



PATENTS ACT 1977

REDDIE & GROSE LLP

Requester

ISSUE Request under section 74A of the Patents Act 1977
for an opinion on patent EP3864025 B1

HEARING OFFICER B Micklewright

DECISION

Introduction

- 1 This decision relates to a request for an opinion.
- 2 The request was filed on 29 April 2025 in the name of REDDIE & GROSE LLP (the requester). The request sought an opinion on whether patent EP 3864025 B1 (the patent) in the name of Theradaptive Inc was valid in view of prior art documents and argument set out in the request. The patent relates to polypeptide sequences.
- 3 In a letter dated 28 July 2025 the Office informed the requester that it proposed to refuse the request as it did not raise a *new question*. The letter offered a hearing to the requester in the event that it wished to contest the decision. The letter noted that in the absence of a response, the opinion request would be refused. No such response has been received, and the requester has not requested a hearing. I therefore intend to refuse the request but before doing so will briefly set out the reasons for my decision.

The law

- 4 Section 74A(3)(b) of the Patents Act provides that in relation to opinions:

(3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so-

(a) ...

(b) if for any reason he considers it inappropriate in all the circumstances to do so.
- 5 The use of this provision to refuse opinion requests has been discussed in several other Office decisions¹. In particular, those decisions considered whether or not it was appropriate to issue an opinion if the question at the heart of the request had

¹ See for example Office decisions BL O/370/07, BL O/298/07 and BL O/289/07.

already been considered during the pre-grant examination of the patent. It was always the intention that the opinion service would not be used to repeat or in some way reappraise the examination of the patent performed either in this Office or at the European Patent Office (EPO). Rather, the intention was that there should be something new and the request should not simply seek to go over old ground. The principal rationale is that a patentee should not be asked to deal again with a question that they have already dealt with to the satisfaction of the Office pre-grant.

Discussion

- 6 The requester seeks an opinion on the validity of the patent on the basis that the independent claims 1, 13 or 15 lack an inventive step. They argue that claims 1 and 13 lack an inventive step based primarily upon the disclosure of US 2014/0037593 A1 (Alvarez) and that claim 15 lacks an inventive step based on a journal article (Christou)².
- 7 The patent originated as a PCT application, published as WO 2020/077265 A1. An International Preliminary Report on Patentability (IPRP) relating to that application was issued on 8 April 2021. Alvarez was cited as D1 in the IPRP. The IPRP contains a reasoned discussion of the applicability of Alvarez (D1) to the novelty and inventiveness of the claims. In particular, I note that independent claim 75 of the PCT application, which became claim 13 following amendment of the claims after entry into the European regional phase, was identified in the IPRP as lacking an inventive step.
- 8 Alvarez was not explicitly referred to by the EPO examiner during prosecution. Although the EPO examiner issued an examination report, that report contained no objection to the novelty or inventiveness of any of the claims. I consider that the EPO examiner would have considered the contents of the IPRP when examining the application for novelty and inventive step, including in particular the reasoned discussion of Alvarez, especially in view of their decision not to raise an objection to claim 13. I therefore conclude that the question of inventive step of at least claims 1 and 13 was considered by the EPO examiner in the light of Alvarez.
- 9 Alvarez is the only document relied upon in the request to demonstrate a lack of an inventive step in claims 1 and 13. In the absence of any other documents I do not consider that the request contains a new question in respect of the validity of claims 1 or 13. In these circumstances I do not therefore consider it appropriate for the patentee to have to deal again with an issue that has already been considered by the EPO examiner.
- 10 Regarding claim 15, I do not consider that sufficient information was provided in the request for the patentee to reasonably address the assertion that claim 15 lacked an inventive step. Nor is there sufficient information in the request to be able to reach an opinion on this question. Accordingly, it is also inappropriate to issue an opinion on the validity of claim 15.

Conclusion

² *"In vivo Assessment of AMP2, a Novel Ceramic-Binding BMP-2, in Ovine Lumbar Interbody Fusion"*; Christou et al. Spine; Volume 49, Number 19, October 2024.

- 11 I refuse the request made under Section 74A by REDDIE & GROSE LLP for an opinion on EP 3864025 B1.
- 12 In accordance with Rule 106(4) I believe that it is appropriate to remit the entire fee paid in this case.

Appeal

- 13 Any appeal must be lodged within 28 days after the date of this decision.

B MICKLEWRIGHT

Deputy Director, acting for the Comptroller