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Aktenzeichen / Case Number / N° du recours : T 182/88 - 3.3.1

Anmeldenummer / Filing No / N° de la demande : 83 303 996.9

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0119342

Bezeichnung der Erfindung: Dimeric oligopeptides as haptenic epitopic sites
Title of invention: for hepatitis
Titre de l'invention :

Klassifikation / Classification / Classement : A 61K 39/385

ENTSCHEIDUNG / DECISION

vom / of / du 3 November 1988

Anmelder / Applicant / Demandeur : The Regents of the University of California

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Oligopeptides

EPO / EPC / CBE Rule 86(3) EPC

Schlagwort / Keyword / Mot clé : "Separate claims for Austria" - "proposed amendment filed after Rule 51(4) communication" - "principles for exercise of discretion under Rule 86(3)".

Leitsatz / Headnote / Sommaire

When a decision hinges upon the exercise of discretion, the reasons should be given (here: amended claims for Austria). Such reasons should take into account those factors which are legally relevant to the issue in question, and should not simply consider whether the facts of the case are exactly the same as in a previously decided case. Such factors are determined by considering the purpose of the exercise of the discretion in its context, and in the context of the EPC as a whole.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : T 182/88 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 3 November 1988

Appellant : The Regents of the University of California
2200 University Avenue
Berkeley, California 94720
USA

Representative : Harrison, David Christopher
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Decision under appeal : Decision of Examining Division 001 of the European
Patent Office dated 16 February 1988 refusing
European patent application No. 83 303 996.9
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : K. Jahn

Members : G.D. Paterson
F. Antony

Summary of Facts and Submissions

- I. European patent application No. 83 303 996.9 was filed on 8 July 1983, and the application designated 8 Contracting States, including Austria. On 1 October 1985, a communication was issued by the Examining Division. In a reply dated 17 January 1986, the Appellant filed amendments to the description and claims to take account of the points raised in the communication, and ended by stating that he awaited the Advance Notice.
- II. An Advance Notice of the communication under Rule 51(4) EPC was issued on 4 March 1986, and a communication under Rule 51(4) EPC was issued on 11 June 1986. By letter dated 21 August 1986 the Appellant filed translations of the claims of the intended text, and stated that the grant and printing fees had been paid.
- III. By letter dated 1 September 1986 the Appellant stated that he withdrew approval of the intended text, the reason being the absence of method claims specifically adapted for Austria. Claims adapted for Austria were enclosed with the letter, and the Appellant requested the indulgence of the Examining Division to allow this amendment of the text for Austria at that stage.
- IV. In a communication dated 27 February 1987, it was stated that the proposed amendment was not allowable under Rule 86(3) EPC, because the communication under Rule 51(4) EPC had already been issued, and there was no sufficient reason given to allow such an amendment at that stage.

In his reply dated 16 April 1987, the Appellant submitted inter alia that the proposed amendment was not one of substance, and merely required examination for conformity

with Article 123(2)EPC; and that perhaps the overriding consideration should be upholding the reputation of the Office for its user-friendly attitude, there being nothing in the EPC prohibiting the grant of the request.

Following further correspondence, in particular concerning the effect of Decision T 166/86, "Separate set of claims", OJ EPO 1987, 372, a Decision was issued by the Examining Division on 16 February 1988, in which the facts of the present case were distinguished from the facts of Decision T 166/86, and on this basis it was held that the same conclusion as in that Decision did not apply. In view of the withdrawal of the approval of the text, the European patent application was rejected in its entirety.

- V. A notice of appeal and a statement of grounds of appeal were filed on 25 February 1988, and the appeal fee duly paid. The Appellant submitted inter alia that the principle set out in Decision T 166/86 should be applied.

Reasons for the Decision

1. The appeal is admissible.
2. Under Rule 86(3) EPC, after the reply to the first communication from the Examining Division (in this case by letter dated 17 January 1986), amendment of a European patent application cannot be made without the consent of the Examining Division and is therefore a matter of discretion for the Examining Division. After issue of the communication under Rule 51(4) EPC and before the Decision to grant the patent has taken effect, amendment is still a matter of discretion for the Examining Division.

3. In any case where the EPC gives discretion to a department of the EPO in relation to an issue in proceedings before it, in accordance with general principles of law such discretion must be exercised having regard to the factors which are relevant to such issue. The factors which are relevant to an issue are in turn determined by considering the purpose of the exercise of the discretion in its context, and in the context of the EPC as whole. In the case of a proposed amendment such as the submission of a separate set of claims for a particular Contracting State, the main factors which are relevant to the issue of the allowability of such amendment at a late stage in the examination procedure (in particular, after issue of the communication under Rule 51(4) EPC) are set out in Decision T 166/86, especially in paragraph 7 of the Reasons. Of course discretion must always be exercised on a case-to-case basis, having regard to the particular circumstances of each case.

In particular, the Board of Appeal in paragraph 7 of Decision T 166/86 referred to "balancing the Office's interest in speedy completion of the proceedings against the Applicant's interest in obtaining a patent which is legally valid in all the Contracting States".

In every particular case of this type involving a request for amendment under Rule 86(3) EPC, the Examining Division clearly has to weigh these factors against one another, as well as considering any other relevant factors, before deciding upon the request.

4. When the EPC has given discretion to a department of the EPO in relation to proceedings at first instance before it, such discretion is normally best exercised by the department at first instance, because that department has control over the proceedings and should be aware of all

the factors which are relevant to the exercise of its discretion. Furthermore, once a department at first instance has exercised its discretion, in any appeal against a Decision involving the exercise of that discretion a Board of Appeal is normally reluctant to interfere with such a Decision, unless the reasoning in the Decision has clearly been based on wrong principles.

5. In the present case, the Decision of the Examining Division by which the requested amendment is refused is based upon reasoning which is entirely concerned merely with distinguishing the facts of the case from the facts which were specifically considered in Decision T 166/86. Having distinguished such facts, the Decision ends by stating that "For these reasons the same conclusion of the Decision T 166/86 does not apply in the present instance".

In the Board's judgement, such reasoning does not provide an adequate basis for deciding upon the exercise of discretion under Rule 86(3) EPC. As pointed out in paragraph 3 above, the principal factors involved in the exercise of such discretion were clearly set out in paragraph 7 of Decision T 166/86, but these factors do not appear to have been considered by the Examining Division in its Decision in the present case at all.

6. It seems to the Board that the Examining Division may have misunderstood its function in the present case. Its function is not merely to consider whether the facts of the case before it are exactly the same as a previous case in which a Board of Appeal has decided in favour of an applicant. Its function is to decide upon the applicant's request having regard to the factors which are relevant, as set out in paragraph 3 above.

In these circumstances, in the Board's judgement this is a proper case in which it should interfere with the Decision of the Examining Division by setting it aside, and in which the Board should then itself decide the question of discretion which has been raised (pursuant to the Board's powers under Article 111(1) EPC).

7. In the present case, as pointed out in the Decision under appeal, if the new set of method claims for Austria is to be allowed it must first be checked that such claims are admissible having regard to Article 123(2) EPC, because there were no method claims present in the application as originally filed. Such further examination is a matter of minutes rather than hours, and would certainly have taken less time than writing the Decision. Thus if the "Office's interest in speedy completion of the proceedings" (this being a facet of the public interest) is balanced against the Appellant's interest in obtaining proper protection for his invention in Austria, in the Board's judgement the balance weighs heavily in favour of the Appellant's interest.

There is nothing in the Decision under appeal to show that this balance had been considered at all.

It is also true, as pointed out in the Decision, that in the present case in contrast to Decision T 166/86, there is nothing else to be considered prior to grant other than the admissibility of the new set of claims under Article 123(2) EPC, but this is a very minor factor compared to the considerations set out above.

It appears from the file of the case that the failure by the Appellant to file a separate set of claims for Austria at an earlier date was a result of human error by or on behalf of the Appellant. However, the fact is that the

error was discovered, and the separate set of claims filed, before the application was granted. It was therefore not too late either for the amendment to be requested, or for the amendment to be allowed. Furthermore no member of the public should be unfairly prejudiced by the allowance of the amendment, since up until grant amendment of an application is clearly envisaged under the EPC as a possibility.

It was submitted by the Appellant that a major consideration in allowing the requested amendment should be to uphold the user-friendly reputation of the EPO. In the Board's judgment, this factor should clearly be excluded from consideration during the exercise of any discretion by the EPO. Discretion must always be exercised judicially, by taking into account those factors which are legally relevant to the issue in question, and by not taking into account those factors which are not legally relevant. The showing of consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to law.

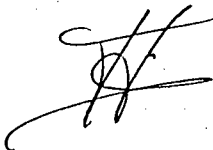
8. When exercising a discretion, whether for or against a particular party, the reasons for the exercise of that discretion should be given. In the present case, the reasons which cause the Board to exercise its discretion in favour of the Appellant are set out in paragraph 7 above, and these reasons are in accordance with the principles discussed and applied in Decision T 166/86.

Order

For these reasons, it is decided that:

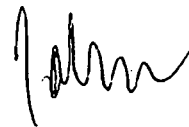
1. The appeal is allowed, and the Decision of the Examining Division dated 16 February 1988 is set aside.
2. The case is remitted to the Examining Division for continuation of examination of the application taking into account the separate set of claims for Austria.

The Registrar:



F. Klein

The Chairman:



K. Jahn



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