BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [ ] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen
(D) [X] No distribution

Datasheet for the decision of 23 April 2013

Case Number: T 2126/08 - 3.3.04

Application Number: 01303073.9

Publication Number: 1142906

IPC: C07K 14/08, A61K 39/42, C07K 16/10, G01N 33/576

Language of the proceedings: EN

Title of invention:
A hepatitis B virus (subtype ayw) surface antigen variant

Applicant:
ORTHO-CLINICAL DIAGNOSTICS, INC.

Headword:
Surface antigen/ORTHO-CLINICAL DIAGNOSTICS

Relevant legal provisions:
EPC R. 139

Keyword:
"Correction - not allowed"

Decisions cited:
G 0003/89, T 0190/99

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 2126/08 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 23 April 2013

Appellant: (Applicant)
ORTHO-CLINICAL DIAGNOSTICS, INC.
100 Indigo Creek Drive
Rochester, NY 14626-5101 (US)

Representative:
Mercer, Christopher Paul
Carpmaels & Ransford
One Southampton Row
London WC1B 5HA (GB)

Decision under appeal:
Decision of the Examining Division of the European Patent Office posted 5 May 2008 refusing European application No. 01303073.9 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman: C. Rennie-Smith
Members: B. Claes
R. Morawetz

Summary of Facts and Submissions

I. The appeal was lodged by the applicant (hereinafter "appellant") against the decision of the examining division to refuse European patent application 01303073.9 with the title "*A hepatitis B virus (subtype ayw) surface antigen variant*" which was published as EP 1 142 906.

II. Claim 1 of the application as filed read:

"1. An isolated variant hepatitis B surface antigen comprising an amino acid sequence wherein mutations from hepatitis B wild type ayw2 strain appear as follows: at position 103 isoleucine is present instead of methionine, at position 118 lysine is present instead of threonine, at position 120 glutamine is present instead of proline, at position 170 serine is present instead of leucine, and at position 213 serine is present instead of leucine."

III. The examining division decided that claim 1 of the set of claims filed by the applicant with its letter dated 26 July 2005 (which apparently is referred to incorrectly in the decision under appeal as the letter of 11 September 2006) failed to comply with the requirements of Article 123(2) EPC.

Claim 1 of the request before the examining division comprised instead of the wording "at position **170** serine is present instead of leucine", the amended wording "at position **175** serine is present instead of leucine" (emphasis added by the board).

In two further "Additional Comments" the examining division provided arguments questioning the compliance of the application as originally filed and the claims therein with the requirements of Articles 83 and 84 EPC, respectively, and whether the subject- matter as claimed involved an inventive step (Article 56 EPC).

IV. The appellant's statement of grounds of appeal was identical to its submissions filed on 17 March 2008 before the examining division in response to the summons to oral proceedings.

V. The board summoned oral proceedings on 16 January 2013 and expressed, in a communication pursuant to Article 15(1) RPBA, its preliminary opinion that the finding and decision of the examining division, that the requested amendment to claim 1 did not comply with the requirements of Article 123(2) EPC, was correct.

VI. With a letter dated 25 March 2013 the appellant submitted further arguments, withdrew its request for oral proceedings and announced it would not to be represented at the oral proceedings.

VII. Oral proceedings took place on 23 April 2013 in the absence of the appellant.

VIII. The appellant requested the board to set aside the decision under appeal and to order the grant of a patent on the basis of the application having the claims as filed with the appellant's letter dated 26 July 2005 and amended pages 5 and 8 of the description filed with the same letter.

IX. The appellant's arguments, insofar as they are relevant for the present decision can be summarised as follows:

– The amendment/correction to claim 1 complied with the requirements of Article 123(2) EPC. Both the typographical error and its correction were immediately obvious to a person skilled in the art. The correction was therefore allowable under Rule 139 EPC.

– The amino acid sequence of the surface antigen of the newly identified HBV strain, called LBN, had five amino acid differences, i.e. at positions 103, 118, 120, 175 and 213, when compared to the known isolate ayw2, the sequence of which was known from GenBank Accession No. X02496. The differences were identified on page 8, in lines 16 to 18 of the application as filed. This list of differences contained an error in the passage "170 L (TTA)—> S (TCA)" (page 8, line 17). Claim 1 as originally filed contained a corresponding error.

– The error in this passage was immediately obvious to a skilled person because residue 170 in the amino acid sequence of strain ayw2 was phenylalanine (F), encoded by the codon TTC. The examining division had acknowledged that it was evident to a skilled person that an error existed. However, it had held that the amendment/correction was not the only possible correction. A person skilled in the art would have been unable to decide between the correction of "17**0 L** (TT**A**)—> S (TCA)" to "17**5** L (TTA)—> S (TCA)" or to "170 **F**

(TT**C**)—> S (TCA)". It therefore refused the correction pursuant to Article 139 EPC.

– In the first possible correction (as now in claim 1), the only correction was to the position of the amino acid and the amino acid as such and the codon remained unchanged. The mutation described was an amino acid change from L -> S as a result of a single base change in the codon from TTA to TCA. Similarly, the other four amino acid changes between LBN and the known ayw2 subtype were also the result of a single base substitution. Furthermore, there were only three leucine (L) residues encoded by a TTA codon between positions 32 and 226 of the amino acid sequence of the prior art isolate ayw2, i.e. at positions 175, 213 and 216. Since the five amino acid mutations in the new LBN strain were listed in a numerical order (see page 8, lines 14-20 of the application as filed), the correct residue number for the leucine (L) encoded by TTA between residue 120 and residue 213 could therefore clearly only be 175. Furthermore, because L was also referred to in claim 1 as originally filed only amino acid L was intended by the drafter of the application. Thus, to a person skilled in the art, it would have been immediately obvious that no other correction could have been intended.

– In the second possible correction both the amino acid residue and the codon encoding it had to be altered and only the position of the amino acid residue was maintained. As a consequence the change was F -> S, which required a two base

change to the codon, i.e. from TTC to TCA. This mutation was far less likely to occur in nature as it required the substitution of two consecutive bases rather than the substitution of a single base. This correction would thus not have been considered by the skilled person with a mind willing to understand (see decision T 190/99 "The patent must be construed by a mind willing to understand not a mind desirous of misunderstanding") as it was not "technically sensible" (see decision T 190/99). The skilled person would therefore immediately have come to the conclusion that the error was in the number of the amino acid residue.

– Thus, given the information in the application as filed, the correction of the error was obvious as it was immediately evident to a person skilled in the art that nothing else would have been intended other than what was offered as the correction. Thus, the proposed correction set out in the claims met the requirements of Rule 139 EPC and did not contravene Article 123(2) EPC.

Reasons for the Decision

1. The statement of the grounds of appeal is identical to the submissions of 17 March 2005 before the examining division. Accordingly, the statement of grounds includes a section entitled "Correction of obvious errors (Rule 139 EPC)". The board therefore considers that the amendment to claim 1 under consideration

entails a request for correction of an obvious error in the present appeal procedure also.

2. Rule 139 EPC (former Rule 88 EPC 1973) provides in its second sentence that a correction of errors in documents filed with the European Patent Office which concerns the description, claims or drawings can only be allowed if the correction is obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as correction. In point 5 of the reasons of its opinion G 3/89 (OJ EPO 1993, 117), the Enlarged Board of Appeal considered that, for a correction under Rule 88, second sentence EPC 1973, that concerns the disclosure of a European application or a European patent to be allowed, the respective parts of the disclosure for which a correction is requested must, either on the date of filing or following an amendment under Article 123 EPC 1973 (unchanged as to substance in EPC 2000), contain such an obvious error that a skilled person would be in no doubt that the information concerned could not be meant to read as such. Furthermore, the skilled person must be in a position objectively and unambiguously to recognise the incorrect information using common general knowledge. If, on the other hand, it is doubtful whether that information is incorrectly defined, then a correction is ruled out (points 2 and 3 of the reasons).

3. The opinion G 3/89 of the Enlarged Board of Appeal, *supra*, held furthermore that any correction under Rule 88 EPC 1973 (corresponding to Rule 139 EPC) is of a strict declaratory nature and thus has not to infringe the prohibition of extension of subject-matter under

Article 123(2) EPC (see Headnote 2). Accordingly the decision of the examining division in the present case also had the effect of refusing the correction under Rule 139 EPC as referred to in the statement of the grounds for appeal.

4. The amendment/correction under consideration is the change of the wording "at position **170** serine is present instead of leucine" in claim 1 to the wording "at position **175** serine is present instead of leucine" (and a corresponding change on page 8, in line 17, of the application as filed; emphasis added by the board; see section III above).

5. In its decision, the examining division acknowledged that it was evident to a skilled person that an error existed. However, the amendment/correction as now contained in claim 1 was not the only possible correction as a person skilled in the art would have to decide between the correction of "17**0** **L** (TT**A**)—> S (TCA)" to "17**5** L (TTA)—> S (TCA)" or to "170 **F** (TT**C**)—> S (TCA)", i.e. between a correction of the position of the mutation or the correction of the amino acid at position 170 and of the corresponding codon. It found that it was therefore not immediately evident what the correction should be and refused the correction pursuant to Article 139 EPC.

6. As can be taken from opinion G 3/89 of the Enlarged Board of Appeal, *supra*, the conditions an error has to fulfil to benefit from a correction are that it must be obvious that an error has occurred and it must be immediately evident what the correction should be.

7. The board considers that it may have been obvious to the person skilled in the art that an error occurred when consulting the sequence of ayw2 which was known from GenBank Accession No. X02496 and wherein the amino acid residue 170 is phenylalanine (F), encoded by the codon TTC. The first condition may therefore be fulfilled.

8. However, the board considers that the second condition is not fulfilled because, as demonstrated by the examining division in its decision (see point 5, above), more than one possible correction becomes immediately evident to the skilled person when considering the error.

9. The appellant has submitted in essence two lines of argument in favour of the position that the proposed amendment/correction was the only correction which was immediately evident.

9.1 A first line of argument was that the second possible correction/amendment referred to in point 5, above, wherein both the amino acid residue and the codon encoding had to be altered, was far less likely to occur in nature as a single mutation underlying the correction/amendment under consideration as it required the substitution of two consecutive bases rather than the substitution of a single base. The other four amino acid changes between LBN and the known ayw2 subtype referred to in claim 1 were also the result of a single base substitution. This second possible correction would therefore not result from a mind willing to understand as it was not "technically sensible" (see decision T 190/99 of 6 March 2001).

9.2 A second line of argument was that there were only three leucine (L) residues encoded by a TTA codon between positions 32 and 226 of the amino acid sequence of the prior art isolate ayw2, i.e. at positions 175, 213 and 216. Since the five amino acid mutations in the new LBN strain were listed in a numerical order (see page 8, lines 14-20 of the aplication as filed), the correct residue number for the leucine (L) encoded by TTA between residue 120 and residue 213 could therefore clearly only be 175. That the reference to Leucine (L) was intentional by the drafter of the application was clear to a skilled person seeing that claim 1 as originally filed also referred, as did the passage on page 8 of the application as filed, to Leucine.

9.3 The board cannot accept either of these lines of argument. Indeed, it is first noted that the appellant has not denied that the second possible correction/amendment referred to by the examining division would not be considered by the skilled person, but has rather argued that it would be based on a mutation which would be "less likely to occur in nature". Furthermore and secondly, the appellant has not argued that when reading the application as filed, the skilled person would have received the technical information that the five amino acid differences were due to point mutations. The board therefore concludes that, because a double mutation would not be precluded for a skilled person addressing the error, the same skilled person would take both possible corrections/amendments into consideration without thereby frustrating the principles established in decision T 190/99, *supra*, that when considering a claim

the skilled person should rule out interpretations which are illogical or which do not make technical sense and a patent should be construed by a mind willing to understand, not a mind desirous of misunderstanding.

10. In view of the above considerations, the board considers that the correction of the error in claim 1 as originally filed was not immediately evident to a person skilled in the art. Thus, the correction proposed by the appellant, and set out in the claims, does not meet the requirements of Rule 139 EPC.

11. The decision of the examining division is therefore correct in the point under appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar The Chairman

P. Cremona C. Rennie-Smith