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**Datasheet for the decision
of 18 March 2014**

Case Number: T 1100/10 - 3.3.08

Application Number: 95912559.2

Publication Number: 701605

IPC: C12N15/57, C12N9/52, C12N9/54,
C12N9/56, C11D3/386

Language of the proceedings: EN

Title of invention:
IMPROVED ENZYMES AND DETERGENTS CONTAINING THEM

Patent Proprietor:
BASF SE

Opponents:
Novozymes A/S
Danisco US Inc.

Headword:
Detergent Bacillus lentus subtilisin protease egg stains/BASF

Relevant legal provisions:
EPC Art. 15, 23(4), 35(1), 54, 56, 83, 84, 112(1)(a), 113,
114(2)
EPC R. 12(1), 12(3), 116(1)
RPBA Art. 12(4), 13(1)

Keyword:
Admissibility of the Main Request and of Auxiliary Requests 1
and 2 (no); Admissibility of Auxiliary Request 3 (yes);
Referral to the Enlarged Board of Appeal (no);
Auxiliary Request 3 - requirements of the EPC (yes);

Decisions cited:

G 0002/10, T 0118/89, T 0214/05, T 1213/05, T 0349/09

Catchword:

Although the Rules of Procedure of the Boards of Appeal (RPBA) are drafted and adopted by the Presidium, it is the Administrative Council of the European Patent Organisation which **decides** to approve the RPBA. Only thereby the RPBA enter into force to be applied by the Boards of Appeal (cf. points (9) to (14) of the Reasons for the Decision).



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Case Number: T 1100/10 - 3.3.08

**D E C I S I O N
of Technical Board of Appeal 3.3.08
of 18 March 2014**

Appellant I: BASF SE
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
12 March 2010 concerning maintenance of the
European Patent No. 701605 in amended form.**

Composition of the Board:

Chairman: M. Wieser

Members: P. Julià

J. Geschwind

Summary of Facts and Submissions

I. European patent No. 0 701 605 is based on European patent application No. 95 912 559.2, published as International patent application WO 95/23221 ("*the application as filed*", hereinafter). The patent was granted with 34 claims. Claims 1 and 11 as granted read as follows:

"1. A mutant subtilisin protease, characterized by at least one amino acid alteration which results in a reduced positive charge or an increased negative charge in the region of the substrate binding pocket, wherein said amino acid alteration is L211D according to the counting of SEQ ID NO. 22."

"11. Detergent composition comprising at least one surfactant and a mutated subtilisin protease according to one of claims 1 to 4."

II. Two oppositions were filed on the grounds of Articles 100(a), (b) and (c) EPC. The opposition division considered the Main Request (claims as granted) not to fulfil the requirements of Article 123(2) EPC and Auxiliary Requests 1 and 2 to contravene Articles 54 and 56 EPC, respectively. The patent was maintained on the basis of an Auxiliary Request 3 and a description amended thereto. All Auxiliary Requests and the amended description were filed on 21 January 2010 at the oral proceedings before the opposition division.

Claim 1 of Auxiliary Request 3 read as granted claim 1 except for the presence of the additional terms "*Bacillus lentus DSM 5483*" after the term "*a mutant*".

- III. Appeals were lodged by the patentee (appellant I) and opponent 02 (appellant II). With its statement of Grounds of Appeal, appellant I filed a new Main Request and Auxiliary Requests 1 to 8.
- IV. On 19 November 2010, appellant II requested an extension of two months of the time limit for responding to appellant I's Grounds of Appeal. In a communication pursuant to Article 17 of the Rules of procedure of the Boards of Appeal (RPBA), the board informed the parties that this request was granted.
- V. With letters of 25 November 2010 and 4 February 2011, appellants I and II replied to the Grounds of Appeal of the other appellant. Both filed further evidence, namely document D14 (appellant I) and the experimental data of document D15 (appellant II).
- VI. In a communication pursuant to Article 15(1) RPBA, annexed to the summons to oral proceedings, the board informed the parties of its preliminary opinion on the issues to be discussed at the upcoming oral proceedings.

In particular, the board expressed its preliminary opinion that the new evidence seemed to be admissible but that it considered several of the newly filed claim requests not to be admissible in the light of Article 12(4) RPBA. It further commented on the presence of added subject-matter and the lack of clarity of several claim requests (Articles 123(2) and 84 EPC) and issues concerning Articles 54 and 56 EPC. Reference was also made to the objection raised by appellant II under Article 83 EPC against all claim requests.

VII. With letters of 14 and 10 of February 2014, appellants I and II announced, respectively, their intention to attend the oral proceedings. None of these letters contained further substantive submissions on the issues of the appeal case.

VIII. Oral proceedings took place on 18 March 2014 in the presence of appellants I and II. At the onset of the oral proceedings, appellant I filed a new Main Request and new Auxiliary Requests 1 to 4 to replace its previous claim requests. Auxiliary Request 4 was withdrawn at the end of the oral proceedings. After the board had informed the parties that the Main Request and Auxiliary Requests 1 and 2 were not admitted into the appeal proceedings, appellant I requested the board to refer four questions to the Enlarged Board of Appeal. These question were submitted in the German language (cf. point XIV *infra*).

IX. Claim 1 of the **Main Request** read as follows:

"1. A mutant *Bacillus lentus* DSM 5483 subtilisin protease, characterized by at least one amino acid alteration which results in a reduced positive charge or an increased negative charge in the region of the substrate binding pocket, wherein said amino acid alteration is L211D according to the counting of SEQ ID NO. 22, except a mutant described by SEQ ID NO. 17 or SEQ ID NO. 18."

X. Claims 1 and 2 of **Auxiliary Request 1** read as follows:

"1. A mutant *Bacillus lentus* DSM 5483 subtilisin protease, characterized by one amino acid alteration which results in a reduced positive charge or an increased negative charge in the region of the

substrate binding pocket, wherein said amino acid alteration is L211D according to the counting of SEQ ID NO. 22."

"2. Mutant protease according to claim 1, described by SEQ ID NO. 16."

XI. Claim 1 of **Auxiliary Request 2** read as follows:

"1. Detergent composition for removal of egg stains from fabrics, comprising at least one surfactant and a mutated subtilisin protease characterized by one amino acid alteration which results in a reduced positive charge or an increased negative charge in the region of the substrate binding pocket, wherein said amino acid alteration is L211D according to the counting of SEQ ID NO. 22."

XII. Claim 1 of **Auxiliary Request 3** read as follows:

"1. Detergent composition for removal of egg stains from fabrics, comprising at least one surfactant and a mutated subtilisin protease wherein said protease is encoded by SEQ ID NO. 16."

Claims 2 to 13 of Auxiliary Request 3 were directed to preferred embodiments of claim 1. Claims 14 and 15 were directed to a method for washing fabrics for removing egg stains comprising contacting said fabric with a detergent composition according to one of claims 1 to 13.

XIII. The following documents are cited in this decision:

D2: EP-A2-0 251 446 (publication date: 7 January 1988);

D4: WO-A1-94/02618 (publication date: 3 February 1994);

D5: Alignment of wild type BLAP, Subtilisin 309 and PB92 (submitted by opponent 01 on 23 December 2008 with Notice of opposition);

D11: Alignment of BLAP and BPN' subtilisins (submitted by opponent 02 on 24 December 2008 with Notice of opposition).

XIV. The submissions of appellant I, insofar as they are relevant to the present decision, may be summarised as follows:

Admissibility of the Main Request and of Auxiliary Requests 1 to 3

These requests were filed in direct reply to the board's communication and intended to overcome the objections raised therein. They were all based on the auxiliary request upheld by the opposition division, did not introduce new issues into the appeal proceedings and were filed in the interest of procedural efficiency.

In the Main Request, former claims objected by the board were deleted and/or amended and the subtilisin proteases described by SEQ ID NOs. 17 (F54) and 18 (F55), for which according to the board's preliminary opinion no evidence was on file to show an improved effect (removal of egg stains from fabrics), were excluded from claim 1 by introducing a disclaimer. A skilled person would read claim 1 to mean that the claimed mutants were limited to a defined class of subtilisin proteases based on the *B. lentus* DSM 5483 subtilisin protease described by SEQ ID NO. 22. Only

mutants of the *B. lentus* DSM 5483 subtilisin protease were claimed, which had the advantageous properties for removal of egg stains from fabrics.

Auxiliary Request 1 was identical to the Main Request except for the deletion of the terms "at least" in claim 1. Claim 1 was thereby limited to mutants of *B. lentus* DSM 5483 subtilisin proteases which, in the region of the substrate binding pocket, had only the advantageous alteration of mutant F49 described by SEQ ID NO. 16. Therefore, all mutants claimed had the same advantageous properties as the mutant F49 disclosed in the patent. The considerations made for the Main Request applied also to this request.

Auxiliary Request 2 did not contain any claim directed to a mutant *B. lentus* DSM 5483 subtilisin protease. Claim 1 was directed to a detergent composition for removal of egg stains from fabrics comprising at least one surfactant and a mutated subtilisin protease, which was characterized by the feature shown in the patent to be advantageous for the intended use.

Auxiliary Request 3 was identical to Auxiliary Request 2 except for the fact that the mutated subtilisin protease comprised in the detergent composition of claim 1 was specified as being mutant F49 encoded by SEQ ID NO. 16.

Referral of questions to the Enlarged Board of Appeal

The Rules of Procedure of the Boards of Appeal (RPBA) had no legal basis because they were drafted by the Presidium of the Boards of Appeal (hereinafter "*the Presidium*"), which had no legislative power to do so. The Administrative Council had illegally delegated

parts of its legislative power to the Presidium, which was not a department mentioned in Article 15 EPC. According to the Historical Documentation relating to the EPC (Travaux Préparatoires), the departments responsible for carrying out the procedures laid down in the EPC were, only and exclusively, those mentioned in Article 15 EPC. Moreover, a discretionary power to be exercised by a judicial body could only be granted to this body by law which was in compliance with the legal European standards. These standards, however, did not apply to the RPBA.

The fact that the RPBA were drafted by the Presidium and that the Administrative Council could not change, amend or modify but only approve or disapprove this draft, was not in line with the EPC. The Presidium was not a department mentioned in Article 15 EPC and drafting the RPBA went far beyond the role and function of the Presidium as established in Rule 12(3) EPC. According to Rule 12(3) EPC, the Presidium was only entitled to adopt the RPBA. This was entirely different from drafting and issuing the RPBA. Rule 12(3) EPC, defining the function of the Presidium, stated that it should advise the Vice-President in charge of the Boards of Appeal with regard to matters concerning the functioning of the Boards of Appeal, i.e. drafting the administrative norms and/or rules for the internal functioning of the Boards of Appeal. This did not include matters such as the drafting of legal norms and/or rules that could affect parties in appeal proceedings. Indeed, this was the case for the present RPBA and, in particular, for Articles 12(4) and 13(1) RPBA, since the board's discretionary power established by these two articles affected the legal rights of the parties in appeal proceedings, namely the right to be heard, enshrined in Article 113 EPC.

Moreover, the composition of the Presidium was *prima facie* not in line with the legal European standards, in particular, with the jurisprudence and legal practice of the Member States of the European Patent Organisation. Firstly, the Vice-President in charge of the Boards of Appeal, acting as chairman of the Presidium, was not a permanent employee of the Organisation but an employee under a temporary contract. Secondly, the twelve members constituting the Presidium as established in Rule 12(1) EPC did not represent the Boards of Appeal in a democratic manner as required for a legislative body according to the jurisprudence and legal practice of the Member States of the EPO. Although the number of technical and legal members in the Boards of Appeal was far higher than the number of Chairmen, the Presidium was constituted by the same number of Chairmen and non-Chairmen.

In view of these considerations, the following four questions (submitted in the German language) had to be referred to the Enlarged Board of Appeal (EBA) (Article 112(1) (a) EPC):

"1. Ist der Verwaltungsrat ermächtigt, über die in Art. 15 EPÜ genannten Organe hinaus weitere Organe für die Durchführung der im Übereinkommen vorgesehen Verfahren zu schaffen?

"2. Falls Frage 1 nicht verneint wird: Ist der Verwaltungsrat ermächtigt, ein "autonomes Organ innerhalb der Beschwerdekammern" zu schaffen und dieses Organ mit Initiativrecht für den Erlass einer Verfahrensordnung der Beschwerdekammern auszustatten?

"3. Falls Frage 2 nicht verneint wird: Ist es mit dem für alle Mitgliedsstaaten des EPÜ geltenden Gewaltenteilungsgebot vereinbar, der rechtsprechenden Gewalt das Initiativrecht zum Erlass einer Verfahrensordnung der Beschwerdekammern abzutreten?

"4. Genügt die Aufteilung der Mitglieder des autonomen Organs der Beschwerdekammern gemäß R. 12(1) EPÜ zwischen Vorsitzenden und weiteren Mitgliedern der Beschwerdekammern den Erfordernissen des Demokratieprinzips?

Auxiliary Request 3

Article 84 EPC

Example 14 of the patent disclosed a value of 0.63 for the keratinase/caseinase (K/C) activity ratio of the specific mutated F49 subtilisin protease. This ratio was determined by using a method and conditions disclosed in other Examples of the patent. The K/C activity ratio could thus be slightly different when using other methods or the same method under different conditions. Therefore, the K/C activity ratio in claim 2 was not a fixed value but was defined by indicating a range (less than 0.80, preferably less than 0.70).

The introduction of the purpose-related feature in claim 1 limited the claimed detergent compositions to those having a composition appropriate for the intended purpose, namely the removal of egg stains from fabrics. Thus, claim 1 was directed to detergent compositions that were appropriate for, or suitable to, display the technical effect that was shown in the patent to be associated to the mutated F49 subtilisin protease encoded by SEQ ID NO. 16.. Thereby, the objections raised under Articles 83 and 56 EPC were moot.

XV. The submissions of appellant II, insofar as they are relevant to the present decision, may be summarized as follows:

Admissibility of the Main Request and of Auxiliary Requests 1 to 3

All claim requests were late filed. They could have been filed at an earlier stage of the proceedings and no reasons had been provided to explain their filing at this late stage of the proceedings. In addition, the Main Request and Auxiliary Requests 1 and 2 did not overcome the objections raised against former requests and, additionally, introduced new issues at a late stage of the appeal proceedings.

Claim 1 of the Main Request did not overcome any of the objections raised in the board's communication against claim 1 of former requests, namely lack of clarity, of novelty and of inventive step. Moreover, the introduction of a disclaimer raised new issues and objections that had never been considered before in the procedure.

The deletion of the term "at least" in claim 1 of Auxiliary Request 1 did not overcome the objection for lack of clarity raised against claim 1 of former requests on file, but introduced further ambiguity concerning the scope of claim 1. Moreover, this amendment was entirely new in the procedure since such a deletion was not present in any of the numerous previous claim requests filed by the patentee during the opposition and appeal proceedings.

Auxiliary Request 2 referred to a mutated subtilisin protease which was no longer required to be based on the *B. lentus* DSM 5483 subtilisin protease of SEQ ID NO. 22. The definition of the mutant subtilisin protease in this request was broader than in the Main Request and Auxiliary Request 1 and thus, it did not simplify the issues to be dealt with. On the contrary, the broader definition introduced issues that had not to be considered in the examination of claim requests of higher ranking.

Auxiliary Request 3 defined the mutated subtilisin protease as being encoded by SEQ ID NO. 16, i.e. the mutant F49. This request could potentially overcome the objections raised against former requests on file and could be admitted into the appeal proceedings.

Referral of questions to the Enlarged Board of Appeal

No submissions or comments were made on this issue.

Auxiliary Request 3

Article 84 EPC

According to the results shown in Example 14, the K/C activity ratio of the mutated F49 subtilisin protease was 0.63. Although claim 1 was limited to this specific protease, claim 2 indicated a range and not a specific value for the K/C activity.

In line with the established practice of the Boards of Appeal, the purpose-related feature introduced into claim 1, namely "*for removal of egg stains from fabrics*", was not actually limiting the scope of the claim but required only that the detergent was "*suitable*" for this intended purpose. Thus, the

introduction of this feature did not overcome any ground of opposition and was not, therefore, occasioned by a ground of opposition as required by Rule 80 EPC.

- XVI. Appellant I (patentee) requested that the decision under appeal be set aside and that a patent be maintained on the basis of the Main Request or, in the alternative, of any of the Auxiliary Requests 1 to 3 filed at the oral proceedings on 18 March 2014. It also requested that the four questions, filed during the oral proceedings in the German language, be referred to the Enlarged Board of Appeal.
- XVII. Appellant II (opponent 02) requested that the decision under appeal be set aside and that the patent be revoked.
- XVIII. There are no submissions and no requests on file from opponent 01 (party as of right).

Reasons for the Decision

Admissibility of the Main Request and of Auxiliary Requests 1 to 3

1. The Main Request and Auxiliary Requests 1 to 3 were filed at the beginning of the oral proceedings before the board and thus, outside the time limit set by the board in its communication pursuant to Article 15(1) RPBA, namely one month before the oral proceedings (cf. point VI *supra*).
2. The filing of these requests represents an amendment of appellant I's case. According to Article 13(1) RPBA,

any amendment to a party's case after it has filed its Grounds of Appeal may be admitted and considered at the board's discretion. The Main Request and Auxiliary Requests 1 to 3 are entirely new in the proceedings, none of them has been filed in the procedure before the opposition division, and no convincing reasons have been provided to explain why they could not have been filed at an earlier stage of the proceedings, for instance at the onset of the appeal procedure, or at least in direct response to the board's communication (Article 12(4) RPBA). Thus, the admissibility of these requests into the appeal proceedings is left to the board's discretion as conferred to it by Articles 12(4) and 13(1) RPBA.

3. In the communication pursuant to Article 15(1) RPBA, the board has considered that appellant II's objection under Article 84 EPC, raised against claim 1 of the requests then on file, was relevant (cf. points 26.1 to 26.4 of the board's communication). According to the board's preliminary opinion, the wording "*a mutant Bacillus lentus DSM 5483 subtilisin protease*" in claim 1 of these requests had to be interpreted broadly and, accordingly, the claim was open to the objections under Articles 54 and 56 EPC (cf. points 31-32 and 34 of the board's communication).

4. Claim 1 of the present Main Request reads "*a mutant Bacillus lentus DSM 5483 subtilisin protease*", which is "*characterized by at least one amino acid alteration*" that has a specific effect (reduced positive charge or increased negative charge) in the region of the substrate binding pocket and wherein said amino acid alteration is "*L211D according to the counting of SEQ ID NO.22*" (cf. point IX *supra*).

Contrary to appellant I's assertion, the board, as stated in its communication, does not see claim 1 to be limited to the specific alkaline protease from *Bacillus lentus* DSM 5483 (BLAP) with sequence SEQ ID NO. 22. Rather, SEQ ID NO. 22 is cited in claim 1 as a counting reference only, with the effect that claim 1 embraces other subtilisin proteases from *B. lentus* DSM 5483. Although according to claim 1 one amino acid alteration must be L211D, neither the absolute number nor the type of "*amino acid alterations*" that might additionally be present is defined. These alterations do not necessarily have to be substitutions but may be other types of alterations as far as they fulfil the required structural feature, namely to give rise to "*a reduced positive charge or an increased negative charge in the region of the substrate binding pocket*".

In accordance with the established case law of the Boards of Appeal, there is no reason for the board to interpret claim 1 in a narrow manner (cf. "Case Law of the Boards of Appeal of the EPO", 7th edition 2013, I.C.3.8, page 114). The fact that neither the structure of the subtilisin protease (SEQ ID NO) on which the alterations are performed, nor the number and type of possible additional alterations are clearly defined in claim 1, renders the scope of this claim unclear and ambiguous, which, as stated in the board's communication, has to be considered when examining the requirements of Articles 54 and 56 EPC. The Main Request, filed at the oral proceedings, does not overcome the objections already raised in the board's communication against former requests.

Moreover, a so-called "*disclosed disclaimer*", i.e. a disclaimer excluding subject-matter which originally was disclosed as part of the invention, has been

introduced into claim 1 of the Main Request ("except a mutant described by SEQ ID No. 17 or SEQ ID NO. 18") (cf. point IX *supra*). This disclaimer is new in the proceedings and its introduction requires the board, for the first time in the procedure, to examine whether the criteria defined in decision G 2/10 (OJ EPO 2012, page 376) are fulfilled. The introduction of the disclaimer clearly represents a new issue and leads to a fresh case.

5. Claim 1 of Auxiliary Request 1 differs from claim 1 of the Main Request by the deletion of the terms "at least". The disclaimer of the Main Request is not present (cf. point X *supra*). The term "at least", defining the number of alterations contained in the claimed mutants, has been present in all claim requests that had been on file so far through the entire procedure.

If the deletion is understood as limiting the scope of claim 1 to a specific mutant of the *B. lentus* DSM 5483 subtilisin protease (BLAP, SEQ ID NO. 22) characterized by a single mutation or amino acid alteration in the region of the substrate binding pocket (L211D), then there exists a clear contradiction with claim 2, which defines the subtilisin protease mutant of claim 1 as being described by SEQ ID NO. 16. Sequence SEQ ID NO. 16 characterizes the subtilisin protease mutant F49 which, apart from the amino acid alteration L211D, contains five other mutations (S3T+V4I+A188P+V193M+V199I) that distinguish the M131 BLAP mutant from the wild type BLAP enzyme (cf. page 13, Table 2 of the patent).

If the deletion of the terms "at least" is not understood as limiting the scope of claim 1 to a

specific mutant of the *B. lentus* DSM 5483 subtilisin protease (BLAP, SEQ ID NO. 22), then this deletion is completely irrelevant and claim 1 still has to be interpreted broadly (i.e. the claimed mutants are not limited to those having, only and exclusively, the amino acid alteration indicated in claim 1). This would have the effect, that the scope of claim 1, like the scope of claim 1 of the Main Request, remains ambiguous and unclear (cf. point 4 *supra*).

Thus, also the amendment present in claim 1 of Auxiliary Request 1 does not overcome the objections raised against former requests on file, introduces further ambiguity and raises new issues not considered so far in the proceedings.

6. Contrary to the Main Request, to Auxiliary Request 1 and to former requests on file, the "*mutated subtilisin protease*" comprised in the detergent composition of claim 1 in Auxiliary Request 2 is not defined as "*a mutant Bacillus lentus DSM 5483 subtilisin protease*" (cf. point XI *supra*). In line with the broad interpretation of the claim (cf. point 4 *supra*), claim 1 requires the mutated subtilisin protease to contain the specific amino acid alteration (L211D), but is not limited in any other way, neither with regard to the source of the subtilisin protease nor to the number and type of alterations additionally present in this mutant.

The introduction of the feature "*for removal of egg stains from fabrics*" has to be understood as limiting the claimed detergents to those having a composition suitable for this indented use.

Thus, in the light of the conclusions drawn by the board with regard to the Main Request and Auxiliary Request 1, also the amendments introduced into claim 1 of Auxiliary Request 2 do not overcome the objections raised against former requests on file.

7. Claim 1 of Auxiliary Request 3 is limited to a detergent composition for removal of egg stains from fabrics comprising at least one surfactant and the specific mutated subtilisin protease F49 encoded by SEQ ID NO. 16, for which an advantageous effect is shown in the patent. The limitation of the claimed subject-matter to a detergent composition comprising the mutant F49 and to a method for washing fabrics for removing egg stains using this detergent composition is clearly intended to overcome objections raised with regard to former requests on file and does not give rise to new issues not considered in earlier stages of the proceedings.
8. In view of the above considerations, following the provisions of Article 114(2) EPC, saying that the European Patent Office may disregard facts or evidence which are not submitted in due time, the board exercises the discretion conferred to it by Articles 12(4) and 13(1) of the RPBA and decides not to admit the Main Request and Auxiliary Requests 1 and 2 into the appeal proceedings and to admit Auxiliary Request 3 into these proceedings.

Referral of questions to the Enlarged Board of Appeal

9. In the light of the board's decision not to admit the Main request and Auxiliary Requests 1 and 2 into the proceedings, appellant I raised a point of law with regard to the legal basis and the legality of the RPBA

and requested the referral of four questions to the Enlarged Board of Appeal (EBA) according to Article 112 EPC. These questions have been submitted at the oral proceedings in the German language (cf. point XIV *supra*).

10. It is evident from the file that this argument has been presented by appellant I for the first time at the oral proceedings. No reasons have been given why it has not been submitted earlier, so it is for the board to establish the chronological circumstances that led to this argument.

10.1 The statement setting out the Grounds of Appeal and the reply to appellant II's Grounds of Appeal were filed by appellant I on 7 July 2010 and 26 November 2010, respectively, under the name of the former patent proprietor Henkel AG & Co. KGaA. No submissions were filed by appellant I in reply to appellant II's letter of 4 February 2011 in which further experimental data were reported. In order to submit these experimental data, appellant II had previously requested the board for an extension of the time limit for replying to appellant I's statement of Grounds of Appeal. This request was granted by the board on 29 November 2010 with explicit reference to the RPBA, in particular to Article 12(5) RPBA (cf. points IV and V *supra*).

10.2 On 2 July 2013, the proprietor, Henkel AG & Co. KGaA, informed the EPO of the transfer and assignment of the patent-in-suit to the new proprietor BASF SE. A confirmation letter from the new proprietor was received at the EPO on 10 July 2013 and communications of amended entries concerning the transfer and the new representative were issued by the EPO on 15 July 2013. In a communication issued on 31 July 2013, the

Registrar of the board informed the parties of all these amendments. No submissions were filed by the new proprietor at this point of the proceedings, neither with regard to appellant II's request for the extension of the time period, nor with regard to the board's decision to grant of this request or with regard to the admissibility of new experimental data, let alone with regard to the legality of the RPBA in general or with regard to specific Articles of the RPBA on which both this request and their grant were based.

10.3 On 7 November 2013, the board submitted summons for oral proceedings to the parties under Rule 115(1) EPC which, as an Annex, comprised a communication pursuant to Article 15(1) RPBA. In this communication, the board referred, *inter alia*, to Article 12(4) RPBA when informing of its intention not to admit some of the claim requests filed by the patent proprietor/appellant I and to admit the new experimental evidence filed by appellant II (cf. points 9 to 19 of the board's communication). The board also set a date for the parties to file observations and to make further submissions at one month before the scheduled oral proceedings (cf. point VI *supra*). Although in February 2014 both appellants announced their presence at these oral proceedings, none of them filed any substantive submission and no objections were raised in particular concerning the procedural rules governing the appeal procedure as such (cf. point VII *supra*).

10.4 In view of all these facts, the board is convinced that the new patent proprietor/appellant I had ample time and opportunities to address the point of law earlier in the procedure. Instead, it decided to present this fresh case only at the oral proceedings before the

- board, which would give the board the discretion to decide whether it is late filed and thus not admissible (Article 114(2) EPC and Articles 12(4) and 13(1) RPBA).
11. In the board's view, Articles 13(1) and 12(4) RPBA directly derive from *inter alia* Article 114(2) EPC and Rule 116(1) EPC, which enshrine the well-established procedural principle requiring the filing of the parties' facts, evidence and arguments at early stages of the proceedings. Furthermore, the board considers the RPBA to codify also the case law of the Boards of Appeal on established procedural practice (cf. *inter alia*, T 349/09 of 26 February 2010, point 9 of the Reasons and T 214/05 of 19 January 2007, point 1.3 of the Reasons). However, the board is aware that a decision on the referral of questions to the EBA concerning the legitimacy of the RPBA, which decision itself would rely also on the application of specific Articles of these RPBA, is not meaningful. Therefore, the board refrains from taking such decision.
 12. As for appeal proceedings in general, Article 112(1) (a) EPC stipulates that the Board of Appeal, following a request from a party to the appeal, shall refer any question to the EBA if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises.
 - 12.1 The questions drafted by appellant I do not relate to the aim of uniform application of the law. The RPBA are applied by all Boards of Appeal of the EPO and, in particular, the discretion given to the Boards of Appeal by Articles 12(4) and 13(1) RPBA is exercised by all Boards of Appeal for deciding on the admissibility or non-admissibility of facts, evidence or requests

filed in appeal proceedings and/or on the amendment of a party's case in appeal proceedings.

- 12.2 The second alternative according to Article 112(1) (a) EPC concerns the possibility of questions to be referred to the EBA in case there exists an important point of law.

The questions formulated by appellant I rely on the assumption that the Administrative Council of the EPO has entitled the Presidium of the Boards of Appeal to legislate the RPBA, whereas the Administrative Council by itself can only accept the provisions as drafted by the Presidium.

This assumption of appellant I is neither well founded nor in line with the provisions laid down in Article 23(4) EPC which reads: "*(t)he Rules of Procedure of the Boards of Appeal and the Enlarged Board of Appeal shall be adopted in accordance with the Implementing Regulations. They shall be subject to the approval of the Administrative Council*", in combination with Rule 12(3) EPC which reads: "*(t)he Presidium shall adopt the Rules of Procedure of the Boards of Appeal*". Thus, it is clearly in the power of the Presidium to draft the RPBA and to **adopt** a version of these rules to be proposed to the approval of the Administrative Council. Eventually, this is not the result of any illegal delegation of the legislative competence of the Administrative Council, as wrongly submitted by appellant I.

It is the Administrative Council of the European Patent Organisation which **decides**, with respect of the requirements of Article 23(4) EPC and Article 35(1) EPC, **to approve** the RPBA which only thereby have the

force of law and subsequently can be applied by the Boards of Appeal. Any further amendment of the RPBA shall also be approved under the same conditions by the Administrative Council. It is furthermore evident from the decision of the Administrative Council published in the Official Journal of the EPO, on pages 34 and 43 of the "Supplementary publication - Official Journal EPO 1/2014" under the heading "Information from the Boards of Appeal", that it is only and exclusively after the decision of the Administrative Council of the European Patent Organisation to approve the RPBA that they become part of the **legal** procedural system of the EPO. Thus, the legislative power is still unambiguously at the Administrative Council.

13. According to established case law of the Boards of Appeal questions based on unsubstantiated assumptions and hypothetical considerations are not suitable for a referral to the Enlarged Board of Appeal (cf. T 1213/05 of 27 September 2007, points 37 to 41 of the Reasons, and T 118/89 of 19 September 1990, point 5 of the Reasons). Therefore, appellant I's request for referral of questions to the Enlarged Board of Appeal is refused.
14. In the light of this decision, appellant I's considerations concerning the alleged incorrect and undemocratic composition of the Presidium of the Boards of Appeal do not have to be further investigated (cf. point XIV *supra*).

Auxiliary Request 3

Articles 123(2), (3) EPC

15. The subject-matter of Auxiliary Request 3 has been limited to embodiments related, only and exclusively,

to the mutant F49 of sequence SEQ ID NO. 16. The scope of the claims of this request is thus narrower than the scope of the granted claims (Article 123(3) EPC) and there is ample basis for this subject-matter in the application as filed (Article 123(2) EPC). No objections have been raised by appellant II under these Articles and the board sees no reason to raise any of its own motion.

Article 84 EPC

16. In line with the case law of the Boards of Appeal, the purpose-related feature introduced into claim 1 of Auxiliary Request 3 requires the claimed detergent composition to be suitable for that purpose and excludes compositions not suitable for the removal of egg stains from fabrics (cf. point XII *supra*). No ambiguity arises from the introduction of this feature.

17. The K/C activity ratio of the subtilisin protease mutant F49 is disclosed in Example 14 of the patent as being 0.63. This ratio has been obtained using the method described in previous examples of the patent, in particular by using the liquid enzymatic detergent composition described in Example 13 (cf. pages 19 and 20 of the patent). Alterations in the specific composition and/or in the washing conditions used may result in a different K/C activity ratio. The board does not see a contradiction between claim 1, requiring the presence of a specific subtilisin protease mutant F49 in the claimed detergent composition, and the indication of a range for the K/C activity ratio in dependent claim 2 ("*wherein said protease has a keratinase/caseinase activity ratio (K/C ratio) of less than 0.80, preferably less than 0.70.*").

18. Therefore, Auxiliary Request 3 fulfils the requirements of Article 84 EPC.

Articles 83, 54 and 56 EPC

19. No objections have been raised by appellant II under Article 83 EPC nor does the board see a reason to raise any of its own motion either. The subtilisin protease mutant F49 of sequence SEQ ID NO. 16 is disclosed and fully characterized in the patent-in-suit, which also discloses detergent compositions for removal of egg-soot stains from fabrics comprising said mutant F49, and methods for washing fabrics based on this detergent. Thus, Auxiliary Request 3 fulfils the requirements of Article 83 EPC.

20. None of the prior art documents on file discloses a detergent composition for removal of egg stains from fabrics comprising the subtilisin protease mutant F49 encoded by SEQ ID NO. 16, i.e. the subject-matter of claim 1 of Auxiliary Request 3 (cf. point XII *supra*).

Document D2, the sole document cited by appellant II under Article 54 EPC in its Grounds of Appeal, discloses the replacement of the amino acid residue tryptophan (Trp) by, *inter alia*, the amino acid residue aspartic acid (Asp) at position 217 (Y217D) of the subtilisin protease BPN' from *B. amyloliquefaciens* (see Example 10 on page 98 of document D2). It is agreed by all parties that position 217 of the BPN' subtilisin protease corresponds to position 211 of the mutant F49, of the wild type BLAP and of the M131 mutant subtilisin proteases disclosed in the patent. As shown by the sequence alignment in document D11 and acknowledged in the patent (cf. *inter alia*, page 2, paragraph [0003] of the patent), the BPN' subtilisin protease has only 60%

identity to the wild type BLAP subtilisin protease, and it is thus entirely different from the subtilisin protease mutant F49 disclosed in the patent.

Therefore, Auxiliary Request 3 fulfils the requirements of Article 54 EPC.

21. In line with the decision under appeal and appellant II's Grounds of Appeal (cf. page 21, point 29 and page 25, point 44 of the decision under appeal and page 8, point 7.1 of appellant II's Grounds of Appeal), document D4 is identified as representing the closest prior art.

Document D4 discloses mutants of the serine protease PB92 and of the subtilisin enzyme 309 derived from *Bacillus* novo sp. PB92 and the *Bacillus* strain NCIB 10147, respectively (cf. page 2, lines 8 to 15 of document D4). Document D4 further refers to homologues (with at least 70% homology) of these two enzymes. The preferred group of mutant proteases comprises those which differ from PB92 and 309 by at least one mutation disclosed in the document and which include, among others, the mutation [L211E] (cf. *inter alia*, page 7, line 15 to page 8, line 5, page 8, lines 20 and 33, page 9, lines 6-7 and 33, page 11, lines 28-29 of document D4). Advantageous properties and washing performance of several mutants, including [L211E] PB92 mutants, are exemplified on page 21, Table II and pages 22 and 23, Table III of document D4. For the washing performance tests, document D4 refers to relevant stains known in standard washing tests, such as the exemplified cacao stains (cf. page 6, lines 11-13, page 14, Table of document D4).

Starting from this document, the objective technical problem to be solved by the present invention is the provision of a detergent composition comprising a subtilisin protease mutant with high efficiency for removal of a specific stain, namely egg stain. For the solution of this problem, the patent proposes the subject-matter of claim 1, a detergent composition comprising the subtilisin protease mutant F49. According to the examples, the technical problem is solved by the subject-matter of claim 1.

Although, as shown in the sequence alignment in document D5, the serine protease PB92 and the subtilisin enzyme 309 are structurally very similar to the BLAP enzyme from which the subtilisin protease mutants M131 and F49 are derived, there is no hint or suggestion in document D4 or in any other prior art document on file, that would have led a skilled person in a straightforward and obvious manner to a detergent composition comprising the mutant F49 with the specific sequence SEQ ID NO. 16, let alone to foresee its advantageous effect for removal of egg stains from fabrics.

No objections have been raised by appellant II under Article 56 EPC and the board, in view of the above considerations, does not see a reason to raise any of its own motion. Therefore, Auxiliary Request 3 fulfils the requirements of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance with the order to maintain the patent in amended form on the basis of Auxiliary Request 3 filed on 18 March 2014 during the oral proceedings and a description to be adapted thereto.

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated