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**Datasheet for the decision
of 22 January 2015**

Case Number: T 2169/10 - 3.3.02

Application Number: 00990401.2

Publication Number: 1254370

IPC: G01N33/53, C12Q1/68

Language of the proceedings: EN

Title of invention:

METHODS FOR ISOLATING AND CHARACTERIZING ENDOGENOUS mRNA-
PROTEIN (mRNP) COMPLEXES

Applicant:

Ribonomics, Inc.

Headword:

mRNA-protein complexes/RIBONOMICS

Relevant legal provisions:

EPC R. 137, 100(1)

RPBA Art. 12(4)

Keyword:

Oral proceedings - held in absence of the appellant
Admissibility of all requests: no

Decisions cited:

G 0010/93

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

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Case Number: T 2169/10 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 22 January 2015

Appellant: Ribonomics, Inc.
(Applicant) 3908 Patriot Drive
Durham, North Carolina 27703 (US)

Representative: Helbig, Christian
Wagner + Helbig
Patentanwälte
Pfarrstrasse 14
80538 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 5 May 2010 refusing European patent application No. 00990401.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman U. Oswald
Members: K. Giebeler
L. Bühler

Summary of Facts and Submissions

- I. European patent application No. 00 990 401.2, entitled "Methods for isolating and characterizing endogenous mRNA-protein (mRNP) complexes" and published as WO 01/48480, was filed with 33 claims.

Claim 1 of the application as originally filed reads as follows:

"A method of partitioning endogenous cellular mRNA-protein (mRNP) complexes, comprising:
contacting a biological sample comprising a mRNA-protein (mRNP) complex with at least one ligand that specifically binds at least one component of the mRNP complex;
separating the mRNP complex by binding the ligand with a binding molecule specific for the ligand, wherein the binding molecule is attached to a solid support; and then
collecting the mRNP complex by removing the mRNP complex from the solid support."

- II. The examining division refused the application under Article 97(2) EPC and held that the claims of the main request and of auxiliary request 1 before it did not comply with Article 123(2) EPC. Furthermore, the examining division did not admit auxiliary requests 2 and 3 before it under Rule 137(3) EPC.
- III. The applicant (appellant) filed an appeal against this decision. With the statement of grounds of appeal of 15 September 2010, the appellant filed a new main request and new auxiliary requests 1-5.

- IV. On 4 July 2014, the board summoned the appellant to attend oral proceedings on 22 January 2015.

In an annex accompanying the summons pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) expressing the board's preliminary opinion, the board informed the appellant that it was minded not to admit any of the claim requests on file into the proceedings under Rule 137(3) EPC and Rule 12(4) RPBA. Moreover, the board explained in detail why it considered that none of the sets of claims on file met the requirements of both Articles 123(2) and 84 EPC.

- V. With a letter dated 16 January 2015, the appellant informed the board that it would not attend the oral proceedings.

- VI. Oral proceedings before the board were held on 22 January 2015, in the absence of the duly summoned appellant, in accordance with Rule 115 EPC and Article 15(3) RPBA.

- VII. The appellant had requested in writing that the decision of the examining division be set aside and that a patent be granted on the basis of the claims of the main request or, alternatively, of any of auxiliary requests 1 to 5, all filed with the statement of grounds of appeal of 15 September 2010.

Reasons for the Decision

1. The appeal is admissible.

2. The oral proceedings before the board took place in the absence of the appellant, who was duly summoned but decided not to attend, as announced in its letter dated 16 January 2015.

The present decision is based on facts and evidence put forward in the written procedure and on which the appellant had an opportunity to comment.

3. ***Admissibility of claim requests (Rule 137(3) EPC in conjunction with Rule 100(1) EPC; Article 12(4) RPBA)***

- 3.1 All claim requests submitted on appeal differ from those that had been presented to the examining division, not only in that independent claim 1 states different combinations of features, but also in that fifteen additional dependent claims (claims 30-44 of the main request and the corresponding claims of auxiliary requests 1-5) have been introduced. These additional dependent claims were in fact not even present in the claims of the application as filed.

In the statement of grounds of appeal, the appellant merely stated that "further embodiments of the invention as originally filed have been introduced as additional dependent claims", and that "the disclosure is obvious from the specification and Examples" (page 18, second last paragraph of the statement of grounds of appeal). The appellant has neither provided any reasons or arguments as to why these fifteen additional dependent claims were not presented in the first instance proceedings, nor specified where a basis for said claims could be found in the application as filed.

- 3.2 Introducing the fifteen additional dependent claims does not constitute a legitimate reaction to the

reasoning underlying the decision under appeal. Moreover, the introduction of said dependent claims is not related or linked in any recognizable way to the amendments to claim 1.

The board further notes that Rule 137(2) EPC does not apply, because amended sets of claims had already been filed with letters of 1 October 2007, 3 March 2009 and 4 January 2010.

- 3.3 According to decision G 10/93 (OJ EPO 1995, 172), point 4 of the reasons, "proceedings before the boards of appeal in ex parte cases are primarily concerned with examining the contested decision", and thus, the appeal proceedings are intended to review the correctness of the decision under appeal rather than to continue examination by other means.

Pursuant to Rule 12(4) RPBA, it lies in a board's discretion not to admit facts, evidence or requests which could have been presented in the first instance proceedings.

In the present case, all claim requests on file contain the additional fifteen dependent claims, which are not justified as means of redressing the decision under appeal. Furthermore, in its communication sent as an annex to the summons, the board informed the appellant of its intention not to admit the claim requests containing said additional fifteen dependent claims into the proceedings. However, the appellant has not availed himself of the possibility to submit, in writing or at the oral proceeding, a substantive reply to the objections raised, or to file claim requests devoid of said fifteen dependent claims.

In this situation, the board has decided to make use of its discretionary power according to Rule 137(3) EPC, in conjunction with Rule 100(1) EPC, and Article 12(4) RPBA not to admit the claim requests filed with the statement of grounds of appeal into the proceedings.

4. It follows that there is no valid request on file and the appeal therefore has to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

U. Oswald

Decision electronically authenticated