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**D E C I S I O N**  
**of 30 July 2002**

**Case Number:** T 0160/99 - 3.3.4

**Application Number:** 87903197.9

**Publication Number:** 0264434

**IPC:** C12P 21/08

**Language of the proceedings:** EN

**Title of invention:**

Detection of a unique chlamydia strain associated with acute respiratory disease

**Patentee:**

Washington Research Foundation

**Opponent:**

- Forschungsinstitut Borstel
- Labsystems Oy
- I O International Ltd.

**Headword:**

Chlamydia/WASHINGTON

**Relevant legal provisions:**

EPC Art. 84, 123(2)(3), 114(2)

**Keyword:**

"Main request - admissibility into proceedings (denied) - too late"  
"Auxiliary request A - formal requirements (met)"  
"Remittal"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0160/99 - 3.3.4

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.4**  
**of 30 July 2002**

**Appellant:** Washington Research Foundation  
(Proprietor of the patent) 2815 Eastlake Avenue East  
Suite 300  
Seattle, Washington 98102 (US)

**Representative:** Bizley, Richard Edward  
Hepworth, Lawrence, Bryer & Bizley  
Merlin House  
Falconry Court  
Baker's Lane  
Epping  
Essex CM16 5DQ (GB)

**Respondent I:** Forschungsinstitut Borstel  
(Opponent 01) Parkallee 22  
D-23845 Borstel (DE)

**Representative:** ter Meer, Nicolaus, Dipl.-Chem., Dr.  
TER MEER STEINMEISTER & PARTNER GbR  
Patentanwälte  
Mauerkirchenstrasse 45  
D-81679 München (DE)

**Respondent II:** Labsystems Oy  
(Opponent 02) Pulttitie 8  
FIN-Helsinki (FIN)

**Representative:** Sulzbach, Werner Dr.  
Prinz & Partner  
Manzingerweg 7  
D-81241 München (DE)

**Respondent III:** I O International Ltd.  
(Opponent 03) Preventive Medicine Research Unit 2A  
29-37 Southbank Technopark  
90 London Rd.  
London SE1 6LN (GB)

**Representative:** Holdcroft, James Gerald, Dr.  
Graham Watt & Co.  
St. Botolph's House  
7-9 St. Botolph's Road  
Sevenoaks, Kent TN13 3AJ (GB)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 13 November 1998  
revoking European patent No. 0 264 434 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** U. M. Kinkeldey  
**Members:** L. Galligani  
V. Di Cerbo

## Summary of Facts and Submissions

I. The patent proprietors lodged an appeal against the decision of the opposition division dated 13 November 1998 whereby the European patent 0 264 434, which had been opposed by three parties on grounds of Article 100(a) to (c) EPC, was revoked. Basis of the revocation were a main request (claims as granted) and three auxiliary claim requests.

The opposition division found that **(i)** claim 1 of the main request offended against Article 123(2) EPC because it contained the undisclosed feature "*Chlamydia pneumoniae*"; and **(ii)** claim 1 of the remaining requests was unclear because the characterisation of the subject-matter was based on the arbitrary term "TWAR".

No substantive examination of the case was carried out by the opposition division.

Claims 1 and 2 as granted read as follows:

"1. A monoclonal antibody directed against an antigenic determinant of the TWAR strain of Chlamydia, Chlamydia pneumoniae"

"2. A monoclonal antibody that binds to an antigen of a Chlamydia strain other than C. psittaci and C. trachomatis that causes acute respiratory disease."

Claims 3 to 19 were directed either to a hybridoma producing a monoclonal antibody against an antigenic determinant of the TWAR strain of Chlamydia, Chlamydia pneumoniae or to methods using said antibody.

- II. With the statement of grounds of appeal, the appellants filed a new main request and two auxiliary requests.
- III. Of the respondents, only respondents II (opponents 02) filed comments to the statement of grounds of appeal.
- IV. On 31 January 2002, the board issued a communication with a preliminary view on some of the issues to be discussed, raising in particular objections under Articles 84 and 123(2)(3) EPC to the amended claims.
- V. In reply to the board's communication, the appellants replaced all previous requests with new requests, namely a main request and auxiliary requests A to D, these requests differing from each other only in the formulation of claim 1. As auxiliary request E, they asked the board to refer, if necessary, two questions of law to the EBA in relation to the interpretation of Article 123(3) EPC. They also filed the declarations of Dr C. Mordhorst and of Dr R. Peeling, and documents relating to the ATCC deposit number 53952.
- VI. Oral proceedings took place on 30 July 2002. They were not attended by respondents I and III (opponents 01 and 03, respectively) which had informed the board beforehand of their intention not to participate.

During the first part of the hearing, the parties were heard on the question of the compliance of claim 1 of the main request on file with Articles 84 and 123(2)(3) EPC, the said claim reading as follows:

"A monoclonal antibody which is directed against an antigenic determinant which is characteristic of Chlamydial organisms that have the following

characteristics, said organisms termed TWAR organisms, said antigenic determinant not being present on Chlamydial organisms other than those exhibiting the characteristics:

- a) associated with human respiratory infection;
- b) have no animal or bird host;
- c) have cytoplasmic inclusions of oval and dense appearance in which glycogen is absent and which have not indented or displaced the nucleus;
- d) are immunologically distinct from *C. psittaci* strains;
- e) do not react with *Chlamydia trachomatis* species-specific monoclonal antibody; and
- f) contain no plasmid."

After the board announced a negative view, the appellants put forward a new main request and reformulated auxiliary requests A and B in replacement of all requests on file. The new requests consisted of 18 claims and differed from each other in the formulation of claim 1.

Claim 1 of the **new main request** differed from claim 1 of the previous main request in that the first part, up to feature (b), read as follows:

"A monoclonal antibody directed against an antigenic determinant specific for the TWAR strain of *Chlamydia*, said strain exhibiting the characteristics:

- a) cause acute human respiratory disease;
- b) ..."

Claim 1 of the **auxiliary request A** differed from claim 1 of the new main request in respect of the first part of the claim which read:

"A monoclonal antibody directed against an antigenic determinant of a Chlamydial organism with accession number ATCC 53592 termed TWAR organism ATCC 53592 and which reacts with said organism but not with Chlamydia organisms other than those exhibiting the following characteristics:..."

- VII. As regards the new main request, the appellants argued that, although it was filed at a late stage, it had to be admitted into the proceedings because the amendments which were introduced in claim 1 took account of the position of the board on the previous main request on file, and aimed at facilitating the analysis for the compliance with the formal requirements of the EPC. In fact, the claim was now essentially based on the wording of granted claim 1, the contested superfluous expression "Chlamydia pneumoniae" being deleted and the features of the TWAR strain being recited according to the description of the patent specification. There could be no formal objections to the amended claim because it was clear (the first part not being open to objection under Article 84 EPC as it was essentially the claim as granted, the second part being the list of features taken from the description), its extent of protection was the same as that of claim 1 as granted (or even narrower), and its subject-matter found full support in the application as filed.



As regards auxiliary request A, they submitted that it was essentially identical to auxiliary request A previously on file with some minor amendments. This request, by referring to the reference TWAR strain ATCC 53592, met any possible outstanding formal objections.

They also submitted that a referral back to the opposition division was not necessary as there was nothing further to decide once an appropriate definition of the monoclonal antibodies was established. However, should the board consider a remittal necessary, the appellants had no objections thereto.

VIII. Respondents II argued that the new main request had to be considered inadmissible for being filed too late. In fact, such a request could have been filed earlier. Moreover, the request did not decisively differ from the previous request, and did not meet all formal objections under Articles 84 and 123(2)(3) EPC as claim 1 still relied on the arbitrary designation TWAR and on a combination of selected features which defined subject-matter extending beyond the content of the application as filed and beyond the protection conferred by the granted claims.

As regards auxiliary request A, the respondents submitted that, in spite of the explicit reference to the TWAR strain ATCC 53592, the ambit of the claim was extended by the wording of the second part to other undisclosed non-TWAR strains having the features (a) to (f). As demonstrated by later literature, there were serovars of *Chlamydia pneumoniae* which differed antigenically from the TWAR strain (cf document D30: J. Clinical Microbiology, March 1997, pages 620 to 623;

and document D31: Abstract No. 542, 32nd Interscience Conference on Antimicrobial Agents and Chemotherapy, 11 to 14 October 1992, Anaheim, California, USA), although possibly exhibiting the features (a) to (f). For these reasons, claim 1 of this request still offended against Article 123(2) and (3) EPC.

IX. The appellants requested that the decision under appeal be set aside and that the patent be maintained on the basis of the main request or of auxiliary requests A or B filed during oral proceedings.

The respondents requested that the appeal be dismissed. Auxiliarily, that the case be remitted to the first instance for further prosecution.

### **Reason for the Decision**

*Main request: admissibility into the proceedings.*

1. The main criteria laid down by the boards of appeal for admission of amended claim requests at a late stage of appeal proceedings are that they be a serious attempt at overcoming objections and that they can be quickly checked as for their compliance with the requirements of Articles 123 and 84 EPC so as to create as little extra work as possible for the other party(ies) and the board (cf Case law of the Boards of Appeal of the European Patent Office, 4th edition 2001, in particular Section VII, D.14.)
2. The main request at issue, having been filed during oral proceedings when the debate on the previous main request had been concluded, was undoubtedly "**late-**

**filed**". Rather than turning to the next request on file, the appellants preferred to rearrange their requests and to file a new main request. In their view, the new main request took account of the objections raised against the previous one and rendered easier the analysis of its compliance with the formal requirements of the EPC because claim 1 was essentially based on the wording of granted claim 1, the contested superfluous expression "Chlamydia pneumoniae" being deleted and the features of the TWAR strain being recited according to the description of the patent specification.

3. However, the board notes that, apart from the deletion of the expression "Chlamydia pneumoniae", the wording of the first part of the claim is not exactly identical to that of claim 1 as granted, this making it open to objection under Article 84 EPC. As a matter of fact, the expression "antigenic determinant **of the** TWAR strain of Chlamydia" has been changed into "antigenic determinant **specific for** the TWAR strain of Chlamydia" (emphasis added). The appellants maintain that there is no difference in meaning between the two expressions in English, the second being linguistically more appropriate. This, however, is a matter of interpretation and thus opens the door to a series of considerations, which, failing a concrete reason for such a change, needlessly complicate the procedure at a late stage. This is already in contradiction with the criteria stated in point 1. above.
4. Moreover, the amended claim 1 as a whole cannot be said to be a serious attempt to overcome the objections raised against the previous version of the claim. These objections stemmed essentially from the difficulty in defining exactly what was claimed and, consequently, in

establishing exactly the boundary of the amended claims in comparison with the claims as granted, in view of the imprecise language used (cf "which is characteristic of Chlamydial organisms", "said organisms termed TWAR organisms") and of the lack of a specific term of reference for the TWAR strain. The new main request does prima facie not overcome said difficulties since claim 1 thereof, notwithstanding the return to the expression "TWAR strain" of the claims as granted, contains further elements of uncertainty such as the expression "specific for" and the use of the third person plural in connection with the features (a) to (f) ("cause", "have", "are", "do not", "contain") so that it is still unclear what exactly is being claimed and how this can be compared with the extent of protection of the granted claims, also in view of the deletion of the feature "Chlamydia pneumoniae".

5. Under these circumstances, in line with the above stated criteria (cf point 1. above), the board, in exercise of its discretion under Article 114(2) EPC, refuses to admit the new main request into the proceedings.

*Auxiliary request A: compliance with the formal requirements, Articles 84 and 123(2)(3) EPC*

6. This request is a slightly revised version of the auxiliary request A which was already on file (cf Section V above). Thus, the request is admitted into the proceedings. Claim 1 of this request identifies the subject monoclonal antibody as being directed against an antigenic determinant of a Chlamydial organism with accession number ATCC 53592 and as reacting with said organism but not with

Chlamydia organisms other than those exhibiting the characteristics (a) to (f).

7. As indicated in the description of the published version of the application as filed, the Chlamydial organism with accession number ATCC 53592 is the representative TWAR isolate AR-39, ie a TWAR strain of Chlamydia, Chlamydia pneumoniae meant by claim 1 as granted. This isolate and other isolates reacting with a TWAR-elicited monoclonal antibody, eg isolate T-183, have in common the features (a) to (f), as described on pages 6 to 8 of the published version of the application as filed.
  
8. By reference to an antigenic determinant of the deposited organism ATCC 53592, claim 1 at issue now unambiguously identifies an antigenic determinant common to all Chlamydia isolates which have the characteristics (a) to (f). The claim also avoids the use of the uncertain expression "determinant specific for" (cf point 3. above), by referring directly to "determinant of". In the board's judgement, claim 1 of this request satisfies the clarity requirements of Article 84 EPC, its subject-matter being unequivocally a monoclonal antibody directed against such an antigenic determinant.
  
9. Contrary to respondents' II views, the board considers that the scope of protection of the amended claim is well within the scope of protection conferred by claims 1 and 2 as granted. The antigenic determinant, against which the monoclonal antibody is directed, is now unequivocally identified as being that of the reference strain. Claims 1 and 2 as granted included in their scope the same monoclonal antibody, namely a

monoclonal antibody directed against an antigenic determinant of the TWAR strain of Chlamydia, Chlamydia pneumoniae (cf claim 1 as granted) or a monoclonal antibody that binds to an antigen of a Chlamydia strain other than C. psittaci and C. trachomatis that causes acute respiratory disease (cf claim 2 as granted).

Thus, no offence against the requirements of Article 123(3) EPC is seen by the board.

10. Moreover, again in contrast with the view of respondents II, amended claim 1 does not include subject-matter which extends beyond the content of the application as filed. The latter describes the preparation of a monoclonal antibody which is elicited against an antigenic determinant of the reference TWAR isolate, reacts with other isolates which display the same determinant (cf Table 1 on page 9 of the published version of the application as filed) and have the same features (a) to (f). The said monoclonal antibody does not react with isolates of C. psittaci and C. trachomatis. This subject-matter is precisely that of claim 1.

The wording of the said claim does not include a monoclonal antibody which reacts with an antigenic determinant other than that of the reference strain, eg it does not include a monoclonal antibody against a Chlamydia pneumoniae strain which, while exhibiting features (a) to (f), does not display the same antigenic determinant as the reference strain ATCC 53592.

Therefore, no offence against the requirements of Article 123(2) EPC is seen by the board.

11. In view of the above conclusions, the board considers that claim 1 of auxiliary request A complies with the formal requirements of the EPC, namely those of Articles 84 and 123 EPC. The same applies to claims 2 to 18 which now make reference to the Chlamydia strain as defined in claim 1, and which are identical to claims 3 to 19 as granted, exception made for the necessary renumbering.

*Remittal*

12. The patent in suit had been revoked by the opposition division on grounds of lack of compliance with the requirements of Articles 84 and 123 EPC, no substantive examination having yet been carried out. At least one party (respondents II) requested, should the appeal not be dismissed, that the case be remitted to the department of the first instance under Article 111 EPC, the appellants not being opposed thereto. In order to ensure that the parties have the opportunity of having the substantial questions of patentability of the amended claims decided by the opposition division, and with the possibility of a further appeal remaining open, the board considers it appropriate to make use of the power granted to it under Article 111(1) EPC to remit the case to the first instance for further examination.

**Order**

**For these reasons it is decided:**

1. The decision under appeal is set aside;

2. The case is remitted to the first instance for further prosecution on the basis of Auxiliary request A filed during oral proceedings.

The Registrar:

The Chairperson:

P. Cremona

U. Kinkeldey