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D E C I S I O N
of 10 January 1996

Case Number: T 0690/91 - 3.3.4

Application Number: 82303035.8

Publication Number: 0068691

IPC: C12N 15/00

Language of the proceedings: EN

Title of invention:
A process for the production of a polypeptide

Applicant:
CELLTECH THERAPEUTICS LIMITED

Opponent:
-

Headword:
Chymosin/CELLTECH

Relevant legal provisions:
EPC Art. 54(3)(4), 111(2)

Keyword:
"Ratio decidendi"
"Res judicata"
"Novelty - (no)"

Decisions cited:
T 0269/87; T 0843/91; T 0079/89

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0690/91 - 3.3.4

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 10 January 1996

Appellant: CELLTECH THERAPEUTICS LIMITED
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Representative: Hallybone, Huw George
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted 11 April 1991 refusing European patent application No. 82 303 035.8 pursuant to Article 97(1) EPC.**

Composition of the Board:

Chairman: U. M. Kinkeldey
Members: F. L. Davison-Brunel
J. Saisset

Summary of Facts and Submissions

I. European patent application No. 82 303 035.8 with the title "A process for the production of a polypeptide" was refused a first time by the Examining Division. One of the grounds for refusal was that the claimed invention lacked novelty within the meaning of Article 54(3)(4) EPC in view of European patent application No. 82 201 272.0 (Unilever).

II. The subsequent appeal procedure against the above decision was the subject of decision T 0269/87 of 24 January 1989 (not published in the OJ EPO). In T 0269/87, the Board of Appeal decided that the claimed invention did not enjoy any priority rights because in the priority applications an essential technical step was missing to reduce the invention to practice and, thus, the European patent application did not relate to the same invention as required by Article 87(1) EPC.

The Board found, moreover, that the Unilever European patent application (see supra, section I) could only be considered as a novelty destroying citation if it disclosed the invention in an enabling manner and enjoyed its priority.

Accordingly, the case was remitted to the first instance with the order to investigate the sufficiency of disclosure of the Unilever application before making any decision on novelty.

III. Upon further examination, the Examining Division came to the conclusion that the Unilever European patent and priority applications were enabling documents. Taking into account this finding and the decision of the Board of Appeal about the priority rights of the claimed

invention, the Examining Division refused the application for lack of novelty within the meaning of Article 54(3)(4) EPC, in the light of the disclosure of said Unilever application.

IV. The Appellant lodged an appeal against this decision, paying the appeal fee at the same time. The Statement of Grounds of Appeal was submitted.

V. The set of claims on appeal is the main set of claims filed on 18 October 1990. Claim 1 reads:

"A process for the production of chymosin comprising cleaving methionine-prochymosin produced by a host organism transformed with a vector system carrying a gene coding for methionine-prochymosin."

VI. The Appellant requested that "the Board confirms the claims in the main set of claims are entitled to the earliest claimed priority date and remits the case to the Examining Division, preferably with an order to grant a patent".

VII. A communication was sent by the Board according to Article 11(2) of the Rules of the procedure of the Boards of Appeal setting out the Board's preliminary position before oral proceedings.

VIII. Finally the Appellant withdrew the request for oral proceedings and requested that the Board takes a decision on the basis of the written proceedings.

IX. The submission in writing by the Appellant can be summarized as follows:

- The Examining Division was wrong to consider itself bound by decision T 0269/87 as this decision was not based on the correct facts.

- The correct facts constituted proof that the specification of the earliest priority application was fully sufficient within the terms of Article 83 EPC. Priority could, thus, be acknowledged and the Unilever application be found irrelevant for the assessment of novelty.

- The reasons invoked in T 0269/87 to deny priority were wholly unforeseen and unforeshadowed denying the Appellant the right to be heard (Article 113(1) EPC).

Reasons for the Decision

1. The appeal is admissible.

The legal effect of the decision of the Board of appeal T 0269/87

2. During the proceeding before the Board of appeal leading to decision T 0269/87, the Board came to the conclusion that the first set of claims, allowable under Articles 123(2)(3) and 84 EPC, did not enjoy any priority rights. As a matter of consequence, the Unilever patent application was deemed relevant to the assessment of novelty, providing that its own priority

rights could be acknowledged. The case was, thus, remitted to the first instance to investigate the status of the Unilever application with regard to priority and further advance prosecution.

3. The Board's reasoning regarding the priority rights of the present application played a key role in the decision of remittal. Thus, it constitutes an essential part of the *ratio decidendi* of this decision.

4. According to Article 111(2) EPC, the *ratio decidendi* of a decision may not be departed from by the first instance in a case of a referral to it by the Board of appeal, insofar as the facts are the same. The same is true for a Board of appeal in any subsequent appeal proceedings since, according to Article 111(1) EPC, the Board may exercise the same power as was within the competence of the department which was responsible for the decision appealed.

5. However, the Appellant has argued that the facts presented to the Examining Division and to the present Board of appeal are different from those the decision T 0269/87 was taken upon.

6. This opinion cannot be shared by the Board. The reason why priority rights were denied in T 0269/87 is that the priority documents did not relate to the same invention as the European patent application because essential elements were missing. The priority documents have, of course, remained unchanged. Claim 1 now on appeal differs from the claim 1, the priority rights of which were refused, in that the earlier claim 1 specifies that the transformed host is of bacterial origin. Yet, the conclusion reached in Decision T 0269/87 is not depending on the host organism. The facts are, thus, unchanged.

7. In the Board's view, the Appellant's arguments are, in fact, aimed at proving that, in T 0269/87, the Board did not properly interpret the priority document. Even if the present Board could ever come to the same conclusion, they would not, however, have any power to reverse the earlier findings, as it is a matter of established jurisprudence that the findings of facts on which the binding part of a Board of Appeal's decision rests are not opened to reconsideration (*res judicata*, Decisions T 0843/91, OJ EPO 94, 818, T 0079/89, OJ EPO 92, 18, 283)).

8. Accordingly, the Examining Division was right in refusing to reconsider the matter of priority.

9. The subject-matter of the European patent application does not enjoy any priority rights.

Novelty

10. The novelty question arises in connection with the Unilever European application (see supra, section I) which enjoys a later filing date but claims an earlier priority date than the filing date of the European patent application (Article 54(3) EPC).

11. The Example 8a of the Unilever European application discloses a vector carrying a gene coding for methionine-prochymosin. Example 11 describes the production of chymosin by expression of said gene in a host organism followed by cleavage of the methionine-pro portion of the molecule. The application, thus, discloses the same subject-matter as the claim 1 of the patent in suit (see above, section V).

12. Whether Unilever derives valid priority rights from the claimed priority application has been positively decided by the Examining Division who came to the conclusion that the written description of the Unilever priority document is sufficient within the terms of Article 83 EPC.

13. The Board sees no reason to challenge this conclusion which, moreover, has never been objected to by the Appellant.

14. In fact, two differences only exist between the total disclosure of the specifications of both documents:

- In accordance with the requirements of Rule 28(1)(c) EPC, the Unilever patent application provides information on the deposited micro-organisms containing the genetic material useful in carrying out the claimed process. This information is, however, not essential to enablement in the light of the finding by the Examining Division (see point 12 supra).

- The Unilever patent application cites a number of specific organisms other than *E.coli* in which to perform the invention. Neither these organisms nor the corresponding processes are claimed. Priority rights are, thus, unaffected.

15. The Board's conclusion is, therefore, that the Unilever European patent application is novelty-destroying for the subject-mater of claim 1 on appeal.

The right to be heard.

16. The Appellant has argued that the reason invoked by the Board in T 0269/87 to deny priority took him by surprise.

17. As already stated in the decisions quoted in point 7 (supra), the present Board has no power to reconsider any of the actions of a previous Board (see, in particular, point 6 of the decision T 834/91).

Therefore, no decision may be taken on this matter.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairwoman:

L. McGarry U. M. Kinkeldey