

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 17 February 2023**

**Case Number:** T 1078/21 - 3.3.08

**Application Number:** 14830801.8

**Publication Number:** 3077520

**IPC:** C12N15/864, C12N9/10

**Language of the proceedings:** EN

**Title of invention:**

Methods and pharmaceutical compositions for expressing a polynucleotide of interest in the retinal pigment epithelium of a subject

**Applicant:**

INSERM (Institut National de la Santé et de la Recherche Médicale)  
Centre Hospitalier Universitaire de Montpellier  
Université de Montpellier

**Headword:**

Expression in retinal pigment epithelium/INSERM

**Relevant legal provisions:**

RPBA 2020 Art. 12(2), 12(4), 12(6)

**Keyword:**

primary object of appeal proceedings to review decision -  
appeal case directed to requests on which decision was based  
(no)

**Decisions cited:**

G 0009/91

**Catchword:**

-



**Beschwerdekammern**

**Boards of Appeal**

**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

**Case Number: T 1078/21 - 3.3.08**

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 17 February 2023**

**Appellant:** INSERM (Institut National de la Santé  
(Applicant 1) et de la Recherche Médicale)  
101, rue de Tolbiac  
75013 Paris Cédex 13 (FR)

**Appellant:** Centre Hospitalier Universitaire de Montpellier  
(Applicant 2) 19, Avenue Doyen Gaston Giraud,  
34005 Montpellier (FR)

**Appellant:** Université de Montpellier  
(Applicant 3) 163, rue Auguste Broussonnet  
34090 Montpellier (FR)

**Representative:** Icosa  
83 avenue Denfert-Rochereau  
75014 Paris (FR)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 29 January 2021  
refusing European patent application No.  
14830801.8 pursuant to Article 97(2) EPC**

**Composition of the Board:**

**Chair** T. Sommerfeld  
**Members:** B. Claes  
N. Obrovski

## **Summary of Facts and Submissions**

- I. The appeal of the applicants (appellants) lies from the decision of the examining division refusing European patent application No. 14 830 801.8, filed under the PCT as an international patent application published as WO 2015/082690 (application as filed). The title of the application is "*Methods and pharmaceutical compositions for expressing a polynucleotide of interest in the retinal pigment epithelium of a subject*".
- II. The examining division decided that the subject-matter of the claims of the main request complied with the requirements of Article 123(2) EPC. The application was, however, refused because the subject-matter of claims 1 to 10 was considered to lack an inventive step (Article 56 EPC).
- III. With the statement of grounds of appeal, the appellants submitted sets of claims of a new main request, two auxiliary requests and arguments that the claimed subject-matter of each of these requests complied with the requirements of Article 123(2) EPC and involved an inventive step (Article 56 EPC).
- IV. Subsequent to summoning the appellants to oral proceedings, the board issued a communication pursuant to Article 15(1) RPBA in which it informed the appellants that, *inter alia*, it intended not to admit and consider the main request and the two auxiliary requests in the appeal proceedings (Article 12(4) and (6) RPBA), explaining its reasons.
- V. Prior to the oral proceedings, the registry of the board was informed by email that the appellants would

not attend the oral proceedings. Oral proceedings were held in the absence of the appellants. At the end of the oral proceedings, the Chair announced the decision of the board.

- VI. The appellants requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims of the main request or, alternatively, one of the sets of claims of auxiliary requests 1 or 2, all submitted with the statement of grounds of appeal.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The appellants were duly summoned but did not attend the oral proceedings. The board decided to continue the proceedings in the appellants' absence, in accordance with Rule 115(2) EPC and Article 15(3) RPBA.

*Admittance into the appeal proceedings of the requests filed with the statement of grounds of appeal*

3. The decision under appeal was based on a set of claims of a main request designated MR4 filed at the end of the oral proceedings before the examining division (see points 23 and 28 of the minutes of the oral proceedings (the minutes) and its annex). Prior to the filing of version MR4 of the main request, other versions of the main request had been filed, including a version on 16 November 2020, which was withdrawn at the beginning of the oral proceedings, and later versions designated MR1, MR2 and MR3, which were successively filed and withdrawn in the course of the oral proceedings.

4. All three sets of claims submitted in appeal for consideration by the board were filed for the first time with the statement of grounds of appeal (see section III.) and are, thus, not requests on which the decision under appeal was based within the meaning of Article 12(2) RPBA. Their submission in the appeal proceedings therefore constitutes an amendment within the meaning of Article 12(4) RPBA, which may be admitted into the appeal proceedings only at the board's discretion. Furthermore, as explained below, these requests also constitute requests which were either no longer maintained by the appellants or which should have been submitted in the examination proceedings under Article 12(6) RPBA.

*Main request and auxiliary request 1*

5. The main request forming the basis of the decision under appeal (MR4, see point 3.) contains only independent claims which either do not limit the polynucleotides of interest to be under the control of a CAG promoter (claim 1) or which limit such control to the specific REP1 encoding polynucleotide of interest (claim 10). The examining division considered these claims to comply with the requirement of Article 123(2) EPC (see point II. above).
6. Independent claim 9 of the main request and independent claim 2 of auxiliary request 1 (the two claims being identical) deviate from independent claim 10 of the main request in version MR4 in that the claimed rAAV2/5 vector contains a polynucleotide of interest which encodes a protein which can be different from REP1, is selected from a particular list and is "*under the control of a CAG promoter*".

7. Independent claim 9 of the main request and independent claim 2 of auxiliary request 1 are identical to dependent claim 11 of the set of claims designated MR1, which was filed during the oral proceedings before the examining division (see annex to the minutes and point 3. above). According to points 7 and 8 of the minutes, the examining division considered that this claim did not comply with the requirements of Article 123(2) EPC (note: the board considers it obvious from the context that the reference in line 2 of point 8 to claim 10 is erroneous and is intended to refer to claim 11). The appellants then withdrew MR1 and replaced it with a new claim request (see point 9 in the minutes).
8. By filing the new main request and auxiliary request 1 in appeal, the appellants are attempting to reinstate a claim which was withdrawn in reaction to the negative opinion of the examining division and was thus no longer maintained in the examination proceedings. As a result, subject-matter is re-introduced in the appeal proceedings on which the examining division opined negatively under Article 123(2) EPC but for which the examining division had no opportunity to provide reasons in the decision under appeal.
9. The primary purpose of the appeal procedure is to give the losing party a possibility to challenge the decision on its merits (see Article 111(1) EPC and decision G 9/91, OJ EPO 1993, 408, Reasons 18). It has further been codified in Article 12(2) RPBA that in view of the primary object of the appeal proceedings to review the decision under appeal in a judicial manner, a party's appeal case is to be directed to the

requests, facts, objections, arguments and evidence on which the decision under appeal was based.

10. In the case in hand, by withdrawing the mentioned claim in the MR1 main request in examination, the appellants deliberately chose not to obtain a written decision covering a rAAV2/5 vector containing a polynucleotide of interest, which encodes a protein which can be different from REP1, is selected from a particular list and is "*under the control of a CAG promoter*".
11. In accordance with Article 12(6), second sentence, RPBA, the board must not, *inter alia*, admit requests which were no longer maintained in the proceedings leading to the decision under appeal unless the circumstances of the appeal case justify their admittance. No justification has been provided by the appellants, and the board does not consider that there are any such justifying circumstances either.
12. In view of the above considerations, the board exercised its discretion under Article 12(6) RPBA and did not admit and consider the main request and auxiliary request 1 in the appeal proceedings.

*Auxiliary request 2*

13. The sole claim of this request is a combination of independent claim 1 and its dependent claim 2 of the main request subject to the decision under appeal (MR4). This is not a request on which the decision under appeal is based either, and its admittance is thus at the board's discretion (see point 4. above).



14. Article 12(4) RPBA, second sentence requires the submitting party to provide reasons for submitting the request in the appeal proceedings and also, besides indicating the basis for the amendments filed, to provide reasons why the amendment overcomes the objections raised. Furthermore, in accordance with Article 12(6) RPBA, second sentence, the board must not admit requests which should have been submitted in the proceedings leading to the decision under appeal unless the circumstances of the appeal case justify their admittance.
  
15. The appellants have not complied with their obligations under Article 12(4) RPBA, second sentence. They have neither provided reasons for submitting this request only in the appeal proceedings, nor indicated the basis for the amendment in the application as filed, nor provided reasons why the amendment overcomes the objections raised. They merely alleged that the decision under appeal was wrong on this point. Moreover, the board considers that the appellants could and should have filed this request in the examination proceedings. The appellants have not argued that auxiliary request 2 was filed in response to e.g. a late turn of events in the examination proceedings or a new reasoning by the examining division in the decision under appeal to which they had not had time to react.
  
16. In view of the above considerations, the board exercised its discretion under Article 12(4), (6) RPBA and did not admit and consider auxiliary request 2 in the appeal proceedings.

*Conclusion*

17. As there is no claim request in the proceedings on the basis of which a patent could be granted, the appeal is to be dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chair:



L. Malécot-Grob

T. Sommerfeld

Decision electronically authenticated