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Datasheet for the decision of 4 May 2021

Case Number: T 2898/18 - 3.3.04

Application Number: 06800177.5

Publication Number: 1910829

IPC: C07K16/18

Language of the proceedings: EN

Title of invention:
Prevention and treatment of synucleinopathic and amyloidogenic disease

Patent Proprietors:
Prothena Biosciences Limited
The Regents of the University of California

Opponent:
MacLean, Martin Robert

Headword:
Antibody binding to alpha-synuclein/PROTHENA

Relevant legal provisions:
EPC Art. 123(2)
EPC R. 31
RPBA 2020 Art. 13(2)

Keyword:

Amendments - added subject-matter (yes)
Amendment after summons - taken into account (no)

Decisions cited:

G 0003/89, G 0002/93, T 0488/89, T 0737/90, T 0990/91

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Case Number: T 2898/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 4 May 2021

Appellant: (Patent Proprietor 1)	Prothena Biosciences Limited 25-28 North Wall Quay Dublin 1 (IE)
Appellant: (Patent Proprietor 2)	The Regents of the University of California 1111 Franklin Street, 5th Floor Oakland, CA 94607 (US)
Representative:	Goodfellow, Hugh Robin Carpmaels & Ransford LLP One Southampton Row London WC1B 5HA (GB)
Appellant: (Opponent)	MacLean, Martin Robert Mathys & Squire LLP The Shard 32 London Bridge Street London SE1 9SG (GB)
Representative:	Miller, David James Mathys & Squire The Shard 32 London Bridge Street London SE1 9SG (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 8 October 2018 concerning maintenance of the European Patent No. 1910829 in amended form**

Composition of the Board:

Chair	B. Claes
Members:	A. Schmitt
	P. de Heij

Summary of Facts and Submissions

I. The appeals lodged by the patent proprietors ("proprietors") and the opponent lie from the opposition division's interlocutory decision that European patent No. 1 910 829, as amended in the form of auxiliary request 6, and the invention to which it relates meet the requirements of the EPC.

Claim 1 of auxiliary request 6 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody binds an epitope within amino acids 1-20 of human alpha-synuclein, as numbered according to SEQ ID NO:1."

II. The patent, entitled "*Prevention and treatment of synucleinopathic and amyloidogenic disease*", was granted on European patent application No. 06 800 177.5, which had been filed as an international application under the PCT and published as WO 2007/012061 ("application as filed").

Claim 1 as granted reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PT6910 for binding to human alpha-synuclein for use in effecting prophylaxis

or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain."

Claims 1, 7, 8, 15, 30 and 31 of the application as filed read:

"1. A method of effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, the method comprising administering to a patient having or at risk of the disease an effective regime of an antibody that specifically binds to an epitope within residues 1-20 of human alpha-synuclein, residues being numbered according to SEQ ID NO:1.

7. The method of any of claims 1-6 wherein the antibody competes with mouse monoclonal antibody 6H7 (ATCC accession number PTA-6910) for binding to human alpha-synuclein.

8. The method of claim 7, wherein the antibody is a humanized version of mouse monoclonal antibody 6H7 (ATCC accession number PTA-6910).

15. The method of any of claims 9-14 wherein the antibody competes with mouse monoclonal antibody 8A5 (ATCC accession number PTA-6909) for binding to human alpha-synuclein.

30. A monoclonal antibody produced by hybridoma JHl7.6H7.1.54.28 (ATCC accession number PTA-6010) or JH4.8A5.25.7.36 (ATCC accession number PTA-6909).

31. A cell of hybridoma JH17.6H7.l.54.28 (ATCC accession number PTA-6010) or JH4.8A5.25.7.36 (ATCC accession number PTA-6909)."

III. An opposition had been filed against the patent in its entirety. The opposition proceedings were based on the grounds under Article 100(a) EPC (lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC)) and Article 100(b) and (c) EPC.

IV. With their statement of grounds of appeal, the proprietors submitted arguments in support of the allowability of the main request (patent as granted). They further maintained the sets of claims of auxiliary requests 1 to 18 and submitted arguments in support of the sufficiency of disclosure of auxiliary requests 1 to 5.

Claim 1 of auxiliary requests 7 and 8 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody will inhibit specific binding of monoclonal antibody 6H7 to human alpha-synuclein by at least 50% when present in excess."

Claim 1 of auxiliary requests 9 and 10 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody binds to the same epitope as the

monoclonal antibody 6H7 or an adjacent epitope sufficiently proximal to the epitope bound by the monoclonal antibody 6H7 for steric hindrance to occur, and will inhibit specific binding of monoclonal antibody 6H7 to human alpha-synuclein by at least 50% when present in excess."

Claim 1 of auxiliary requests 11 and 12 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody binds to an epitope within amino acids 1-20 of human alpha-synuclein, as numbered according to SEQ ID NO:1, and will inhibit specific binding of monoclonal antibody 6H7 to human alpha-synuclein by at least 50% when present in excess."

Claim 1 of auxiliary requests 13 and 14 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody is the 6H7 monoclonal antibody produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910, or a chimeric or humanized form of the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910."

Claim 1 of auxiliary requests 15 and 16 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody binds to an epitope within amino acids 1-20 of human alpha-synuclein, as numbered according to SEQ ID NO:1, and binds to the same epitope as the monoclonal antibody 6H7 or an adjacent epitope sufficiently proximal to the epitope bound by the monoclonal antibody 6H7 for steric hindrance to occur."

Claim 1 of auxiliary requests 17 and 18 reads:

"1. An antibody that competes with the monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 for binding to human alpha-synuclein for use in effecting prophylaxis or treating a disease characterized by Lewy bodies or alpha-synuclein aggregation in the brain, wherein the competing antibody binds to an epitope within amino acids 1-20 of human alpha-synuclein, as numbered according to SEQ ID NO:1, binds to the same epitope as the monoclonal antibody 6H7 or an adjacent epitope sufficiently proximal to the epitope bound by the monoclonal antibody 6H7 for steric hindrance to occur, and will inhibit specific binding of monoclonal antibody 6H7 to human alpha-synuclein by at least 50% when present in excess."

V. With their statement of grounds of appeal, the opponent submitted 12 documents and, *inter alia*, argued that the subject-matter of claim 1 of auxiliary request 6

related to added subject-matter and that paragraph [0132] of the application as filed could not be corrected under Rule 139 EPC.

VI. With their reply to the opponent's statement of grounds of appeal, dated 4 July 2019, the proprietors submitted one document and arguments, *inter alia,* in support of claim 1 of auxiliary request 6 in the context of added subject-matter and indicated that a "*correction under Rule 139 EPC was never requested*", was "*not necessary*" and that Rule 139 EPC was "*not relied on by the Patentees*" (points 2.10 to 2.14).

VII. With their reply to the patent proprietors' appeal submitted on 4 July 2019, the opponent, *inter alia,* argued that claim 1 of the main request and each of auxiliary requests 1 to 18 related to added subject-matter. The opponent no longer addressed the issue of correction under Rule 139 EPC.

VIII. With a letter dated 20 November 2019, the proprietors submitted four more documents and further arguments in support of the allowability of the main request and auxiliary requests 1 to 18.

IX. The board issued a summons to oral proceedings as requested by the parties, and a communication pursuant to Article 15(1) RPBA 2020 setting out its preliminary opinion. The board *inter alia* expressed the view that claim 1 as granted and claim 1 of each of auxiliary requests 1 to 18 contained subject-matter extending beyond the disclosure of the application as filed. The board also noted that the patent proprietors had explicitly stated they would not be relying on any correction under Rule 139 EPC.

X. In reply, with a letter dated 1 April 2021, the proprietors submitted four documents and requested that paragraph [0132] of the application as filed be corrected under Rule 139 EPC. Arguments were provided as to why this correction was allowable.

XI. With a letter dated 26 April 2021, the opponent submitted one further document and argued that the proprietors' request for the description of the application to be corrected under Rule 139 EPC should not be admitted into the appeal proceedings.

XII. Oral proceedings took place by videoconference with both parties' consent. The proprietors (hereinafter "respondents") withdrew their appeal. They also withdrew the previous main request and auxiliary requests 1 to 5, made previous auxiliary request 6 their main request and renumbered previous auxiliary requests 7 to 18 as auxiliary requests 1 to 12. At the end of the oral proceedings, the chair announced the board's decision.

XIII. The following documents are referred to in this decision:

D7 ATCC website search results for "PT6910", "PTA-6910" and "JH17.6H7.1.54.28"

D8 US 6,815,590 B2

D10 ATCC deposit receipt for JH4.8A5.25.7.36 and JH17.6H7.1.54.28

XIV. The appellant's (opponent's) arguments, where relevant to the decision, are summarised as follows.

Main request - claim 1 (Article 123(2) EPC)

The features "hybridoma JH17.6H7.1.54.28" and "ATCC accession number PTA-6910" were not disclosed in combination in the application as filed. Claim 7 and paragraph [0132] of the application could not provide a basis for a monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910 since claim 7 only recited "mouse monoclonal antibody 6H7 (ATCC accession number PTA-6910)" without mentioning the hybridoma JH17.6H7.1.54.28, and paragraph [0132] disclosed a different ATCC accession number (PTA-6010) for the hybridoma JH17.6H7.1.54.28. Combining the features of claim 7 and paragraph [0132] would thus result in the 6H7 antibody being characterised in a way that included both of the ATCC accession numbers and not as recited in claim 1.

The inconsistency between claim 7 and paragraph [0132] of the application could not be resolved by consulting the ATCC database to identify the correct ATCC accession number because the contents of the ATCC database were not part of the application as filed and did not constitute common general knowledge. In fact, Rule 31 EPC, under which the ATCC accession number had to be provided within 16 months of the relevant date of the application, confirmed that the results of a query in the ATCC database were not part of the application as filed. If the result of a query with the ATCC database were part of the application as filed, this time limit would be meaningless. Consequently, the disclosures in documents D7 and D8 did not form part of the application as filed or the common general

knowledge and thus could not help resolve an inconsistency in the application as filed (see e.g. decision G 3/89 of the Enlarged Board of Appeal, Reasons 7; OJ EPO 1993, 117).

Moreover, pursuant to decision G 2/93 of the Enlarged Board of Appeal (OJ EPO 1995, 275), the indication of a culture deposit's accession number in a patent application was substantive because it was instrumental in enabling a person skilled in the art to carry out the invention (Reasons 13). The ATCC accession number mentioned in the claim was thus a technical feature and should be directly and unambiguously derivable from the application as filed.

Since the ATCC accession number PTA-6910 was not directly and unambiguously linked to the hybridoma designated JH17.6H7.1.54.28 in the application as filed, claim 1 contained subject-matter going beyond the disclosure of the application as filed.

The respondents' request for correction under Rule 139 EPC (Article 13(2) RPBA 2020)

The respondents' request for paragraph [0132] of the application as filed to be corrected under Rule 139 EPC, submitted on 1 April 2021, represented an amendment to their appeal case as per Article 13(2) RPBA 2020. There were no exceptional circumstances, nor had the respondents given any cogent reasons, that would justify submitting this request so late.

On the contrary, the respondents had stated in their reply to the appellant's statement of grounds of appeal in the context of added subject-matter in claim 1 that

they were not relying on a correction of paragraph [0132] of the application.

The request for correction should therefore not be taken into account in accordance with Article 13(2) RPBA 2020.

Auxiliary requests 1 to 12 - claim 1 (Article 123(2) EPC)

Claim 1 of each of auxiliary requests 1 to 12 related to subject-matter extending beyond the application as filed for the same reasons as claim 1 of the main request and hence did not meet the requirements of Article 123(2) EPC.

XV. The respondents' (proprietors') arguments, where relevant to the decision, are summarised as follows.

Main request - claim 1 (Article 123(2) EPC)

Claim 7 combined with paragraph [0132] of the application as filed provided the basis for the claimed subject-matter. Claim 7 linked the antibody 6H7 to the correct ATCC accession number PTA-6910. Paragraph [0132] referred to the same antibody 6H7 and provided the information that it was produced by the cell line designated JH17.6H7.1.54.28. The antibody thus linked the hybridoma to the correct ATCC accession number.

The skilled person would consult the ATCC database and inevitably establish that the correct accession number of the cell line designated JH17.6H7.1.54.28 was indeed PTA-6910, i.e. the number disclosed in claim 7. This was evident from document D7, a summary of the ATCC

website search results when searching for the terms "PT6910", "PTA-6910" and "JH17.6H7.1.54.28".

Without an ATCC database consultation, which was part of the skilled person's common general knowledge, an ATCC accession number was technically meaningless. Moreover, features disclosed in a document referred to in an application could be incorporated into the application if that document could be easily retrieved, which was the case for the result of a database query (see e.g. decision T 737/90, Reasons 5, and Case Law of the Boards of Appeal of the European Patent Office, 9th edition, 2019, II.C.4.2).

ATCC accession number PTA-6010 was for a deposit of a tuber of a potato cultivar, as evident from document D8, a patent document that was published before the application's priority date and thus also established that the correct ATCC accession number was PTA-6910, not PTA-6010. The disclosure of document D8 could be taken into account to establish which ATCC accession number was correct since cited documents published before an application's priority date could be taken into account for a correction (see decisions T 488/89, Reasons 2.2, and T 990/91, Reasons 2.2 and 2.3).

Furthermore, the ATCC deposit receipt relating to the two hybridomas designated JH4.8A5.25.7.36 and JH17.6H7.1.54.28 (see document D10, which had already been submitted during the examination proceedings) also linked these hybridomas to the correct ATCC accession numbers: PTA-6909 and PTA-6910, respectively.

Therefore, the correct ATCC accession number was directly and unambiguously derivable from the technical

information provided in the application with due regard to the skilled person's common general knowledge. In this respect, the case at hand was different from that discussed in decision G 2/93 of the Enlarged Board of Appeal (OJ EPO 1995, 275) since in the case at hand the application as filed had disclosed the correct ATCC accession number in combination with the antibody 6H7 (see claim 7 of the application as filed).

Consequently, the amendment to claim 1 did not introduce any new technical information, so the requirements of Article 123(2) EPC were met. This was in line with established case law (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition, 2019, II.E.1.3.2), which has it that the key question when assessing added subject-matter was whether the amendments provided the skilled person with additional technically relevant information that the application as filed did not contain.

The respondents' request for correction under Rule 139 EPC (Article 13(2) RPBA 2020)

The issues relevant to a correction of paragraph [0132] had been addressed before and during the opposition proceedings. Furthermore, in the reply to the appellant's statement of grounds of appeal (see section VI.), the respondents had made it clear that they would rely on a correction under Rule 139 EPC to the extent necessary. In the submission dated 1 April 2021, the previous arguments and submissions were continued and merely tied to new evidence (four documents submitted with that letter) without changing the arguments. Therefore, the request for correction of paragraph [0132] was not an amendment to the respondents' case as per the provisions of

Article 13(2) RPBA 2020, so it should be taken into account.

Auxiliary requests 1 to 12 - claim 1 (Article 123(2) EPC)

The respondents did not submit any specific arguments for auxiliary requests 1 to 12 in the context of added subject-matter.

XVI. The appellant requested that the decision under appeal be set aside and that the patent be revoked; and, that the respondents' request to correct paragraph [0132] of the application under Rule 139 EPC not be admitted into the proceedings.

The respondents requested that the appeal be dismissed (main request, implying that the patent be maintained based on the set of claims of former auxiliary request 6), or, alternatively, that the patent be maintained on the basis of the set of claims of one of auxiliary requests 1 to 12, filed as auxiliary requests 7 to 18 during the opposition proceedings, and that paragraph [0132] of the application as filed be corrected under Rule 139 EPC.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is admissible.

Main request - claim 1 (Article 123(2) EPC)

2. As the basis for the feature "*monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC*

accession number PTA-6910", the respondents referred to claim 7 (see section II.) and paragraph [0132] of the application as filed, arguing in particular that claim 7 disclosed that the 6H7 antibody had the ATCC accession number PTA-6910 and that paragraph [0132] provided the information that the antibody 6H7 was produced by the cell line designated "JH17.6H7.1.54.28".

3. Paragraph [0132] discloses that "[*t*]*he cell line designated JH17.6H7.1.54.28 producing the antibody 6H7 has the ATCC accession number PTA-6010 having been deposited under the provisions of the Budapest Treaty with the American Type Culture Collection (ATCC, Manassas, VA 20108) on August 4, 2005.*"

4. The technical information provided by claim 7 and paragraph [0132] of the application is an antibody that competes with another antibody that is i) designated "6H7" and has the ATCC accession number PTA-6910 (claim 7) and ii) produced by a particular cell line designated "JH17.6H7.1.54.28" deposited under the ATCC accession number PTA-6010 (paragraph [0132]).

5. Claimed is an antibody that competes with one designated "6H7" and is produced by a cell line designated "JH17.6H7.1.54.28" (see section I.). The claim specifies, however, that this cell line can be acquired from a deposit with the ATCC accession number PTA-6910, i.e. a different cell line from that disclosed in paragraph [0132] of the application. Consequently, the technical information conveyed by the claim differs from the technical information which the skilled person can derive from paragraph [0132] when combined with claim 7 of the application as filed (see point 4.). The claim therefore relates to new

technically relevant information not contained in paragraph [0132] and claim 7 of the application as filed.

6. The respondents further argued that the term "monoclonal antibody 6H7" used in both claim 7 and paragraph [0132] of the application as filed linked the ATCC accession number PTA-6910 (claim 7) to the hybridoma designated JH17.6H7.1.54.28 (paragraph [0132]). Since an antibody could not be deposited *per se*, the ATCC accession number mentioned in claim 7 had to relate to the cell line producing this antibody and thus was "*shorthand*" for the hybridoma deposited under the provisions of the Budapest Treaty with the ATCC on 4 August 2005 using the depositor's reference JH17.6H7.1.54.28, which led to the antibody 6H7 (paragraph [0132]). The other ATCC accession number "PTA-6010" disclosed in paragraph [0132] did "*not detract from the direct and unambiguous derivability of the technical information in claim 1*" (page 2 of the respondents' letter of 1 April 2021; see section X.). Therefore, no technical teaching going beyond the disclosure of the application as filed had been added to the claim.

7. However, paragraph [0132] explicitly discloses that the cell line JHl7.6H7.1.54.28 has the ATCC accession number PTA-6010 – teaching that is also present in claims 30 and 31 as filed (see section II.). This cannot simply be ignored even if the skilled person would indeed spot an inconsistency in the disclosures of paragraph [0132] and claim 7. The technical teaching of paragraph [0132] is that the cell line JHl7.6H7.1.54.28 has the ATCC accession number PTA-6010. Replacing this ATCC accession number with "PTA-6910" thus alters the technical teaching of

paragraph [0132]. Consequently, combining the disclosure of claim 7 and paragraph [0132] does not result in direct and unambiguous disclosure of the cell line JHl7.6H7.1.54.28 having the ATCC accession number PTA-6910. Hence, the board considers that the application as filed does not disclose a link between the cell line "JHl7.6H7.1.54.28" and the ATCC accession number PTA-6910 despite the fact that the antibody 6H7 has been linked to both.

8. The respondents also argued that any inconsistency between the disclosure in claim 7 and paragraph [0132] was solved by consulting the ATCC database, which was part of the skilled person's common general knowledge and which, as evidenced by documents D7 and D8, unequivocally linked the hybridoma JH17.6H7.1.54.28 to the ATCC accession number PTA-6910.

9. However, including the accession number for a deposit of biological material in a patent application is necessary to allow the skilled person to carry out the invention if the invention concerns or involves using biological material which is not available to the public and cannot be described in any other way (Rule 31(1) EPC). Rule 31 EPC is therefore a provision to implement the general principle of Article 83 EPC for such inventions (see decision G 2/93 (OJ EPO 1995, 275), point 5 of the Reasons). The accession number of the biological material that an applicant has to provide within the time limit set in Rule 31 (2) EPC does not serve any other purpose and thus cannot be considered to constitute a cross-reference to the particular content of the database entry (here the proprietary name for the antibody-producing cell line used in the application).

10. Consequently, while it may be possible for the skilled person to submit a query to the ATCC database, the result cannot be considered to be part of their common general knowledge or to form part of the disclosure of a patent application reciting that ATCC accession number because it is not information which a skilled person would objectively derive directly and unambiguously, using common general knowledge, from the application as filed.

11. In view of these considerations, neither information that a particular deposit number is incorrect nor information on the correct deposit number (both of which might result from any such query) can be regarded as being disclosed in the application as filed. Therefore, the information contained in documents D7 (results of ATCC database queries) and D10 (the respondents' deposit receipt), both submitted by the respondents in support of their arguments, is not part of the disclosure of the application as filed and therefore cannot be used to resolve an inconsistency in the application as filed (see e.g. decision G 3/89 of the Enlarged Board of Appeal, Reasons 7; OJ EPO 1993, 117).

12. The respondents' referred also to a number of decisions from the Boards of Appeal in support of their arguments relating to incorporating features from a referenced document (here document D8) into an application. However, in the cases on which decisions T 488/89, T 990/91 and T 737/90 were based, the applications as filed contained explicit reference to particular prior art documents (decision T 990/91) or co-pending patent applications (decisions T 488/89 and T 737/90). Since the application in hand does not contain a reference to

document D8, these decisions are not relevant for this case.

13. Consequently, the respondents' argument that the skilled person could consult the ATCC database and/or document D8 to resolve the inconsistency between claim 7 and paragraph [0132] of the application as filed fails to convince the board.

14. On the basis of the above consideration, the board holds that the application as filed does not directly and unambiguously disclose the feature "*monoclonal antibody 6H7 produced by hybridoma JH17.6H7.1.54.28 having ATCC accession number PTA-6910*" present in the claim, either explicitly or implicitly.

15. Consequently, the claim relates to subject-matter which extends beyond the content of the application as filed and therefore does not comply with the requirements of Article 123(2) EPC.

The respondents' request for correction under Rule 139 EPC (Article 13(2) RPBA 2020)

16. The correction concerns the ATCC accession number in paragraph [0132] of the application (see point 3.), which would be corrected from "PTA-6010" to "PTA-6910".

17. In the decision under appeal, the opposition division agreed with the appellant that the skilled person would not necessarily conclude that the ATCC accession number in claim 7 of the application (PTA-6910) was correct and the number in paragraph [0132] of the application (PTA-6010) was incorrect. However, the opposition division concluded, apparently regardless of the alleged incorrect number in paragraph [0132], that

claim 1 of the main request (submitted as auxiliary request 6 during the opposition proceedings) fulfilled the requirements of Article 123(2) EPC.

18. In their statement of grounds of appeal (see section V.), the appellant contested that the subject-matter of claim 1 of the main request had a basis in the application as filed. They also provided arguments as to why an alleged error in an ATCC accession number in paragraph [0132] of the application as filed could not be corrected, stating that neither the error nor the correction was obvious.

19. In their response (see section VI.), the respondents argued that the skilled person would understand that the reference to ATCC accession number "PTA-6010" in paragraph [0132] of the application was a typographical error and that nothing else other than "PTA-6910" could have been intended. Claims 7 and 8 of the application as filed (see section II.) provided an adequate basis for accession number PTA-6910 as recited in claim 1. The respondents underlined that they had not actually requested a correction under Rule 139 EPC, nor had they relied on any such correction. In their subsequent submission of 4 July 2019 (see section VII.), the appellant provided further arguments concerning the requirements of Article 123(2) EPC, but no longer addressed the issue of correcting the accession number.

20. In view of the above, the board cannot endorse the respondents' view that the requested correction was already part of their case and that the written submissions made it clear that they would be relying on a correction under Rule 139 EPC to the extent necessary. On the contrary, their reply to the appellant's statement of grounds of appeal explicitly

stated that they would not be relying on any request for correction. As such, it was not part of their case on appeal and neither the appellant nor the board needed to consider the issue any further.

21. The request for correction of paragraph [0132] therefore constitutes an amendment to the respondents' case on appeal, which is subject to Article 13(2) RPBA 2020. As the respondents changed their case after the notification of the summons to oral proceedings, the amendment will not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons.

22. The board fails to see any such exceptional circumstances. The respondents have not put forward any reason why they were justified in reconsidering their position. The fact that they considered correction not to be necessary as the opposition division had not relied on it but had nonetheless accepted the basis for claim 1 in the application as filed cannot be deemed a cogent reason. The respondents should have made these considerations at the latest when preparing their response to the appellant's statement of grounds of appeal and should have submitted a request to that effect with their response. However, they failed to do so within the set time limit.

23. Therefore, the board decided not to take the requested correction under Rule 139 EPC into account in accordance with Article 13(2) RPBA 2020.

Auxiliary requests 1 to 12 - claim 1 (Article 123(2) EPC)

24. Claim 1 of each of these auxiliary requests recites the feature "monoclonal antibody 6H7 produced by hybridoma

JH17.6H7.1.54.28 having ATCC accession number PTA-6910" (see section IV.). Consequently, each of these claims relates to subject-matter which extends beyond the content of the application as filed and thus does not meet the requirements of Article 123(2) EPC for the same reasons as claim 1 of the main request (see points 2. to 15.).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chair:

A. Chavinier Tomsic B. Claes

Decision electronically authenticated