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**Datasheet for the decision
of 6 April 2021**

Case Number: T 1122/17 - 3.3.02

Application Number: 10737870.5

Publication Number: 2456763

IPC: C07D265/30, C07D413/12,
C07D417/12, C07D471/04,
C07D487/04, A61K31/5377,
A61K31/553, A61P25/00, A61P9/00

Language of the proceedings: EN

Title of invention:
OXAZINE DERIVATIVES AND THEIR USE AS BACE INHIBITORS FOR THE
TREATMENT OF NEUROLOGICAL DISORDERS

Patent Proprietor:
Novartis AG

Opponent:
Janssen Pharmaceutica NV

Headword:

Relevant legal provisions:
EPC Art. 113(2)

Keyword:

Agreement to text withdrawn by patent proprietor - appeal
dismissed

Decisions cited:

T 0454/15

Catchword:



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Case Number: T 1122/17 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 6 April 2021

Appellant:
(Patent Proprietor)

Novartis AG
Lichtstrasse 35
4056 Basel (CH)

Representative:

de Weerd, Petrus G.W.
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4002 Basel (CH)

Respondent:
(Opponent)

Janssen Pharmaceutica NV
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Representative:

Cornish, Kristina Victoria Joy
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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 3 March 2017
revoking European patent No. 2456763 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: A. Lenzen
P. de Heij

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the patent proprietor (appellant) against the opposition division's decision (decision under appeal) to revoke European patent No. 2 456 763 (patent in suit).
- II. In its statement of grounds of appeal, the appellant requested, *inter alia*,
- that the decision under appeal be set aside and the patent in suit be maintained as granted (main request), or, in the alternative,
 - that the patent in suit be maintained based on the set of claims of the auxiliary request filed by letter dated 16 December 2016,
 - that oral proceedings be appointed if the main request could not be allowed.
- III. The opponent (respondent) filed a reply to the statement of grounds of appeal and requested, *inter alia*,
- that the appeal be held inadmissible,
 - that costs be awarded due to the procedural complications arising from the appellant's decision to late-file new evidence,
 - that the appeal, should it be held admissible, be dismissed,
 - that oral proceedings be appointed.
- IV. In preparation for the oral proceedings, which were arranged in accordance with the parties' requests, the board issued a communication pursuant to Article 15(1) RPBA 2020.

V. In its letter of 19 January 2021, the appellant declared the following:

"We no longer approve the text in which the patent was granted and withdraw (i) all of our existing requests and (ii) our approval of the text on which the patent was granted. We will not be filing any replacement text, and understand that the consequence of these actions is that the patent will be revoked, in line with long-standing case law (e.g. as summarised in T1288/18, going back to T73/84).

We will therefore not be attending the oral proceedings scheduled for 4 March 2021 on the assumption that, in view of the foregoing, these will not take place."

VI. In its letter of 24 February 2021, the respondent clarified that it was requesting oral proceedings only in the event that the patent was not revoked.

VII. Subsequently, the oral proceedings were cancelled.

Reasons for the Decision

1. The respondent requested that the appeal be held inadmissible. In its communication pursuant to Article 15(1) RPBA 2020, the board had expressed its preliminary view according to which the appeal was admissible. The reason for this was that, unlike the respondent, the board was of the opinion that the appellant in its statement of grounds of appeal had sufficiently addressed the decision under appeal and discussed why the decision was allegedly wrong. This

view was not challenged by the respondent in the further course of the appeal proceedings. The board therefore sees no reason to deviate from its preliminary opinion. In addition, the appeal also meets the other requirements of Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

2. In the introductory part of its reply to the statement of grounds of appeal (page 1, point 1.0), the respondent requested that costs be awarded due to the procedural complications arising from the appellant's decision to late-file new evidence. With regard to this introductory request, the respondent further stated in the course of its reply (point 4.7):

"In the event that the Board of Appeal decides to admit the new evidence, and remits the case to the Opposition Division for consideration of that evidence, I request an apportionment of costs in the Respondent's favour. In this case, the Respondent's time and resource in preparation for and attendance at the oral proceedings before the Opposition Division has been wasted, as has his time and resource in preparing his answer to the Appellant's Grounds of Appeal."

Based on this passage, the respondent's request for apportionment of costs (point III above) is a conditional request that applies only in the event that the new evidence is admitted and the case is remitted to the opposition division. In view of the present decision to dismiss the appeal (see below), this request does not apply and no decision on this conditional request is needed.

3. Pursuant to Article 113(2) EPC, the European Patent Office is to examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent.

The appellant no longer approves the text in which the patent was granted, has withdrawn all of its pending requests and has indicated that it will not be filing any replacement text.

It is established case law that in these circumstances, the proceedings are to be terminated by a decision ordering revocation of the patent without substantive examination as to patentability (see decision T 73/84 and similar decisions referred to in Case Law of the Boards of Appeal of the EPO, 9th edition 2019, III.B.3.3). In the present case, since the patent had already been revoked by the opposition division and, as correctly pointed out in decision T 454/15, cannot be revoked again, the effect of the appellant's declaration filed with the letter of 19 January 2021 is that the appeal has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated