) EPC (see T 231/99 of 31 August 1999, reasons, points 1.3 to 1.5). The question of whether the rejection of a request for correction was a decision was left undecided in case T 231/99 of 31 August 1999 (see reasons, point 3), but there is no apparent reason why such a rejection should become the subject of an appeal if the minutes as such are not a decision open to appeal.

6.2 Given that professional representatives must be expected to be acquainted with the above case law, the appellant who was represented by a professional representative should have realised that the refusal to correct the minutes of the oral proceedings of 19 September 2013 did not constitute a decision open to appeal. Therefore, the appellant could not have legitimately relied on the erroneous statement by the opposition division as regards the appeal against the rejection by the opposition division of the appellant's request to correct the minutes.

7. *Correction of the decision posted on 8 November 2013*

7.1 As regards the appeal against the rejection by the opposition division of the appellant's request of 3 December 2013 to correct the opposition division's decision posted on 8 November 2013, the board is aware of decisions which consider that a rejection of such a request can, in principle, be contested by means of an appeal (see T 1063/02 of 16 June 2004, reasons, point 1, referring to G 8/95, OJ EPO 1996, 481 [which is superseded by decision G 1/10, OJ EPO 2012, 376];

J 17/04 of 9 April 2005, reasons, point 1, referring to J 12/85, OJ EPO 1986, 155).

7.2 In contrast to a request for correction of the minutes or the decision to grant (an issue considered by the Enlarged Board of appeal in decision G 1/10, OJ EPO 2012, 376), there is no established case law on the issue of whether or not the rejection of a request for correction of a decision under Rule 140 EPC is open to appeal. It cannot, therefore, be ruled out, and is even likely, that the appellant relied on the opposition division's statement when filing the appeal.

7.3 The appeal having been withdrawn, the board does not need to decide on whether, and if so, to what extent, the refusal of a request for correction of a decision under Rule 140 EPC can become the subject of an admissible appeal. However, for the above reason, the board considers the opposition division's statement to have created a legitimate expectation that an appeal would be found admissible and examined as to its substance, at least in respect of the request for correction of the decision.

However, in its preliminary opinion, the board took the position that the appeal against the opposition division's refusal of the request to correct its decision was not admissible. The board thus deprived the appellant of its legitimate expectations. After the board had maintained its preliminary opinion during the oral proceedings, the appellant withdrew its appeal. Under these circumstances, the board considers it justified to order the reimbursement of the appeal fee in accordance with the case law cited above (point 4).

**Order**

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

The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated