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**Datasheet for the decision
of 13 November 2012**

Case Number: T 0679/09 - 3.3.08

Application Number: 95940351.0

Publication Number: 796327

IPC: C12N 15/10

Language of the proceedings: EN

Title of invention:
ISOLATION OF NUCLEIC ACID

Patentee:
Invitrogen Dynal AS

Opponent:
QIAGEN

Headword:
isolation of nucleic acids/INVITROGEN DYNAL

Relevant legal provisions:
EPC Art. 54
RPBA Art. 12(4), 13(1)

Relevant legal provisions (EPC 1973):

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Keyword:
"Main request - novelty (no)"
"Auxiliary requests I and II - not admitted"

Decisions cited:
T 0495/10

Catchword:

-



Case Number: T 0679/09 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 13 November 2012

Appellant:
(Patent Proprietor)

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 23 January 2009
revoking European patent No. 796327 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 appeal lies against the decision of the opposition division to revoke European patent No. 796 327.
- II. The opposition division found that:

the main request, claims 1 to 18 filed on 8 October 2008, lacked novelty (Article 54 EPC), and

auxiliary request I, claims 1 to 17 filed on 8 October 2008, lacked an inventive step (Article 56 EPC).
- III. With its grounds for appeal, dated 1st June 2009, the patentee (appellant) filed a main request and auxiliary requests I to VI. The main request was identical with the main request of the decision under appeal, and auxiliary requests II and VI, respectively, were to a large extent (including claims 1 to 8, 13, and 14) identical with auxiliary requests II and III filed at the beginning of the oral proceedings before the opposition division.
- IV. With letter dated 1 October 2009, the opponent (respondent) filed its reply to the statement of grounds of appeal.
- V. With letter dated 6 April 2011, the appellant filed a main request and auxiliary requests I and II, replacing all requests previously on file.
- VI. The parties were summoned to oral proceedings. A communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to the

summons, informed them of the preliminary non-binding opinion of the board on some of the issues of the appeal proceedings.

VII. Oral proceedings were held on 13 November 2012 where the appellant filed a new main request and new auxiliary requests I and II, and withdrew all previous requests.

VIII. Independent claim 1 of the main request reads:

"1. A method of isolating nucleic acid from a sample containing cells, said method comprising contacting said cells with a detergent and a particulate solid support, whereby soluble nucleic acid in said sample is bound to the surface of the support by sequence-independent binding in the presence of said detergent and absence of chaotropic agent, and separating said support with bound nucleic acid from the sample."

Dependent claims 2 to 18 refer to preferred embodiments of the method of claim 1.

IX. Independent claim 1 of auxiliary request I reads:

"1. A method of isolating nucleic acid from a sample containing cells, said method comprising contacting said cells with a detergent and a particulate solid support, wherein said particulate solid support comprises magnetic beads and which particulate support is added to the sample prior to or simultaneously with the detergent, whereby soluble nucleic acid in said sample is bound to the surface of the support by sequence-independent binding in the presence of said

detergent and absence of chaotropic agent, and separating said support with bound nucleic acid from the sample." (amendments emphasized)

X. Independent claim 1 of auxiliary request II reads:

"1. A method of isolating nucleic acid from a sample containing cells, said method comprising contacting said cells with a detergent and a particulate solid support, wherein said particulate solid support comprises magnetic beads and which particulate support is added to the sample prior to or simultaneously with the detergent, whereby soluble nucleic acid in said sample is bound to the surface of the support by sequence-independent binding in the presence of said detergent and absence of chaotropic agent, and separating said support with bound nucleic acid from the sample wherein the particulate solid support comprises spherical beads of diameter from 1 to 10 μm ." (amendments emphasized)

XI. The following document is referred to in this decision:

D2: EP 270 017

XII. Appellant's arguments as far as relevant for the present decision can be summarized as follows:

The main request was novel over the cited prior art and involved an inventive step. The claimed method differed from the method disclosed in document D2 by the way of contacting the cells in the sample with a detergent and a solid support, and by the way of separating the bound nucleic acid from the sample.

Auxiliary requests I and II were late filed but should be admitted in view of the history of the case in opposition proceedings. The minutes of the proceedings before the opposition division did not accurately reflect the course of these proceedings. Contrary to what is said in the minutes, the patentee had not withdrawn any of then auxiliary requests I to IV, and the opposition division had committed a serious procedural violation by not deciding on their admissibility. Moreover, the minutes showed that the patentee seeked to add important features to the claims to delimit the claimed subject matter from the prior art, and that it did not abandon any subject matter. For the same reason, auxiliary request II contained a further limitation.

XIII. Respondent's arguments as far as relevant for the present decision can be summarized as follows:

The main request lacked novelty in view of document D2.

The auxiliary requests should not be admitted as they were not filed in time. The treatment of the appellant in opposition proceedings was more than fair. The appellant got multiple opportunities for the filing of additional requests at the oral proceedings. At the oral proceedings the main request was modified several times and the auxiliary request I was also amended, despite the protests of the opponent. To the best of the respondent's recollection, the patentee had withdrawn auxiliary requests I to IV.

XIV. The appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request, or in the alternative, on the basis of one of auxiliary requests I or II, all filed at the oral proceedings, and that the appeal fee be reimbursed.

XV. The respondent requested that the appeal be dismissed.

Reasons for the Decision

Main request

Admissibility

1. Claims 1 to 18 of the main request, submitted at the oral proceedings before the board of appeal, are identical with claims 1 to 18 of the main request underlying the decision under appeal and with claims 1 to 18 of the main request filed with the grounds of appeal.

The only difference between claim 1 of the new main request and the main request filed on 6 April 2011 can be found in line 1. Claim 1 of the new main request refers to the "contacting of said cells" with a detergent and a solid support, while the main request of 6 April 2011 referred to "the contacting of said sample". According to the appellant, this amendment in the request of 6 April 2011 was unintended, and it requested an opportunity to submit a main request corresponding to the main request filed with the grounds of appeal.

Under these circumstances, the board, exercising its discretion under Article 13(1) RPBA, decided to admit the main request.

Article 123(2),(3) EPC

2. In the light of the board's decision given below, there is no need to consider the requirements of Articles 123(2) and 123(3) EPC.

Article 54 EPC

3. Claim 1 refers to a method of isolating nucleic acid from a sample comprising cells. The method comprises the steps of contacting cells in a sample with a detergent and a particulate solid support, and separating said support with bound nucleic acid from said sample. A further characterizing feature of the claimed method is the binding of the nucleic acid to the solid support by sequence independent binding in the presence of a detergent and in the absence of chaotropic agents.
4. Document D2 discloses several methods of isolating and purifying nucleic acids from biological samples.

Example IV discloses a procedure for isolating DNA from blood cells comprising lysing the cells in the presence of SDS, and isolation of the nucleic acid by pouring the clear lysate (still containing the detergent) on a column comprising a particulate anion exchange material equilibrated with a NaCl buffer. Nucleic acid binds to

the column material, and the sample is separated from the bound nucleic acid by flowing through the column.

Similarly, example V(b) discloses the isolation of nucleic acid from urine comprising cells by lysing the cells with a detergent and passing the clear lysate over an anion exchange column.

Nucleic acids binds in the absence of chaotropic agents and independent of its sequence. Examples IV and V(b) therefore comprise all the features of the claimed method.

5. The board disagrees with the appellant's view that document D2 fell outside the scope of claim 1 because the wording of the claim required the simultaneous addition of a detergent and a particulate solid support to the sample. The term "contacting" is open to interpretation and does not limit the claimed method to procedures bringing intact cells into physical contact with a particulate support. In the broadest sense, the term contacting simply means "bringing together", and the claim does not specify any order in which cells, detergent and support have to be brought together. This interpretation is in line with the description (page 6, lines 22-25, of the published international patent application) which specifies that "the sample may, generally speaking, simply be contacted with the detergent, and a solid phase which may be added to the sample prior to, simultaneously with, or subsequently to the detergent".

The board also disagrees with the appellant's view that the separation by binding of the nucleic acid to an

anion exchange column fell outside the scope of claim 1. The anion exchange material is of a particulate solid nature, and the claim merely requires separation of the solid support with bound nucleic acid from the sample. Although the examples of the patent disclose the use of particulate solid supports in batch procedures, the claimed method is not limited to batch procedures and does not exclude the use of particulate solid material packed in a column.

6. Therefore, the board decided that the main request lacked novelty.

Auxiliary request I

Admissibility

7. Claim 1 of auxiliary request I is, although not literally, identical with claim 1 of auxiliary request III, submitted to the opposition division on 8 October 2008, in all its technical features and hence its scope. According to the minutes of the oral proceedings, the patentee (appellant) withdrew auxiliary request III at the oral proceedings before the opposition division.
8. In its grounds of appeal, the appellant heavily contested that it had withdrawn auxiliary requests I to IV during opposition proceedings. It stated that "[T]he representative never withdrew previous ARs I to VI (sic) at this point (or at any other point) in the oral proceedings. The Minutes themselves prove how the OD unilaterally deemed AR1 - AR4 filed at the start of oral proceedings to be withdrawn, without considering

- or deciding on the issue of *prima facie* admissibility of those claim requests."
9. From the minutes of the oral proceedings it can be seen that the appellant filed a new main request and new auxiliary requests I to IV at the beginning of the proceedings. In the course of these proceedings it replaced the main request filed at the beginning by a further main request, and it replaced auxiliary request I twice by amended auxiliary requests I. According to point 19 of the minutes, the patentee itself withdrew auxiliary requests I to IV when submitting the last version of auxiliary request I. A statement to the same effect is also contained in item 6 of the section "Facts and Submissions" of the decision issued by the opposition division.
 10. The board notes that the patentee, at the end of the oral proceedings, after the opposition division had considered the main request and auxiliary request I then on file and had decided to revoke the patent and to close the proceedings, did not protest that the opposition division had not decided on the admissibility of auxiliary requests I to IV filed at the beginning of the oral proceedings. The board also notes that the patentee never requested a correction of the minutes.
 11. On the basis of the available evidence, the board therefore can only conclude that auxiliary request III was indeed withdrawn during opposition proceedings.
 12. According to Article 12(4) RPBA, the board has the power to hold inadmissible requests which could have

been presented in the first instance proceedings. This includes requests which were filed but then withdrawn or abandoned.

One criterion for exercising its discretion is to consider whether the withdrawal of a request has prevented the department of first instance from giving a reasoned decision on the critical issues, thereby compelling the board of appeal either to give a first ruling on those issues or to remit the case to the department of first instance (cf. point 2.1.2 of decision T 495/10 of 3 July 2012).

Withdrawal of auxiliary requests I to IV in opposition proceedings had exactly this effect. While the appellant may not have intended to avoid a decision of the opposition division on the admissibility of inter alia auxiliary request III, this was the inevitable result of its withdrawal (cf. point 2.1.7 of decision T 495/10).

13. For these reasons, the board, exercising its discretion under Article 12(4) RPBA, decided not to admit auxiliary request I into the proceedings.

Auxiliary request II

Admissibility

14. Claim 1 of auxiliary request II is derived from claim 1 of auxiliary request I and includes additional features specifying the shape of the particulate solid support as being spherical and the diameter of the support as ranging from 1 to 10 μm (cf. item X, above).

15. These new, limiting features originate from the last paragraph on page 9 of the published patent application and were not present in any of the dependent claims on file.

16. Up to this point in time of the procedure, the shape and diameter of the particulate solid support were never an issue in opposition or appeal proceedings. Moreover, the cited prior art is silent about the shape and size of the particulate supports used. Assessing the prior art in this respect might therefore necessitate the consideration of new prior art documents. Admitting auxiliary request II at this stage of the proceedings would therefore require the assessment of new issues and result in procedural delays.

17. For these reasons, the board, exercising its discretion under Article 13(1) RPBA, decided not to admit auxiliary request II.

Reimbursement of the appeal fee

18. The appellant submitted that the opposition division, for the reasons mentioned in point 8 above, committed a substantial procedural violation by not deciding on auxiliary requests I to IV filed at the beginning of the oral proceedings before the opposition division.

19. According to Rule 103(1)(a) EPC, an appeal fee shall be reimbursed where the board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

20. As mentioned above (points 9 to 11), the board, on the basis of the available evidence, concluded that said auxiliary requests were withdrawn during said oral proceedings. Hence, there was no need for the opposition division to reach any decision on these requests, and it follows that the opposition division did not commit a substantial procedural violation.
21. As a consequence, the request for reimbursement of the appeal fee pursuant to Rule 103 EPC, is rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

M. Wieser