

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen  
(D)  No distribution

**Datasheet for the decision  
of 26 November 2009**

**Case Number:** T 0780/08 - 3.3.08

**Application Number:** 00990628.0

**Publication Number:** 1234024

**IPC:** C12N 7/04

**Language of the proceedings:** EN

**Title of invention:**

Artificial chromosome constructs containing nucleic acid sequences capable of directing the formation of a recombinant RNA-virus

**Patentee:**

CONSEJO SUPERIOR DE INVESTIGACIONES CIENTIFICAS

**Opponent:**

Akzo Nobel N.V.

**Headword:**

RNA virus/CSIC

**Relevant legal provisions:**

EPC Art. 83

**Relevant legal provisions (EPC 1973):**

-

**Keyword:**

"Sole claim request - objection of insufficient disclosure overcome by amendment"

"Both parties request maintenance of the patent on its basis"

"No other objections of the board of its own motion"

**Decisions cited:**

-

**Catchword:**

-



Case Number: T 0780/08 - 3.3.08

**DECISION**  
of the Technical Board of Appeal 3.3.08  
of 26 November 2009

**Appellant:**  
(Opponent)

Akzo Nobel N.V.  
P.O. Box 9300  
NL-6800 SB Arnhem (NL)

**Representative:**

Mestrom, Joannes Jozef Louis  
Intervet International B.V.  
Patent Department  
P.O. Box 31  
NL-5830 AA Boxmeer (NL)

**Respondent:**  
(Patent Proprietor)

CONSEJO SUPERIOR DE INVESTIGACIONES  
CIENTIFICAS  
Serrano, 117  
ES-28006 Madrid (ES)

**Representative:**

von Menges, Albrecht  
UEXKÜLL & STOLBERG  
Patentanwälte  
Beselerstrasse 4  
D-22607 Hamburg (DE)

**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 7 February 2008  
rejecting the opposition filed against European  
patent No. 1234024 pursuant to Article 102(2)  
EPC.

**Composition of the Board:**

**Chairman:** L. Galligani  
**Members:** F. Davison-Brunel  
C. Heath

## Summary of Facts and Submissions

- I. European patent No. 1 234 024 with the title "Artificial chromosome constructs containing nucleic acid sequences capable of directing the formation of a recombinant RNA-virus" was granted with 18 claims on the basis of the European patent application No. 00990628.0 filed on 30 November 2000.

Claims 1, 6 and 10 read as follows:

"1. A method of preparing a DNA comprising sequences derived from the genomic RNA (gRNA) of a coronavirus said sequences having a homology of at least 60% to the natural sequence of the virus and coding for an RNA dependent RNA polymerase and at least one structural or non-structural protein, wherein a fragment of said DNA is capable of being transcribed into RNA and assembled to a virion, said method comprising the steps, wherein a coronavirus interfering defective genome is cloned under the expression of a promotor into a bacterial artificial chromosome (BAC) and the deleted sequences within the defective genome are re-inserted into said genome.

6. An infective clone comprising a full-length copy of complementary DNA (cDNA) to the genomic RNA (gRNA) of a coronavirus, cloned under a transcription-regulatory sequence.

10. An infective clone according to one of claims 6 to 9, wherein said infective cDNA is cloned in a bacterial artificial chromosome (BAC)."

II. An opposition was filed under Article 100(a) and (b) EPC for lack of novelty and inventive step and lack of sufficient disclosure. The opposition division rejected the opposition.

III. On 11 April 2008, the appellant (opponent) filed an appeal, paid the appeal fee. A statement of grounds of appeal was submitted in due time.

IV. On 4 November 2008, the respondent (patentee) submitted a reply thereto which was accompanied by six auxiliary requests.

Auxiliary request I was identical to the granted claims except for the fact that the subject-matter of granted claim 10 was introduced in granted claim 6 and the remaining claims were accordingly re-numbered. Claim 6 reads as follows:

"6. An infective clone comprising a full-length copy of complementary DNA (cDNA) to the genomic RNA (gRNA) of a coronavirus, cloned under a transcription-regulatory sequence, **wherein said infective cDNA is cloned in a bacterial artificial chromosome (BAC).**" (emphasis added by the board).

V. The board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, indicating its preliminary, non binding-opinion that the claims as granted seemed to fulfil the requirements of novelty, inventive step and sufficiency of disclosure except, as regards this last requirement, in relation to the subject-matter of claim 6 over the scope of the claim.

- VI. Oral proceedings took place on 26 November 2009. During the oral proceedings, the respondent filed a new auxiliary request I which was thereafter withdrawn at the same time as the request to dismiss the appeal, ie the request to allow the granted claims. Auxiliary request I filed by the respondent together with its reply to the grounds of appeal (see Section IV, supra) was taken as the sole request. The appellant had no objections against this request.
- VII. Both parties requested that the decision under appeal be set aside and that the patent be maintained on the basis of auxiliary request I filed on 4 November 2008.

### **Reasons for the decision**

*The sole request: auxiliary request I filed on 4 November 2008*

1. In the course of oral proceedings, the respondent chose auxiliary request I filed on 4 November 2008 as its sole request. In claim 6 of this request, the infective clone is characterized as comprising the coronavirus full-length cDNA **in a bacterial artificial chromosome** (see Section IV, supra). As a consequence of the amendment which consists in the introduction of the feature of granted claim 10 in granted claim 6, the objection raised by the appellant in respect of granted claim 6 is no longer relevant. The appellant had no objections against this request and, in fact, requested - as the respondent did - the maintenance of the patent on its basis. In its communication, the board already indicated that its only concern was sufficiency of

disclosure in relation to the subject-matter of claim 6, which concern is taken care of in amended claim 6 of the present request. The board, thus, does not see any factual basis for pursuing the case of its own motion.

*Amendment to the description*

2. In the course of oral proceedings, the description of the granted patent was amended by altering paragraph [0013] to reflect the newly claimed subject-matter in claim 6, ie that, in the infective clone, the infective coronavirus full-length cDNA is cloned in a bacterial artificial chromosome.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted back to the first instance with the order to maintain the patent on the basis of auxiliary request I filed on 4 November 2008, the description as granted except for an amended page 3 as filed during the oral proceedings, and the figures as granted.

The Registrar

The Chairman

A. Wolinski

L. Galligani