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**Datasheet for the decision
of 5 June 2020**

Case Number: T 0682/16 - 3.3.08

Application Number: 02714955.8

Publication Number: 1456346

IPC: C12N15/63, C12N15/85,
C12N15/12, C12N15/62,
C07K14/705, C07K14/72,
A01H5/00, C12Q1/68, G01N33/68

Language of the proceedings: EN

Title of invention:
NOVEL ECDYSONE RECEPTOR/INVERTEBRATE RETINOID X RECEPTOR-BASED
INDUCIBLE GENE EXPRESSION SYSTEM

Patent Proprietor:
Intrexon Corporation

Opponent:
Then, C./A. Schweitzer Stiftung f.u.M./BUAV/
Deutscher Tierschutzbund/GeN/Ges.f.ök.Forschung/
Pro Wildlife e.V./SAG/STS/WCF/

Headword:
Non-human organism/INTREXON

Relevant legal provisions:

EPC Art. 53(a), 111(2)

EPC R. 28(d)

RPBA 2020 Art. 13(1)

Keyword:

Admission joint opposition and appeal (yes);

Main request - admission in appeal (yes);

Main request - overcomes all grounds of opposition (yes);

Main request - remittal to the first instance (yes);

Decisions cited:

T 0315/03

Catchword:



Beschwerdekammern

Boards of Appeal

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Case Number: T 0682/16 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 5 June 2020

Appellant: Then, C./A. Schweitzer Stiftung f.u.M./BUAV/
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Pro Wildlife e.V./SAG/STS/WCF/
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Respondent: Intrexon Corporation
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 January 2016
rejecting the opposition filed against European
patent No. 1456346 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman B. Stolz
Members: P. Julià
D. Rogers
M. Montrone
J. Geschwind

Summary of Facts and Submissions

- I. European patent no. 1 456 346 is based on European patent application no. 02 714 955.8 (published under the PCT with the international publication number WO 02/066613; hereinafter "the patent application") and was granted with 57 claims.
- II. Claims 48 to 53 as granted were directed to non-human organisms. Claims 49 to 50 and claims 52 to 53 were dependent on claims 48 and 51, respectively, which both read as follows:
- "A non-human organism comprising the host cell of claim 45".
- III. Several oppositions were filed on the grounds as set forth in Articles 100(a) and 100(b) EPC against the subject-matter of claims 48 to 53. The opposition division held that the grounds of opposition did not prejudice the maintenance of the patent as granted and, accordingly, rejected the oppositions.
- IV. An appeal was lodged by one of the opponents (appellant). In the statement setting out the grounds of appeal, the appellant filed new documentary evidence and maintained the objections raised at first instance under Articles 100(a) and 100(b) EPC against the subject-matter of granted claims 48 to 53. In reply thereto, the patent proprietor (respondent) filed an auxiliary request 1 and new documentary evidence. As an auxiliary measure, oral proceedings were requested by both parties.

V. The parties were summoned to oral proceedings. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA 2007), the parties were informed of the board's provisional opinion on the issues of the case.

In particular, the board stated that the joint opposition and the appeal appeared to be admissible and, with reference to the decision T 315/03 (OJ EPO 2006, 15) and the two tests mentioned in point 6.3 of its Reasons, namely the "Rule 28(d) EPC test" and the "real Article 53(a) EPC test", that the main request (claims as granted) and auxiliary request 1 appeared to contravene Article 53(a) EPC in combination with Rule 28(d) EPC (Article 100(a) EPC).

VI. In reply thereto, without making any substantive submissions, the respondent filed auxiliary request 2.

VII. In a communication pursuant to Article 17 RPBA 2020, the board informed the parties that it intended to admit auxiliary request 2 into the appeal proceedings (Article 13(1) RPBA 2020), and that this auxiliary request appeared to overcome all grounds of opposition (Articles 100(a) and 100(b) EPC). Thus, the board indicated its intention to set aside the decision under appeal and to remit the case to the opposition division with the order to maintain the patent on the basis of auxiliary request 2 and a description to be adapted thereto. The board further stated that, if necessary, these issues had to be discussed at the scheduled oral proceedings.

VIII. In reply thereto, the respondent informed the board that its request for oral proceedings was maintained only in the event that the board intended to deviate

from its provisional opinion on the admissibility of auxiliary request 2 and on the maintenance of the patent on the basis of this auxiliary request.

- IX. In a further communication pursuant to Article 17 RPBA 2020, the board observed that no further submissions had been filed by the appellant, relating to either the admittance of auxiliary request 2 into the appeal proceedings or to any substantive objection under the grounds set forth in the opposition. Therefore, the board saw no reason to change its provisional opinion and did not consider it necessary to hold the scheduled oral proceedings. The appellant was requested to inform the board whether its request for oral proceedings was maintained.
- X. In reply thereto, the respondent withdrew the main request and auxiliary request 1, and made auxiliary request 2 its new main request. The appellant informed the board that auxiliary request 2 was considered not to contain opposed subject-matter and thus, its request for oral proceedings was withdrawn.
- XI. The board cancelled the oral proceedings.

Reasons for the Decision

Admissibility of the joint opposition and of the appeal

1. In reply to the statement of grounds of appeal, the respondent contested the decision of the opposition division on the admissibility of the joint opposition and requested the board to dismiss both, the opposition and the appeal, as inadmissible.

2. In its communication pursuant to Article 15(1) RPBA 2007, the board drew the parties' attention to the opposition division's summary in both, its summons to attend oral proceedings and the decision under appeal, of the facts and submissions on the basis of which the respondent argued against the admissibility of the joint opposition (cf. pages 2 to 4 of the Summons to attend oral proceedings; pages 3 to 6 of the decision under appeal). The board further noted that these facts and submissions were not contested in appeal and, indeed, were identical to those put forward by the respondent in appeal proceedings.
3. After consideration of the facts and submissions as well as of the respondent's arguments and the evidence on file, the board informed the parties that it saw no reason to deviate from the findings of the opposition division as regards this issue, namely that "Testbiotech e. V., represented by Mr. Then [as executive director of Testbiotech e.V.], continues to be regarded as opponent and common representative of the joint opposition" (cf. bottom of page 6 in the Summons to attend oral proceedings, and pages 6 to 8 of the decision under appeal).
4. Since the parties have not contested the board's provisional opinion on this issue, the board thus considers the joint opposition and the appeal to be admissible.

Admission of the main request into the appeal proceedings

5. The main request was filed (as auxiliary request 2) in response to the communication pursuant to Article 15(1) RPBA 2007, wherein the parties were informed of the board's provisional opinion on the

issues of the appeal. The main request is thus an amendment of the respondent's case and may be admitted into the proceedings only at the discretion of the board (Article 13(1) RPBA 2020).

6. The appellant has not provided any reasons against the admission of this request into the appeal proceedings.
7. By deleting claims 48 to 53, the respondent addressed all issues raised by the appellant and by the board in its communication. The main request does not give rise to new objections and contributes to the efficiency of the procedure.
8. Therefore, the board, in the exercise of its discretion (Article 13(1) RPBA 2020), admits the main request into the appeal proceedings.

Main request

9. In the present case, the opposition was only directed against claims 48 to 53 to the extent that they related to "a non-human organism" comprising a host cell of claim 45.
10. The main request no longer contains claims directed to "a non-human organism". Thus, it overcomes all grounds of opposition. This has also been acknowledged by the appellant.
11. Therefore, the patent can be maintained on the basis of the main request and a description to be adapted thereto (Article 111(2) EPC).

Order

For these reasons it is decided that:

1. The joint opposition and the appeal are admissible.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division with the order to maintain the patent on the basis of claims 1 to 51 according to the main request filed on 8 April 2020 and a description to be adapted thereto.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated