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**Datasheet for the decision  
of 21 January 2021**

**Case Number:** T 1976/18 - 3.5.05

**Application Number:** 11784180.9

**Publication Number:** 2572003

**IPC:** G06F19/18, G06F19/22, C12Q1/68

**Language of the proceedings:** EN

**Title of invention:**  
METHODS FOR NON-INVASIVE PRENATAL PLOIDY CALLING

**Applicant:**  
Natera, Inc.

**Headword:**  
Substantial procedural violation/NATERA

**Relevant legal provisions:**  
EPC Art. 113(2)  
EPC R. 103(1) (a)  
RPBA 2020 Art. 11

**Keyword:**

Basis of decision - text submitted or agreed by applicant (no)  
- substantial procedural violation (yes)

Remittal - fundamental deficiency in examination proceedings  
(yes)

Reimbursement of appeal fee - equitable by reason of a  
substantial procedural violation (yes)



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Case Number: T 1976/18 - 3.5.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.05**  
**of 21 January 2021**

**Appellant:** Natera, Inc.  
(Applicant) 201 Industrial Road  
Suite 410  
San Carlos, CA 94070 (US)

**Representative:** Gibbs, Richard  
Marks & Clerk LLP  
Aurora  
120 Bothwell Street  
Glasgow G2 7JS (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 14 February  
2018 refusing European patent application No.  
11784180.9 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chair** A. Ritzka  
**Members:** E. Konak  
D. Prietzel-Funk

## **Summary of Facts and Submissions**

- I. The appeal is against the decision of the examining division to refuse the patent application on the grounds that a request deemed to be the main request did not meet the requirements of the EPC. A request deemed to be the auxiliary request was not admitted into the examination proceedings.
- II. The appellant requested that the decision be set aside and a patent be granted on the basis of a main request or of one of three auxiliary requests filed with the statement setting out the grounds of appeal, or alternatively that the case be remitted to the examining division for further prosecution of one of these requests. It further requested oral proceedings as an auxiliary measure.
- III. In its preliminary opinion issued in preparation for the oral proceedings, the board identified fundamental deficiencies amounting to a substantial procedural violation in the examination proceedings. It informed the appellant of its intention to remit the case to the examining division and to order reimbursement of the appeal fee in full.
- IV. In response to the summons to oral proceedings, the appellant informed the board that it agreed with the board's findings, and withdrew its request for oral proceedings. The scheduled oral proceedings were therefore cancelled.
- V. The wording of the claims of the requests on file is not relevant to this decision.

## Reasons for the Decision

1. The contested decision states on page 4, first and second paragraphs that the claims filed by the appellant on 9 November 2017 (before the oral proceedings scheduled for 15 November 2017, which took place *in absentia*) were indicated to be "further submissions", and therefore it was not clear whether they were intended to replace the claims then on file (filed previously on 9 October 2017). In view of its perception that the status of this request was not clear, and in view of the consideration that the decision to admit a newly filed request might require a discussion of the objections raised against previous requests, the examining division deemed the claims then on file to be the main request and the newly-filed claims (filed on 9 November 2017) to be the auxiliary request.
  
2. The appellant's letter dated 8 November 2017, received at the EPO on 9 November 2017, unambiguously states on page 1, third paragraph, second sentence that amended claims were enclosed "to replace those currently on file". The replacement of the claims currently on file with amended claims in legal terms leads to the withdrawal of the previous main request. This is a direct result of the fundamental procedural principle of party disposition (*ne ultra petita*), guaranteed by Article 113(2) EPC. Freedom of disposition is cardinal, and to disregard it adversely affects the entire proceedings. Basing a decision on a withdrawn request, as in the present case, constitutes a violation of this principle and hence a substantial procedural violation.

3. Since a substantial procedural violation is a fundamental deficiency in the examination proceedings, the decision under appeal must be set aside and the case remitted to the examining division for further prosecution (Article 11 RPBA).
  
4. In view of the substantial procedural violation in the examination proceedings, reimbursement of the appeal fee in full is equitable (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 in full.

The Registrar:

The Chair:



A. Chavinier-Tomsic

A. Ritzka

Decision electronically authenticated