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**Datasheet for the decision
of 6 November 2024**

Case Number: T 1549/22 - 3.3.08

Application Number: 18152360.6

Publication Number: 3401400

IPC: C12N15/11, C12N15/63,
C07K19/00, C12N15/10,
C12N15/90, A61K38/46, A61K48/00

Language of the proceedings: EN

Title of invention:

Methods and compositions for RNA-directed target DNA
modification and for RNA-directed modulation of transcription

Patent Proprietors:

The Regents of the University of California
University of Vienna
Charpentier, Emmanuelle

Opponents:

df-mp Dörries Frank-Molnia & Pohlman
Patentanwälte Rechtsanwälte PartG mbB
Testbiotech e.V.
Greaves Brewster LLP
HGF Limited

Headword:

RNA-directed target DNA modification/UC

Relevant legal provisions:

EPC Art. 104(1), 111(1), 113(2)
RPBA 2020 Art. 16(1)

Keyword:

Basis of decision - text or agreement to text withdrawn by
patent proprietor - patent revoked
Apportionment of costs - (no)
Appellant may withdraw appeal any time unless abuse of
procedure
Same principles apply to withdrawal consent to/approval of text
of patent
Withdrawal of consent four weeks before oral proceedings, one
month from communication with preliminary opinion, and in
light of complexity of case - no abuse of procedure

Decisions cited:

T 0073/84, T 0186/84, T 0490/05, T 0301/12, T 1663/13,
T 1714/14, T 0040/17, T 1310/19, T 1484/19, T 0635/21,
T 1995/21

District Court Munich (Landgericht München) 7 O 2456/20



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1549/22 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 6 November 2024

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Appellant I: University of Vienna
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Appellant I: Charpentier, Emmanuelle
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Appellant III: Testbiotech e.V.
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Appellant IV: Greaves Brewster LLP
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Appellant V: HGF Limited
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Representative: HGF
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
25 April 2022 concerning maintenance of the
European Patent No. 3401400 in amended form**

Composition of the Board:

Chair T. Sommerfeld
Members: A. Schmitt
R. Winkelhofer

Summary of Facts and Submissions

- I. The appeals lodged by the patent proprietors (appellants I) and by opponents 1, 2, 3 and 4 (appellants II, III, IV and V) are against the opposition division's interlocutory decision that European patent No. 3 401 400 (the patent) as amended in the form of auxiliary request 10 and the invention to which it relates meet the requirements of the EPC.
- II. The patent proprietors requested that the decision under appeal be set aside and amended such that the patent be maintained on the basis of the claims of the main request filed with their grounds of appeal or on the basis of the claims of one of the auxiliary requests filed in the appeal proceedings.
- III. Opponents 1, 2, 3 and 4 requested that the decision under appeal be set aside and amended such that the patent be revoked.
- IV. The board issued a summons to oral proceedings scheduled to take place from 16 to 18 October 2024 and, on 16 August 2024, the board issued a communication pursuant to Article 15(1) RPBA.
- V. In a submission dated 20 September 2024, the patent proprietors stated that they no longer approved the text on the basis of which the patent had been granted. They withdrew all requests previously pending in the appeal proceedings, and requested that the patent be revoked.
- VI. The board then cancelled the oral proceedings.

VII. After this, opponents 4, 3 and 1 (in this order) requested a different apportionment of costs, i.e. that the patent proprietors be ordered to bear the expenses the opponents had already incurred in preparation for the oral proceedings.

These requests were justified as follows:

"The Proprietor has requested revocation of the Patent at a very late stage in proceedings, waiting over a month from the issuance of the Preliminary Opinion to notify the Board and the Opponents that they are surrendering the Patent" (opponent 4)

*"We agree [with opponent 4] ... the Patentees waited for over a month after receiving the Preliminary Opinion to surrender the Patent and did so just over three weeks before the Oral Proceedings. The Patentees clearly did this at the last minute to avoid a negative, final decision they did not want from the Board of Appeal even though it would be **based on issues that had been raised in the Notices of Opposition back in 2019** [emphasis in the original] ... Given the importance of the technology and Patent in question, we believed in good faith the Oral Proceedings would go ahead. We also started to prepare for the Oral Proceedings in good faith shortly after the Preliminary Opinion ... However, it seems that this work was in vain, due to the Patentees' actions" (opponent 3)*

"We ... fully endorse the comments made [by opponent 4] ... Thus, it is fairly evident that Proprietor is simply seeking to prevent issuance of a decision on the merits that they do not want" (opponent 1)

VIII. The patent proprietors objected to these requests for a different apportionment of costs, essentially arguing that they were entitled to withdraw consent to the text of the patent at any time, based on the principle of free party disposition.

Reasons for the Decision

1. Pursuant to Article 113(2) EPC the EPO will examine, and decide upon, a European patent only in the text submitted to it, or agreed, by the patent proprietor(s).
2. There is no such agreement if, as in the present case, the patent proprietors expressly withdraw their consent to the text of the patent in the form as granted, and indeed withdraw all of the requests on file (see section V. above).
3. In the present case, there is therefore no approved text on the basis of which the patent could be maintained. In these circumstances, the patent is to be revoked without any further assessment of issues relating to patentability (see, for example, T 73/84 (OJ EPO 1985, 241), T 186/84 (OJ EPO 1986, 79) and T 1995/21, and Case Law of the Boards of Appeal of the European Patent Office, 10th edition, 2022 ("Case Law"), sections III.B.3.3 and IV.D.2).
4. As a further consequence of a withdrawal of consent to the text of the patent, the appeal proceedings are to be terminated.
5. Ancillary issues including requests for a different apportionment of costs - as in the current case - may

nevertheless still be decided upon by the board (see Case Law, V.A.7.3.2, and decisions T 1484/19 of 4 July 2023, with further references, and T 1310/19, for example).

6. Articles 104(1) and 111(1) EPC and Article 16(1) RPBA stipulate that in opposition appeal proceedings a party may be ordered to pay (bear) some or all of the costs (expenses) of another party for reasons of equity, if such costs are caused by culpable or even abusive conduct of the party (see, for example, T 301/12, T 1714/14, T 1484/19 of 4 July 2023, or T 1310/19).
7. As a general rule, as derived from the principle of party disposition, an appellant may withdraw their appeal at any time, without this right being limited by considerations regarding the apportionment of costs (see T 490/05, T 1663/13, T 40/17, T 1484/19 of 4 July 2023, and T 1310/19).
8. The withdrawal of an appeal, even shortly before the oral proceedings, does not *per se* constitute a reason to impose costs on another party in the absence of additional circumstances amounting to an abuse of procedure by the party not acting in good faith (see T 1663/13, T 1714/14, T 40/17, T 1484/19 of 4 July 2023, and T 1310/19).
9. The same principles apply to an applicant or patent proprietor which are not limited in their freedom to withdraw their consent to the text of a patent at any time during the appeal proceedings (see, for example, T 1484/19 of 4 July 2023).
10. Opponents 1, 3 and 4 did not put forward any circumstances which could amount, even *in abstracto*, to

an abuse of procedure on the part of the patent proprietors. The withdrawal of consent some four weeks before the oral proceedings - about one month after the communication setting out the board's preliminary opinion had been issued - is clearly not a sufficient indication of such an abuse of procedure, particularly in light of the complexity of the case, regardless - at least in principle - of the motivation for the withdrawal.

11. Moreover, there are no legitimate expectations that oral proceedings will go ahead as scheduled.
12. Finally, the patent proprietors' conduct outside the remit of the opposition (appeal) proceedings and the possible financial consequences thereof may play a role in court proceedings (see T 635/21, Reasons 6, with reference to decision 7 O 2456/20 of District Court Munich) but not in proceedings before the boards of appeal (see also T 635/21, Reasons 7, first sentence). In this context, when adding that the withdrawal of an appeal as part of a systematic approach to avoid clarifying the issues of patentability by way of a written decision could, in principle, play a role, T 635/21 (Reasons 7, second sentence) is, in this board's opinion, too far-reaching as this would go beyond the competence and means of the boards of appeal.
13. A different apportionment of costs is therefore not justified in the present case.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The requests for a different apportionment of costs are rejected.

The Registrar:

The Chair:



C. Rodríguez Rodríguez

T. Sommerfeld

Decision electronically authenticated