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**Datasheet for the decision of 1 February 2021**

**Case Number:** T 0186/18 - 3.3.08

**Application Number:** 09781633.4

**Publication Number:** 2328918

**IPC:** A01K67/027, A01K67/033, C12N15/10, C07K14/47

**Language of the proceedings:** EN

**Title of invention:**
MUTANT ALPHA-SYNUCLEIN, AND METHODS USING SAME

**Patent Proprietor:**
Max-Planck-Gesellschaft zur Förderung der Wissenschaften e.V.

**Opponents:**
Then, Christoph / Tippe, Ruth / Hamberger, Sylvia

**Headword:**
Non-human animals/MAX PLANCK

**Relevant legal provisions:**
EPC Art. 53(a), 111(2)
EPC R. 28(d)

**Keyword:**
Exceptions to patentability - animals and animal species (no);
Main request - overcomes all grounds of opposition (yes);
Main request - remittal to the first instance for adaptation of the description (yes);

**Decisions cited:**
T 0315/03

**Catchword:**

Europäisches Patentamt
European Patent Office
Office européen des brevets

**Beschwerdekammern**

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**Case Number: T 0186/18 - 3.3.08**

# D E C I S I O N
# of Technical Board of Appeal 3.3.08
# of 1 February 2021

| | |
|---|---|
| **Appellant:** (Opponent) | Then, Christoph / Tippe, Ruth / Hamberger, Sylvia<br>Frohschammerstrasse 14<br>80807 München (DE) |
| **Respondent:** (Patent Proprietor) | Max-Planck-Gesellschaft zur Förderung der Wissenschaften e.V.<br>Hofgartenstrasse 8<br>80539 München (DE) |
| **Representative:** | Wichmann, Hendrik<br>Wuesthoff & Wuesthoff<br>Patentanwälte PartG mbB<br>Schweigerstraße 2<br>81541 München (DE) |
| **Decision under appeal:** | **Interlocutory decision of the Opposition Division of the European Patent Office posted on 17 November 2017 concerning maintenance of the European Patent No. 2328918 in amended form.** |

**Composition of the Board:**

| | |
|---|---|
| **Chairman** | B. Stolz |
| **Members:** | P. Julià |
| | D. Rogers |
| | M. Montrone |
| | A. Bacchin |

## Summary of Facts and Submissions

I. European patent no. 2 328 918 is based on European patent application no. 09 781 633.4, originally filed under the PCT as International patent application PCT/EP2009/060299 and published as WO 2010/015714. The patent was granted with 15 claims.

II. Claim 12 as granted read as follows:

"12. A non-human animal comprising the polynucleotide according to claim 10 or a non-yeast cell according to claim 11, wherein the non-human animal is an invertebrate, preferably *C. elegans*, or *D. melanogaster*; or a vertebrate, preferably a mammal, more preferably a mouse, rat, or a primate."

III. An opposition was filed on the grounds set forth in Articles 100(a) and 100(b) EPC. The opposition division considered the main request not to fulfil the requirements of Article 84 EPC and auxiliary request 1 to fulfil the requirements of the EPC. Both requests were filed on 14 November 2016 as auxiliary requests 1 and 2, respectively.

IV. An appeal was lodged by the opponents (appellants). In the statement setting out their grounds of appeal, the appellants maintained the objection raised at first instance under Article 53(a) EPC and Rule 28(1)(d) EPC against claim 12 of the request upheld by the opposition division. The appellants neither raised any other objection against the request upheld by the opposition division nor did they attack any other claim of that request. The appellants requested that the

decision under appeal be set aside and that the patent be revoked.

V. In response to the appellants' statement of grounds of appeal, the patent proprietor (respondent) requested, as its main request, that the appeal be dismissed or, in the alternative, that the patent be maintained on the basis of any one of auxiliary requests 1 to 6 filed at first instance as auxiliary requests 3 to 8, respectively. Oral proceedings were requested as an auxiliary measure.

VI. Claim 12 of the main request (auxiliary request 1 upheld by the opposition division) read as follows:

"12. A non-human animal comprising the polynucleotide according to claim 10 or a non-yeast cell according to claim 11, wherein the non-human animal is an invertebrate selected from *C. elegans*, and *D. melanogaster*,
or a vertebrate selected from guinea pig, hamster, mouse, rat, *Sigmidon hispidus*, chicken, cat, dog, lamprey, Japanese ricefish, pufferfish, zebrafish, zebra finch, African clawed frog, and a primate selected from rhesus macaque, baboon, marmoset, and green monkey,
preferably a mammal selected from guinea pig, hamster, mouse, rat, *Sigmidon hispidus*, chicken, cat, dog, rhesus macaque, baboon, marmoset, and green monkey, more preferably a mouse, a rat, or a primate selected from rhesus macaque, baboon, marmoset, and green monkey."

VII. The parties were summoned to oral proceedings. In a communication pursuant to Article 17 of the Rules of

Procedure of the Boards of Appeal (RPBA 2020), the parties were informed of the board's provisional opinion on the issues of the case.

In particular, the board stated, 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 and auxiliary requests 1 to 5, all of them with a claim directed to a non-human animal, appeared to contravene Article 53(a) EPC in combination with Rule 28(d) EPC (Article 100(a) EPC). Auxiliary request 6, without any claim directed to a non-human animal, appeared to overcome all grounds of opposition and to provide a basis for the maintenance of the patent.

VIII. With submissions dated 11 January 2021, the respondent withdrew the main request and auxiliary requests 1 to 5 and, without making any substantive submissions, made previous auxiliary request 6 its new main request. This auxiliary request 6 had originally been filed as auxiliary request 8 on 27 July 2017. The respondent requested that the case be remitted to the first instance for the adaptation of the description.

IX. With submissions dated 15 January 2021, the appellants agreed that the case could be remitted to the first instance and that there was no need for holding the scheduled oral proceedings.

X. The board cancelled the oral proceedings scheduled for 19 March 2021.

XI. Both the appellants and the respondent request that the decision under appeal be set aside, the patent be

maintained on the basis of the new main request, and that the case be remitted to the opposition division for adaptation of the description.

## Reasons for the Decision

*Main request*

1. In the present case, the opposition was only directed against claim 12 to the extent that it related to "a non-human animal".

2. The main request no longer contains a claim directed to "a non-human animal". Thus, the main request overcomes all grounds of opposition. This has also been acknowledged by the appellants.

3. 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 decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent on the basis of claims 1 to 12 of the main request (filed as auxiliary request 8 on 27 July 2017) and a description to be adapted thereto.

The Registrar: The Chairman:

L. Malécot-Grob B. Stolz

Decision electronically authenticated