

Internal distribution code:

- (A) [-] Publication in OJ
- (B) [-] To Chairmen and Members
- (C) [-] To Chairmen
- (D) [X] No distribution

**Datasheet for the decision
of 16 November 2020**

Case Number: T 1642/17 - 3.3.04

Application Number: 12713656.2

Publication Number: 2691418

IPC: C07K16/28

Language of the proceedings: EN

Title of invention:

Bispecific anti-CXCR7 immunoglobulin single variable domains

Applicant:

Ablynx N.V.

Headword:

Anti-CXCR7 Ig variable domains/ABLYNX

Relevant legal provisions:

EPC Art. 84

Keyword:

Claims - clarity - main request (yes)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1642/17 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 16 November 2020

Appellant: Ablynx N.V.
(Applicant) Technologiepark 21
9052 Ghent-Zwijnaarde (BE)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 March 2017
refusing European patent application No.
12713656.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairwoman G. Alt
Members: A. Chakravarty
L. Bühler

Summary of Facts and Submissions

- I. The applicant (appellant) filed an appeal against the decision of the examining division to refuse the European patent application No. 12 713 656.2.
- II. In the decision under appeal, the examining division held that the application did not meet with the requirements of Article 84 EPC.
- III. In the statement of grounds of appeal, the appellant provided arguments as to why they considered that the application met the requirements of Article 84 EPC and also submitted amended pages 7, 19, 29, 32, 52 and 58 of the description.
- IV. The arguments of the appellant can be summarised as follows:

The refusal was solely based on an alleged lack of clarity due to the fact that certain passages in the specification, including parts of the "definitions" section, relied on cross-references to one or several prior art documents. This, in the examining division's view, resulted in a lack of clarity. The lack of clarity was said to stem from the fact that certain passages from the cross referenced document WO 08/020079 were not explicitly incorporated into the description, in the sense that the cross-referenced text was not copied into the specification. However, the examining division gave no reasons as to why any particular feature of the claims was unclear.

In the examining division's view, the terms "nucleic acid" and "comprise" used in the claims, while not

unclear *per se*, became unclear when read in conjunction with the description because the definition of these terms in the cross-referenced document. However, this reading of the claims was incorrect because the cross-referencing of a document in the specification did not lead to the claims lacking clarity. The refusal was therefore without any concrete substantiation of the alleged breach of Article 84 EPC, and for this reason alone was legally flawed.

The objection by the examining division was not based on general principles of claim interpretation either because the claims were clear in themselves. The description could not be used to redefine the meaning of established terms such as "nucleic acid", "comprising" or an amino acid sequence defined by reference to a SEQ ID NO. This was reflected in the case law of the Boards of Appeal.

- V. The board issued a communication in which it informed the appellant that it considered the appeal allowable, but that it could not accede to the appellant's request to order the grant of a patent. However, it informed the appellant that it was in a position to set the decision under appeal aside and to remit the case to the examining division for further prosecution.

- VI. In reply to this communication the appellant requested, as a main request, that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of the claims currently on file, i.e. the set of claims attached to the minutes of oral proceedings before the examining division, as a main request, the adapted specification also attached to these minutes, together

with the amended pages of the specification as enclosed with the statement of grounds of appeal.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

Main request

Article 84 EPC - Clarity

2. The sole reason for refusal was that the application did not meet the requirements of the Article 84 EPC. In particular, the examining division held that *"in analogy to "incorporated by reference" (GL F-III-8) the definitions [in the cross-referenced document] are essential to determine the boundaries of the claims and must be introduced in the description, which should be self-contained, i.e. capable of being understood without reference to any other document. Based on said objections the Examining Division considers that the application does not comply with the requirements of Art 84 EPC"*.

The examining division referred to *"established case-law (c.f. Case Law of the Boards of Appeal of the European Patent Office; 8th Edt., 2016; p292, §3) that a patent document may be its own dictionary"* and therefore *"specific definitions of subject matter have to be considered an essential part of the application and fully provided in the description itself and not by reference to one (or more) other documents"* (see decision under appeal, point 3.3).

3. The board understands the examining division's objection to be that the claims lack clarity when read and interpreted in the light of the description.

However, it is established case law that in cases where the claims and the terms used in them are clear when read on their own, for instance because they have a well established meaning in the art, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description. (see decisions T 2221/10 and T 197/10, as well as Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, II.A 6.3.1). As set out in the latter decision, "*in the event of a discrepancy between the claims and the description, the unambiguous claim wording must be interpreted as it would be understood by the person skilled in the art without the help of the description*".

4. In the present case, the examining division was of the view that the terms used in the claims had a "*generally accepted meaning*" to the skilled person (see decision under appeal, point 3.3). The board agrees. In view of this and of the above cited case law, the board must conclude that the claims meet the requirements of Article 84 EPC for clarity.
5. It follows from this that the presence of a cross-reference in the description containing a definition of these terms, should not be treated differently to a case where the description itself contains such a definition. In neither of these cases would the effect of the definition of terms which already have a well established meaning in the art have a negative effect on the clarity of the claims. Indeed, neither the

description nor a cross-reference can change a generally accepted meaning of terms in a claim. It is also noted that the parallel drawn by the examining division to the case where the description has to be adapted to ensure compliance with Article 83 EPC (as set out in the Guidelines for Examination, F-III-8) is incorrect, because Article 84 EPC refers to the claims, whereas Article 83 EPC refers to the disclosure of the patent application. Instead, to ensure that the application complies with the requirement of Article 84 EPC that the claims are supported by the description, the examining division could request that the description be adapted to be in line with the claims (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, II.A 5.3).

Remittal to the examining division - Article 111(1) EPC

6. Although it expressed an opinion, the examining division did not take a decision on any other requirement for patentability with respect to the set of claims of the main request.
7. Accordingly, in line with the appellant's request, the board has decided to remit the case to the examining division for further prosecution.

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 on the basis of the set of claims of the main request, i.e. the set of claims attached to

the minutes of oral proceedings before the examining division.

The Registrar:

The Chair:



I. Aperribay

G. Alt

Decision electronically authenticated