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**Datasheet for the decision  
of 9 June 2011**

**Case Number:** T 0379/09 - 3.3.08

**Application Number:** 97953786.7

**Publication Number:** 0977874

**IPC:** C12N 15/74

**Language of the proceedings:** EN

**Title of invention:**

Attenuated Salmonella strain used as a vehicle for oral immunization

**Patentee:**

Gesellschaft für Biotechnologische Forschung mbH (GBF)

**Opponent:**

Merck Patent GmbH

**Headword:**

Attenuated Salmonella/GBF

**Relevant legal provisions:**

RPBA Art. 12(1)(2)(4)

EPC Art. 13(1)

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

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**Keyword:**

"Main request, auxiliary requests 1 and 2 - admissibility (no)"

**Decisions cited:**

G 0009/91, T 1091/00

**Catchword:**

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Case Number: T 0379/09 - 3.3.08

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.08  
of 9 June 2011

**Appellant:** Gesellschaft für Biotechnologische  
(Patent Proprietor) Forschung mbH (GBF)  
Mascheroder Weg 1  
D-38124 Braunschweig (DE)

**Representative:** Forstmeyer Dirk und Walter  
BOETERS & LIECK  
Oberanger 32  
D-80331 München (DE)

**Respondent:** Bauer O. und Benz J.  
(Opponent) Merck Patent GmbH  
Frankfurter Straße 250  
D-64293 Darmstadt (DE)

**Representative:** -

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 7 November 2008  
revoking European patent No. 0977874 pursuant  
to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** M. Wieser  
**Members:** B. Stolz  
J. Geschwind

## Summary of Facts and Submissions

- I. The patentee (appellant) filed an appeal against the decision of the opposition division dated 7 November 2008 to revoke the European patent no. 0977874 pursuant to Article 101(3)(b) EPC.
- II. The opposition division decided that the sole request before it, the claims as granted, did not meet the requirements of Article 83 EPC. It decided also that claims 7 and 9 did not meet the requirements of Article 56 EPC.

Claims 1, 7, and 9 of the claims as granted read as follows:

"1. Attenuated Salmonella strain carrying an eukaryotic expression vector for the expression of a heterologous gene or gene fragment or an autologous gene or gene fragment under the control of an eukaryotic promoter comprised by the vector within an open reading frame, wherein the attenuation is adjusted to a vaccination of vertebrates including humans.

7. Vaccine for oral and/or nasal and/or mucosal gene delivery to vertebrates including humans, wherein the vaccine comprises a Salmonella strain according to any of the preceding claims.

9. Use of a Salmonella strain according to any of the preceding claims for the preparation of a vaccine for vaccination of vertebrates including humans."

- III. With letter dated 13 March 2009, the appellant submitted its grounds of appeal, requested the decision of the opposition division to be set aside and the patent in suit to be maintained on the basis of amended claims 1 to 10.
- IV. In a letter dated 16 July 2009, the opponent (respondent) submitted its response to the grounds of appeal and referred to a newly cited document.
- V. The board summoned the parties to oral proceedings. A communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) dated 23 February 2011, annexed to the summons, informed the parties of the preliminary non-binding opinion of the board on some of the issues of the appeal proceedings.
- VI. With letter dated 9 May 2011, the appellant submitted further arguments and five auxiliary requests.
- VII. Oral proceedings were held on 9 June 2011. In the course of the oral proceedings, the appellant withdrew the request filed with its grounds of appeal, as well as auxiliary requests 2 and 4 filed with its letter dated 9 May 2011.
- VIII. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of its main request, originally filed as auxiliary request 1 on 9 May 2011. As an auxiliary measure it requested that the patent be maintained on the basis of auxiliary request 1 (originally filed on 9 May 2011 as auxiliary request 3), or on the basis of auxiliary

request 2 (originally filed on 9 may 2011 as auxiliary request 5).

IX. The respondent requested that the appeal be dismissed.

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

Appellant believed the claims filed with its grounds of appeal to overcome the objections under Article 83 EPC. The present requests were filed only in response to the board's communication annexed to the summons to attend oral proceedings and to respondent's attempt to introduce a new prior art document at a late stage of the proceedings.

The new main request did not contain any new subject matter. It differed from the claims as granted only by the deletion of claims 7 and 9. Therefore, neither the respondent nor the board could have been surprised by its contents, and the procedure was not delayed by the late submission.

XI. Respondent's arguments can be summarised as follows:

Appellant should have reacted earlier. The filing of additional requests one month before oral proceedings was clearly belated. According to appellant's own submissions of 9 may 2011 the new auxiliary requests were not filed in response to a late filed document.

## Reasons for the Decision

Articles 12(1), 12(2), 12(4), and 13(1) of the Rules of Procedure of the Boards of Appeal (RPBA)

1. The main request, and auxiliary requests 1 and 2, as finally submitted by the appellant, have been filed one month before oral proceedings were held.
  
2. The admission of late filed requests in appeal proceedings is governed by the Rules of Procedure of the Boards of Appeal. According to Article 12(1) RPBA, appeal proceedings shall be based on (a) the notice of appeal and the statement of grounds of appeal filed pursuant to Article 108 EPC, (b) in cases when there is more than one party, any written reply of the other party or parties to be filed within four months of notification of grounds of appeal, and (c) any communication sent by the Board and any answer thereto filed pursuant to directions of the Board (Article 12(1) RPBA). The statement of grounds of appeal and the reply shall contain a party's complete case (Article 12(2) RPBA). Article 13(1) RPBA leaves it to the board's discretion to admit any amendment to a party's case after it has filed its grounds of appeal. This discretion shall be exercised in view of *inter alia* the complexity of the new subject matter submitted, the current state of the proceedings and the need for procedural economy.
  
3. In the present case, it is important to note that the opposition division, with its summons to attend oral proceedings, issued a communication expressing its preliminary opinion. In this preliminary opinion it

already raised objections against claims 7 and 9 under the provisions of Articles 56 and 83 EPC. It stated *inter alia* that claims 7 and 9, referring to vaccines, were not sufficiently disclosed over the whole breadth claimed. The reason given by the opposition division was that the patent did not provide any indication how to put the invention into practice when the Salmonella strains expressed non-protective antigens. Despite this clear indication of the objections raised against claims 7 and 9, the then patentee and now appellant did not react by filing a reply but on the contrary withdrew its request for oral proceedings. The opposition division revoked the patent for the reasons already indicated in its preliminary opinion. The appellant filed amended claims only with its statement of grounds of appeal. At the oral proceedings it withdrew this request and replaced it with requests filed one month before oral proceedings were held.

The board notes that the RPBA in addition to the requirements indicated in point (2) above also state in its Article 12(4) that facts, evidence or requests which could have been presented or were not admitted in the first instance proceedings could be held inadmissible.

4. The appellant argued that its three new requests were filed only at a late stage because it believed the amendments filed with the statement of grounds of appeal to solve all problems under Article 83 EPC.

In the board's opinion, this argument is contradicted by appellants own written submissions filed with its grounds of appeal. From the outset of the opposition

proceedings, the objections against claims 7 and 9 as granted were based on insufficiency of disclosure because the claims were not limited to vaccines comprising Salmonella strains expressing protective antigens but also included Salmonella strains expressing antigens which were not protective. On page 3 of its statement of grounds of appeal, appellant explicitly stated that "the Opposition Division considers the subject-matter of claims 7 and 9 not sufficiently disclosed over the whole breadth claimed, in the light of the fact that also antigens which indeed are not protective, are embraced by the scope of the claims." Appellant also stated that "the opposition division acknowledged sufficient disclosure for protective antigens". Nevertheless, the appellant submitted, with its statement of the grounds of appeal, amended claims 7 and 9 embracing "protective antigens or immunogenic proteins". It was only one month before oral proceedings in the appeal procedure that appellant filed requests clearly overcoming the reason for revocation of the patent given by the opposition division.

Therefore, the board is not satisfied by this argument given as a justification for the late filing of the requests.

5. Furthermore, the appellant argued that the main request, and partially also auxiliary requests 1 and 2, differed from the claims as granted only by the deletion of claims 7 and 9, which did not add any new subject matter and did therefore not increase the complexity of the case.



The board accepts that the deletion of claims does not normally create new substantive problems. However, in the present case it creates procedural problems adding to its complexity.

The opposition division decided that the subject matter of claims 7 and 9 was insufficiently disclosed and lacked an inventive step. While all claims were assessed in respect of Article 83 EPC, only claims 7 and 9 have been assessed in respect of Article 56 EPC. Inventive step of claims 1 to 6, 8 and 10 has not been examined.

6. According to decision G 9/91 (OJ EPO 1993, 408, pt. 18 of the reasons), the main purpose of appeal proceedings is to give the losing party the possibility of challenging the decision of the opposition division. It is not in conformity with this purpose to consider grounds for opposition on which the decision of the Opposition Division has not been based.
7. Remittal to the department of first instance is at the discretion of the board (cf. decision T 1091/00 of 2 July 2002, pt. 4 of the reasons).

Although Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should preferably be given the opportunity to have two readings of the important elements of the case. Hence, a case is normally remitted, if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first instance department issues a decision solely upon one particular issue which is decisive for the case against a party and leaves other essential issues outstanding. If, as a result of the appeal proceedings, the appeal on the particular issue is allowed, the case is normally remitted to the department of first instance for consideration of the undecided issues. In the present case remittal to the first instance to decide on inventive step of claims 1 to 6, 8, and 10 would be the normal consequence in the light of new claim requests wherein claims 7 and 9, which were the only two claims decided upon in the decision under appeal, have been deleted.

This would result in a considerable delay of the procedure which is not acceptable to the board at this late stage of the procedure.

8. Further, the appellant argued that it amended the claims because of respondent's attempt to introduce a new prior art document into the appeal proceedings.

The board does not accept this argument either because appellant itself stated at the top of page 5 of its letter of 9 May 2011, that it "at least for the time being refrained from filing any auxiliary requests taking document D17 into account".

9. Finally, the appellant argued that all three requests were filed in response to the communication of the

board annexed to the summons to attend oral proceedings.

The board is not convinced by this argument. As mentioned above in point 2, the deficiencies of claims 7 and 9 as granted with respect to sufficiency of disclosure and inventive step were clearly stated and reasoned in the decision under appeal. The board, in its communication dated 23 February 2011, mentioned some of the issues to be discussed at the oral proceedings. The communication, as far as it related to amended claims 7 and 9, and sufficiency of disclosure, addressed respondent's objection that finding suitable immunogenic proteins or protective antigens constituted an undue burden. The board expressed its preliminary view that the skilled person would be in a position to provide attenuated bacteria transformed with a vector as claimed without undue burden. Thus, in this respect, the Board agreed with appellant's reasoning. However, the Board did not comment on other issues under Article 83 which were raised in the decision of the opposition division and which remained unchanged from the onset of the appeal procedure.

Thus, the argument that the late filing was caused by the communication of the Board also fails.

10. For the above reasons, exercising its discretion under Article 13(1) RPBA, the board decides not to admit the main request, and auxiliary requests 1 and 2 into the appeal proceedings.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

M. Wieser