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**Datasheet for the decision
of 10 November 2010**

Case Number: T 0005/08 - 3.3.08

Application Number: 98943872.6

Publication Number: 1002138

IPC: C12Q 1/70

Language of the proceedings: EN

Title of invention:

Nucleic acid sequences that can be used as primers and probes
in the amplification and detection of all subtypes of HIV-1

Patentee:

bioMerieux B.V.

Opponents:

Gen-Probe Incorporated
Novartis Vaccines and Diagnostics, Inc.

Headword:

HIV probes/BIOMERIEUX

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(2)(4), 13(1)

Relevant legal provisions (EPC 1973):

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Keyword:

"Main request - admissibility (yes); disclaimer (not
allowable)"
"Auxiliary request - admissibility (no)"

Decisions cited:

G 0001/03, G 0002/03, T 0446/00, T 1120/00, T 0397/01,
T 0870/02, T 1593/05, T 1720/06, T 0361/08

Catchword:

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Case Number: T 0005/08 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 10 November 2010

Appellant: bioMerieux B.V.
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Respondent II: Novartis Vaccines and Diagnostics, Inc.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 16 August 2007
revoking European patent No. 1002138 pursuant
to Article 102(1) EPC 1973.

Composition of the Board:

Chairman: L. Galligani
Members: P. Julià
R. Moufang

Summary of Facts and Submissions

- I. Two oppositions were filed against European patent no. 1 002 138 which was based on European patent application no. 98 943 872 (published as International patent application WO 99/07898, hereinafter "*the application as filed*"). The opposition division considered the main request and auxiliary requests 1 to 6 then on file not to fulfil the requirements of the EPC and, accordingly, revoked the patent.
- II. The patentee (appellant) filed a notice of appeal and a statement setting out its grounds of appeal together with a new main request, new auxiliary requests 1 to 6 and further experimental evidence ("Experimental Report II").
- III. Both opponents 01 and 02 (respondents I and II, respectively) replied to the appellant's grounds of appeal. With its reply, respondent I also filed a "Declaration of Dr Brentano" dated 16 May 2008.
- IV. The board issued a summons to oral proceedings to which a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) was attached and wherein the parties were informed of the board's preliminary, non-binding opinion on the issues to be discussed at the upcoming oral proceedings.
- V. All parties replied to the communication of the board. In its reply of 8 October 2010, the appellant filed a new main request and an auxiliary request to replace all previous requests on file. On 8 November 2010, the

appellant filed a corrected auxiliary request to replace its previous auxiliary request.

VI. Oral proceedings took place on 10 November 2010. At the beginning of the oral proceedings, the appellant made the corrected auxiliary request filed on 8 November 2010 its first auxiliary request and filed a second auxiliary request (cf. Annex I attached to the minutes of the oral proceedings before the board). After discussing and deciding on the appellant's main request, a discussion took place on the appellant's first auxiliary request. At the end of that discussion and before the board announced a decision, the appellant withdrew its first auxiliary request and replaced its second auxiliary request by a corrected version which was to be its sole auxiliary request (cf. Annex II attached to the minutes of the oral proceedings before the board). In the course of the discussion on the admissibility and the alleged formal deficiencies of that auxiliary request, the appellant filed three further versions of this auxiliary request, each time replacing the previously submitted version (cf. Annex III to V of the minutes of the oral proceedings before the board). Except for the last version, all other versions were withdrawn before the board decided on their admissibility.

VII. Appellant's **main request** consisted of 11 claims, wherein claims 1 and 2 read as follows:

"1. Pair of oligonucleotides, for use as a primer set in the amplification of a target sequence located within the LTR region of the genome of HIV-1, said pair consisting of a first oligonucleotide being 10-50

nucleotides in length and comprising at least a fragment of 10 nucleotides of the sequence:

SEQ ID 1: G GGC GCC ACT GCT AGA GA

And a second oligonucleotide being 10-50 nucleotides in length and comprising at least a fragment of 10 nucleotides of the sequence:

SEQ ID 4: CTG CTT AAA GCC TCA ATA AA

with the exception of the oligonucleotide pairs:

1) CTG CTT AAG CCT CAA TAA AGC TTG CCT TGA
and TGT TCG GGC GCC ACT GCT AGA GA

and

2) CTG CTT AAG CCT CAA TAA AGC TTG CCT TGA G
and TGT TCG GGC GCC ACT GCT AGA GA."

"2. Pair of oligonucleotides, for use as a primer set in the amplification of a target sequence located within the LTR region of the genome of HIV-1, said pair consisting of a first oligonucleotide, which hybridizes to the target sequence or to its complement, being 10-50 nucleotides in length and comprising at least a fragment of 10 nucleotides of the sequence:

SEQ ID 1: G GGC GCC ACT GCT AGA GA

and a second oligonucleotide being 10-50 nucleotides in length and comprising at least a fragment of

10 nucleotides of a sequence selected from the group consisting of:

SEQ ID 4: CTG CTT AAA GCC TCA ATA AA

SEQ ID 5: CTC AAT AAA GCT TGC CTT GA

SEQ ID 12: GAT GCA TGC TCA ATA AAG CTT GCC TTG AGT

with the exception of the oligonucleotide pairs:

1) CTG CTT AAG CCT CAA TAA AGC TTG CCT TGA

and TGT TCG GGC GCC ACT GCT AGA GA

and

2) CTG CTT AAG CCT CAA TAA AGC TTG CCT TGA G

and TGT TCG GGC GCC ACT GCT AGA GA

wherein the first oligonucleotide is provided with a promoter sequence recognized by a DNA dependent RNA polymerase."

Claim 3 was dependent on claim 2 and defined the first and second oligonucleotides as comprising at least a fragment of 10 nucleotides of the sequences SEQ ID NO: 1 and 5, respectively. Claim 4 was dependent on claim 1 and required the first oligonucleotide to be provided with a promoter sequence recognized by a DNA dependent RNA polymerase. Claim 5 was dependent on claims 2 or 3 and defined the first and second oligonucleotides as consisting essentially of the sequences SEQ ID NO: 9 and 5, respectively. Claims 6 to 8 were directed to a method of detection of HIV-1 nucleic acid in a sample wherein the sample was subjected to a nucleic acid amplification using a pair of oligonucleotides

according to any of claims 1 to 5. Claims 9 and 10 concerned a test kit for the detection of HIV-1 in a sample comprising *inter alia* a pair of oligonucleotides according to claim 1 or 2 (claim 9) or the pair of oligonucleotides according to claim 5 (claim 10). Claim 11 was directed to the use of a pair of oligonucleotides according to claim 1 or 2.

VIII. Appellant's **auxiliary request** (in the last version submitted during the oral proceedings) consisted of 6 claims, wherein claim 1 read as follows:

"1. Pair of oligonucleotides, for use as a primer set in the amplification of a target sequence located within the LTR region of the genome of HIV-1, said pair consisting of a first oligonucleotide consisting of the sequence:

SEQ ID 1: G GGC GCC ACT GCT AGA GA

and a second oligonucleotide consisting of the sequence:

SEQ ID 5: CTC AAT AAA GCT TGC CTT GA."

Claims 2 to 3 were directed to a method for the detection of HIV-1 nucleic acid using a pair of oligonucleotides as defined in claim 1. Claims 4 to 5 concerned a test kit comprising the pair of oligonucleotides of claim 1 and claim 6 was directed to the use of such a pair of oligonucleotides.

IX. The following document is cited in the present decision:

D1: EP 0 887 427 (filing date: 24 June 1998, priority date: 25 June 1997).

X. The arguments of the appellant, insofar as they are relevant to the present decision, may be summarized as follows:

Main request

Admissibility in the appeal proceedings

In the notice of appeal, the board was initially requested to maintain the patent as granted, i.e. with claims which *inter alia* comprised subject-matter related to sequence SEQ ID NO: 12. Claim requests comprising sequence SEQ ID NO: 12 were discussed before the opposition proceedings and subject-matter related to that sequence was never abandoned. The main request now on file was identical to the auxiliary request 6 which was considered by the opposition division to overcome all formal deficiencies, to be novel over the prior art but not inventive (cf. Section IX of the decision under appeal). It did not raise issues other than those already discussed at first instance. Its filing now as the main request in appeal proceedings was prompted by the communication of the board in which it was indicated that none of the requests filed with the grounds of appeal was present before the opposition division. Thus, the current main request was known to the respondents, it could be expected by them, it was not a surprise and it did not raise any new issue. It was just a bona fide reply to the communication of the board.

The filing of divisional applications in order to preserve appellant's rights was not part of the appeal proceedings and it could not be taken into account for the board to reach a decision. The appeal proceedings was the last chance for the appellant to save its patent and the main request was a bona fide attempt to provide a valid basis for the maintenance of the patent. The facts and circumstances of the present case justified the exercise by the board of its discretion under Article 13(1) RPBA to admit the main request in the appeal proceedings.

Article 100(c) EPC, Article 123(2) EPC

Document D1, on which the disclaimer was based, referred to a broad and to an intermediate generalization that contemplated, respectively, the addition of nucleotides to the 5' and 3' ends of the disclosed oligonucleotide probes and the preferred total length of these oligonucleotide probes or primers. In line with the criteria set out in decision T 1120/00 of 22 October 2004, the broad generalization - which did not indicate any specific length or boundaries for the disclosed primers - was to be disregarded and only the intermediate generalization was to be considered. In the present case, the intermediate generalization was only found in the general part of the description of document D1, whereas the specific pair of oligonucleotides relevant to the patent-in-suit, namely the pairs 24/4 and 2/4 (SEQ ID NO. 24, 2 and 4), were described only in the examples of that document. There was no disclosure directly and unambiguously linking the very specific pairs 24/4 and/or 2/4 - which were

disclosed among many other pairs listed in Table 1 - and the intermediate or the broad generalization found in the general part of the description. Thus, in line with decisions G 1/03 and G 2/03 (OJ EPO, 2004, pages 413 and 448) which required a disclaimer not to remove more than what was necessary to restore novelty, there was no need for the disclaimer to comprise these generalizations referred to, only and exclusively, in the general part of the description of document D1.

The appellant also indicated its willingness to delete the disclaimer from claim 2 because document D1 did not propose the use of a promoter linked to the oligonucleotide sequences disclosed in that document.

Auxiliary request

Admissibility in the appeal proceedings

The auxiliary request was a bona fide attempt to overcome all grounds of opposition as well as the formal and substantive objections raised during appeal proceedings. The subject-matter of the auxiliary request was restricted to a preferred embodiment of the invention that had been present in all the requests before the first instance and in those filed in appeal proceedings. The auxiliary request was filed at a late stage of the appeal proceedings because it was the result of a lengthy discussion in preparation for and during the oral proceedings before the board. The auxiliary request also fulfilled all the criteria set out in the case law of the Boards of Appeal for a new request containing amended sets of claims to be admitted into the appeal proceedings, even if filed at the oral proceedings (cf. "Case Law of the Boards of

Appeal", 5th edition 2006, VII.D.14.2, page 642, in particular decision T 397/01 of 14 December 2004). The auxiliary request was justified since it was filed in reply to the objections raised during the appeal proceedings, it did not extend the frame of discussion and it was clearly allowable and thus, it could be easily dealt with during the oral proceedings by the other parties and by the board. It was also evident to all parties and to the board that it was the very last chance for the appellant to save its patent. Thus, in the exercise of its discretion under Article 13(1) RPBA, the board was justified to admit the auxiliary request into the appeal proceedings.

- XI. The arguments of the respondents, insofar as they are relevant to the present decision, may be summarized as follows:

Main request

Admissibility in the appeal proceedings

The main request, which was filed only one month in advance of the oral proceedings, was late filed. The presence in that request of SEQ ID NO: 12, which was not present in any of the appellant's requests filed with the statement of grounds of appeal, raised new substantive issues for which the respondents had had no opportunity to submit comments on writing. Embodiments related to SEQ ID NO: 12 were not discussed in, and were not part of, the appeal proceedings. Indeed, the experimental evidence filed with the appellant's grounds of appeal provided information only for SEQ ID NOs other than SEQ ID NO: 12. Moreover, the appellant failed to provide an explanation for the introduction

of SEQ ID NO: 12 at that late stage of the appeal proceedings, such as the objections and grounds of opposition which it intended to address or overcome.

In the course of appeal proceedings, it was normal to expect an appellant to further limit its requests but not to broaden them, the less so when no reasons or explanations were given. The main request could not be expected by the respondents and it came as a surprise to them. The filing of divisional applications containing claims directed to the same subject-matter as that of the patent-in-suit showed that the appeal proceedings were not the last chance for the appellant to save a patent for its invention.

Article 100(c) EPC, Article 123(2) EPC

The teachings of document D1 were not limited to the specific oligonucleotide probes, primers and pairs exemplified by that document. There was also a general teaching which stated that the length of these products could be longer than that exemplified in the document. The skilled person understood this general teaching to apply, directly and unambiguously, to the examples of document D1, in particular to the pairs shown in Table 1 and to the specific pairs 24/4 and 2/4. Both document D1 and the patent-in-suit contained a specific disclosure of particular oligonucleotide probes and pairs and generalizations regarding the length of these products. The teaching was identical in both documents and it was understood by the skilled person in the same manner. In line with the case law and the criteria set out in decision T 1120/00 (*supra*), for a disclaimer to restore novelty over document D1, it had to comprise

the complete disclosure of document D1, i.e. both the specific and the general teaching of this document.

The novelty of claim 2 was given by the presence of a promoter sequence in the first oligonucleotide because document D1 did not refer to any promoter. According to the criteria set out in decisions G 1/03 and G 2/03 (*supra*), a disclaimer was thus not necessary in claim 2.

Auxiliary request

Admissibility in the appeal proceedings

Whereas respondent II did not object to the admissibility of the auxiliary request, respondent I left it to the board's discretion. Both respondents, however, had raised objections based on Articles 12(2),(4) and 13 RPBA against the admissibility of previous versions of the auxiliary request which were filed and withdrawn during the oral proceedings before the board and replaced at the end by the present auxiliary request (cf. point VI *supra*). These objections were mainly based on the fact that oral proceedings before the board were the latest stage of an appeal proceedings and that all requests filed during these proceedings were late filed. Moreover, the auxiliary request derived from a previous version first filed at the beginning of the oral proceedings which was replaced several times during these proceedings. Thus, the auxiliary request was not a bona fide attempt to overcome all grounds of opposition and objections raised during appeal proceedings but, in view of the history of its prosecution, it was a request merely derived from, and occasioned by, the formal objections raised against the previous replaced versions of the

auxiliary request. At that stage of the proceedings, a bona fide attempt required for a request to overcome at least the most evident formal deficiencies. However, the appellant failed to provide such a request at the very latest stage of the appeal proceedings. It was unfair to the respondents and against the purpose of an appeal proceedings to allow now the filing of further requests and admit them into the appeal proceedings. The more so because the auxiliary request was restricted to a preferred embodiment of the invention. The appellant chose not to file a request limited to such embodiment in the opposition proceedings and none of its requests filed with its grounds of appeal or in reply to the board's communication was limited to that embodiment.

XII. The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request filed on 8 October 2010 or the last version of the auxiliary request filed during the oral proceedings.

XIII. The respondents (opponents) requested that the appeal be dismissed.

Reasons for the Decision

Main request

Admissibility in the appeal proceedings

1. The main request is considered to be a direct reply to the communication of the board pursuant to Article 15(1) RPBA in which the parties were informed of the board's

preliminary, non-binding opinion on the issues to be discussed at the appeal oral proceedings (cf. point IV *supra*). In that communication, the board discussed the admissibility of the claim requests filed with the appellant's statement of grounds of appeal (a main request and auxiliary requests 1 to 6) and, with reference to the purpose of appeal proceedings and to Article 12(4) RPBA, the board stated that none of these requests had ever been as such in the first instance proceedings.

2. In reply to these observations and in order to have at least one request already considered by the first instance, the appellant filed the main request which is identical to the auxiliary request 6 decided upon by the first instance. The opposition division considered this auxiliary request to fulfil all the requirements of the EPC except for those of Article 56 EPC. The main request is also identical to the auxiliary request 3 filed with the appellant's statement of grounds of appeal except for the absence in the latter of any subject-matter related to the sequence SEQ ID NO: 12. The main request was filed within the time limit set in the board's communication under Article 15(1) RPBA for the parties to file new submissions, i.e. one month before the oral proceedings at the latest.
3. Thus, although the main request at issue was filed at a late stage of the appeal proceedings, it was still within the time limit set by the board considered to be sufficient to allow the parties, in this case the respondents, to prepare themselves appropriately. Moreover, as this main request is identical to the narrowest request decided upon by the opposition

division, it was known to the respondents and cannot be seen as a complete surprise to them.

4. The fact that the request introduces subject-matter related to the sequence SEQ ID NO: 12 into the appeal proceedings is considered by the board not to be, in the circumstances of the present case, a disadvantage for the respondents. In the board's view, the absence of any submission or technical information regarding the sequence SEQ ID NO: 12 in the appellant's statement of grounds of appeal can only support the respondent's arguments concerning the alleged lack of evidence for the advantages of the claimed subject-matter, i.e. no demonstration of the alleged advantageous effect over the whole claimed scope, which for the main request includes now the sequence SEQ ID NO: 12.
5. Therefore, the main request is admitted into the appeal proceedings.

Article 100(c) EPC, Article 123(2) EPC

6. Document D1 is a prior art document under Article 54(3) EPC which discloses multiple primer sets for the detection and amplification of nucleic acids from the human immunodeficiency virus (HIV) type 1 and/or type 2. Primer sets are selected from different HIV regions including HIV-1 LTR regions. The oligonucleotides of sequences SEQ ID NO: 2 (30-mer) and 24 (31-mer) - which are identical except for the presence in SEQ ID NO: 24 of an additional (G) nucleotide at 3' position - represent forward primer regions of a HIV-1 LTR region and the oligonucleotide of sequence SEQ ID NO: 4 (23-mer) represents a reverse primer region of a second

HIV-1 LTR region (cf. *inter alia* page 9, lines 6 to 33 of document D1). The first 19 nucleotides of sequences SEQ ID NO: 2 and 24 are identical to the sequence SEQ ID NO: 4 of the patent-in-suit, except for the presence of an "AA" duplet instead of an "AAA" triplet at positions 7 and 8. Thus, the sequences SEQ ID NO: 2 and 24 comprise a fragment of 13 nucleotides (positions 7 to 19) which is identical to a fragment of the sequence SEQ ID NO: 4 of the patent-in-suit (positions 8 to 20). The sequence SEQ ID NO: 4 of document D1 comprises the sequence SEQ ID NO: 1 of the patent-in-suit and has five additional nucleotides at its 5' end. Document D1 explicitly discloses the use of the specific pairs 24/4 and 2/4 as primers for the detection of HIV-1 (cf. page 9, lines 47 to 53 and page 10, Table 1 of document D1). The disclaimer of claims 1 and 2 in the main request ("*... with the exception of the oligonucleotide pairs ...*", see point VII *supra*) removes these specific pairs 24/4 and 2/4 of document D1 from the claimed subject-matter.

7. However, the disclosure of document D1 is not limited to the very specific sequences of the oligonucleotide primers disclosed therein. Document D1 explicitly states that, depending upon several considerations, such as the complexity of the targeted sequence, "*(g)enerally, the primers used in this invention will have from 12 to 60 nucleotides, and preferably, they have from 16 to 40 nucleotides. More preferably, each primer has from 18 to 35 nucleotides*" (cf. page 6, lines 7 to 10 of document D1). And indeed it further states that, apart from the specific sequence of the primers and probes, "*(i)t will be apparent to those skilled in the art that additional sequence specific*

primers and probes can be prepared by, for example, the addition of nucleotides to either the 5' and 3' ends, which nucleotides are complementary or noncomplementary to the target sequence" (cf. page 6, lines 20 to 23 of document D1). The disclosure of document D1 is thus not limited to the specific sequences disclosed therein (specific teaching) but it also contemplates these specific sequences within a more general group of sequences of variable length (generic teaching). The disclaimer of claims 1 and 2 in the main request does not exclude the more generic teaching of document D1 from the claimed subject-matter.

8. The board fails to see any difference between this generic teaching of document D1 and the disclosure of the patent-in-suit in which the specific sequences disclosed therein are also contemplated within a general group of sequences having a variable range of preferred length, such as the 10-50 nucleotides in length indicated in claims 1 and 2 or the 15-26 nucleotides referred to in the patent-in-suit ("*... but longer primers may also be employed ...*") (cf. page 4, paragraph [0021], in particular lines 19 to 21 of the patent-in-suit). The examples of both document D1 and the patent-in-suit are all performed using only the specific sequences disclosed in these documents and the general information conveyed to the skilled person is the same in both documents.

9. According to the case law of the Boards of Appeal, the same standard is to be applied when considering the disclosure of the patent-in-suit and that of a prior art document (cf. *inter alia* T 870/02 of 16 September 2004, point 6 of the Reasons, T 1593/05 of 7 November

2007, point 4 of the Reasons and T 1720/06 of 22 April 2008, point 19 of the Reasons). This is also in line with decision T 1120/00 (*supra*) referred to by the appellant (cf. point X *supra*). Even though in the context of priority entitlement, the board considered in the latter decision that the information disclosed in the priority documents of the prior art document for carrying out an intermediate and a broad generalization referred to in these documents was the same than that provided by the patent-in-suit in that case and therefore, both generalizations were considered to be entitled to the claimed priority rights (cf. T 1120/00, *supra*, points 13 to 16 of the Reasons). In line with this case law, the board considers that, for the disclaimer of the main request to restore novelty of claim 1, it is necessary in the present case to exclude also the generic teaching of document D1. In view of this the question of the disclaimer in claim 2 can be left aside.

10. In view of the fact that the disclaimer of claim 1 does not exclude, as required by decisions G 1/03 and G 2/03 (*supra*), the complete teachings of document D1, the main request is considered not to fulfil the requirements of Article 123(2) EPC as an incomplete disclaimer constitutes added subject-matter which was not originally disclosed.

Auxiliary request

Admissibility in the appeal proceedings

11. Articles 12(2),(4) and 13(1) RPBA are relevant for assessing the admissibility of the auxiliary request. Article 12(2) RPBA requires the statement of grounds of

appeal to contain the appellant's complete case. Article 13(1) RPBA leaves to the board's discretion to consider and admit any amendment to a party's case after it has filed its grounds of appeal or a reply thereto. In the exercise of its discretion, account is to be taken of *inter alia* the current state of the proceedings. Article 12(4) RPBA refers to the power of the board to hold inadmissible requests which could have been presented in the first instance proceedings.

12. The subject-matter of the auxiliary request at issue is directed to a pair of oligonucleotides consisting of a first and a second oligonucleotide consisting, respectively, of the sequences SEQ ID NO: 1 and 5 (cf. point VIII *supra*). The combination of this pair of oligonucleotides is disclosed in the patent-in-suit and in the application as filed as "*a most preferred pair of oligonucleotides according to the invention*" (cf. page 6, paragraph [0033] of the patent-in-suit and page 8, lines 5 to 7 of the application as filed) and, accordingly, it is the subject-matter of a dependent claim in the claims as granted (claim 3) and in the original claims of the application as filed (claim 5). However, both in the patent-in-suit and in the application as filed, the pair of oligonucleotides is not directed to the very specific oligonucleotides of sequences SEQ ID NO: 1 and 5 but to general sequences having a total length of 10-50 nucleotides (original and granted claims) - or 10-26 nucleotides (granted claims) - and comprising a fragment of at least 10 nucleotides of these SEQ ID NO: 1 and 5 (original and granted claims).

13. A similar subject-matter is also found in the requests dealt with at the oral proceedings before the first instance and decided upon by the opposition division as well as in several of the claim requests filed by the appellant with its statement of grounds of appeal. However, none of these requests - either in the opposition or in the appeal proceedings - contemplated a pair of oligonucleotides with the first and second oligonucleotides restricted to the very specific oligonucleotides of sequences SEQ ID NO: 1 and 5, respectively. This is all the more surprising since the experimental reports filed by the appellant in the opposition proceedings and with its statement of grounds of appeal contained data derived from such a specific pair of oligonucleotides.
14. Thus, even though the objection of lack of inventive step put forward by the opposition division in the decision under appeal was mainly based on the scope of the claims, in the words of the opposition division "... *it is even reasonable to assume that not all the primer pairs ... are effective in amplifying HIV. Hence, the problem is not solved over the whole claimed range and consequently the claim is not inventive over the whole claimed scope ...*" (cf. page 13 of the decision under appeal, underlining added by the board), the appellant chose not to file a request specifically directed, and limited to, a pair of oligonucleotides as that claimed in the present auxiliary request which was characterized, both in the patent-in-suit and in the application as filed, as a preferred embodiment of the invention. Nor was such a request filed in the appellant's reply to the board's communication pursuant to Article 15(1) RPBA, even though the pair of

oligonucleotides of sequences SEQ ID NO: 1 and 5 was identified in that communication (albeit in the context of Articles 123(2),(3) EPC) and the issue concerning the scope of the claims was also mentioned therein (cf. point IV *supra*).

15. It was only at the beginning of the oral proceedings before the board that the appellant filed - as its second auxiliary request - a request which intended to limit the claimed subject-matter to the specific pair of oligonucleotides consisting of a first and a second oligonucleotide of the sequences SEQ ID NO: 1 and 5, respectively. However, this auxiliary request presented several deficiencies which required the appellant to necessarily introduce further amendments and modifications. In all, five different versions of the auxiliary request were submitted at the oral proceedings before the board, each time replacing the previously submitted version. Except for the last version, all other versions of the auxiliary request were withdrawn before the board decided on their admissibility (cf. Annexes I to V of the minutes of the oral proceedings before the board) (cf. point VI *supra*).
16. There is no doubt that the auxiliary request is a very late filed request. No convincing reasons have been provided by the appellant to justify its filing at this very late stage of the proceedings. Indeed and in view of the above mentioned facts, the board considers that such a request limited to a preferred embodiment of the invention could well have been filed at an earlier stage of the appeal or the opposition proceedings, either with the appellant's statement of grounds of appeal - so as to have a complete case as required by

Article 12(2) RPBA, in reply to the board's communication pursuant to Article 15(1) RPBA, or even at first instance in order to overcome the objection of the opposition division regarding the breadth of the claims (Article 12(4) RPBA). The appellant's choice not to file such a request deprived the respondents of the opportunity for preparing and presenting their case appropriately and it certainly did not contribute to the procedural economy of the present case.

17. This situation is further aggravated by the fact that the present auxiliary request, as such, has not been directly put forward by the appellant itself but it is the final result of a lengthy discussion between the respondents, the appellant and the board that took place at the oral proceedings and occasioned the introduction of several amendments, modifications and changes, in several different versions of a first filed auxiliary request (cf. points VI and 15 *supra*). This chain of events is not in line with the function of an appeal proceedings as established in the case law of the Boards of Appeal, namely to give a judicial decision upon the correctness of a separate earlier decision taken by a department of the European Patent Office (cf. "Case Law of the Boards of Appeal of the EPO", 6th edition 2010, VII.E.1, page 821). As repeatedly stated in the case law, it is not the purpose of an appeal proceedings to give the patent proprietor the opportunity to recast its claims as it sees fit and to have all its requests admitted into the appeal proceedings - a principle mirrored in Articles 12(4) and 13 RPBA (cf. *inter alia* decision T 361/08 of 3 December 2009, point 14 of the Reasons).

18. As for the appellant's argument that the auxiliary request represents the appellant's last chance to save the patent (cf. point X *supra*), the board considers this argument inappropriate to justify, in the present case, the very late filing of the auxiliary request and the complete chain of events or the history of its prosecution as cited above. It has also been clearly established by the Boards of Appeal that there is no absolute right for a patentee to such a last chance. On the contrary, the admissibility of a late filed request is always a matter of the board's discretion (cf. *inter alia* T 446/00 of 3 July 2003, point 3.3 of the Reasons). Although not part of the present appeal proceedings, the fact that a divisional application is still pending before the first instance speaks also against the appellant's argument (cf. "Case Law", 6th edition 2010, VII.E.16.5.5, page 903).
19. In view of the complete chain of events cited above and the particular circumstances of the present case, it is the board's conviction that not even the principle of procedural economy can assist the appellant's request to have its late filed auxiliary request admitted into the appeal proceedings. First, the appellant's auxiliary request is not clearly and directly allowable but requires further examination as to the substantive requirements of the EPC, at least for those of Article 56 EPC. Second, the conduct of the appellant during the oral proceedings, in particular the filing, modification and replacement of a fairly large number of auxiliary requests in a short time, is not seen as being in accordance with a party's obligation to take care not to act in a manner detrimental to the efficient conduct of oral proceedings (cf. "Case Law",

6th edition 2010, VII.E.16.5.4, page 902). This is all the more important specially in those cases, as in the present one, in which a decision taken by the board in appeal proceedings might be of relevance for pending divisional applications and for possible subsequent litigations before national courts. In these cases, the respondents should be given at least an opportunity to prepare and present their case appropriately. This was not so in the present case. Reasons of procedural economy cannot, in principle, override the actual purpose of an appeal proceedings or excuse an appellant from complying with the basic requirements of these proceedings, such as an early filing of amendments and an efficient conduct at oral proceedings.

20. In view of the foregoing considerations, the state of the appeal proceedings and the complete prosecution history of the present auxiliary request, the board, in the exercise of its discretion under Article 13(1) RPBA, decides not to admit the auxiliary request into the appeal proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani