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**Datasheet for the decision
of 12 March 2019**

Case Number: T 0171/15 - 3.3.04

Application Number: 08868841.1

Publication Number: 2237796

IPC: A61K38/17, C12N15/11,
A61L24/00, A61K9/70, A61P41/00

Language of the proceedings: EN

Title of invention:

Use of anti-connexin peptides, alone or in combination with anti-connexin polynucleotides, for the treatment of surgical adhesions

Applicant:

Ocunexus Therapeutics, Inc.

Headword:

Anti-connexin peptides/OCUNEXUS THERAPEUTICS

Relevant legal provisions:

EPC Art. 111(1), 113(1), 113(2)
EPC R. 103(1)(a), 111(2)
RPBA Art. 11

Keyword:

Substantial procedural violation - appealed decision reasoned (no) - violation of the right to be heard (yes)
Basis of decision - text submitted or agreed by applicant (no)
Remittal to the department of first instance - (yes)
Reimbursement of appeal fee - equitable by reason of a substantial procedural violation

Decisions cited:

T 0952/07

Catchword:



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Case Number: T 0171/15 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 12 March 2019

Appellant: Ocunexus Therapeutics, Inc.
(Applicant) 12481 High Bluff Drive, Suite 150
San Diego CA 92130 (US)

Representative: J A Kemp
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 15 July 2014
refusing European patent application
No. 08 868 841.1 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair G. Alt
Members: M. Blasi
R. Morawetz

Summary of Facts and Submissions

I. The appeal lies against the decision of the examining division refusing European patent application No. 08 868 841.1 entitled "*Use of anti-connexin peptides, alone or in combination with anti-connexin polynucleotides, for the treatment of surgical adhesions*". The application had been filed as an international application under the PCT which was published as WO 2009/085268.

II. The decision under appeal was issued using EPO Form 2061 and reads:

"Grounds for the decision

In the communication(s) dated 15.01.2014, 18.09.2012 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 02.05.2014.

The application must therefore be refused."

III. The proceedings before the examining division can be summarised as follows:

- The examining division's communication under Article 94(3) EPC dated 18 September 2012 dealt with the set of claims filed on 21 July 2010 upon entry into the regional phase before the EPO.

The examining division had raised, *inter alia*, objections under Articles 84 and 56 EPC.

- In reply, the applicant submitted an amended set of claims replacing the previous claim request, contested the objections concerning Articles 84 and 56 EPC, and presented counter-arguments as to why the objections did not or no longer applied.

- A communication dated 15 January 2014 was issued by the examining division, together with a summons to oral proceedings. The examining division maintained the lack of clarity objection raised in the previous communication and raised new objections against claims 8 and 17, and, in relation to the objection under Article 56 EPC, pointed out on which points the applicant had, in its view, not yet presented arguments.

- By letter dated 4 April 2014, the applicant submitted amended sets of claims of a new main request, replacing the previous claim request, and an auxiliary request. Furthermore, the applicant presented, *inter alia*, arguments on clarity and on inventive step.

- Subsequently - after a "*telephone call from the Examiner*", as stated in the applicant's letter dated 2 May 2014 - the applicant withdrew its request for oral proceedings and requested "*a written decision on the basis of the current file*".

- The examining division then cancelled the summons to oral proceedings and issued the decision against which an appeal was duly lodged by the applicant (appellant).

- IV. The board issued a communication under Article 17(1) RPBA setting out its preliminary opinion on the relevant issues and informing the appellant that it envisaged to remit the case, without consideration of its merits, to the examining division for further prosecution.
- V. In reply to the board's communication, the appellant clarified that the board could make its decision without holding oral proceedings.
- VI. The appellant had requested in its statement of grounds of appeal that "*examination of this application be continued with the claims of the Main Request*", this main request being identical to the main request filed by letter dated 4 April 2014.

Reasons for the Decision

Remittal of the case pursuant to Article 11 RPBA

1. Under Article 11 RPBA, the board remits a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.
2. In the board's judgement, the decision under appeal is deficient in various aspects, namely, for lack of proper reasoning within the meaning of Rule 111(2) EPC and in view of violations of the right to be heard under Article 113(1) EPC and of the principle laid down in Article 113(2) EPC, i.e. that the European Patent

Office (EPO) must examine and decide upon a European patent application only in the text submitted to it, or agreed, by the applicant.

3. Pursuant to Rule 111(2) EPC, decisions of the EPO which are open to appeal must be reasoned. This requirement ensures that the losing party is informed of the detailed grounds of the decision against it. A reasoned decision is also a prerequisite for the examination of an appeal as the board of appeal has to understand why the department of first instance took the impugned decision, otherwise it cannot rule on the correctness of that decision (see for example decision T 952/07, Reasons, point 3).
4. A decision, therefore, should discuss in detail the facts, evidence and arguments essential to the decision. It must contain the logical chain of reasoning which led to the relevant conclusion (see Case Law of the Boards of Appeal, 8th edition 2016, (CLBA), III.K.4.2.1).
5. In the present case, the impugned decision justifies the refusal of the application by reference to the reasons given in the examining division's communications dated 18 September 2012 and 15 January 2014.
6. However, each of these communications related to a different set of claims then pending before the examining division, i.e. the set of claims filed upon entry into the regional phase before the EPO and the set of claims filed in reply to the first communication under Article 94(3) EPC, respectively, and not to the claims pending at the time of the impugned decision, i.e. the main and auxiliary requests of 4 April 2014.

7. It is therefore left to the appellant and the board to speculate on what considerations the examining division exactly based its decision in relation to the main and the auxiliary requests, and to what extent the reasons in the earlier communications still applied or were overcome by the appellant's arguments put forward in the meantime. Whilst it might be assumed that the sets of claims filed on 4 April 2014 were the subject of the telephone conversation to which the appellant referred in its letter of 2 May 2014 (see section III above), the board can only speculate whether the appellant was informed of the grounds for the refusal of the application during that conversation. In any case, an oral conversation cannot replace the requirement of a reasoned decision under Rule 111(2) EPC, i.e. a written decision clearly specifying the decisive facts, evidence and arguments that allows the board to examine whether the decision under appeal was justified.
8. Furthermore, the appellant's right to be heard under Article 113(1) EPC was not observed.
9. Pursuant to Article 113(1) EPC, the decisions of the EPO must only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In accordance with established case law of the boards of appeal, this means that in the present case the appellant must be given an opportunity not only to present comments on the facts and considerations pertinent to the decision but also to have those comments considered, that is, reviewed with respect to their relevance for the decision on the matter (see also CLBA, III.B.2.4.1).

10. The decision under appeal expressly states that no submissions of the appellant were filed "*in reply to the latest communication*" - this being the communication dated 15 January 2014 (see point II above). However, this is not correct since the appellant had actually filed amended sets of claims together with a letter dated 4 April 2014, also comprising, *inter alia*, arguments in relation to Article 56 EPC. The board can therefore only conclude that the examining division failed to take the appellant's submissions of 4 April 2014 into account, thereby violating the appellant's right to be heard pursuant to Article 113(1) EPC.
11. Furthermore, the letter dated 4 April 2014 also comprised new sets of claims replacing the previous set of claims (see section III). However, the decision of the examining division refers to communications dealing with sets of claims preceding the main and auxiliary requests of 4 April 2014. The claims addressed in the communications had been replaced by the appellant in the meantime and, hence, should not have been considered by the examining division when making its decision.
12. It follows that a violation of Article 113(2) EPC also occurred. According to this provision, the EPO must examine and decide upon the patent application only in the text submitted to it, or agreed, by the applicant.
13. The deficiencies under Rule 111(2) EPC and Article 113(1) and (2) EPC mentioned above in points 2 to 12 affect the outcome of the examination proceedings in their entirety and are thus considered by the board to be fundamental deficiencies within the meaning of Article 11 RPBA.

14. No special reasons present themselves in the circumstances of the present case which would warrant that the board deals with the appeal case notwithstanding the above-mentioned fundamental deficiencies.
15. The board also notes in this context that no objections had been raised by the appellant against a direct remittal of the case, i.e. without considering compliance of the claims of the main and auxiliary requests with the requirements of the EPC.
16. Accordingly, the board considers it appropriate to set aside the contested decision and remit the case to the examining division for further prosecution, pursuant to Article 111(1) EPC and Article 11 RPBA.

Reimbursement of the appeal fee pursuant to Rule 103(1)(a) EPC

17. Since the examination proceedings suffered from fundamental deficiencies resulting in a remittal of the case under Article 11 RPBA, the decision under appeal is to be set aside and the appeal is allowable in this respect. Furthermore, the board considers it equitable that the appeal fee be refunded in view of these deficiencies representing substantial procedural violations and of the fact that the appellant was obliged to file an appeal to ensure that its submissions would be duly considered.
18. Accordingly, the requirements for a full refund of the appeal fee pursuant to Rule 103(1)(a) EPC are met.

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 in full.

The Registrar:

The Chair:



S. Lichtenvort

G. Alt

Decision electronically authenticated