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Datasheet for the decision of 6 September 2022

Case Number: T 2455/19 - 3.3.04

Application Number: 09768694.3

Publication Number: 2307455

IPC: C07K16/22, C07K16/24

Language of the proceedings: EN

Title of invention:
Solubility optimization of immunobinders

Patent Proprietor:
ESBATech, an Alcon Biomedical Research Unit LLC

Opponent:
Greaves Brewster LLP

Headword:
Soluble immunobinders/ESBATECH

Relevant legal provisions:
EPC Art. 56
RPBA Art. 12(4)
RPBA 2020 Art. 13(2)

Keyword:
Inventive step - main request (no)
Late-filed request - submitted shortly before oral proceedings (auxiliary requests 1 to 4) - submitted during oral proceedings (auxiliary request 5)
Exceptional circumstances justified by cogent reasons (no)

Decisions cited:
G 0007/95, T 0494/18, T 2091/18, T 2295/19

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Case Number: T 2455/19 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 6 September 2022

Appellant I: (Patent Proprietor)	ESBATech, an Alcon Biomedical Research Unit LLC Wagistrasse 21 8952 Schlieren (CH)
Representative:	Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Appellant II: (Opponent)	Greaves Brewster LLP Copa House Station Road Cheddar Somerset BS27 3AH (GB)
Representative:	Greaves Brewster LLP Copa House Station Road Cheddar Somerset BS27 3AH (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 5 July 2019 concerning maintenance of the European Patent No. 2307455 in amended form.**

Composition of the Board:

Chair	M. Pregetter
Members:	B. Rutz
	M. Blasi

Summary of Facts and Submissions

I. The appeals by the patent proprietor (appellant I) and the opponent (appellant II) lie from the decision of the opposition division that European patent No. 2 307 455, entitled "*Solubility optimization of immunobinders*", met the requirements of the EPC in amended form according to auxiliary request 6.

II. The opposition proceedings were based on the grounds of Article 100(a) EPC, in relation to novelty (Article 54 EPC) and inventive step (Article 56 EPC), and of Article 100(b) and (c) EPC.

III. In the decision under appeal, the opposition division decided, *inter alia*, that the subject-matter of claims 13 to 15 of auxiliary request 6 was inventive when starting from the disclosure of document D8 as the closest prior art.

IV. In its statement of grounds of appeal, appellant I relied on the sets of claims of the patent as granted (main request) and of auxiliary requests 1 to 5, i.e. on all the claim requests on which the decision under appeal was based.

V. With its statement of grounds of appeal, appellant II objected to the subject-matter of claims 13 and 14 of auxiliary request 6 on the grounds of a lack of novelty over the disclosure of document D8 and to the subject-matter of claims 13 to 15 of auxiliary request 6 on the grounds of a lack of an inventive step over the disclosure of documents D2/D8, D4 or D3/D9 in combination with common general knowledge.

VI. With the reply to appellant II's statement of grounds of appeal, appellant I requested that the objection relating to a lack of novelty of the subject-matter of claims 13 and 14 of auxiliary request 6 over the disclosure of document D8 not be admitted into the proceedings as it was new and could have been submitted during the opposition proceedings. This also applied to the objection relating to a lack of an inventive step of the subject-matter of claims 13 to 15 starting from document D9 as the closest prior art.

VII. The board summoned the parties to oral proceedings, as requested, and informed them of its preliminary opinion in a communication under Article 15(1) RPBA 2020.

VIII. In this communication, the board indicated that it preliminarily agreed with the findings of the opposition division with regard to the main request and auxiliary requests 1 to 5. It further stated that it was inclined to admit the novelty objection in relation to claims 13 and 14 of auxiliary request 6 and that it preliminarily found the subject-matter of those claims to lack novelty over the disclosure of document D8.

IX. With a letter dated 5 August 2022, appellant I made former auxiliary request 6 its main request and filed sets of claims of new auxiliary requests 1 to 4. The former main request and auxiliary requests 1 to 5 were renumbered as auxiliary requests 5 to 10.

X. Claim 13 of the main request reads as follows:

"13. A composition comprising
(a) the immunobinder of any one of claims 1, 2, 10, 11 or 12; or

(b) an immunobinder comprising the following solubility enhancing motif in the heavy chain amino acid positions 12, 103 and 144 (AHo numbering):
(a1) Serine (S) at heavy chain amino acid position 12;
(b1) Threonine (T) at heavy chain amino acid position 103; and
(c1) Serine (S) at heavy chain amino acid position 144;
or
(a2) Serine (S) at heavy chain amino acid position 12;
(b2) Threonine (T) at heavy chain amino acid position 103; and
(c2) Threonine (T) at heavy chain amino acid position 144,
and a pharmaceutically acceptable carrier."

Claim 13 of auxiliary request 1 differs from claim 13 of the main request as follows (changes highlighted):

"13. A pharmaceutical composition ..."

Claim 13 of auxiliary request 2 differs from claim 13 of the main request as follows (changes highlighted):

"13. ...
~~(a1) Serine (S) at heavy chain amino acid position 12;~~
~~(b1) Threonine (T) at heavy chain amino acid position 103; and~~
~~(c1) Serine (S) at heavy chain amino acid position 144;~~
~~or~~
(a~~2~~) Serine (S) at heavy chain amino acid position 12;
(b~~2~~) Threonine (T) at heavy chain amino acid position 103; and
(c~~2~~) Threonine (T) at heavy chain amino acid position 144,
and a pharmaceutically acceptable carrier."

Claim 13 of auxiliary request 3 differs from claim 13 of the main request as follows (changes highlighted):

"13. ... wherein the immunobinder of (b) specifically binds to human TNFα or to human VEGF.

Claim 13 of auxiliary request 4 differs from claim 13 of the main request as follows (changes highlighted):

"13. A composition comprising
~~(a)~~ the immunobinder of any one of claims 1, 2, 10, 11 or 12; ~~or~~
~~(b) an immunobinder comprising the following solubility enhancing motif in the heavy chain amino acid positions 12,103 and 144 (AHo numbering):~~
~~(a1) Serine (S) at heavy chain amino acid position 12;~~
~~(b1) Threonine (T) at heavy chain amino acid position 103; and~~
~~(c1) Serine (S) at heavy chain amino acid position 144;~~ ~~or~~
~~(a2) Serine (S) at heavy chain amino acid position 12;~~
~~(b2) Threonine (T) at heavy chain amino acid position 103; and~~
~~(c2) Threonine (T) at heavy chain amino acid position 144,~~
and a pharmaceutically acceptable carrier."

XI. During the oral proceedings, appellant I filed the set of claims of a new auxiliary request 5. This set was identical to the one of the main request except that claims 13 to 15 had been deleted. The previous auxiliary requests 5 to 10 were withdrawn.

XII. At the end of the oral proceedings the Chair announced the board's decision.

XIII. The following document is referred to in this decision:

D8 H. Ohba et al., "*An immunodominant neutralization epitope on the 'thumb' subdomain of human immunodeficiency virus type 1 reverse transcriptase revealed by phage display antibodies*", Journal of General Virology 82, 2001, 813-820.

XIV. Appellant I's submissions are summarised as follows:

Main request - claim 13
Ground for opposition
Admission of novelty objection
(Article 12(4) RPBA 2007)

Until the filing of the statement of grounds of appeal, appellant II had never challenged claim 14 as granted (corresponding to claim 13 of the main request), nor had it challenged claim 14 in its amended form, which is present in identical form in the main request and all of the auxiliary requests.

The objection relating to the alleged lack of novelty of the subject-matter of claim 13 of the main request based on document D8 could have been submitted during the opposition proceedings, and no amendments were made during the proceedings before the opposition division or in the decision under appeal that might have justified the late submission of this objection in the appeal proceedings. Moreover, appellant II did not submit any reasons why the new line of argument was first filed with its statement of grounds of appeal. The new line of argument with regard to novelty based on document D8 should thus not be admitted into the appeal proceedings in accordance with Article 12(4) RPBA 2007.

Novelty was also a fresh ground for opposition and its introduction was not permissible on appeal: the subject-matter of claim 14 of the patent as granted had not been objected to for lack of novelty in the opposition proceedings, and the novelty of the subject-matter of claim 13 of the main request had not been objected to during the opposition proceedings either.

Inventive step (Article 56 EPC)

While water and PBS (phosphate buffered saline) were known and suitable as pharmaceutically acceptable carriers, the disclosure of water and PBS in D8 had to be considered in the specific context of the disclosure of the document. In document D8, water and PBS were not disclosed as pharmaceutically acceptable carriers but rather for storage or *in vitro* assays. This was also evident from the presence of "Block Ace" in one of the compositions, which was an agent that was clearly not intended for pharmaceutical use (see page 815, middle of the left-hand column). Furthermore, administration of the antibody disclosed in document D8 with a pharmaceutically acceptable carrier would not work because the target of the antibody (HIV-1 RT) was intracellular. Document D8 thus did not disclose a pharmaceutical composition with the immunobinder as claimed or its use in medicine. The subject-matter of claim 13 therefore differed from the disclosure of document D8.

Auxiliary requests 1 to 4
Admission (Article 13(2) RPBA 2020)

A new objection had been raised against auxiliary request 6 on appeal. This and the board's intention to

actually consider the objection represented exceptional circumstances. The new claim requests were a bona fide attempt to address this objection. Appellant II had eschewed the opportunity to present objections before the opposition division, and had instead merely reacted to the decision of the opposition division. For reasons of equity of arms and procedural fairness, appellant I should therefore be given the opportunity to await the preliminary opinion of the board in order to react, if necessary. Moreover, the development of the case was surprising. There had been no need to file further auxiliary requests in the opposition proceedings, since the objection had not been presented then. Submitting auxiliary requests 1 to 4 only after the board's communication was not contrary to procedural efficiency; the framework of the discussion would not change. Furthermore, there was a clear basis for these requests in the application (see e.g. decision T 601/05, which showed that the amendment of "composition" to "pharmaceutical composition" was acceptable). The claim requests were filed four months after the board's communication, i.e. within the standard time normally set by an office action.

In the context of considering admittance, a distinction had to be made between the claim requests which contained a deletion (auxiliary requests 2 and 4) and those which contained a combination of claims (auxiliary request 3). The deletions were straightforward. Furthermore, a distinction should be made as to the objection that was to be addressed by the respective claim request: the objection of a lack of inventive step based on document D9 was entirely new and different from the objection of a lack of novelty based on document D8 since the latter document had already been used for inventive step. In the claims of

auxiliary request 4 there was an obvious error; claim 14 should obviously have been deleted. This should not influence the decision on admission.

Auxiliary request 5
Admission (Article 13(2) RPBA 2020)

All claims which had been objected to in the statement of grounds of appeal by appellant II had been deleted in this request, thus removing all remaining issues. It had been a big surprise that the other auxiliary requests had not been admitted into the proceedings. Appellant I had seen no reason to file this claim request earlier in the proceedings; it was simply a reaction to the development of the oral proceedings. Moreover, the amendments were not complex, consisting merely in deletions of claims. If this were not allowable, patent proprietors would have to file dozens of claim requests at the beginning of appeal proceedings, which would be detrimental to procedural economy.

XV. Appellant II's submissions are summarised as follows:

Main request - claim 13
Ground for opposition
Admission of novelty objection
(Article 12(4) RPBA 2007)

The set of claims of the main request (former auxiliary request 6) was filed during the course of the oral proceedings on 8 May 2019, which appellant II did not attend. As such, appellant II was unable to raise objections to this newly-filed request. The submissions in the statement of grounds of appeal had been made in response to the decision under appeal, specifically to

section 22.5, and inventive step had been invoked against all claims in the notice of opposition.

Inventive step (Article 56 EPC)

The only potentially differentiating feature of composition claim 13 compared to the disclosure of document D8 was the presence of "a pharmaceutically acceptable carrier". However, this feature was not sufficient to distinguish the subject-matter of claim 13.

The term "pharmaceutically acceptable carrier" was defined very broadly in the patent, and included very simple solutions such as water (paragraph [0062]) and saline solution (water + sodium chloride; paragraph [0063]), potentially also comprising surfactants (paragraph [0062]).

Document D8 described the use of PBS for dialysis of the Fab fragments disclosed therein, which included the 5G Fab fragment (see page 814, right-hand column, last three lines of the section entitled "Expression and purification of recombinant Fab fragments"). The use of PBS-Tween as a carrier for 5G was also disclosed on page 815 (see the sections entitled "Epitope mapping of Fab fragments" and "Competition ELISA" in the left-hand column). PBS was a well-known pharmaceutically acceptable carrier. Polysorbate 20 (also known as Tween® 20), was a surfactant (c.f. paragraph [0062] of the patent), and was also commonly used as a pharmaceutically acceptable carrier.
Thus, document D8, which disclosed the 5G Fab fragment (having the STS motif as defined in claim 13) in PBS and PBS-Tween, anticipated the subject-matter of claim 13 of the main request, as both PBS and PBS-Tween

were pharmaceutically acceptable carriers according to the invention (following the broad definition in the patent).

Auxiliary requests 1 to 4
Admission (Article 13(2) RPBA 2020)

The auxiliary requests had been filed just one month before the oral proceedings, leaving very little time for searches to be conducted and for the issues to be considered. No explanation had been given as to why the claims were filed only after the board's communication. The board's communication did not create exceptional circumstances and cogent reasons were not presented. In fact, appellant I should have filed the auxiliary requests with its reply to appellant II's statement of grounds of appeal. It was clear from its statement of grounds of appeal that appellant II's claim interpretation was different from that of the opposition division. Furthermore, the amendments were not straightforward as features were taken from the description, e.g. in auxiliary request 1. Moreover, new issues arose, in particular under Article 123(2) and Article 83 EPC. Reference was made to the publication "CLBA", Case Law of the Boards of Appeal, 10th edition, 2022, V.A.4.5.6 c), V.A.4.5.10 b) and g), and decisions T 1187/16 and T 967/16 cited therein. The situation underlying decision T 601/05 was different.

Auxiliary request 2 did not address objections relating to documents D3 and D9. Combinations of claims in auxiliary request 3 also represented amendments within the meaning of Article 13 RPBA 2020 (CLBA, V.A.4.2.2 e)). Auxiliary request 4 raised new issues, since it had a clarity issue in claim 14. The claim requests were not convergent with each other.

Auxiliary request 5
Admission (Article 13(2) RPBA 2020)

The arguments with regard to auxiliary requests 1 to 4 also applied to auxiliary request 5. The objections addressed by this new claim request had already been raised in the statement of grounds of appeal, and therefore no exceptional circumstances were present; nor were cogent reasons submitted as to why this claim request could not have been presented with appellant I's reply to the statement of grounds of appeal. Moreover, there was no absolute right for a party to have a "last chance request". Reference was made to CLBA, V.A.4.5.1, V.A.4.5.4 b) and V.A.5.12.7.

XVI. Appellant I requested that appellant II's appeal be dismissed, i.e. that the patent be maintained as amended in the form of auxiliary request 6 considered allowable by the opposition division (main request), or alternatively, that the decision under appeal be set aside and the patent be maintained in amended form on the basis of one of the sets of claims of auxiliary requests 1 to 4 filed with letter dated 5 August 2022, or further alternatively, on the basis of the set of claims of auxiliary request 5 filed at the oral proceedings.

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

Reasons for the Decision

Main request - claim 13
Ground for opposition
Admission of novelty objection (Article 12(4) RPBA 2007)

1. Appellant I submitted that lack of novelty was a fresh ground for opposition and could not be assessed in the appeal proceedings without its agreement, which would not be given.

2. The board agrees that objecting to novelty is a different legal objection from the objection of a lack of inventive step and, thus, is a different ground for opposition (see also decision G 7/95, OJ EPO 1996, 626, Reasons 7.1). In the present case, appellant II had objected to the novelty of the subject-matter of claim 1 of the patent as granted in its notice of opposition and it appears that no objections were raised during the opposition proceedings relating to a lack of novelty of independent claim 13 of the main request and the corresponding claims of requests that were higher-ranking at that time. Whether or not the objection of a lack of novelty as raised by appellant II on appeal in relation to the subject-matter of claim 13 is a fresh ground for opposition which cannot be considered without appellant I's agreement, does not have to be decided upon since the board also has to deal with the ground for opposition of a lack of inventive step.

3. In accordance with decision G 7/95, the allegation that the subject-matter of a claim lacks novelty in view of the closest prior art may be considered in the context of deciding upon the ground of lack of inventive step (see decision G 7/95, supra, Order). If, when assessing

inventive step, no differences between the claimed subject-matter and the disclosure of the closest prior art can be established, i.e. if the disclosure of the closest prior art *"destroys the novelty of the claimed subject-matter, such subject-matter obviously cannot involve an inventive step. Therefore, a finding of lack of novelty in such circumstances inevitably results in such subject-matter being unallowable on the ground of lack of inventive step*" (see decision G 7/95, supra, Reasons 7.2).

4. It was undisputed that the ground for opposition of a lack of inventive step had been raised in the notice of opposition in relation to all of the claims. Moreover, document D8 was considered to be the closest prior art for the subject-matter of independent claim 13 and dependent claims 14 and 15 in the decision under appeal when dealing with the inventive step of the subject-matter of these claims (see section 22.5). Accordingly, the question of whether or not appellant I agreed to dealing with this issue on appeal did not arise.

5. Appellant I requested that the objection of a lack of novelty of the subject-matter of claim 13 over the disclosure of document D8 not be admitted into the proceedings in accordance with Article 12(4) RPBA 2007, because it had been raised by appellant II for the first time in its statement of grounds of appeal, when it should have been raised during the opposition proceedings.

6. However, under Article 12(4) RPBA 2007 the board did not exclude from the appeal proceedings the objection of a lack of novelty, or of a lack of a difference between the claimed subject-matter and the closest prior art. The board agrees with appellant I that

appellant II should not be put in a more favourable position as a result of not having attended the oral proceedings before the opposition division than the position it would have been in had it actually attended the oral proceedings. Accordingly, this objection is to be considered one which could have been raised by appellant II during the opposition proceedings. As regards the question of whether or not appellant II's objection should be admitted into the appeal proceedings, the board thus has discretion in accordance with Article 12(4) RPBA 2007, which is applicable in the present case pursuant to Article 24 and Article 25(1),(2) RPBA 2020.

7. In exercising this discretion, the board has decided to admit appellant II's objection into the appeal proceedings. The set of claims of the main request (then auxiliary request 5) had first been submitted by appellant I at the oral proceedings in opposition and the board is of the view that it cannot reasonably be expected of an opposing party, whether or not it attended said oral proceedings, to address in substance newly submitted claim requests in relation to each and every aspect at the oral proceedings. The board therefore agrees with appellant II that raising this objection in the statement of grounds of appeal was a legitimate reaction to the decision of the opposition division.

Inventive step (Article 56 EPC)

8. The opposition division found that the only difference between the subject-matter of claim 13 and the disclosure of document D8 was the presence of a "*pharmaceutically acceptable carrier*" in the composition. According to the opposition division,

this, "*implies that the fragment* [i.e. the immunobinder] *is used for a therapeutic purpose*". Since there was "*no hint in D8 to use the 5G Fab protein fragment together with a pharmaceutically acceptable carrier in therapy*", the subject-matter of claims 13 to 15 was not obvious in view of the available art (see section 22.5 of the decision under appeal). In the statement of grounds of appeal, appellant II contested the correctness of the opposition division's finding that the presence of a "*pharmaceutically acceptable carrier*" in the composition was not disclosed in document D8, and that an inventive step could be based on this "*potentially differentiating feature*" (see, in particular, appellant II's statement of grounds of appeal, page 5, first paragraph, under the heading 'Inventive step', referring to the submissions under the heading 'Novelty', e.g. page 3, penultimate paragraph).

9. The board agrees with appellant II and is of the view that the presence of a "*pharmaceutically acceptable carrier*" in the composition is not a distinguishing feature between the subject-matter of claim 13 and the disclosure of document D8. The reason for this is that firstly, compounds that are well known as being "pharmaceutically acceptable carriers" and that are also listed in the patent (see section 12. below) are disclosed in document D8 in compositions comprising the 5G Fab protein (see section 13. below).

10. Secondly, the presence of a "pharmaceutically acceptable carrier" in a composition does not imply that said composition has to be used for a therapeutic purpose. By analogy, a composition comprising an edible ingredient (e.g. starch) would not imply that the composition has to be used as a foodstuff. This is also

apparent from the wording of claim 13, which is directed to "a composition comprising ... an immunobinder ... and a pharmaceutically acceptable carrier". A composition "comprising" certain ingredients may contain further ingredients. In the present case, the composition may also include ingredients which are not "pharmaceutically acceptable" because this characteristic only applies to the "carrier". The presence of a "pharmaceutically acceptable carrier" in the composition thus does not restrict the composition as a whole to a therapeutic use within the meaning of Article 54(4) EPC, i.e. "*for use in a method referred to in Article 53(c)*". Moreover, it does not imply a therapeutic purpose for the composition.

11. Thirdly, to anticipate the subject-matter of a product claim it is not necessary that the product disclosed in the state of the art serves the same or a similar purpose as described in the patent. Instead, what is required is that said product has all the features (structural and/or functional) of the claim.

12. As appellant II pointed out, the patent defines in paragraph [0059] a "pharmaceutically acceptable carrier" as including "*any and all solvents, ..., and the like that are physiologically compatible*" and in paragraph [0062] provides "[e]*xamples of suitable aqueous and nonaqueous carriers that may be employed in the pharmaceutical compositions of the invention* [that] *include water, ethanol, ... Proper fluidity can be maintained, for example, ... by the use of surfactants*".

13. Document D8 discloses a composition comprising an immunobinder as defined in claim 13 and a

pharmaceutically acceptable carrier, e.g. PBS (phosphate buffered saline) (see page 814, right-hand column, lines 16 to 14 from the bottom) or PBS-Tween (see page 815, left-hand column, third and fourth full paragraphs). During the oral proceedings, appellant I acknowledged that it was common general knowledge that PBS was a "pharmaceutically acceptable carrier". Furthermore, all compositions disclosed in document D8 contain water, which is also well known as being pharmaceutically acceptable (see also paragraph [0062] of the patent). No difference between the subject-matter of claim 13 and the disclosure of document D8 can thus be established. Subject-matter which does not differ from the state of the art cannot involve an inventive step either (see also decision G 7/95, supra, Reasons 7.2).

14. The subject-matter of claim 13 lacks an inventive step within the meaning of Article 56 EPC over the disclosure of document D8.

Auxiliary requests 1 to 4
Admittance (Article 13(2) RPBA 2020)

15. Auxiliary requests 1 to 4 were not admitted into the proceedings.

16. The sets of claims of auxiliary requests 1 to 4 were filed about one month before the oral proceedings, i.e. after notification of the summons to oral proceedings. The admission of these requests is thus governed by Article 13(2) RPBA 2020, which is applicable in the present case in accordance with Articles 24 and 25 RPBA 2020.

17. Under Article 13(2) RPBA 2020, any amendment to a party's appeal case after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

18. The sets of claims of these auxiliary requests contain various different modifications, i.e. the insertion of wording from the description (auxiliary request 1), the deletion of parts of claims (auxiliary requests 2 and 4) and the combination of claims (auxiliary request 3).

19. Appellant I acknowledged that it was at the board's discretion whether or not to admit auxiliary requests 1 to 4 into the proceedings (see the letter of 5 August 2022, page 4, section 3.). The board agrees. The submission of the sets of claims of auxiliary requests 1 to 4 represented an amendment of appellant I's appeal case within the meaning of Article 13(2) RPBA 2020.

20. As an explanation for the late submission, appellant I considered the filing of auxiliary requests 1 to 4 to be a direct response to the preliminary opinion of the board and a *bona fide* attempt to address the novelty objection that is based on document D8. Neither argument, however, relates to exceptional circumstances. The fact that the board provided a preliminary opinion in which it addressed certain aspects was the ordinary course of appeal proceedings, as also reflected in Article 15(1), fifth sentence, RPBA 2020, and was in no way exceptional. Moreover, in that communication the board did not introduce any new objections, facts or evidence, but instead merely relied on the decision under appeal and the submissions

by the parties presented on appeal, notably appellant II's objections regarding claim 13 in the statement of grounds of appeal. The fact that appellant I had been of the opinion that the objection against claim 13 based on document D8 should or would not be admitted into the appeal proceedings, and yet the board did otherwise, did not represent exceptional circumstances either, and did not relieve appellant I from its obligation to present its response in a timely manner, i.e. with the reply to the appeal. Simply hoping that the board would accept appellant I's arguments with regard to admission and therefore not reacting to it in substance is not in line with the rules of procedure of the boards of appeal. In this regard it is irrelevant that appellant II had not attended the oral proceedings in opposition proceedings and that an objection might have been raised by appellant II for the first time with the statement of grounds of appeal. Appellant I had an obligation to present its full case in this respect at the earliest possible stage of the appeal proceedings. Likewise, the complexity of the amendments, how they address objections and whether they introduce new issues is not relevant for establishing whether exceptional circumstances existed.

21. In conclusion, the board has found no exceptional circumstances justified by cogent reasons for the submission of these claim requests at this stage of the appeal proceedings and has therefore decided not to admit auxiliary requests 1 to 4 into the proceedings.

Auxiliary requests 5
Admittance (Article 13(2) RPBA 2020)

22. During the oral proceedings, the set of claims of auxiliary request 5 in which claims 13 to 15 of the main request had been deleted was filed. The board has decided not to admit auxiliary request 5 into the appeal proceedings under Article 13(2) RPBA 2020.

23. In the board's view, the filing of this new claim request at this stage of the proceedings represented an amendment to appellant I's appeal case within the meaning of Article 13(2) RPBA 2020. Even though the amendments in the new claim request only consisted in the deletion of claims from the main request, i.e. from the version considered allowable by the opposition division and maintained on appeal by appellant I, the board considers the submission of this claim request to be an amendment to appellant I's case. The reason for this is that appellant I, by filing this request, changed its defence in relation to appellant II's appeal so as to no longer pursue the patent in a version comprising the subject-matter of claims 13 to 15 (for a deletion of claims to be considered an amendment to a party's case, see also decisions T 494/18, Reasons 1.4, T 2091/18, Reasons 4.1 and T 2295/19, Reasons 3.4.5).

24. The amendments as such may be straightforward and not complex, but the board's considerations are similar to those with respect to auxiliary requests 1 to 4. The issue addressed by these amendments, which consisted in the deletion of claims 13 to 15 from the main request, had already been raised by appellant II in its statement of grounds of appeal and thus the claims of auxiliary request 5 should have been filed with the

reply to appellant II's appeal. Appellant I may subjectively have been surprised that auxiliary requests 1 to 4 were not admitted into the proceedings, but non-admittance is a scenario that appellant I should have taken into consideration. Thus, no exceptional circumstances existed, nor were any justified with cogent reasons by appellant I, for the filing of the set of claims of auxiliary request 5 during the oral proceedings.

25. Thus, in exercising its discretion under Article 13(2) RPBA 2020, the board has not taken auxiliary request 5 into account.

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:

I. Aperribay M. Pregetter

Decision electronically authenticated