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**Datasheet for the decision
of 5 June 2020**

Case Number: T 0789/16 - 3.3.08

Application Number: 02714990.5

Publication Number: 1572862

IPC: C12N15/63, C12N15/85,
C12N15/12, C12N15/62,
C07K14/705, C07K14/72,
A01H5/00, C12Q1/68, G01N33/68

Language of the proceedings: EN

Title of invention:

CHIMERIC RETINOID X RECEPTORS AND THEIR USE IN A NOVEL
ECDYSONE RECEPTOR-BASED INDUCIBLE GENE EXPRESSION SYSTEM

Patent Proprietor:

Intrexon Corporation

Opponent:

Then, Christoph

Headword:

Non-human organism/INTREXON

Relevant legal provisions:

EPC Art. 53(a), 111(2)
EPC R. 28(d)
RPBA 2020 Art. 13(1)

Keyword:

Admission joint opposition and appeal (yes);

Main request - admission in appeal (yes);

Main request - overcomes all grounds of opposition (yes);

Main request - remittal to the first instance (yes);

Decisions cited:

T 0315/03

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 0789/16 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 5 June 2020

Appellant: Then, Christoph
(Opponent) c/o Testbiotech e.V.
Frohschammerstr. 14
80807 München (DE)

Representative: Testbiotech e.V.
Frohschammerstrasse 14
80807 München (DE)

Respondent: Intrexon Corporation
(Patent Proprietor) 1750 Kraft Drive, Suite 1400
Blacksburg, VA 24060 (US)

Representative: Pohlman, Sandra M.
df-mp Dörries Frank-Molnia & Pohlman
Patentanwälte Rechtsanwälte PartG mbB
Theatinerstrasse 16
80333 München (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 21 January 2016
rejecting the opposition filed against European
patent No. 1572862 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman B. Stolz
Members: P. Julià
D. Rogers
M. Montrone
J. Geschwind

Summary of Facts and Submissions

- I. European patent no. 1 572 862 is based on European patent application no. 02 714 990.5 (published under the PCT with the international publication number WO 02/066614; hereinafter "the patent application") and was granted with 60 claims.
- II. Claims 45 to 50 as granted were directed to non-human organisms. Claims 46 to 47 and claims 49 to 50 were dependent on claims 45 and 48, respectively, which read as follows:
- "45. A non-human organism comprising the host cell of claim 39".
- "48. A non-human organisms comprising the host cell of claim 42."
- III. Several oppositions were filed on the grounds as set forth in Articles 100(a) and 100(b) EPC against the subject-matter of claims 45 to 50. The opposition division held that the grounds of opposition did not prejudice the maintenance of the patent as granted and, accordingly, rejected the oppositions.
- IV. An appeal was lodged by one of the opponents (appellant). In the statement setting out the grounds of appeal, the appellant filed new documentary evidence and maintained the objections raised at first instance under Articles 100(a) and 100(b) EPC against the subject-matter of granted claims 45 to 50. In reply thereto, the patent proprietor (respondent) filed an auxiliary request 1 and new documentary evidence. As an

auxiliary measure, oral proceedings were requested by both parties.

- V. The parties were summoned to oral proceedings. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA 2007), the parties were informed of the board's provisional opinion on the issues of the case.

In particular, the board stated that the joint opposition and the appeal were admissible and, with reference to the decision T 315/03 (OJ EPO 2006, 15) and the two tests mentioned in point 6.3 of its Reasons, namely the "Rule 28(d) EPC test" and the "real Article 53(a) EPC test", that the main request (claims as granted) and auxiliary request 1 appeared to contravene Article 53(a) EPC in combination with Rule 28(d) EPC (Article 100(a) EPC).

- VI. In reply thereto, without making any substantive submissions, the respondent filed auxiliary request 2.

- VII. In a communication pursuant to Article 17 RPBA 2020, the board informed the parties that it intended to admit auxiliary request 2 into the appeal proceedings (Article 13(1) RPBA 2020), and that this auxiliary request appeared to overcome all grounds of opposition (Articles 100(a) and 100(b) EPC). Thus, the board indicated its intention to set aside the decision under appeal and to remit the case to the opposition division with the order to maintain the patent on the basis of auxiliary request 2 and a description to be adapted thereto. The board further stated that, if necessary, these issues had to be discussed at the scheduled oral proceedings.

- VIII. In reply thereto, the respondent informed the board that its request for oral proceedings was maintained only in the event that the board intended to deviate from its provisional opinion on the admissibility of auxiliary request 2 and on the maintenance of the patent on the basis of this auxiliary request.
- IX. In a further communication pursuant to Article 17 RPBA 2020, the board observed that no further submissions had been filed by the appellant, relating to either the admittance of auxiliary request 2 into the appeal proceedings or to any substantive objection under the grounds set forth in the opposition. Therefore, the board saw no reason to change its provisional opinion and did not consider it necessary to hold the scheduled oral proceedings. The appellant was requested to inform the board whether its request for oral proceedings was maintained.
- X. In reply thereto, the respondent withdrew the main request and auxiliary request 1, and made auxiliary request 2 its new main request. The appellant informed the board that auxiliary request 2 was considered not to contain opposed subject-matter and thus, its request for oral proceedings was withdrawn.
- XI. The board cancelled the oral proceedings.

Reasons for the Decision

Admissibility of the joint opposition and of the appeal

1. In reply to the statement of grounds of appeal, the respondent referred to the decision of the opposition division acknowledging that "all joint opponents

mentioned by name in the notice of opposition ... were thereby unambiguously identified beyond doubt within the opposition period". In the same section of the decision under appeal, the opposition division acknowledged that the joint opposition was admissible under Article 99(1) EPC and Rule 76 EPC.

2. In the communication pursuant to Article 15(1) RPBA 2007, the board observed that no reasons had been put forward in appeal proceedings to contest or dispute the decision of the opposition division as regards the admissibility of the joint opposition. Nor saw the board any reason for deviating from the findings of the opposition division as regards this issue.
3. Therefore, the joint opposition and the appeal are admissible.

Admission of the main request into the appeal proceedings

4. The main request was filed (as auxiliary request 2) in response to the communication pursuant to Article 15(1) RPBA 2007, wherein the parties were informed of the board's provisional opinion on the issues of the appeal. The main request is thus an amendment of the respondent's case and may be admitted into the proceedings only at the discretion of the board (Article 13(1) RPBA 2020).
5. The appellant has not provided any reasons against the admission of this request into the appeal proceedings.
6. By deleting claims 45 to 50, the respondent addressed all issues raised by the appellant and by the board in its communication. The main request does not give rise

to new objections and contributes to the efficiency of the procedure.

7. Therefore, the board, in the exercise of its discretion (Article 13(1) RPBA 2020), admits the main request into the appeal proceedings.

Main request

8. In the present case, the opposition was only directed against claims 45 to 50 to the extent that they related to "a non-human organism" comprising a host cell of either claim 39 or 42.
9. The main request no longer contains claims directed to "a non-human organism". Thus, it overcomes all grounds of opposition. This has also been acknowledged by the appellant.
10. Therefore, the patent can be maintained on the basis of the main request and a description to be adapted thereto (Article 111(2) EPC).

Order

For these reasons it is decided that:

1. The joint opposition and the appeal are admissible.
2. The decision under appeal is set aside.
3. The case is remitted to the opposition division with the order to maintain the patent on the basis of claims 1 to 54 according to the main request filed on 8 April 2020 and a description to be adapted thereto.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated