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**Datasheet for the decision  
of 3 May 2023**

**Case Number:** T 0972/20 - 3.3.08

**Application Number:** 11714788.4

**Publication Number:** 2561064

**IPC:** C12N1/36, C07K14/395

**Language of the proceedings:** EN

**Title of invention:**

Cell suitable for fermentation of a mixed sugar composition

**Patent Proprietor:**

DSM IP Assets B.V.

**Opponents:**

Novozymes A/S  
Lesaffre International

**Headword:**

Cell suitable for fermentation of a mixed sugar composition/  
DSM IP Assets B.V.

**Relevant legal provisions:**

RPBA 2020 Art. 13(2)

**Keyword:**

Amendment after summons - exceptional circumstances (no)

**Decisions cited:**

T 1904/16



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

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Case Number: T 0972/20 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 3 May 2023**

**Appellant:** DSM IP Assets B.V.  
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**Respondent I:** Novozymes A/S  
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**Respondent II:** Lesaffre International  
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**Representative:** Bandpay & Greuter  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 19 February  
2020 revoking European patent No. 2561064  
pursuant to Article 101(3) (b) EPC**

**Composition of the Board:**

<b>Chairwoman</b>	T. Sommerfeld
<b>Members:</b>	R. Morawetz
	A. Bacchin

## **Summary of Facts and Submissions**

- I. European patent EP 2 561 064 (the patent) is based on European patent application No. 11 714 788.4, published as WO 2011/131667 (the application) and claiming priority from, *inter alia*, US 61/326,351 (first priority application), filed on 21 April 2010. The patent is entitled "Cell suitable for fermentation of a mixed sugar composition".
- II. Two oppositions to the granted patent were filed. The patent was opposed under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC), and under Article 100(b) and (c) EPC.
- III. The opposition division revoked the patent. It held that the patent was not entitled to priority; that the effective date was the filing date and that WO 2011/003893 (document D6) was therefore prior art within the meaning of Article 54(2) EPC and the subject-matter of claim 1 of each of the main request (patent as granted) and auxiliary requests 1 to 4, all submitted by letter dated 28 November 2019, lacked an inventive step (Article 56 EPC) when document D6 was taken to represent the closest prior art.
- IV. The patent proprietor (appellant) filed notice of appeal against the opposition division's decision and paid the required fee.
- V. With the statement setting out the grounds of appeal, the appellant maintained the set of claims of the main request considered in the decision under appeal and re-submitted sets of claims of auxiliary requests 1 to 4

considered in the decision under appeal. It submitted lines of argument to the effect that the claims were entitled in full, or at least in part, to priority of the first priority application and that document D6 therefore was not prior art pursuant to Article 54(2) EPC.

- VI. Opponent 1 (respondent I) and opponent 2 (respondent II) submitted replies to the appeal.
- VII. The board scheduled oral proceedings in accordance with the parties' requests and subsequently issued a communication under Article 15(1) RPBA in which it indicated its preliminary opinion on, *inter alia*, entitlement to priority and inventive step of the main request. The board considered that claim 1 of the main request was not entitled to priority, in full or in part, that the effective date of claim 1 was the filing date and that the decision under appeal was correct on this point. On inventive step, the board considered that the appellant's submissions which were solely based on the assertion that document D6 was not prior art pursuant to Article 54(2) EPC could not succeed, that document D6 was to be taken into account for the assessment of inventive step and that it saw no reason to set aside the decision under appeal on this point either.
- VIII. By letter dated 28 April 2023, the appellant withdrew the main request and auxiliary requests 1 to 4 and submitted a new main request and new auxiliary requests 1 to 4.

Claim 1 of the new main request reads as follows (amendments compared to claim 1 of the previous main request are indicated by underlining or strike-

through) :

"1. Cell suitable for production of one or more fermentation product from a sugar composition comprising glucose, galactose, xylose, arabinose and mannose wherein the cell comprises two to fifteen copies of one or more xylose isomerase gene or two to fifteen copies of one or more xylose reductase and xylitol dehydrogenase, and ~~two to ten copies of each of araA, araB and araD genes~~, wherein said cell is a cell of strain B1E252, and wherein these genes are integrated into the cell genome."

In claim 1 of each of new auxiliary requests 1 to 4, the feature "*and two to ten copies of each of araA, araB and araD genes*", present in auxiliary requests 1 to 4 submitted with the statement of grounds of appeal, was replaced with the feature "*and araA, araB and araD genes, wherein said cell is a cell of strain B1E252*".

- IX. Oral proceedings before the board took place as scheduled. At the end of the oral proceedings, the Chairwoman announced the board's decision.
- X. The appellant's arguments relevant to the decision are summarised below.

*New main request and new auxiliary requests 1 to 4  
Admittance (Article 13(2) RPBA)*

The appellant had been taken by surprise by the board's preliminary opinion that the first priority application did not disclose the same invention as claim 1 of the previous main request and that claim 1 of the previous main request was not entitled to priority, in full or in part, and that the invention lacked inventive step

over document D6, which was published in the priority period.

The new claim requests were submitted in response to this unforeseeable development and could not have been filed earlier. The appellant had been certain that the opposition division had been wrong and that the arguments on priority and inventive step submitted in the grounds of appeal were persuasive and strong. Due to a change of representative, additional time had been required to identify a suitable strategy to address the board's preliminary opinion.

The new claim requests served to streamline the appeal proceedings by focusing on the exemplified strain, which had been extensively discussed in opposition proceedings, and procedural economy was enhanced by the withdrawal of the previous claim requests. The amendment was easy to understand and overcame the objections in the board's preliminary assessment. The strain BIE252 was explicitly mentioned in the priority document and hence, by limitation to this strain, priority was restored. Basis for the amendment could be found on page 4, lines 10 to 16 and in Example 4 on pages 49 to 52 of the application as filed. Strain BIE252 comprised three copies of each of the *araA*, *araB* and *araD* genes. The amendment thus represented a limitation of the earlier range from "two to ten copies" to three copies. The skilled person clearly understood the scope of the claim and would have had no problem to reproduce the exemplified strain. Document D6 did not disclose the BIE252 strain and hence was no longer relevant, pursuant neither to Article 54(2) EPC nor Article 56 EPC, for the new claim requests.



XI. Respondent I's and II's arguments relevant to the decision are summarised below.

*New main request and new auxiliary requests 1 to 4  
Admittance (Article 13(2) RPBA)*

There were no new or unforeseeable developments that justified an objective surprise, and the appellant's submissions were an admission that the surprise was subjective only. The board's preliminary view, far from being surprising, was to be expected. It merely confirmed what had been stated in the preliminary opinion of the opposition division and in the decision under appeal and could not justify the filing of new requests (see Case Law of the Boards of Appeal, 10th edn. 2022, (Case Law), V.A.4.5.4a)).

A change of representative could not justify late submissions (see Case Law, V.A.4.5.6n)).

The patent not being entitled to the claimed priority had been objected to from the outset of the opposition proceedings. The appellant should have addressed the objection earlier, during opposition proceedings or at the latest when making its case on appeal. The complete case had to be made at the beginning of the appeal.

Even if the board were to find that there were exceptional circumstances justifying the admittance of the amended claim requests, the new claim requests were not *prima facie* clearly allowable, and the amendment introduced new issues, including lack of clarity, lack of sufficiency of disclosure, added subject-matter and extension of protection. The amendment came from the description, not from a dependent claim. The term "strain BIE252" was not clear because the skilled

person did not know what this strain was. Since the strain BIE252 had not been deposited, the skilled person had no access to it, leading to a sufficiency issue. Suppression of the "*and two to ten copies of each of araA, araB and araD genes*" feature led to an extension of protection. The amendments did not therefore contribute to simplifying the proceedings.

There were no exceptional circumstances justified by cogent reasons.

XII. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the new main request and new auxiliary requests 1 to 4, submitted with the letter dated 28 April 2023, be admitted into the appeal proceedings and that the patent be maintained in amended form on the basis of the new main request or, alternatively, the new auxiliary requests.

Respondent I and II (opponent 1 and 2) requested that the appeal be dismissed and that the new main request and the new auxiliary requests 1 to 4, filed with the letter dated 28 April 2023, be not admitted into the appeal proceedings. Respondent II requested in addition that if the new requests were admitted, oral proceedings be postponed and a different apportionment of costs be ordered.

### **Reasons for the Decision**

*New main request and new auxiliary requests 1 to 4  
Admittance (Article 13(2) RPBA)*

1. The new main request and new auxiliary requests 1 to 4 were submitted in response to the board's communication

under Article 15(1) RPBA, shortly before the oral proceedings (see section VIII. above). The respondents requested that these new claim requests not be admitted into the appeal proceedings.

2. In the following, the new claim requests are dealt with together because the amendment in claim 1 of each of these claim requests compared to the corresponding previous requests is the same (see section VIII. above). It consists in the replacement of the feature "*and two to ten copies of each of araA, araB and araD genes*", present in all claim requests submitted with the statement of grounds of appeal, with the feature "*and araA, araB and araD genes, wherein said cell is a cell of strain BIE252*".
  
3. Pursuant to Article 13(2) RPBA, which applies in the case at hand (Article 25(1) and (3) RPBA), any amendment to a party's appeal case after notification of a summons to oral proceedings is, as a rule, not to be taken into account unless there are exceptional circumstances justified with cogent reasons by the party concerned. Article 13(2) RPBA implements the third level of the convergent approach applicable in appeal proceedings and imposes the most stringent limitations on a party wishing to amend its appeal case at an advanced stage of the proceedings (see document CA/3/19, section VI, Explanatory remarks on Article 13(2) RPBA, in Supplementary publication 2 to OJ EPO 2020). Exceptional circumstances are new or unforeseen developments in the appeal proceedings which lie outside the sphere of influence of the party affected by them, such as new objections raised by the board or another party (see Case Law, V.A.4.5.1).

4. The appellant submitted as justification for filing the new claim requests a few days before the oral proceedings that it had been surprised by the board's preliminary opinion that claim 1 of the main request submitted with the statement of grounds of appeal was not entitled to priority and lacked inventive step over document D6. The amendment served to restore entitlement to priority and could not have been filed earlier. Additional time had been required to prepare the new claim requests due to a change of representative.
5. The board was not persuaded that the appellant's reasons were indicative of exceptional circumstances justified with cogent reasons within the meaning of Article 13(2) RPBA.
6. In the decision under appeal, the opposition division had found that the patent was not entitled to priority and that the subject-matter of claim 1 of the main request submitted with the statement of grounds of appeal lacked an inventive step when document D6 was taken to represent the closest prior art (see section III. above). The appellant had to expect that the board would accept either the argument of the opposition division or the appellant. As it turned out, the board's preliminary opinion (see section VII.) agreed with the opposition division - one of the expected outcomes - and thus was not a new or unforeseeable development that constituted an objective surprise (see Case Law, V.A.4.5.4a) and V.A.4.5.6c)).
7. When asked at the oral proceedings why it had been taken by surprise by the preliminary opinion of the board, the appellant did not allege that the board had raised any new objections. Instead, it submitted that

it had been convinced that the decision under appeal was wrong as regards entitlement to priority and certain that its line of argument on entitlement to priority submitted with the statement of grounds of appeal was persuasive and strong. The negative opinion of the board had therefore come as a surprise to the appellant.

8. The board agrees with the respondents that this line of reasoning is indicative of a subjective surprise of the appellant based on the conviction of its own arguments. However, it cannot be objectively justified by an unforeseeable development and does not explain why the amendment at issue could not have been made at an earlier stage, e.g. with the statement of grounds of appeal when any claim requests on which the appellant wished to rely on appeal should have been filed pursuant to Article 12(3) RPBA. The board furthermore agrees with the respondents that in the case at hand, amendments aiming at restoring priority could evidently have been submitted at an earlier stage since the objection had been in the proceedings from the outset of the opposition proceedings (see respondent I's notice of opposition, points 5.4 to 5.9 and respondent II's notice of opposition, section 1.4) and was also addressed by the opposition division in its preliminary opinion of 7 May 2019 issued in preparation for the oral proceedings (see point 3.7 at page 4).
9. Since a change of representation lies within a party's control, it is unsuitable for establishing extraordinary circumstances or for justifying the submission of amendments only a few days before the oral proceedings (see e.g. T 1904/16, Reasons 16.4 and

Case Law, V.A.4.5.6n)).

10. Exceptional circumstances within the meaning of Article 13(2) RPBA have been acknowledged to exist in the case law of the boards provided the admittance of amendments to a party's appeal was not detrimental to the procedural economy of the appeal proceedings (see Case Law, V.A.4.5.1).
11. In the case at hand, the admittance discussion during oral proceedings alone spoke against the appellant's argument that the submission of the new requests streamlined the proceedings and served procedural economy. Furthermore, the amendment, which came from the description, not from a dependent claim, *prima facie* gave rise to new issues which had not been considered in the opposition or appeal proceedings, including the question of whether the term "strain BIE252" had a clear meaning to the skilled person (Article 84 EPC) and whether "strain BIE252" was sufficiently disclosed in the application as filed (Article 83 EPC). The new claim requests were therefore not *prima facie* clearly allowable and required more discussion, and their admittance would have been inconsistent with the requirement of procedural economy of the appeal proceedings.
12. The board therefore decided not to admit the new main request and new auxiliary requests 1 to 4 into the appeal proceedings.

#### *Conclusion*

13. All claim requests submitted with the statement of grounds of appeal have been withdrawn, and the new claim requests, submitted by letter dated

28 April 2023, were not admitted into the appeal proceedings. Therefore, the decision under appeal cannot be set aside, and the appeal must be dismissed.

14. Since the new claim requests were not admitted into the proceedings, the requests of respondent II for postponement of the oral proceedings and for apportionment of costs did not need to be addressed.

### **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairwoman:



L. Malécot-Grob

T. Sommerfeld

Decision electronically authenticated