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**Datasheet for the decision
of 31 August 2018**

Case Number: T 0312/12 - 3.3.08

Application Number: 05005783.5

Publication Number: 1580262

IPC: C12N1/20, C12N15/11, C07K14/245

Language of the proceedings: EN

Title of invention:
Method for producing L-amino acid

Patent Proprietor:
Ajinomoto Co., Inc.

Opponent:
Evonik Degussa GmbH

Headword:
Amino acid production/AJINOMOTO

Relevant legal provisions:
EPC Art. 113(1), 123(2), 123(3)
RPBA Art. 12(4)

Keyword:

Main request (granted claims) - added subject-matter (yes)
Auxiliary request 1 - broadening of claim (yes)
Auxiliary request 2 - added subject-matter (yes)
Auxiliary request 3 - could have been filed in first instance proceedings (yes); admitted (no)
Opponent's right to be heard - opposition procedure (yes)

Decisions cited:

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0312/12 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 31 August 2018

Appellant: Ajinomoto Co., Inc.
(Patent Proprietor) 15-1, Kyobashi 1-chome,
Chuo-ku
Tokyo (JP)

Representative: Fischer, Heinrich
Strehl Schübel-Hopf & Partner
Maximilianstrasse 54
80538 München (DE)

Appellant: Evonik Degussa GmbH
(Opponent) Intellectual Property
Rodenbacher Chaussee 4
63457 Hanau (DE)

Representative: Hiebl, Inge Elisabeth
Kraus & Weisert
Patentanwälte PartGmbB
Thomas-Wimmer-Ring 15
80539 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
13 December 2011 concerning maintenance of the
European Patent No. 1580262 in amended form.**

Composition of the Board:

Chairman B. Stolz
Members: P. Julià
D. Rogers

Summary of Facts and Submissions

- I. European patent no. 1 580 262 with the title "Method for producing L-amino acid", based on European patent application no. 05 005 783.5, was granted with a set of 8 claims. The patent was opposed on the grounds of opposition set forth in Articles 100(a) and 100(c) EPC.
- II. In an interlocutory decision, an opposition division maintained the patent in amended form on the basis of an auxiliary request 3. The subject-matter of the main request (granted claims) was considered to extend beyond the content of the application as filed (Article 100(c) EPC), auxiliary request 1 to contravene Article 123(3) EPC, and auxiliary request 2 was found to contravene Article 123(2) EPC. All three auxiliary requests were filed at the oral proceedings before the opposition division.
- III. Appeals were lodged by both the patent proprietor and the opponent (appellants I and II, respectively).

With the statement of grounds of appeal, appellant I requested to set aside the decision under appeal and, as a main request, to reject the opposition or, in the alternative, to maintain the patent upon the basis of any of auxiliary requests 1 to 3 filed with the statement of grounds of appeal.

With the statement of grounds of appeal, appellant II requested to set aside the decision under appeal and to revoke the patent. Appellant II argued that, by admitting auxiliary requests 1 to 3 into the opposition procedure, the opposition division had not correctly exercised its discretion under Article 114(2) EPC and

thereby opponent/appellant II's right to be heard had been violated (Article 113(1) EPC).

As an auxiliary measure, both parties requested oral proceedings.

- IV. The parties replied to their respective statements of grounds of appeal.
- V. The board summoned the parties to oral proceedings. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the board informed them of its provisional, non-binding opinion on some of the issues of the case, in particular that:
i) the subject-matter of the main request (claims as granted) extended beyond the content of the application as filed (Article 100(c) EPC); ii) auxiliary requests 1 and 2 were part of the proceedings; iii) auxiliary requests 1 and 2 contravened Articles 123(3) and 123(2) EPC, respectively; and iv) the admission of auxiliary request 3 into the proceedings had to be discussed at oral proceedings and, in any case, it did not comply with Article 123(2) EPC. Therefore, the patent was likely to be revoked. The board was also of the opinion that the opposition division, when admitting auxiliary requests 1 and 2 into the proceedings, had exercised its discretion correctly and that opponent/appellant II's right to be heard had not been violated (Article 113(1) EPC).
- VI. In reply thereto, appellant I filed further observations and appellant II, without making any substantive submission, informed the board of its intention not to attend the oral proceedings.

VII. Oral proceedings were held on 31 August 2018 in the absence of appellant II.

VIII. Claim 1 as granted (main request) reads as follows:

"1. A bacterium belonging to the genus Escherichia and having an ability to produce an L-amino acid, wherein the ability to produce the L-amino acid is increased by increasing the amount of at least one protein produced in the bacterium and selected from the group consisting of the following proteins of (G) and (H):

(G) a protein having an amino acid sequence shown in SEQ ID NO: 16 in Sequence Listing; or

(H) a protein which has an amino acid sequence including deletion, substitution, insertion, addition or inversion of one or several amino acids in the amino acid sequence shown in SEQ ID NO: 16 in Sequence Listing, and which has an activity of increasing the ability to produce the L-amino acid of the bacterium having the protein, wherein the copy number of a DNA coding for said protein in a cell is increased, and/or the expression regulatory sequence of a DNA coding for said protein is replaced by a strong expression regulatory sequence."

IX. Claim 1 of auxiliary requests 1, 2 and 3 differ from claim 1 as granted by the following amendments:

AR1: "1. [...] , and/or the expression regulatory sequence of a DNA coding for said protein is replaced by a ~~strong~~ stronger expression regulatory sequence."

AR2: "1. [...] , and/or the ~~expression regulatory sequence~~ promoter of a DNA coding for said protein is

replaced by a strong ~~expression regulatory sequence~~ promoter."

AR3: "1. [...] , and/or the ~~expression regulatory sequence~~ promoter of a DNA coding for said protein is replaced by a ~~strong expression regulatory sequence~~ lac promoter, trp promoter, tac promoter, P_R promoter or P_L promoter of lambda phage."

X. The submissions made by appellant I, insofar as relevant to the present decision, may be summarised as follows:

Main request (Claims as granted)

Article 100(c) EPC

Claim 1 was a product-claim directed to an *Escherichia* bacterium which, regardless of the method used for its production, was required to have an increased L-amino acid production. The replacement of the expression regulatory sequence by a strong expression regulatory sequence was a feature related to the method of production of the claimed bacterium and had to provide the increased L-amino acid production. The actual strength of the original expression regulatory sequence was thus irrelevant because, regardless thereof, the replacement had to result always in an increased amino acid production. It could be assumed, for instance, that the original expression regulatory sequence was inactive. The replacement of such a non-functional sequence by any other functional expression regulatory sequence, regardless of whether strong or weak, always resulted in an increased amino acid production. The actual strength of the original expression regulatory sequence was thus irrelevant because even a weak expression regulatory sequence, in an absolute sense,

could be a strong expression regulatory sequence, in a relative sense, when compared with the original sequence. This was in fact the actual meaning of the term "strong" in claim 1 and this meaning/term was clearly and unambiguously supported by the disclosure on page 11, last paragraph of the application as filed.

Admission of auxiliary requests 1 and 2

These auxiliary requests were identical to auxiliary requests 1 and 2 underlying the decision under appeal. They were thus already part of the present proceedings.

Auxiliary request 1

Article 123(3) EPC

Claim 1 as granted required the claimed bacterium to have an increased amino acid production. This bacterium could be produced by two methods: by increasing the copy number of the DNA coding for the protein referred to in the claim, or by replacing the expression regulatory sequence of a DNA coding for said protein by a strong expression regulatory sequence. In the context of claim 1 as granted, the term "strong" could only mean stronger than the original expression regulatory sequence because the increased amino acid production could only be achieved by a stronger expression regulatory sequence. The replacement of the term "strong" in claim 1 as granted by the term "stronger" in auxiliary request 1 did not thus extend the scope of the claim but merely reworded the claim so as to make clear what was already implicit in granted claim 1.

Auxiliary request 2

Article 123(2) EPC

The wording of the amended feature in claim 1 corresponded *expressis verbis* to the wording on page 11, lines 19 to 25 of the application as filed, wherein it was stated that the promoter of the amino acid excretion protein gene was replaced by a strong promoter and five well-known strong promoters were explicitly listed.

Admissibility of auxiliary request 3

In the communication attached to the Summons to attend oral proceedings, the opposition division considered the objection under Article 100(c) EPC not to be relevant and the term "strong" in granted claim 1 to be directly and unambiguously derivable from the application as filed. At the oral proceedings, the patent proprietor was therefore surprised by the view taken by the opposition division that this objection was highly relevant and precluded the maintenance of the granted patent. The representative of the patent proprietor had to react to this unexpected situation by filing *ad hoc* auxiliary requests 1 to 3 without being able to contact the patent proprietor in Japan. It was only in appeal proceedings that the patent proprietor/appellant I had an actual chance to file the new auxiliary request 3. This request was filed at the earliest possible stage of the appeal proceedings, with the statement of grounds of appeal and had thus to be admitted into the proceedings. In reply to appellant II's statement of grounds of appeal, auxiliary request 3 filed with the grounds of appeal was replaced by an auxiliary request 3 amended to correct a mere clerical error.

XI. The submissions made by appellant II in writing and insofar as relevant to the present decision may be summarised as follows:

Main request (Claims as granted)
Article 100(c) EPC

The last paragraph on page 11 of the application as filed referred only to a replacement of the expression regulatory sequence by a stronger expression regulatory sequence, not by strong expression regulatory sequences in general. This disclosure did not support the term "strong" in granted claim 1.

Exercise of discretion by the opposition division;
right to be heard

Rule 116(1) EPC required the opposition division to fix a final date for making written submissions in preparation of the oral proceedings and stated that facts/evidence filed after that date did not need to be considered. Rule 116(2) EPC required a patent proprietor to submit the requests before the final date set by the opposition division. In the present case, the patent proprietor submitted no requests before the oral proceedings and it was only during these proceedings that auxiliary requests 1 to 3 were filed. These requests were thus clearly late-filed and to admit them into the proceedings was incorrect. In view of the amendments introduced into these requests, it was clear that they could have been filed at an earlier stage of the proceedings. Moreover, it could not have been expected from the opponent to examine/deal with these auxiliary requests at the oral proceedings before the opposition division. By admitting and considering

them, the opposition division had violated opponent/
appellant II's right to be heard.

Auxiliary request 1

Article 123(3) EPC

The term "strong" in claim 1 as granted referred to a limited group of expression regulatory sequences in which the original promoter was replaced by a strong promoter, such as those listed on page 11, lines 22 to 25 of the application as filed. The term "stronger" in claim 1 of auxiliary request 1 allowed for a different gradation of the promoter used to replace the original one, such as promoters that were outside the limited and clearly defined group of strong promoters. Claim 1 of auxiliary request 1 comprised thus a larger group of expression regulatory sequences than granted claim 1. Thereby, the scope of the claim was extended when compared with that of the granted claim.

Auxiliary request 2

Article 123(2) EPC

On page 11, lines 19 to 21 of the application as filed, it was stated that the increase in the amino acid production was achieved by replacing an expression regulatory sequence such as a promoter of the amino acid excretion protein gene with a stronger one. The mere replacement of a strong promoter by another strong promoter was not directly and unambiguously derivable from this disclosure.

Admissibility of auxiliary request 3

In reply to the board's communication, appellant II did not file any substantive submission on this issue (cf. point VI *supra*).

XII. The appellant I (patent proprietor) requested to set aside the decision under appeal and, as a main request, to maintain the patent as granted or, alternatively to maintain the patent upon the basis of one of auxiliary requests 1 or 2, both submitted under cover of a letter dated 26 March 2012, or auxiliary request 3 submitted under cover of a letter dated 3 September 2012.

XIII. The appellant II (opponent) requested, in writing, to set aside the decision under appeal and to revoke the patent. Appellant II requested also that auxiliary requests 1 and 2 not be admitted into the proceedings.

Reasons for the Decision

The disclosure of the application as filed

1. The application as filed discloses a bacterium of the genus *Escherichia* having an increased L-amino acid production capacity achieved by increasing an expression amount of at least one protein selected from the group of proteins (A) to (H) (cf. page 3, lines 6 to 12). Claim 1 as granted is directed to such a bacterium, wherein the selected proteins are the protein (G) with the amino acid sequence shown in SEQ ID NO: 16 and the related protein (H) (cf. point VIII *supra*). For increasing the expression amount of these proteins, the application as filed refers to increasing the copy number of the DNA coding for said protein in a cell (cf. *inter alia*, page 5, lines 18 to

20; page 7, lines 10 to 12; page 9, line 26 to page 11, line 16).

2. On page 11, last paragraph of the application as filed, it is stated that:

*"Besides the above-mentioned gene amplification, the increase of the expression amount of the amino acid excretion protein can be also achieved by replacing an expression regulatory sequence such as a promoter of the amino acid excretion protein gene with **stronger** one ... For example, lac promoter, trp promoter, tac promoter, P_R promoter and P_L promoter of lambda phage, and the like are known as a **strong** promoter."* (emphasis by the board)

3. Example 1 of the application as filed discloses the preparation of plasmids containing DNA coding for proteins (A), (C), (E) and (G), and Examples 2 to 8 report the effect of introducing these plasmids (i.e. increasing the copy number of a DNA coding for these proteins) into several host cells. There is, however, no example based - solely - on the replacement of the expression regulatory sequence of a DNA coding for any of the proteins (A) to (G), including the protein (G) (YggA protein/yggA gene) or the protein (H) cited in claim 1 as granted. In fact, there is no information in the application as filed on the properties (such as strength, inducible/constitutive, etc.) of the expression regulatory sequences of any of proteins (A) to (H). And thus, there is no information or evidence in the application as filed showing whether an expression regulatory sequence, such as a promoter, of a DNA coding for any of the proteins (G) or (H) is as strong as, or stronger than, a strong expression

regulatory sequence, such as the strong promoters referred to, and listed in, the application as filed.

Main request (Claims as granted)

Article 100(c) EPC

4. Claim 1 of this request requires that "*the expression regulatory sequence of a DNA coding for said protein is replaced by a **strong** expression regulatory sequence*" (emphasis by the board) (cf. point VIII *supra*). As a basis for this feature, appellant I has given the disclosure found on page 11, last paragraph. In this paragraph, there is a first reference to "*replacing an expression regulatory sequence such as a promoter of the amino acid excretion protein gene with **stronger** one*" (emphasis by the board), and only afterwards, reference is made to a list of five specific strong promoters (cf. point 2 *supra*). Whilst the former reference defines the strength of the expression regulatory sequence in a relative sense (i.e. in comparison to the original expression regulatory sequence), the strength is defined in an absolute sense in the second reference. The board agrees with appellant II that this paragraph of the application as filed does not provide a basis for a replacement of the expression regulatory sequence by a strong expression regulatory sequence in general.

5. Appellant I argues that, in the absence of any information on the properties of the original expression regulatory sequence, it is fair to assume that the original expression regulatory sequence could be inactive or non-functional and thus, any active expression regulatory sequence would be stronger than the original sequence, regardless of whether the active sequence is a strong or a weak expression regulatory

sequence in absolute terms. This is, according to appellant I, the actual meaning of the term "strong" in granted claim 1 and the claimed subject-matter is therefore directly and unambiguously derivable from the application as filed (cf. point X *supra*).

6. By the same token, the board considers that, in the absence of any information on the properties of the original expression regulatory sequence, it is also fair to assume that the original expression regulatory sequence may well be a strong expression regulatory sequence. The replacement of such a strong expression regulatory sequence by another strong expression regulatory sequence, in particular those which are known in the art as strong in an absolute sense but weaker than the original expression sequence, i.e. weaker in a relative sense, has certainly no basis in the application as filed.

7. The board does not agree with appellant I that the fact that granted claim 1 requires the claimed bacterium to have an increased L-amino acid production excludes replacements such as those considered above because, according to appellant I, they would not provide an increased L-amino acid production (cf. point X *supra*). In the board's view, granted claim 1 comprises not only two alternatives for increasing the L-amino acid production, namely an increase of the copy number of a DNA coding for proteins (G)/(H) or a replacement of the expression regulatory sequence of these proteins by a strong expression regulatory sequence, but it also comprises a third alternative based on the combination of the other two alternatives, namely an increase of the copy number of a DNA coding for proteins (G)/(H) and a replacement of the expression regulatory sequence

of these proteins by a strong expression regulatory sequence.

8. Indeed, such a combination is disclosed on page 12, lines 1 to 3 of the application as filed, wherein it is stated that "[t]he enhancement of the expression regulatory sequence may be combined with the increase of the copy number of the amino acid excretion protein". This disclosure requires that both, the increase in the DNA copy number and the replacement of the expression regulatory sequence, must provide an increased L-amino acid production. This requirement is however not present in claim 1 as granted which is thus, broader than, or extends beyond, the original disclosure. Claim 1 as granted comprises embodiments in which the DNA copy number is increased - thereby achieving a bacterium with an increased L-amino acid production - and the expression regulatory sequence is replaced by a strong expression regulatory sequence which may be however weaker than the original sequence. There is no basis in the application as filed for these embodiments falling within the scope of granted claim 1.

9. The subject-matter of the main request therefore extends beyond the content of the application as filed (Article 100(c) EPC).

Exercise of discretion by the opposition division; right to be heard

10. In the "Minutes of the oral proceedings before the opposition division" (hereinafter "the Minutes"), it is stated that the opponent/appellant II requested not to admit auxiliary request 1 "as it was late filed without good grounds" (page 1, third paragraph from the

bottom), and also not to admit auxiliary requests 2 and 3 "as late filed" (page 2, last paragraph but one; page 3, fourth paragraph).

11. According to the established case law, if the way in which the opposition division has exercised its discretion when deciding on a procedural matter is challenged in an appeal, it is not the function of the board to review all the facts and circumstances of the case as if it were in the place of the opposition division, and to decide whether or not it would have exercised such discretion in the same way as the opposition division. The board will only overrule the way in which the opposition division has exercised its discretion, if the board concludes that it has done so according to the wrong principles or in an unreasonable way (cf. "Case Law of the Boards of Appeal of the EPO", 8th edition 2016, III.K.5, 761, and case law referred to therein).
12. In the Minutes, it is stated that the opposition division "pointed out that it is general practice to allow ARs in OP and that the invitation [i.e. the Summons to attend the oral proceedings] makes no definitive statements". Accordingly, the request not to admit auxiliary request 1 was rejected (page 1, last paragraph but one of the Minutes). For auxiliary requests 2 and 3, the opposition division rejected/refused the opponent's request "but noted it" (page 2, last paragraph but one; page 3, fourth paragraph). There is however no reference in the decision under appeal to the reasons for admitting auxiliary requests 1 to 3.
13. Although not desirable, the filing of claim requests at oral proceedings is not uncommon practice. Whilst a

late-filing *per se* does not necessarily imply that the request is not admissible, the fact that late-filed requests are, under certain circumstances, admissible does not necessarily imply that all late-filed requests are admissible (cf. "Case Law", *supra*, IV.D.4.1.3, 1040).

14. According to the Minutes, the oral proceedings were interrupted when the patent proprietor filed auxiliary requests 1 and 3. After the break, the opponent requested the auxiliary requests not to be admitted into the proceedings but it did not request more time for further examination of these auxiliary requests, nor a postponement of the oral proceedings due to the nature of the amendments introduced into the requests. Auxiliary requests 1 to 3 were thus admitted into the opposition proceedings, examined by the opposition division and, after hearing all arguments of the parties, a decision on these requests was taken and the reasons for this (interlocutory) decision given in the decision under appeal.

15. Apart from the late filing and the nature of the amendments, no other arguments have been provided by appellant II to support the assertion that the opposition division exercised its discretion according to a wrong principle or in an unreasonable way. No such argument has been provided in reply to the board's communication under Article 15(1) RPBA, nor has appellant II availed himself of the opportunity to submit such argument at the oral proceedings before the board.

16. In view thereof, the board considers that the opposition division exercised its discretion correctly and is convinced that the opponent/appellant II's right

to be heard was not violated (Article 113(1) EPC). Thus, auxiliary requests 1 and 2, filed at the oral proceedings before the opposition division and submitted again with appellant I's statement of grounds of appeal, are already part of the appeal proceedings.

Auxiliary request 1

Article 123(3) EPC

17. According to claim 1, an increased L-amino acid production is achieved by increasing the copy number of a DNA coding for proteins (G) or (H), and/or by replacing the expression regulatory sequence of this DNA "by a **stronger**" expression regulatory sequence (emphasis by the board) (cf. point IX *supra*). This feature is disclosed on page 11, lines 19 to 21, of the application as filed (Article 123(2) EPC).
18. This feature requires the replacement of the expression regulatory sequence of a DNA coding for proteins (G) or (H) by an expression regulatory sequence stronger than the original sequence but it does not require that this stronger sequence is a strong expression regulatory sequence in the absolute sense known in the art. In other words, claim 1 comprises bacteria of the genus *Escherichia* in which the original expression regulatory sequence may be replaced by a weak expression regulatory sequence as long as said weak expression regulatory sequence is stronger than the original sequence, i.e. the term "stronger" in claim 1 is meant to have only a relative sense.
19. This group of expression regulatory sequences, namely weak expression regulatory sequences, is certainly not comprised in granted claim 1 because it clearly requires the original expression regulatory sequence to

be replaced by a strong expression regulatory sequence in an absolute sense, regardless of the actual strength - whether strong or weak - of the original sequence.

20. Therefore, claim 1 of auxiliary request 1 comprises subject-matter beyond that of granted claim 1 and contravenes thus Article 123(3) EPC.

Auxiliary request 2

Article 123(2) EPC

21. Claim 1 of this request requires the increased L-amino acid production to be achieved by increasing the copy number of a DNA coding for proteins (G) or (H), and/or by replacing the **promoter** of this DNA "by a **strong promoter**" (emphasis by the board) (cf. point IX *supra*). The disclosure on page 11, last paragraph of the application as filed has been given as a basis for this feature.
22. The board agrees with appellant I that this paragraph discloses the use of strong promoters, such as those well-known in the art and explicitly listed therein, for replacing the original promoter of the DNA coding for proteins (G) or (H). However, this disclosure also requires that, regardless of its actual strength, the original promoter must always be replaced by a stronger promoter.
23. In line with the decision taken for the main request, the board considers that, in the absence of any information on the properties of the original promoter, it may well be assumed that the original promoter is a strong promoter in an absolute sense. In that case, claim 1 of auxiliary request 2 comprises embodiments in which the original strong promoter is replaced by

another strong promoter which, however, may be weaker than the original one. There is certainly no basis in the application as filed for these embodiments.

24. Thus, claim 1 comprises subject-matter that has no basis in the application as filed and auxiliary request 2 contravenes Article 123(2) EPC.

Admissibility of auxiliary request 3

25. Auxiliary request 3 was filed by appellant I in reply to appellant II's statement of grounds of appeal and replaces a former auxiliary request 3 filed with appellant I's statement of grounds of appeal. According to appellant I, the amendment introduced into this request addresses only a clerical error in the former auxiliary request 3.

26. Regardless of this amendment, the subject-matter of auxiliary request 3 is characterized by a feature that requires the promoter of a DNA coding for proteins (G) or (H) to be replaced by a promoter selected from the list of five strong promoters specifically mentioned on page 11, last paragraph of the application as filed (cf. points IX and 2 *supra*). The board observes that, in auxiliary request 2 filed at first instance (and maintained in appeal), the corresponding feature required the original promoter to be replaced by a strong promoter defined only in generic terms. In auxiliary request 3 filed at first instance, this feature was deleted so that the increased L-amino acid production was achieved only by increasing the DNA copy number. Thus, the subject-matter of auxiliary request 3 filed in appeal falls in-between that of auxiliary requests 2 and 3 filed at first instance. Under these circumstances, the board is convinced that auxiliary

request 3 filed in appeal could, and should, have been filed at an earlier stage of the proceedings (Article 12(4) RPBA).

27. Moreover, the board considers the reasons given by appellant I to explain the filing of auxiliary request 3 only in appeal proceedings, not to be convincing.

27.1 Appellant I argues that, in the communication attached to the "Summons to attend oral proceedings", the opposition division considered the term "strong" in granted claim 1 to have a basis in the application as filed and, accordingly, the ground of opposition set forth in Article 100(c) EPC not to be relevant. At oral proceedings, the patent proprietor/appellant I was therefore surprised by the view taken by the opposition division that this ground of opposition was highly relevant (cf. point X *supra*).

In the board's view, the opposition division's communication provided only a provisional opinion ("*the opposition division tends to agree with the patent proprietor*") which could not be taken as definitive and not susceptible to change. The purpose of a provisional opinion is to give the parties an opportunity to present their arguments anew and, if necessary, try to convince the opposition division of their correctness. In the present case, the patent proprietor/appellant I should have expected the opponent/appellant II to react in such a way, i.e. to maintain its objection raised under Article 123(2) EPC and to try to convince the opposition division that the ground of opposition set forth in Article 100(c) EPC was, contrary to the expressed provisional opinion, highly relevant.

Indeed, in a reply to the opposition division's communication attached to the "Summons" filed before the oral proceedings, the opponent/appellant II provided further submissions and argued for the relevance of the ground of opposition set forth in Article 100(c) EPC. Thus, the patent proprietor/appellant I could well have contemplated, as a possible outcome of the oral proceedings at first instance, that the opposition division changed its provisional opinion and, accordingly, it could have filed a set of claims trying to overcome said ground of opposition.

27.2 The filing of such a set of claims at an earlier stage of the proceedings was all the more necessary in view of the representative's argument based on the difficulties encountered in contacting the patent proprietor in Japan and getting appropriate instructions during the oral proceedings at first instance. Indeed, if the patent proprietor did not intend to attend the oral proceedings, the filing of auxiliary requests addressing all objections, especially those that had been on file from the very beginning of the proceedings, was all the more imperative. By neither filing such requests nor attending the oral proceedings, the patent proprietor has run the risk of not being prepared for all possible outcomes of these proceedings.

28. In view of all the considerations above, the board, in the exercise of its discretion pursuant to Article 12(4) RPBA, decides not to admit the auxiliary request 3 into the appeal proceedings.

Conclusion

29. Since neither the main request nor auxiliary requests 1 and 2 fulfill the requirements of the EPC, the patent has to be revoked.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated