

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 30 July 2013**

Case Number: T 0332/12 - 3.3.08
Application Number: 01924218.9
Publication Number: 1343877
IPC: C12N 9/16, C12N 9/22, C12Q 1/68
Language of the proceedings: EN

Title of invention:

Stable composition comprising a nuclease and a phosphatase

Applicant:

Affymetrix, Inc.

Headword:

Stable composition/AFFYMETRIX

Relevant legal provisions:

EPC Art. 123(2), 83, 84, 111(1)
RPBA Art. 12(4)

Keyword:

"Main request and auxiliary requests 1-8 not admitted"
"Auxiliary request 9 - amendments (yes), clarity (yes),
sufficiency of disclosure (yes) - remittal to first instance"

Decisions cited:

-

Catchword:

-



Case Number: T 0332/12 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 30 July 2013

Appellant: Affymetrix, Inc.
(Applicant) 3420 Central Expressway
Santa Clara, CA 95051 (US)

Representative: Tombling, Adrian George
Withers & Rogers LLP
4 More London Riverside
London SE1 2AU (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 19 September 2011
refusing European patent application
No. 01924218.9 pursuant to Article 97(2) 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 examining division to refuse European patent application No. 01 924 218. The examining division held that the main request and auxiliary request 3 before it did not meet the requirements of Article 123(2) EPC, and that auxiliary requests 1 and 2 did not meet the requirements of Articles 83 and 84 EPC.
- II. With its grounds of appeal, the appellant filed a new main request and new auxiliary requests I to IV.
- III. The appellant was summoned to oral proceedings to be held on 30 July 2013. A communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) annexed to the summons, informed it of the preliminary non-binding opinion of the board that none of the requests on file seemed to meet the requirements of Articles 123(2) EPC and of Article 83 EPC.
- IV. With letter dated 27 June, the appellant submitted a new main request and new auxiliary requests 1 to 10.
- V. Oral proceedings were held on 30 July 2013.
- VI. Independent claim 1 of the main request, and of auxiliary requests 1 and 2 refers to (emphasis added):
- "1. A composition comprising a nuclease and a phosphatase, ...".

Independent claim 1 of auxiliary requests 3 to 8 refers to:

"1. A composition comprising Exonuclease I and an alkaline phosphatase, ...".

VII. Independent claim 1 of auxiliary request 9 reads as follows:

"1. A composition comprising Exonuclease I and shrimp alkaline phosphatase, said composition being free from the presence of amplified deoxyribonucleic acid, wherein said composition further comprises at least 20 volume percent of a stabilizer selected from the group consisting of glycerol, ethylene glycol and glycine."

VIII. Appellants arguments as far as relevant for the present decision can be summarized as follows:

During examination, the claimed subject matter was restricted to compositions comprising Exonuclease I (ExoI) and shrimp alkaline phosphatase (SAP). Further limitations were introduced into the claims to overcome additional objections but were not accepted by the examining division. In appeal proceedings, the appellant was entitled to switch back to broader claims. This did not pose a problem because the broad subject matter had been searched.

Basis for claim 1 of auxiliary request 9 could be found in original claim 13 in combination with page 12, lines 32 to 34, and in all the exemplary compositions.

The claimed subject matter was clearly defined and sufficiently disclosed.

Should the board find one or more of the requests to meet the requirements of Articles 123, 83 and 84 EPC, the case should, in line with general policy, be remitted to the first instance for further examination of novelty and inventive step.

- IX. The final requests of the appellant were that the decision under appeal be set aside and that a patent be granted on the basis of the main request or of one of the auxiliary requests 1 to 10 or, in the alternative, that the case be remitted to the examining division for further prosecution on the basis of the auxiliary request 9.

Reasons for the decision

Article 12(4) RPBA

1. According to the established case law of the Boards of Appeal, the function of appeal proceedings is to give a decision upon the correctness of a separate earlier decision taken by a department of first instance (cf. "Case Law of the Boards of Appeal of the EPO", 6th edition 2010, VII.E.1, page 821). In line therewith, Article 12(4) RPBA states that it is within the power of the board to hold inadmissible facts, evidence or requests which could have been admitted in the first instance. Although new requests with amended claims may exceptionally be admitted in appeal proceedings, it is not the purpose of the appeal to give the appellant the

opportunity to recast its claims as it sees fit and to have all its requests admitted into these proceedings (cf. "Case Law", supra, VII.E.16.1.2, page 889).

2. In the written procedure, the examining division repeatedly raised objections under Articles 83 and 84 EPC against claims referring to compositions defining the subject matter in broad terms. It considered it an undue burden of experimental work on the skilled person to elaborate the conditions for obtaining stable compositions comprising a nuclease and a phosphatase other than ExoI and SAP (cf. communications dated 18 April 2006, point 4.2, and 9 September 2009, point 5.2). In response to the second communication, the applicant restricted the claimed subject matter to compositions comprising ExoI and SAP. In fact, all requests underlying the appealed decision (main request and auxiliary requests 1 to 3) were claiming compositions comprising ExoI and SAP.

The unresolved issues leading to the decision under appeal concerned amendments which the examining division considered to contravene the requirements of Article 123(2) EPC (main request and auxiliary request 3) and issues under Article 83 EPC (auxiliary requests 1 and 2).

3. The main request and auxiliary requests 1 to 8 now on file refer to compositions defining the nucleases and/or phosphatases in broader terms (cf. item VI, above).

A request corresponding to the main request or any of auxiliary requests 1 to 8 has not been at the examining division's disposition when it issued the decision under

appeal. Admitting the main request or any of auxiliary requests 1 to 8 at this stage of the proceedings would thus undermine the purpose of appeal proceedings, i.e. the review of the decision under appeal as established in the case law.

4. Exercising its discretion under Article 12(4) RPBA, the board therefore decided not to admit the main request and auxiliary requests 1 to 8.

Auxiliary request 9 refers to compositions comprising ExoI and SAP and was admitted into the proceedings.

Auxiliary request 9

Article 123(2) EPC

5. Basis for claim 1 can be found in claim 13 as originally filed in combination with the general teaching of ExoI and SAP as the preferred enzymes (cf. e.g. page 12, lines 32-34, page 13, lines 19-20, and all Examples).

Basis for dependent claims 2 to 8, further specifying individual features, can be found on pages 14 and 15 as originally filed.

6. The board is therefore satisfied, that the requirements of Article 123(2) EPC are met.

Article 84 EPC

7. The composition of claim 1 comprises ExoI, SAP and at least 20% of either glycerol or ethylene glycol or glycine.

8. The subject matter is clearly defined, and supported by the description.

Article 83 EPC

9. The claims of all requests underlying the decision under appeal referred to a certain stability of ExoI and/or SAP, i.e. they referred to a technical effect imposing a functional limitation on the claimed subject matter.

According to decision G 1/03, "[i]f an effect is expressed in a claim, there is lack of sufficient disclosure. Otherwise, i.e. if the effect is not expressed in a claim but is part of the problem to be solved, there is a problem of inventive step" (point 2.5.2 of decision G 1/03).

The examining division rightly assessed whether the subject matter of the claims before it was disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person.

10. The claims of auxiliary request 9 no longer contain a functional limitation and the board is convinced that the skilled person is in a position to readily produce the claimed compositions. Whether the claims as presently worded encompass subject matter not suitable to solve any yet to be defined technical problem will have to be assessed under the provisions of Article 56 EPC.
11. The board is satisfied that auxiliary request 9 meets the requirements of Articles 83 and 84 EPC.

Article 111(1) EPC

12. Novelty and inventive step were not addressed in the decision under appeal, and the appellant requested that the case be remitted to the first instance for further examination on the basis of auxiliary request 9.
13. Under the circumstances of the case, the board decided to remit it to the examining division for further examination (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of auxiliary request 9 filed with letter of 27 June 2013.

The Registrar:

The Chairman:

A. Wolinski

M. Wieser