

Internal distribution code:

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

**Datasheet for the decision
of 27 March 2025**

Case Number: T 0386/23 - 3.3.08

Application Number: 16724290.8

Publication Number: 3283625

IPC: C12N9/22

Language of the proceedings: EN

Title of invention:

Nuclease-mediated genome editing

Patent Proprietor:

Wageningen Universiteit

Opponents:

Strawman Limited (opposition withdrawn)
James Poole Limited
Boult Wade Tennant LLP

Headword:

Nuclease-mediated genome editing/WAGENINGEN UNIVERSITEIT

Relevant legal provisions:

EPC Art. 113(1), 111(1), 100(a), 56
EPC R. 111(2)
RPBA 2020 Art. 12(3), 13(2)

Keyword:

Appealed decision - substantial procedural violation (no) -
reasoned (yes)

Remittal to the department of first instance (no)

Grounds for opposition - inventive step (no)

Statement of grounds of appeal - reasons set out clearly and
concisely (no)

Amendment after summons - exceptional circumstances (no)

Decisions cited:

T 1577/07



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

Case Number: T 0386/23 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 27 March 2025

Appellant: Wageningen Universiteit
(Patent Proprietor) Droevendaalsesteeg 4
6708 PB Wageningen (NL)

Representative: HGF
HGF Limited
1 City Walk
Leeds LS11 9DX (GB)

Respondent I: James Poole Limited
(Opponent 2) One Southampton Row
London WC1B 5HA (GB)

Representative: Carpmiels & Ransford LLP
One Southampton Row
London WC1B 5HA (GB)

Respondent II: Boulton Wade Tennant LLP
(Opponent 3) Salisbury Square House
8, Salisbury Square
London EC4Y 8AP (GB)

Representative: Boulton Wade Tennant LLP
Salisbury Square House
8 Salisbury Square
London EC4Y 8AP (GB)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 22 December
2022 revoking European patent No. 3283625
pursuant to Article 101(3)(b) EPC**

Composition of the Board:

Chairwoman	T. Sommerfeld
Members:	R. Morawetz
	D. Rogers

Summary of Facts and Submissions

- I. The appeal lodged by the patent proprietor (appellant) lies from the decision of the opposition division revoking European patent No. 3 283 625 ("the patent"), granted on European patent application No. 16 724 290.8 which was filed as an international application under the PCT and published as WO 2016/166340. The patent is entitled "*Nuclease-mediated genome editing*".
- II. Three oppositions were filed against the patent, which was opposed under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC), lack of inventive step (Article 56 EPC) and lack of industrial application (Article 57 EPC) and under Article 100(b) and (c) EPC.
- III. In the decision under appeal, the opposition division considered a main request (claims as granted) and sets of claims of auxiliary requests 1 to 13. The opposition division found that all requests contravened Article 56 EPC.
- IV. In their grounds of appeal, the appellant maintained the requests considered in the decision under appeal and provided arguments why the case should be remitted to the opposition division for further prosecution, and why the main request met the requirements of Article 56 EPC.
- V. In the reply to the appellant's grounds of appeal, both opponents 1 and 2 provided arguments why the case should not be remitted to the opposition division and why the subject-matter of *inter alia* the main request

lacked an inventive step.

- VI. The board scheduled oral proceedings, in accordance with the parties' requests, and in a communication pursuant to Article 15(1) RPBA, expressed the preliminary opinion that it had seen no reasons to remit the case to the opposition division or to set aside the decision under appeal with respect to the main request. The board noted that the appellant had failed to explain the purpose of the amendments to claim 1 in auxiliary requests 5 to 11 or how these amendments contributed to the inventive step of the claimed subject matter.
- VII. By letter dated 11 December 2024, opponent 1 withdrew their opposition thereby ceasing to be a party to the appeal proceedings. Opponent 2 (respondent I) and Opponent 3 (respondent II) indicated that they would not attend the oral proceedings.
- VIII. In response to the board's communication, under cover of a letter dated 14 March 2025, the appellant provided arguments why the subject-matter of the main request and of auxiliary requests 5 to 11 involved an inventive step.
- IX. Oral proceedings took place as scheduled, in the absence of the respondents. At the end of the oral proceedings, the chairwoman announced the board's decision.
- X. The following documents are referred to in this decision:

D3: Schunder E. *et al.*, International Journal of Medical Microbiology, 2013, vol. 303,

pages 51 to 60

D5a: Zetsche B. *et al.*, Cell, 22 October 2015,
vol. 163, pages 759 to 771

- XI. The parties' submissions and arguments, in so far as they are relevant to the present decision, are discussed in the Reasons for the decision.
- XII. The appellant's requests relevant for the decision were:
- that the case be remitted to the opposition division because of procedural violations arising from the conduct of the oral proceedings by the opposition division and the lack of reasoning in the decision under appeal with respect to auxiliary requests 5 to 11;
 - should the board decide that there were no procedural violations, that the board remit the case to the opposition division because the manner in which the opposition division conducted the oral proceedings and the lack of reasoning in the decision under appeal in relation to auxiliary requests 5 to 11 amounted to fundamental deficiencies which constitute "special reasons" for a remittal to the opposition division under Article 11 RPBA;
 - that, if the case is not remitted to the opposition division, the board decide on inventive step in relation to the main request and each of auxiliary requests 5 to 11 and the board appoint an (interim) oral proceedings prior to the issue of any decision concerning non-compliance of a claim request with Article 56 EPC; and
 - that the decision under appeal be set aside and the patent be maintained on the basis of the patent as granted (main request) or, alternatively, that the

patent be maintained in amended form on the basis of one of auxiliary requests 1 to 13.

Respondent I requested in writing:

- that the appeal be dismissed;
- that the case be remitted to the opposition division for further prosecution if the appeal is allowed in relation to any claim request;
- that the appellant's requests for remittal of the case to the opposition division because of procedural violations or because of "special reasons" be dismissed.

Respondent II made no requests or submissions during the appeal procedure.

Reasons for the Decision

Request for remittal of the case due to procedural violations

1. Remitting a case to the department whose decision was appealed requires special reasons (Article 11 RPBA). As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons. A fundamental deficiency within the meaning of Article 11 RPBA is not caused by all procedural violations but rather only by a "substantial" procedural violation.
2. According to the established case law of the boards of appeal, the violation of a party's right to be heard under Article 113(1) EPC or a breach of Rule 111(2) EPC would constitute fundamental procedural deficiencies that amount to a special reason within the meaning of Article 11 RPBA and justify remittal to the department that issued the contested decision (Case Law of the

Boards of Appeal of the European Patent Office 10th edition 2022, "Case Law", V.A.9.4.4 a) and b)).

3. As a first line of argument the appellant submitted that there was a violation of procedure on the basis that, during the oral proceedings *"no decisions with reasons were made with respect to AR5 -AR11 where additional features are included compared to claim 1 of the MR"* (grounds of appeal, item 4.3). In particular, neither the decision nor the minutes provide any reasons why the amendments to claim 1 made in auxiliary requests 5 to 11 *"simply incorporated inherent features"* (grounds of appeal, item 4.5).
4. Pursuant to Rule 111(2), first sentence, EPC, decisions of the European Patent Office which are open to appeal shall be reasoned. The reasons for the opposition division's decision must be given in the written decision. By contrast, the minutes of the oral proceedings ("minutes") need only fulfil the requirements of Rule 124(1) EPC, i.e. contain the essentials of the oral proceedings. Contrary to the appellant's view, the fact that the opposition division did not give reasons for its decision at the oral proceedings and the absence of reasons in the minutes therefore do not constitute procedural violations.
5. As regards the lack of reasons for holding that the amendments to claim 1 in auxiliary requests 5 to 11 amounted to the incorporation of inherent features, the board observes that according to the case law, a decision must comment on the crucial points of dispute to give the losing party a fair idea of why its arguments were not considered convincing (T 1557/07, Reasons 2.6). It follows that a decision does not have

to deal with issues that were not in dispute.

6. In the present case, it is apparent from the minutes that it was not in dispute that the additional features added to claim 1 in auxiliary requests 5 to 11 were in fact inherent features of the protein encoded by the FTN1397 gene.
7. Thus, the minutes show that the chairperson of the opposition division, after the parties were heard on inventive step of claim 1 of the main request stated *"the OD's opinion that claim 1 of the MR lacks an inventive step according to Article 56 EPC"* (minutes, paragraph 12). In addition, *"[t]he chairperson further announced that the expression from a vector of FTN1397 would be obvious to the skilled person and that the definition of the expressed protein by inherent features of FTN1397 would therefore not appear to render claims to expression vectors inventive."* (ibid.)
8. In reaction to this announcement, *"[t]he PA asked the chairperson to consider whether this opinion meant that also all ARs were not inventive"* (ibid.) and *"after a further break from 14:15 to 14:25, the chairperson of the OD expressed the preliminary opinion that the main claims of all requests lack an inventive step according to Article 56 EPC"* (minutes, paragraph 13) and *"[i]n reply, the PA requested a break to prepare a further auxiliary request"* (minutes, paragraph 14).
9. Claim 1 of auxiliary requests 1 to 4, 12 and 13 is identical to claim 1 of the main request. It is therefore clear from the way in which the appellant formulated its question at the oral proceedings before the opposition division (point 8. above), that the appellant itself considered that the features added to

claim 1 in auxiliary requests 5 to 11 define the expressed protein by features inherent to the protein encoded by the FTN1397 gene.

10. Moreover, the appellant did not contest this when it had the opportunity to do so at the oral proceedings before the opposition division. Thus, when the opposition division announced its preliminary opinion that the main claims of all requests lacked an inventive step (point 8. above), the appellant did not argue against the opposition division's preliminary opinion, for example to explain why the additional features could overcome the lack of inventive step found in respect of the main request or why the additional features were not inherent in the protein encoded by the FTN1397 gene. Instead, they requested a break in order to prepare a further auxiliary request (point 8. above).
11. The opposition division was therefore not obliged to give reasons why the amendments to claim 1 made in auxiliary requests 5 to 11 constitute inherent features of the protein encoded by the FTN1397 gene.
12. The board concludes from the above that the decision under appeal is reasoned within the meaning of Rule 111(2) EPC.
13. In a further argument, the appellant submitted that the "[t]he OD's conduct of the oral proceedings was such that a decision to revoke was announced in under a day (when two days were allocated) without the Proprietor having the opportunity to make oral submissions directly on the question of inventive step of any of AR5 - AR11." (grounds of appeal, item 4.11)

14. Pursuant to Article 113(1) EPC the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.
15. The question to be addressed is therefore whether the appellant had the opportunity to comment on the inventive step of auxiliary requests 5 to 11 at the oral proceedings before the opposition division.
16. The relevant parts of the minutes of the oral proceedings before the opposition division are set out in points 7. and 8. above.
17. In the board's view, it is clear from the minutes that the appellant had the opportunity to comment on the inventive step of auxiliary requests 5 to 11 after the opposition division had expressed its preliminary opinion that these requests were not based on an inventive step by providing arguments why auxiliary requests 5 to 11 could overcome the lack of inventive step found in respect of the main request (see also point 10. above). It was the appellant's own decision not to challenge the opposition division's preliminary opinion at this stage of the oral proceedings and instead to request a break for the preparation of a further auxiliary request (point 8. above).
18. At the oral proceedings before the board, the appellant further developed its argumentation as follows: At the oral proceedings before the opposition division, three possible technical problems were discussed. When the opposition division announced its view that the main request contravened Article 56 EPC, that only inherent features had been included in claim 1 of auxiliary requests 5 to 11 and that all auxiliary requests

contravened Article 56 EPC, the appellant concluded that the opposition division had accepted that the main request solved the objective technical problem proposed by the appellant, i.e. problem 3 in the decision under appeal. This was because auxiliary requests 5 to 11 necessarily solved problem 3. The decision on auxiliary requests 5 to 11 would have been different had the opposition division not accepted that the main request also solved problem 3. For this reason, the appellant was prevented from arguing during oral proceedings before the opposition division that auxiliary requests 5 to 11 necessarily solved problem 3. Only from the written decision of the opposition division did the appellant learn that the opposition division had come to the conclusion that problem 3 was not solved by claim 1 of the main request. This was a surprise.

19. This argument is also unconvincing. The appellant's argumentation as to why they assumed that the opposition division had accepted that the main request solved problem 3 is unreasonable. Different claim requests may solve different technical problems and yet all of them may lack inventive step. There was no objective reason to conclude from the opposition division's preliminary view (point 8. above) that it had accepted that the main request solved problem 3. Furthermore, the fact that the appellant, as a consequence of their unfounded assumptions, felt prevented from arguing at the oral proceedings that auxiliary requests 5 to 11 necessarily solved problem 3, does not mean that they were actually prevented from doing so by the opposition division. Rather, it reflects their own decision not to argue this point.

20. Finally, the fact that the appellant's assumption as to which problem the opposition division considered to be solved by the subject-matter of claim 1 of the main request proved to be incorrect may constitute a subjective surprise but it does not constitute a procedural error on the part of the opposition division. As the appellant acknowledged, all three technical problems were discussed at the oral proceedings and, objectively, the appellant had to expect that the opposition division would follow either the appellant's or the opponents' arguments with respect to the objective technical problem solved by claim 1 of the main request. As it turned out, the opposition division agreed with the opponents.
21. Hence, the board concludes that the appellant had an opportunity to present their comments on inventive step of auxiliary requests 5 to 11 at the oral proceedings before the opposition division. That the appellant's arguments presented in writing in support of auxiliary requests 5 to 11 were duly considered by the opposition division was not contested by the appellant.
22. The board concludes from the above that the opposition division's reasoning for holding that auxiliary requests 5 to 11 lack inventive step is based on grounds on which the appellant had the opportunity to comment (Article 113(1) EPC).
23. Furthermore, the appellant criticised the opposition division for treating auxiliary requests 5 to 11 "*as a parallel bundle of requests without considering each in turn and providing a separate reasoned decision for each claim request*" (grounds of appeal, item 4.10).

24. However, the board cannot recognise any error in the opposition division's approach. It is common practice of the departments of first instance, and also of the boards of appeal, to group together different requests if - as in the present case - the same reasons apply to these requests.
25. The board concludes from the above that the opposition division did not commit any procedural violation, let alone a substantial one.

Request for remittal of the case for special reasons

26. The appellant asserted that, *"even if the Board does not agree that there has been a procedural violation, the manner in which the OD conducted the oral proceedings and issued the Decision in relation to AR5 - Ar11 still amounts to fundamental deficiencies, which constitute 'special reasons' for a remission back to the OD under Art. 11 RPBA."* (grounds of appeal, item 4.12)
27. The board already found that the conduct of the oral proceedings by the opposition division did not infringe the appellant's right to be heard under Article 113(1) EPC and that the decision under appeal is reasoned within the meaning of Rule 111(2) EPC (points 3. to 24. above). It is neither explicitly nor implicitly apparent from the appellant's submissions in the grounds of appeal that the proceedings at first instance suffered from any other fundamental deficiencies. There are therefore no fundamental deficiencies which constitute "special reasons" for remitting the case (Article 11 RPBA).

28. The board therefore decided to reject the appellant's request for a remittal to the opposition division due to procedural violations or for special reasons.

Main request (patent as granted) - claim 1

The claimed invention - claim construction

29. Claim 1 of the main request reads as follows:

"An expression vector comprising a nucleotide sequence encoding a Cpf1 polypeptide comprising the amino acid sequence YLFQIYNKDF (amino acid residues 784-793 of SEQ ID NO: 1)."

30. The opposition division found that the term "Cpf1" was not part of the common general knowledge at the priority date, that the patent did not contain a limiting definition of the term and that the patent did not establish that the amino acid sequence YLFQIYNKDF was associated with a function. Claim 1 was accordingly understood to cover vectors that comprise a nucleic acid that encodes merely a polypeptide with a YLFQIYNKDF motif.

31. The appellant has neither disputed the finding of the opposition division regarding the amino acid sequence YLFQIYNKDF nor the finding that the term "Cpf1" had no accepted meaning in the art at the priority date of the patent.

32. However, they submitted that *"the term 'Cpf1' as recited in claim 1, would be readily recognised by the skilled person reading the application as filed as referring to 'a novel nuclease (Cpf1) unrelated to Cas9 for application as a gene editing tool' [note by the*

board: that disclosure is found in the application, on page 5, lines 31 and 32, and in the patent in paragraph [0020] *that has at least a structure as shown in Figure 1 the legend of which discloses 'the domain structure of the novel CRISPR-Cas nuclease, Cpf1. Three RuvC nuclease domains, a Zinc-finger and an arginine-rich domain that allows for interaction with RNA guide and DNA target are shown.'* [note by the board: that disclosure is found in the application on page 16, lines 29 to 31, and in the patent in paragraph [0084]]" (letter dated 14 March 2025, page 2, second paragraph). At the oral proceedings before the board, the appellant in addition referred to paragraph [0083] of the patent as providing information on the new class of "Cpf1" polypeptides.

33. On this basis, the appellant submitted that the term "Cpf1" was limiting on the scope of the claims, and claim 1 of the main request accordingly limited to a polypeptide that has nuclease activity, is unrelated to Cas9 and has a structure including three RuvC nuclease domains, a Zinc-finger, and an arginine-rich domain.
34. The appellant's argument is thus based on the premise, firstly, that the description provides a limiting definition of the term "Cpf1", and secondly, that this limiting definition of the term "Cpf1" must be taken into account when interpreting the claims.
35. The board adopts the approach that the claims are the starting point and the basis for assessing the patentability of an invention under Articles 52 to 57 EPC. The description and any drawings are always referred to when interpreting the claims, and not just in the case of unclarity or ambiguity.

36. For the reasons set out below, however, the board did not need to consider whether a limiting definition of a term contained in the description can be taken into account when interpreting the claims.
37. In the following, the board refers to the patent.
38. None of the passages of the description relied on by the appellant provides an explicit definition of how the term "*Cpf1*" is to be understood in the context of the claimed invention. Indeed, nowhere in the description is there an explicit definition of the term "*Cpf1*".
39. Contrary to the appellant's submission, paragraph [0083] of the patent relates to a specific protein having amino acid sequence SEQ ID NO: 1, not to a class of proteins. Taken together, the patent teaches in paragraphs [0020], [0083] and [0084] that a novel nuclease is provided, which is unrelated to Cas9, has been labelled "*Cpf1*", has the amino acid sequence SEQ ID NO:1 and the structure shown in Figure 1, i.e. three RuvC nuclease domains, a Zinc-finger and an arginine-rich domain.
40. However, it cannot be inferred from the description that the function and structure of this novel CRISPR-Cas nuclease, which is designated "*Cpf1*", are defining features of the term "*Cpf1*" or of a new class of proteins that are identified as "*Cpf1*".
41. Furthermore, as correctly noted by respondent I, e.g. paragraph [0041] of the patent states that a RuvC domain is optional and the patent also does not provide any experimental data for any *Cpf1* polypeptides.

42. Also for this reason, the skilled person reading the patent would therefore not have concluded that the function and structure of the novel CRISPR-Cas nuclease described in paragraphs [0020], [0083] and [0084], which has a RuvC-like nuclease domain, defines the term "*Cpf1*" throughout the patent.
43. The appellant's argument that the patent provides a limiting definition of the term "*Cpf1*" is therefore not found persuasive.
44. The board concludes that the term "*Cpf1*" does not impart any identifiable and unambiguous structural or functional features to the claimed polypeptide, and therefore does not define it any further.
45. In view of the above, the board sees no reason to deviate from the claim construction applied in the decision under appeal.

Inventive step

46. The opposition division held that claim 1 of the main request lacked inventive step in view of the teaching of document D3.
47. As a first line of argument the appellant submitted that the opposition division had not properly applied the problem and solution approach because it failed to identify the features distinguishing the claimed invention from the disclosure in document D3 and the technical effect resulting from these features and instead directly identified three different technical problems. On this basis, the appellant submitted that problems 1 and 2 identified by the opposition division

had to be rejected.

48. The board agrees with the appellant that the opposition division failed to expressly indicate the features distinguishing the claimed invention from the disclosure in document D3 and the technical effects resulting from these distinguishing features. However, the board is not convinced that technical problems 1 and 2 identified by the opposition division must therefore be rejected.
49. In the board's view, the decision under appeal allows the individual elements of the opposition division's reasoning which formed the steps leading to the formulation of the three technical problems to be analysed.
50. Thus, for analysing inventive step, the opposition division first examined the features of claim 1 (Reasons 42.3.3 and 42.3.12 and 42.3.13) and compared them to the disclosure in document D3, which it considered to qualify as the closest prior art (Reasons 42.3.4 to 42.3.11). It follows from Reasons 42.3.12 and 42.3.13 of the decision under appeal that no function was acknowledged for a Cpf1 polypeptide with a YLFQIYNKDF motif and that nuclease activity was not considered to be a distinguishing feature.
51. The reasons given by the opposition division in the decision under appeal (Reasons 42.3.3; 42.3.4; 42.3.7; 42.3.12, 42.3.13, 42.4.1.1. to 42.4.1.3 , 42.5.1, 42.5.2) are furthermore sufficient to enable the parties and the board to understand that the opposition division considered that document D3 discloses a polypeptide that comprises the YLFQIYNKDF motif and that claim 1 of the main request differs from this

disclosure in that it provides an expression vector comprising a sequence encoding this polypeptide.

52. The objective technical problem has to be formulated based on the effect(s) achieved by the distinguishing feature(s).
53. As regards the technical effects associated with the distinguishing features, it is clear that the opposition division considered three possible technical effects, which are reflected in the formulation of the different technical problems, i.e. problems 1, 2 and 3 (decision under appeal, Reasons 42.4.1.1 to 42.4.1.3). Problem 1 was defined as the provision of an expression vector comprising a sequence that encodes a member of a group of polypeptides sharing a specific sequence motif.
54. It is furthermore clear (decision under appeal, Reasons, 42.3.3, 42.3.12, 42.3.13 and 42.4.1.1) that the opposition division considered that only problem 1 was solved across the whole scope of claim 1 of the main request.
55. However, the opposition division found that the claimed solution was obvious, irrespective of how ambitious the technical problem was formulated vis-à-vis document D3 (decision under appeal, Reasons 42.5.1, 42.5.2 and 42.5.3).
56. In the grounds of appeal, the appellant did not contest the opposition division's reasoning for holding that the claimed subject-matter was an obvious solution to each of problem 1 and problem 2.

57. Against this background, the board stated in its communication under Article 15(1) RPBA that, on a preliminary basis, it saw no reason to set aside the decision under appeal on these points.
58. In response, the appellant further argued that the term "*Cpf1*" limited the scope of the claims and claim 1 was therefore directed to a polypeptide with nuclease activity unrelated to Cas9 and having a structure including three RuvC nuclease domains, a Zinc-finger and an arginine-rich domain. On this basis, they argued that the subject-matter of claim 1 differed from document D3 not solely by virtue of claim 1 relating to an expression vector but by definition of the polypeptide as a *Cpf1* polypeptide that includes the claimed sequence. The formulation of the less ambitious technical problem 1 was therefore not applicable. The technical effect resulting from the distinguishing features was the capability of expressing in a gene editing system, an improved gene editing nuclease unrelated to Cas9 and the technical problem solved by claim 1 was the provision of a useful CRISPR/Cas protein as an alternative to Cas9 that can be used in gene targeting and editing. Post-published document D5a provided evidence that *Cpf-1* proteins are effective nucleases. The technical problem was therefore solved across the whole scope of claim 1.
59. The board disagrees. The appellant's line of argument is based on the premise that the term "*Cpf1*" limits the scope of the claims. However, for the reasons set out above (points 31. to 43.), the board does not accept the appellant's interpretation of claim 1. In view of the interpretation of the claim adopted by the board (point 45. above), claim 1 is not confined to a polypeptide that has nuclease activity, is unrelated to

Cas9 and has a structure including three RuvC nuclease domains, a Zinc-finger, and an arginine-rich domain. Consequently, the entire line of argument of the appellant fails to persuade. The appellant's argument based on document D5a therefore did not need to be considered.

60. Neither in their letter dated 14 March 2025, nor at the oral proceedings before the board, has the appellant disputed that the claimed subject-matter is an obvious solution to technical problem 1.

61. The board has therefore seen no reasons to deviate from the decision under appeal that the subject-matter of claim 1 of the main request contravenes Article 56 EPC.

Auxiliary requests 1 to 4, 12 and 13

Inventive step

62. Claim 1 of auxiliary requests 1 to 4, 12 and 13 is identical to claim 1 of the main request and the opposition held that these auxiliary requests lacked inventive step for the same reasons as claim 1 of the main request.

63. This was not contested by the appellant, which did not put forward any arguments in favour of these requests. The board therefore has seen no reason to deviate from the decision under appeal on this point either.

Auxiliary requests 5 to 11

64. Claim 1 of each of auxiliary requests 5 to 11 has been amended to include various additional features characterising the claimed Cpf1 polypeptide.

Claim 1 of auxiliary request 5 is based on claim 1 of the main request, which has been amended to additionally recite *"wherein the polypeptide has binding affinity for a guide RNA molecule and for a polynucleotide sequence motif in a target nucleic acid strand."*

Claim 1 of auxiliary request 6 is based on claim 1 of auxiliary request 5 amended to additionally recite *"polypeptide, and does not comprise an HNH (nuclease) domain"*.

Claim 1 of auxiliary request 7 is based on claim 1 of the main request, which has been amended to additionally recite *"wherein the polypeptide has a single nuclease domain, binding affinity for a guide RNA molecule, binding affinity for a protospacer adjacent motif (PAM) located upstream of a protospacer in a target nucleic acid strand, and does not comprise an HNH (nuclease) domain."*

Claim 1 of auxiliary request 8 reads as follows:

"An expression vector comprising a nucleotide sequence encoding a Cpf1 polypeptide, wherein the polypeptide comprises the amino acid sequence YLFQIYNKDF (amino acid residues 784-793 of SEQ ID NO: 1), has nuclease activity, and has binding affinity for a guide RNA molecule."

Claim 1 of auxiliary request 9 reads as follows:

"1. An expression vector comprising a nucleotide sequence encoding a Cpf1 polypeptide, wherein the polypeptide comprises the amino acid sequence YLFQIYNKDF (amino acid residues 784-793 of

SEQ ID NO: 1), wherein the polypeptide has a single nuclease domain, binding affinity for a guide RNA molecule, binding affinity for a protospacer adjacent motif (PAM) located upstream of a protospacer in a target nucleic acid strand, and does not comprise an HNH (nuclease) domain."

Claim 1 of auxiliary request 10 is identical to claim 1 of auxiliary request 8 and claim 1 of auxiliary request 11 is identical to claim 1 of auxiliary request 9.

65. In the decision under appeal, the opposition division noted that the additional features added to claim 1 in auxiliary requests 5 to 11 were inherent properties of the protein encoded by the FTN1397 gene. Since the claimed product was obvious, these inherent features could not establish an inventive step of the claimed product and auxiliary requests 5 to 11 contravened Article 56 EPC.
66. Under Article 12(3) RPBA, the statement of grounds of appeal and the reply have to contain a party's complete appeal case. Accordingly, they must set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on.
67. However, in their statement of grounds of appeal, the appellant did not dispute that the amendments made to claim 1 in auxiliary requests 5 to 11 were inherent features of the protein encoded by the FTN1397 gene. Nor did the appellant dispute that auxiliary requests 5 to 11 lacked an inventive step if these additional features were inherent features of the protein encoded by the FTN1397 gene. Indeed, the appellant did not

explain the amendments made in claim 1 of auxiliary requests 5 to 11 or their purpose in their grounds of appeal. In particular, the appellant did not argue that any of these amendments contribute to an inventive step of the claimed subject-matter.

68. The appeal, as far as it relates to auxiliary requests 5 to 11 was therefore not substantiated in the appellant's grounds of appeal, contrary to the requirements of Article 12(3) RPBA.

Admittance of the appellant's submissions made with the letter dated 14 March 2025 as far as they relate to auxiliary requests 5 to 11

69. Shortly before the oral proceedings and after the board had expressed its preliminary opinion in a communication under Article 15 (1) RPBA, the appellant submitted arguments in support of an inventive step of auxiliary requests 5 to 11 under cover of a letter dated 14 March 2025.

70. The filing of its substantiation for auxiliary requests 5 to 11 at this stage of the appeal proceedings constitutes an amendment to the appellant's appeal case pursuant to Article 13(2) RPBA, the admittance of which is at the discretion of the board.

71. Article 13(2) RPBA requires exceptional circumstances for such an amendment to be considered.

72. In the letter dated 14 March 2025, the appellant provided no justification for the late filing of the substantiation for auxiliary requests 5 to 11.

73. At the oral proceedings before the board, when invited to justify the late filing of the substantiation for auxiliary requests 5 to 11, the appellant merely reiterated its arguments submitted in the letter dated 14 March 2025 and put forward additional arguments as regards inventive step of auxiliary requests 5 to 11.
74. In the absence of any justification for the late filing of the substantiation of auxiliary requests 5 to 11, there are no exceptional circumstances within the meaning of Article 13(2) RPBA which would justify the admittance and consideration of the appellant's late substantiation. The board therefore decided not to admit the submissions of 14 March 2025 as far as they related to auxiliary requests 5 to 11 into the appeal proceedings.
75. In conclusion, the appeal as far as it relates to auxiliary requests 5 to 11 is not substantiated. There is therefore no basis for setting aside the opposition division's decision on these requests.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

T. Sommerfeld

Decision electronically authenticated