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Datasheet for the decision of 9 April 2019

Case Number: T 0982/14 - 3.3.08

Application Number: 05815027.7

Publication Number: 1824969

IPC: C12N9/12, C12N15/54, C12N1/19, C12N1/21, C12Q1/48, C12P23/00, A61K38/45

Language of the proceedings: EN

Title of invention:
Improved mevalonate kinase

Patent Proprietor:
DSM IP Assets B.V.

Opponent:
Maiwald Patent- und Rechtsanwaltsgesellschaft mbH

Headword:
Mevalonate kinase mutants/DSM

Relevant legal provisions:
EPC R. 115(2)
RPBA Art. 12(4), 15(3)

Keyword:
Late-filed request - admitted (no)

Decisions cited:
G 0009/91, T 1836/12

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0982/14 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 9 April 2019

Appellant: (Patent Proprietor)	DSM IP Assets B.V. Het Overloon 1 6411 TE Heerlen (NL)
Representative:	Schwander, Kuno DSM Nutritional Products Ltd., Wurmisweg 576 4303 Kaiseraugst (CH)
Respondent: (Opponent)	Maiwald Patent- und Rechtsanwaltsgesellschaft mbH Elisenhof Elisenstrasse 3 80335 München (DE)
Representative:	Lasar, Andrea Gisela Maiwald Patentanwalts- und Rechtsanwaltsgesellschaft mbH Elisenhof Elisenstraße 3 80335 München (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 5 March 2014 revoking European patent No. 1824969 pursuant to Article 101(2) and 101(3)(b) EPC.**

Composition of the Board:

Chairman	B. Stolz
Members:	M. Montrone
	D. Rogers

Summary of Facts and Submissions

I. An appeal was lodged by the patent proprietor (hereinafter the "appellant") against the decision of an opposition division to revoke the European patent No. 1 824 969, having the title "*Improved mevalonate kinase*".

II. With its statement of grounds of appeal, the appellant submitted a new and sole claim request.

III. In reply, the opponent (hereafter the "respondent") submitted *inter alia* arguments as to why the new claim request should not be admitted into the appeal proceedings.

IV. The parties were summoned to oral proceedings. In a communication pursuant to Article 15(1) RPBA, the parties were informed of the board's provisional, non-binding opinion on some of the legal and substantive matters of the case. In reply thereto, the appellant and the respondent announced that they would both not be attending the oral proceedings. Moreover, none of the parties submitted substantive arguments in response to any of the issues raised in the board's communication.

V. Oral proceedings before the board were held on 9 April 2019, in the absence of both parties.

VI. Claim 1 of the sole claim request reads:

1. A modified mevalonate kinase which exhibits a sensitivity to feedback inhibition which is reduced in comparison to the corresponding non-modified mevalonate kinase characterized in that the amino acid sequence of

the modified mevalonate kinase contains at least one of the following mutations corresponding to the amino acid sequence of *Saccharomyces cerevisiae* mevalonate kinase as shown in SEQ ID NO:1:

- P55L, F59S, N66K, C117S, I152M;

- P55L/C117S, N66K/I152M, K83E/S249P, H111N/K375N, L106P/S218P;

- I142N/L158S/L231I/T367S.

VII. The respondent's arguments, insofar as relevant to the present decision, may be summarised as follows:

Admission of the sole request into the appeal proceedings (Article 12(4) RPBA)

The new claim request should not be admitted into the appeal proceedings. The issue that the subject-matter of claim 1 was broadly defined was known to the appellant since the early written phase of the opposition proceedings. Thus, the present set of claims aimed at remedying this issue could have been filed during the first instance proceedings.

VIII. The appellant requests that the decision under appeal be set aside and that the patent be maintained on the basis of the sole claim request filed with its statement of grounds of appeal.

IX. The respondent requests that the appeal be dismissed and the sole claim request submitted with appellant's statement of grounds not be admitted into the appeal proceedings.

Reasons for the Decision

1. The duly summoned parties did not attend the oral proceedings, which in accordance with Rule 115(2) EPC and Article 15(3) RPBA took place in their absence.

2. The appeal is admissible.

Article 113(1) EPC

3. The board in its communication pursuant to Article 15(1) RPBA expressed a reasoned provisional opinion on the issues to be discussed at the oral proceedings, which included the admission of the sole set of claims into the appeal proceedings (Article 12(4) RPBA).

4. The appellant did not provide any substantive comments or arguments in reply to the board's communication pursuant to Article 15(1) RPBA (cf. point V supra). Moreover, by not attending the oral proceedings, the appellant decided not to avail itself of another opportunity to orally address or comment on the issues raised by the board in its communication. The present decision is therefore based on the same grounds, arguments and evidence on which the provisional opinion of the board was based.

Admission of the sole claim request into the appeal proceedings (Article 12(4) RPBA)

5. The primary function of appeal proceedings is to give a judicial decision upon the correctness of an earlier decision taken by a department of the European Patent Office (see G 9/91, OJ EPO 1993, 408). The purpose of

appeal proceedings is not to give the appellant the opportunity to re-cast its claims as it likes and to have such claim requests admitted as of right into the appeal proceedings. In fact, it is a matter of discretion of the board whether or not requests and evidence filed for the first time in appeal proceedings, but which could have been presented in the previous proceedings, are admitted and considered (see Article 12(4) RPBA).

6. The present set of claims has been submitted by the appellant with its statement of grounds of appeal. Claim 1 of this request differs from that dealt with in the decision under appeal essentially in that features (i) and (ii) of former claim 1 are combined, wherein in (ii) the following features were deleted: "the at least one mutation is at one or more amino acid position(s) selected from the group consisting of amino acid positions corresponding to positions 55, 59, 66, 83, 111, 106, 117, 142, 152, 158, 218, 231, 249, 367 and 375". The amendment in claim 1 aimed at limiting the modified mevalonate kinases to the specifically recited mutants.

7. In the communication pursuant to Article 15(1) RPBA, the board explicitly addressed the issue of admission of the present set of claims into the proceedings. In this context it was noted that no reasons were provided by the appellant why the present set of claims could not have been filed in the first instance proceedings, although the opponent had raised during the early written phase of the opposition proceedings the issue that former claim 1 dealt with in the decision under appeal was not limited to the recited mutants (see letter dated 26 November 2012, page 1, point 1 a)). A view, likewise shared by the opposition division (see

communication annexed to the summons to oral proceedings, point 5.4).

8. The appellant neither replied to the board's communication nor attended the oral proceedings, despite the board's negative opinion on the issue of admission of the present set of claims. In these circumstances, the board in exercise of its discretion (Article 12(4) RPBA), does not admit the sole claim request into the appeal proceedings.

9. Given that the appellant's sole claim request has not been admitted into the proceedings and there is no request upon which the patent may be maintained, the appeal must be dismissed (see T 1836/12 of 5 March 2014 points 3 and 4 of the Reasons).

Order

For these reasons it is decided that:

The appeal is dismissed

The Registrar: The Chairman:

M. Kiehl B. Stolz

Decision electronically authenticated