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**Datasheet for the decision
of 20 July 2020**

Case Number: T 2312/18 - 3.3.02

Application Number: 07774640.2

Publication Number: 2004646

IPC: C07D471/10, A61K31/438,
A61P1/08

Language of the proceedings: EN

Title of invention:

HYDROCHLORIDE SALT OF 8-[[1-(3,5-BIS-(TRIFLUOROMETHYL) PHENYL)
-ETHOXY]-METHYL]-8-PHENYL-1,7-DIAZA-SPIRO[4.5]DECAN-2-ONE AND
PREPARATION PROCESS THEREFOR

Patent Proprietor:

OPKO Health, Inc.

Opponent:

Teva Pharmaceutical Industries Ltd

Headword:

Relevant legal provisions:

EPC Art. 101, 113(2)

Keyword:

Basis of decision - text or agreement to text withdrawn by
patent proprietor - patent revoked

Decisions cited:

T 0073/84, T 0655/11, T 0220/12, T 0381/12, T 2680/17

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
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Case Number: T 2312/18 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 20 July 2020

Appellant: Teva Pharmaceutical Industries Ltd
(Opponent) 5 Basel Street
P.O. Box 3190
49131 Petah Tiqva (IL)

Representative: D Young & Co LLP
120 Holborn
London EC1N 2DY (GB)

Respondent: OPKO Health, Inc.
(Patent Proprietor) 4400 Biscayne Blvd.
Miami, FL 33137 (US)

Representative: Mathys & Squire
The Shard
32 London Bridge Street
London SE1 9SG (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 13 July 2018
rejecting the opposition filed against European
patent No. 2004646 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
L. Bühler

Summary of Facts and Submissions

- I. The opposition division with its decision found that European Patent 2 004 646 as granted met the requirements of the European Patent Convention, and rejected the opposition.
- II. The opponent (appellant) filed an appeal against this decision, requesting revocation of the patent in its entirety.
- III. In response to a communication of the board requesting clarification, the respondent (patent proprietor), with the letter of 3 June 2020, stated that it no longer approved of the text in which the patent was granted. Auxiliary requests 1, 2 and 3 were withdrawn. The respondent furthermore stated that it understood the effect of those actions would be the revocation of the patent.

Reasons for the Decision

1. Under Article 113(2) EPC, the European Patent Office shall consider and decide upon the European patent only in the text submitted to it, or agreed, by the proprietor of the patent. This principle must also be observed in opposition and opposition appeal proceedings.
2. The respondent, by withdrawing approval of the text of the granted patent, indicating that it would not be submitting an amended text, and expecting the patent to be revoked, has thereby withdrawn its approval of any text for maintenance of the patent. Since the text of the patent is at the disposition of the patent

proprietor, a patent cannot be maintained against the patent proprietor's will. There is therefore no text on the basis of which the board can maintain the patent.

3. In view of the above, the board concludes that the patent must be revoked as envisaged in Article 101 EPC and as expected by the respondent. This conclusion is also in line with established case law following decision T 73/84, OJ 1985, 241 (see e.g. T 655/11 of 11 November 2005; T 220/12 of 22 June 2015; T 381/12 of 3 January 2018; T 2680/17 of 2 April 2019).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated