

Internal distribution code:

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

**Datasheet for the decision
of 9 January 2024**

Case Number: T 0325/19 - 3.3.08

Application Number: 02795539.2

Publication Number: 1453547

IPC: A61K48/00, C12N5/10, C12N7/01,
C12N7/04, C12N15/63, C12N15/64,
C12N15/864, C07H21/04,
C07K14/015, C07K7/04, C07K7/06,
C07K7/08

Language of the proceedings: EN

Title of invention:

Adeno-Associated Virus (AAV) serotype 8 sequences, vectors
containing same, and uses therefor

Patent Proprietor:

The Trustees of The University of Pennsylvania

Opponent:

Vossius & Partner
Patentanwälte Rechtsanwälte mbB

Headword:

Adeno-Associated Virus (AAV) serotype 8/THE TRUSTEES OF THE
UNIVERSITY OF PENNSYLVANIA

Relevant legal provisions:

EPC Art. 113(2)

Keyword:

Basis of decision - text or agreement to text withdrawn by patent proprietor

Decisions cited:

T 0073/84, T 0186/84, T 0646/08, T 2434/18

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 0325/19 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 9 January 2024

Appellant: The Trustees of The University of Pennsylvania
(Patent Proprietor) 3160 Chestnut Street, Suite 200
Philadelphia, PA 19104-6283 (US)

Representative: Pohlman, Sandra M.
df-mp Dörries Frank-Molnia & Pohlman
Patentanwälte Rechtsanwälte PartG mbB
Theatinerstrasse 16
80333 München (DE)

Appellant: Meier, Jürgen
(Opponent) Vossius & Partner
Patentanwälte Rechtsanwälte mbB
Siebertstrasse 3
81675 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
30 November 2018 concerning maintenance of the
European Patent No. 1453547 in amended form**

Composition of the Board:

Chairwoman T. Sommerfeld
Members: M. Montrone
L. Bühler

Summary of Facts and Submissions

- I. Both parties to the proceedings (the patent proprietor and the opponent) lodged an appeal against the interlocutory decision of an opposition division according to which European patent No. 1 453 547 ("the patent") could be maintained in amended form.
- II. With their statement of grounds of appeal, appellant I (patent proprietor) submitted *inter alia* a main request and 29 auxiliary requests (auxiliary requests 1, 1A, and 2 to 28) and requested *inter alia* that the patent be maintained on the basis of the main request, or in the alternative on the basis of auxiliary requests 1, 1A or 2 to 28.
- III. With their statement of grounds of appeal, appellant II (opponent) requested *inter alia* that the decision under appeal be set aside and the patent be revoked.
- IV. The board appointed oral proceedings and, in a subsequent communication pursuant to Article 15(1) RPBA 2020, provided its preliminary appreciation of some matters concerning the appeal.
- V. In their letters dated 11 December 2023 and 14 December 2023, appellant I declared that they no longer approved the text of the patent as granted, and that they withdrew all auxiliary requests on file.

Reasons for the Decision

1. Pursuant to the principle of party disposition established by Article 113(2) EPC, the EPO shall examine, and decide upon, the European patent only in the text submitted to it, or agreed, by the proprietor of the patent.

2. In the present case, the patent proprietor no longer approves of the text in which the patent was granted. Furthermore, it has withdrawn all its pending requests (see letters dated 11 and 14 December 2023). There is thus no approved text on the basis of which the board could consider the appeals of the opponent and examine whether a ground for opposition prejudices the maintenance of the patent. It is also no longer possible to take a decision as to substance because the absence of an approved text precludes any substantive examination of the alleged impediments to patentability (T 186/84, OJ 1986, 79, point 5 of the Reasons; T 646/08, point 4 of the Reasons and T 2434/18, point 4 of the Reasons).

3. According to the case law of the boards of appeal, in these circumstances the proceedings are to be terminated by a decision ordering revocation of the patent under Article 101 EPC without assessing issues relating to patentability since the patent proprietor no longer challenges the request for revocation of the opposed patent, and the patent cannot be maintained against the proprietor's will (see decision T 73/84, OJ EPO 1985, 241, and Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022, III.B. 3.3).

4. There are no remaining issues that need to be dealt with by the board in the present appeal case.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The Registrar:

The Chairwoman:



L. Malécot-Grob

T. Sommerfeld

Decision electronically authenticated