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**Datasheet for the decision
of 9 March 2023**

Case Number: T 1846/20 - 3.3.02

Application Number: 15810067.7

Publication Number: 3159341

IPC: C07D471/04, A61K31/519,
A61P35/00

Language of the proceedings: EN

Title of invention:

PYRIDINO[1,2-A]PYRIMIDONE ANALOGUE USED AS PI3K INHIBITOR

Applicant:

Chia Tai Tianqing Pharmaceutical Group Co., Ltd.

Headword:

Relevant legal provisions:

Keyword:

Decisions cited:

G 0001/10, T 0014/89, J 0013/90, T 1003/19

Catchword:



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Case Number: T 1846/20 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 9 March 2023

Appellant: Chia Tai Tianqing Pharmaceutical Group Co., Ltd.
(Patent Proprietor) No. 369 Yuzhou South Road
Haizhou District
Lianyungang, Jiangsu 222062 (CN)

Representative: Brand Murray Fuller LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 16 July 2020
refusing the request for re-issuance of the B
specification of European Patent EP 3 159 341
and the request for re-establishment of rights.**

Composition of the Board:

Chairman M. O. Müller
Members: M. Maremonti
L. Bühler

Summary of Facts and Submissions

- I. The appeal lodged by the patent proprietor ("appellant") lies from the decision of the examining division refusing the request for the re-issue of the B-specification of European Patent No. 3 159 341 ("the patent") and the request for re-establishment of rights.
- II. The examining division came to the conclusion that the request for re-issue of the B specification of the patent to include sheets 1/3 to 3/3 of the drawings as filed on 4 November 2019 and the request for re-establishment of rights had to be refused.
- III. In its statement of grounds of appeal, the appellant contested the reasoning of the examining division and submitted arguments in favour of the issue of a corrected version of the B-specification of the patent.
- IV. The appellant was summoned to oral proceedings as per its request. In preparation for the oral proceedings, the board issued a communication under Article 15(1) RPBA 2020 in which it expressed, *inter alia*, the preliminary opinion that the request for re-issue of the B-specification of the patent and the request for re-establishment of rights should be refused.
- V. Oral proceedings before the board were held on 9 March 2023 by videoconference in the presence of the appellant.
- VI. Final requests

The appellant requested that the appealed decision be set aside and that the B-specification of the patent be

re-issued by including sheets 1/3 to 3/3 of the drawings as filed on 4 November 2019.

VII. The appellant's submissions relevant to the present decision are summarised as follows. For further details, reference is made to the reasons for the decision.

- As regards the appellant's failure to file a translation of the text matter in the drawings upon entry into the European phase (as required by Article 153(4) and Rule 159(1) (a) EPC), the appellant argued that this omission should have been noted by the EPO.
- The EPO should have issued a communication inviting the applicant to file the missing translation of any text matter in the drawings (under Rule 49.5(e) PCT) immediately after receipt of the translation of the description and the claims or, based on the principle of legitimate expectation (T 14/89), at a later time.
- The omission by the EPO deprived the appellant of an opportunity to rectify its error. As the appellant should not be penalised for the EPO's failure to issue an invitation to file a translation of the text matter in the drawings which *de facto* resulted in a loss of these drawings, the appellant should be able to file a request for re-establishment of rights.
- The request for re-establishment of rights in relation to the drawings met all the requirements of Article 122(1) EPC and should thus be allowed.
- There was no legal basis for the EPO to remove the drawings from the application and patent even without a translation of the text matter in the

drawings. Therefore, it could not have been the real intention of the examining division to grant a patent without drawings. The situation was thus the same as in T 1003/19.

- The issue of a corrected B-specification of the patent including the drawings of the published international application was thus justified in view of decisions T 1003/19 and J 13/90 and would not contravene the principles laid down in decision G 1/10 of the Enlarged Board of Appeal.

Reasons for the Decision

The examination proceedings

1. The application for the patent was filed on 16 June 2016 in Chinese as an international application under the PCT with application number PCT/CN2015/081518. The application was published on 23 December 2015 with number WO 2015/192760 and included sheets 1/3 to 3/3 of drawings. These drawings contained text in Chinese.
 - 1.1 The application entered the European phase before the EPO on 23 December 2016. In Form 1200P, the applicant checked, *inter alia*, box 6.1 specifying that the proceedings before the EPO were to be based on the application documents published by the International Bureau with all claims, description and drawings.
 - 1.2 In Form 1200P, the applicant also checked two boxes under "7. *Translations*", specifying that the translations of the international application documents, i.e. abstract, description, claims and any text in the drawings, in one of the official languages of the EPO were attached. Despite this, however, only translations of the abstract, description and claims were attached. No translation of text matter of the

drawings was filed, be it in the form of a copy of the original drawings with the translation pasted on the original text matter or in the form of a drawing executed anew (as required by Article 153(4) EPC together with Rule 159(1) (a) EPC and Rule 49.5(a) and (d) PCT).

- 1.3 By letter dated 19 July 2017, the applicant filed an amended set of claims in reply to a communication from the EPO under Rules 161(2) and 162 EPC.
- 1.4 By communication dated 18 April 2018, the EPO sent the extended European search report to the applicant, which contained, *inter alia*, the European search opinion. The latter (page 1) specified that the examination had been carried out "**on the following application documents**
- Description pages**
- 1-94 filed with entry in the regional phase before the EPO*
- Claims, Numbers**
- 1-15 filed in electronic form on 19-07-2017"*
- No drawings were mentioned.
- 1.5 On 7 May 2018, the EPO issued a communication under Rules 70(2) and 70a(2) EPC, inviting the applicant to indicate within six months of notification of the communication whether it wished to proceed further with the application. The applicant was invited, *inter alia*, "**to file any amendments to the description, claims **and drawings** correcting any deficiencies noted in the [European search] opinion"** (emphasis and text in square brackets added by the board).
- 1.6 By letter dated 5 October 2018, the applicant replied to this communication confirming its wish to proceed with the application. With this letter, the applicant

filed an amended set of claims 1 to 15 to replace claims 1 to 15 previously filed and pages 1 to 91 of the description to replace pages 1 to 94 previously filed. No drawings were filed. The applicant requested the issue of a communication under Rule 71(3) EPC.

- 1.7 On 5 April 2019, the examining division issued a communication under Rule 71(3) EPC notifying the applicant about its intention to grant a European patent on the basis of the following documents:

"Description pages

1-91 filed in electronic form on 05-10-2018

Claims, Numbers

1-15 filed in electronic form on 05-10-2018"

with amendments to page 1 of the description as proposed by the examining division. No drawings were mentioned. The text intended for grant, i.e. the *Druckexemplar*, not containing any sheet of drawings, was attached to the communication.

- 1.8 By letter dated 10 July 2019, the applicant replied to the above communication under Rule 71(3) EPC, by stating *expressis verbis* that the text proposed for grant was approved. Translations of the claims into French and German were also filed. The fee for grant was paid.

- 1.9 On 25 July 2019, the examining division issued the decision to grant a European patent with the documents indicated in its communication under Rule 71(3) EPC (see above). It stated that the decision would take effect on the date on which the European Patent Bulletin mentioned the grant. This occurred in European Patent Bulletin 19/34 of 21 August 2019.

- 1.10 No appeal against this decision to grant was filed.

The post-grant proceedings

2. By letter dated 4 November 2019, the applicant stated that the applicant's name in the B-specification of the patent was incorrect. Moreover, it noted that the B-specification of the patent did not include the drawings present in the PCT application. It requested re-issue of the B-specification of the patent, including the correct applicant's name and the drawings filed with this letter. Drawings sheets 1/3 to 3/3 corresponding to sheets 1/3 to 3/3 as published under the PCT (see above) with Chinese text matter translated into English were enclosed.
 - 2.1 By communication dated 20 November 2019, the applicant was informed that the applicant's name had been corrected as requested.
 - 2.2 By communication dated 25 November 2019, the examining division stated that the applicant's request to correct the patent was not admissible. Reference was made to decision G 1/10.
 - 2.3 By letter dated 3 December 2019, the applicant reiterated its request for re-issue of the B-specification of the patent, including sheets 1/3 to 3/3 of drawings as filed with the letter dated 4 November 2019.
 - 2.4 By letter dated 26 December 2019, the applicant requested re-establishment of rights under Article 122(1) EPC for the time limit for filing a translation of the text matter in the drawings of the PCT application or for the time limit for further processing.
 - 2.5 By communication dated 7 April 2020, the examining division expressed its provisional opinion that neither the applicant's request for re-issue of the B-

specification of the patent, including sheets 1/3 to 3/3 of drawings as filed by letter dated 4 November 2019, nor its request for re-establishment of rights under Article 122(1) EPC were allowable.

2.6 By letter dated 27 May 2020, the applicant replied to the above communication and maintained its requests.

2.7 On 16 July 2020, the examining division issued the decision refusing the applicant's requests. This decision is the subject of this appeal.

Appellant's arguments in appeal

3. The appellant based its request on two main lines of argument. First, it submitted that its right to the inclusion of sheets 1/3 to 3/3 of the drawings as filed on 4 November 2019 should be re-established under Article 122(1) EPC. Second, it argued that this inclusion of the drawings in the B-specification of the patent should be allowed in line with decisions T 1003/19 and J 13/90 and would not contravene the principles laid down in decision G 1/10 of the Enlarged Board of Appeal (Official Journal of the European Patent Office, 2013, page 194).

These two lines of arguments are dealt with in turn below.

Re-establishment of rights under Article 122(1) EPC

4. The appellant referred to Form 1200P mentioned above. It argued that by entry into the European phase, the filing of the drawings in the original application with the Chinese text translated into English had been omitted by mistake. However, in view of the boxes ticked in Form 1200P (see above), the intention of the applicant to include these drawings was clear.

- 4.1 In the appellant's view, according to the Guidelines, E-IX, 2.1.3, the EPO should have invited the applicant under Rule 49.5(e) PCT upon entry into the regional phase to furnish the translation of the text matter in the drawings within a two-month time limit. This invitation was not merely a matter of seeking clarification on a discrepancy in Form 1200P as suggested by the examining division. The EPO was under a legal obligation to inform the applicant of the missing translation of the text matter in the drawings and to afford the applicant an opportunity to rectify the omission of the translation. Any perceived discrepancy in Form 1200P in view of the missing drawings heightened the need to issue such a communication. However, the EPO failed to issue this invitation upon entry into the regional phase. Based on the principle of legitimate expectation and in line with decision T 14/89, the EPO was nevertheless under the obligation to subsequently issue this invitation and set a new time limit. It was inequitable for the EPO to proceed with examination without the drawings without informing the applicant.
- 4.2 As a result of the failure by the EPO to meet its obligation, the applicant was denied an opportunity to rectify the omission of the translation. Moreover, the fact that the EPO proceeded and examined the application without the drawings resulted, in the appellant's opinion, in the loss of rights in these drawings.
- 4.3 Furthermore, according to the appellant, since the above time limit of two months had not been set, this was equivalent to an open-ended time limit. The applicant did not meet it, this having a direct consequence of causing a loss of rights. The request for re-establishment of rights in relation to the

translation of text matter in the original drawings met the requirements of Article 122(1) EPC in that the failure to meet the deadline to file the translation of the drawings was despite all due care being taken.

4.4 The appellant further argued that the request for re-establishment of rights could equally be construed to apply to the time limit for responding to the communication under Rule 71(3) EPC and requesting the inclusion of the missing drawings. The failure to observe this time limit had the direct consequence of a loss of rights. But this failure was despite all due care being taken and in large part due to the fact that the EPO had not informed the applicant that it had unilaterally decided to remove the drawings. Also in this case, the request for re-establishment of rights in relation to the drawings met the requirements of Article 122(1) EPC.

4.5 Thus, it was equitable that the request for re-establishment be granted and the drawings be included in a new B-specification of the patent.

5. The board finds these arguments unconvincing for the following reasons.

5.1 The Guidelines for examination in the EPO, in section E-IX, 2.1.3 referred to by the appellant, state that "*[i]f the applicant does not furnish the translation of [any text matter in the drawings except for the expression 'Fig.' (as originally filed)] within the 31-month period, the EPO will invite him to furnish the translation within a two-month period from notification of the respective communication under Rule 159(1) (a)*" (text in square brackets added by the board).

5.2 As the drawings in the published international application had not been filed upon entry in the European phase, it can be accepted that the EPO should

have invited the applicant to file the missing drawings with a translated text, in accordance with Rule 159(1) (a) EPC and Rule 49.5(e) PCT. However, in the absence of such an invitation by the EPO, no time limit was set. Thus, the appellant did not fail to comply with a time limit under the provisions of Rule 159(1) (a) EPC and Rule 49.5(e) PCT.

5.3 Had a time limit been set by the issue of a communication pursuant to Rule 159(1) (a) EPC and Rule 49.5(e) PCT, the non-observance of this time limit would have had as a consequence that the whole application would have been deemed to be withdrawn (Rule 160(1) EPC). Instead, contrary to the appellant's view, the omission of the EPO in issuing such a communication did not result in any loss of rights of the appellant as regards the drawings. In fact, even accepting that the examining division erred in basing the examination only on the description and the claims without considering the drawings of the application as filed, the appellant could have filed these drawings at any time during the examination proceedings. The appellant had several opportunities to do so, for example, after receiving the European search opinion accompanying the extended European search report (see above), from which it was evident that the application documents forming the base of the examination did not contain any drawings.

5.4 Also, the appellant, upon replying to the communication under Rules 70(2) and 70a(2) EPC, which invited the applicant "*to file any amendments to the description, claims **and drawings***", could have filed the drawings. Instead, the appellant requested the issue of a communication under Rule 71(3) EPC (see above).

- 5.5 Most importantly, a further opportunity was given to the appellant when the communication under Rule 71(3) EPC was issued, accompanied by the text intended for grant. At least upon receiving this communication, the appellant should have noted that the text intended for grant did not contain any drawings. Instead, the appellant explicitly approved the text proposed for grant.
- 5.6 For these reasons, the appellant did not lose any rights by the EPO omitting to send a communication under Rule 159(1)(a) EPC and Rule 49.5(e) PCT. There is also no time limit that was not observed by the appellant. In fact, contrary to the appellant's view, the time limit for responding to the communication under Rule 71(3) EPC was met by the appellant explicitly approving the proposed text.
- 5.7 Article 122(1) EPC is only available for non-observance of a time limit which has the direct consequence of a loss of right or remedy. In the current case, there is no loss of right due to the non-observance of a time limit by the appellant. Therefore, Article 122(1) EPC is not applicable to the case at hand.
- 5.8 Moreover, the board holds that in the current case, Article 122(1) EPC would only have been applicable if examination proceedings were still pending. Since the decision to grant has become final, examination proceedings have terminated and the EPO ceases to have jurisdiction (G 1/10, OJ EPO 2013, 194, point 6 of the reasons). Also for this reason, the examining division is precluded from dealing with a request for re-establishment of rights within the meaning of Article 122(1) EPC for the granted patent even if this request might have retroactive effect. Otherwise, legal certainty in the decision to grant would not be served.

5.9 As a consequence, the board concluded that the appellant's request for the re-establishment of rights has to be refused.

Correction of the B-specification of the patent in view of decisions T 1003/19, J 13/90 and G 1/10

6. The appellant further argued that the issue of a corrected B-specification of the patent including the drawings with translated text would not have any adverse effects on third parties because the drawings were in the published international application and the scope of protection would not be affected. On the contrary, the inclusion of the drawings would increase legal certainty, and no third party would be deprived of the possibility to file an opposition. Therefore, there would be no contravention of the principles laid down in decision G 1/10. Furthermore, the inclusion of the drawings was an obvious correction since it was immediately evident that the drawings in the published international application were missing in the B-specification. Moreover, decision G 1/10 stated under point 8 of the reasons that the absence of the possibility to correct a patent should not prejudice patent proprietors. But in the current case, refusing to include the drawings would prejudice the patent proprietor. Thus, the current case went beyond decision G 1/10 since it was not foreseen that a detriment to patent proprietors could occur by refusing the correction.

6.1 The appellant referred to decision T 1003/19 demonstrating that under certain conditions it was possible to correct a patent after grant while not deviating from G 1/10. As in T 1003/19, in the current case, the *Druckexemplar* sent to the applicant could not be considered the text intended for grant since the drawings should have been included in this text on the

basis of the information provided by the applicant in Form 1200P (see above). Hence, the applicant had not approved the text intended for grant.

6.2 The appellant further referred to decision J 13/90. As in that case, the appellant in the current case could have expected to receive a communication warning it of an impending loss of rights. Since this communication was not issued in due time, the EPO had to set a new period allowing the applicant to remedy the deficiency and perform the omitted procedural act in due time. Thus, it was equitable and in line with the principle of legitimate expectation that the drawings be reintroduced into a re-issued corrected B-specification of the patent.

7. These arguments are also not convincing.

7.1 Decision T 1003/19 invoked by the appellant concerns a case in which an appeal against the decision to grant a European patent had been filed (point I). In contrast, in the current case, the appellant did not file any appeal against the decision to grant. Therefore, the grant decision became final, and the granted patent ceased to be within the jurisdiction of the EPO (G 1/10, OJ EPO 2013, 194, point 6 of the reasons; see below point 7.8).

7.2 Irrespective of this lack of jurisdiction, in T 1003/19 (points 2.1 to 2.4 of the reasons), the entrusted board held that the granted version of the patent corresponded neither to a text submitted by the appellant, nor to a text agreed to by it or deemed to have been approved by it. The entrusted board especially referred to the fact that the single sheet of drawings included in the *Druckexemplar* proposed for grant had never been submitted by the applicant. Moreover, the board observed that even though the

translation of the claims had been filed and the fee for grant paid, the applicant had not *expressis verbis* approved the text proposed for grant. In contrast, in the case at hand, the documents forming the text proposed for grant correspond to the documents filed by the appellant, and the appellant explicitly approved this text (see above).

For these reasons, the *rationale* in T 1003/19 is not applicable to the case at hand.

- 7.3 As stated in decision G 1/10, Rule 140 EPC, stipulating that in decisions of the European Patent Office only linguistic errors, errors of transcription and obvious mistakes may be corrected, is not applicable for correcting patents. The Enlarged Board of Appeal held that patent proprietors "*have adequate remedies available, both before and after grant, to ensure that the text of their patents is correct*" (point 5 of the reasons).
- 7.4 In fact, as expressed in point 9 of the reasons of G 1/10, "*[s]hould an applicant, at any stage up to and including the final approval by him of the text of his patent, make a mistake (or overlook a mistake he has previously made) in a document he has filed [...] then before grant that mistake can be corrected under Rule 139 EPC on request*". As stated above, in the current case, the appellant could have sought the introduction of the drawings at any stage of the examination proceedings, not only possibly under Rule 139 EPC but also by means of an amendment.
- 7.5 Moreover, the Enlarged Board of Appeal (points 10 and 11 of the reasons) observed that "*a patent applicant is obliged to approve the text in which his patent is to be granted*" and "*[i]f, given the opportunity to check the patent text before approving it, an applicant does*

not draw any errors to the attention of the examining division and thus ensure his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division". Since in the case at hand the appellant did not draw the attention of the examining division to the fact that the drawings were missing from the text intended for grant but instead approved the proposed text, the appellant bears the entire responsibility for the omission of the drawings, even if the appellant's argument was correct that the examining division failed to include the drawings (without the translation of the text matter).

7.6 The Enlarged Board of Appeal (point 12 of the reasons) further noted that if the examining division committed an error in the decision to grant "*so that the granted text is not that approved by the proprietor, then the proprietor is adversely affected by that decision and is entitled to appeal*" seeking an "*interlocutory revision and reimbursement of the appeal fee as being equitable in view of the examining division's mistake*". Therefore, even assuming, *arguendo*, that in the current case the text of the patent was not that approved by the appellant in view of the missing drawings, the appellant should have filed an appeal against the decision to grant. However, no appeal was filed.

7.7 Since no errors have occurred in the process of converting the version as intended for grant into the B-specification, the discussion of affecting third parties is irrelevant. When receiving the communication under Rule 71(3) EPC clarifying the examining division's position on the text intended for grant, the appellant should have realised that to safeguard its interests it should request the inclusion of the

drawings. However, the appellant failed to do this and instead approved the proposed text and did not file any appeal. As a consequence, the decision to grant became final (Article 97(1) and (3) EPC).

- 7.8 As stated in point 6 of the reasons of decision G 1/10, "[a]s from its grant, a European patent ceases to be within the jurisdiction of the EPO and becomes, subject only to the possibility of later EPO proceedings by way of opposition or limitation, a bundle of national patents each of which falls **within the exclusive jurisdiction of a designated Contracting State** (see Article 2(2) EPC)" (emphasis added by the board). Therefore, since in the current case the decision to grant has become final, the EPO, except in opposition or limitation proceedings, has no jurisdiction to change the text of the granted patent or deal with the request for correction.
- 7.9 For these reasons, the board concluded that the request for re-issue of the B-specification of the patent by including sheets 1/3 to 3/3 of the drawings as filed on 4 November 2019 is not allowable in view of decision G 1/10.
- 7.10 As regards decision J 13/90, also invoked by the appellant, this decision (point 9 of the reasons) concerned a case in which the EPO, contrary to its obligation to act in accordance with the principle of good faith, failed to draw the applicant's attention to a deficiency (payment of renewal fee) and nevertheless held that a loss of rights had ensued since the deficiency was not corrected in due time. The entrusted board stated (point 6 of the reasons) that in accordance with the principle of good faith, the EPO is obliged to warn an applicant of omissions or errors which lead to a final loss of rights so that the applicant is in a position to correct the deficiency

and avoid the impeding loss of rights. The case underlying J 13/90 is thus different from the current case, in which, as set out above, no loss of rights has been notified by the EPO, and no loss of rights has resulted from the omission of the EPO to send a communication under Rule 159(1) (a) EPC.

As a consequence, the *rationale* in J 13/90 is not applicable to the case at hand.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated