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**Datasheet for the decision  
of 30 July 2019**

**Case Number:** T 1278/14 - 3.3.08

**Application Number:** 07777180.6

**Publication Number:** 2018441

**IPC:** C12Q1/68

**Language of the proceedings:** EN

**Title of invention:**

Tagged microorganisms and methods of tagging

**Patent Proprietor:**

DuPont Nutrition Biosciences ApS

**Opponents:**

Dutch Dairy Ingredients B.V.  
Chr. Hansen A/S

**Headword:**

Tagging microorganisms/DUPONT NUTRITION BIOSCIENCES

**Relevant legal provisions:**

EPC Art. 111(1), 113(1)  
EPC R. 103(1) (a)

**Keyword:**

Substantial procedural violation - reimbursement of appeal fee  
(yes)

**Decisions cited:**

J 0032/95, T 0552/97, T 0642/97, T 1676/08, R 0008/15

**Catchword:**



**Beschwerdekammern**

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Case Number: T 1278/14 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 30 July 2019**

**Appellant I:** Dutch Dairy Ingredients B.V.  
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**Representative:** ten Haaft, Petrus Johannes Fredrik  
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**Appellant II:** Chr. Hansen A/S  
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**Representative:** Renken, Joachim  
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**Respondent:** DuPont Nutrition Biosciences ApS  
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**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
28 March 2014 concerning maintenance of the  
European Patent No. 2018441 in amended form.**

**Composition of the Board:**

**Chairman**            B. Stolz  
**Members:**         M. Montrone  
                         D. Rogers

## Summary of Facts and Submissions

- I. The appeals lie against the decision of an opposition division to maintain European patent No. 2 018 441 in amended form.
- II. The opposition division took the view that the subject-matter of claims 3 and 4 of the main request (claims as granted) was not sufficiently disclosed (Article 100(b) EPC). Documents D34 and D35 were not admitted into the proceedings. Auxiliary request 1 filed during oral proceedings was found to meet the requirements of the EPC.
- III. With their statements of grounds of appeal, opponents 01 and 02 (hereinafter appellants I and II, respectively) submitted arguments as to why the subject-matter of auxiliary request 1 contravened Articles 54, 56, 83, 87, and 123(2) EPC. Furthermore, appellant II submitted that its right to be heard had been violated since facts and considerations presented during the oral proceedings although pertinent, were not considered in the decision under appeal (Article 113(1) EPC).
- IV. In reply, the patent proprietor (hereinafter the "respondent") submitted *inter alia* a main request (which is identical to auxiliary request 1 dealt with in the decision under appeal), and eight auxiliary requests. In a further submission, the respondent filed various documents in support of its case on priority entitlement.
- V. In reply, appellant II *inter alia* requested not to admit auxiliary requests 3 to 8 into the proceedings.

- VI. In reply to the summons to oral proceedings, the respondent reordered its previously submitted sets of claims.
- VII. In a communication pursuant to Article 15(1) RPBA, the parties were informed of the board's provisional, non-binding opinion that a substantial procedural violation occurred in the decision under appeal and of the board's intention to remit the case to the opposition division.
- VIII. In reply, appellant I announced that it would not be attending the oral proceedings, and the respondent provided substantive submissions on the issues of substantial procedural violation and remittal.
- IX. Oral proceedings before the board were held on 30 July 2019, in the absence of appellant I.
- X. The following documents are referred to in this decision:
- D1: US provisional application 60/747,682 (filed: 19 May 2006, "P1" document of patent in suit);
- D3: WO2007/025097 (published: 1 March 2007);
- D6: A. Bolotin *et al.*, Journal of General Microbiology, (2005), Vol. 151, 2551-2561;
- D8: C. Pourcel *et al.*, Journal of General Microbiology, (2005), Vol. 151, 653-663;
- D19: J. M. Sturino and T. R. Klaenhammer, Advances in Applied Microbiology, (2004), Vol. 56, 331-378;

D25: S. Lucchini *et al.*, *Virology*, (2000), Vol. 275, 267-277.

XI. Appellant II's submissions, insofar as relevant to the present decision, may be summarised as follows:

*Right to be heard (Article 113(1) EPC)*

It was undisputed that objections of an insufficient disclosure of document D1 in the context of priority entitlement of the patent in suit and of the invention as defined in claim 1 of auxiliary request 1 were raised in the first instance proceedings before the opposition division. These objections were supported *inter alia* by experimental data in example 12 of document D3, which disclosed a need for Clustered Regularly Interspaced Short Palindromic Repeats ("CRISPR") and functional cas genes for generating bacteriophage insensitive mutants ("BIMs"). The decision under appeal was silent on document D3, which implied, that the arguments and facts based on this document were not considered by the opposition division. However, if they had been considered, the outcome of the decision under appeal could be different, since relevant intermediate documents were on file, and insufficiency was a ground for revocation.

Furthermore, it was undisputed that an alternative line of argumentation with regard to inventive step was submitted during the oral proceedings before the opposition division which was based on the teachings of document D19 combined with documents D6 or D8. However, the decision under appeal was silent on this issue too. Document D19 was relevant for the claimed method since it summarised the common general knowledge of the skilled person in the generation of BIMs. In this

context document D19 reported on several bacterial phage defense systems which were very similar to CRISPR as recited in claim 1. The document was thus directed to the same purpose as the claimed invention. Moreover, document D19 cited document D25 which was used by the opposition division as closest prior art, and provided additional information including pointers to combine the teaching of document D19 with that of documents D6 or D8. Thus, it could not be excluded that, had the opposition division considered this line of argumentation, the outcome of the decision under appeal was different.

*Remittal (Article 111(1) EPC)*

Since the non-consideration of the relevant issues set out above in the decision under appeal amounted to a substantial procedural violation, the case should be remitted to the opposition division for further prosecution, and the appeal fee be reimbursed.

- XII. The respondent's submissions, insofar as relevant to the present decision, may be summarised as follows:

*Right to be heard (Article 113(1) EPC)*

Although the decision under appeal was silent on document D3 in the context of assessing sufficiency of disclosure of document D1 and the patent, the decision under appeal implicitly took account of the objections raised. Thus, the findings of the opposition division on these issues would not be different from those provided in the decision under appeal. Furthermore document D3 was irrelevant for carrying out the invention as defined in claim 1, since it was concerned with the mechanism by which phage resistance was



achieved. This mechanism however, was not required for performing the claimed method, since it was sufficient that the skilled person could select phage-resistant strains. These strains were inevitably generated upon a phage infection, irrespective of the mechanism involved. This aspect had been considered by the opposition division in the decision under appeal on pages 23 and 24, where it was stated that the patent application contained enough information for the skilled person to carry out the invention for all bacteria falling within the scope of claim 1.

Document D19 was a review article that mentioned *inter alia* document D25, i.e. the closest prior art document selected by the opposition division. Document D19 neither mentioned the generation of BIMs nor their isolation from a bacterial population. Accordingly, the document was not suitable as closest prior art and *prima facie* not relevant. Even if document D19 disclosed the generation of BIMs in accordance with steps a) and b) of the claimed method, the document was not more relevant than document D25 since both were silent on CRISPR. Thus, document D19 represented at most a substitute of document D25, and even if considered, the assessment of obviousness would not be different from that reported in the decision under appeal. Furthermore, although the opposition division's reasoning with regard to inventive step was silent on document D19, the list of relevant documents referred to in this context on page 19 of the decision under appeal was not exhaustive. In these circumstances, the mentioning of document D19 on page 18 of the decision under appeal in the context of opponent 02's submissions on inventive step was an indication that the opposition division implicitly considered the document.

Consequently, since the outcome of the first instance proceedings would not be different, and at worst, the reasoning in the decision under appeal was incomplete, the opposition division did not commit a substantial procedural violation. This required a causal link between the alleged violation and the final decision - a link being absent if the same decision would have been taken for other reasons.

Furthermore, a request by appellant II for correction of the minutes to include any items considered incomplete was lacking. In these circumstances an allegation of a substantial procedural violation was not justified (see decision T 642/97 of 15 February 2001).

Lastly, appellant II did not set out its complete case in the statement of grounds of appeal relating to an enabling disclosure of document D1, since a reference to document D3 was missing. This approach was not in line with decision T 1676/08 of 9 March 2012 stating that it should be immediately apparent to the board why a decision was allegedly incorrect.

*Remittal (Article 111(1) EPC)*

In the light of the considerations above there was no need for remitting the case to the opposition division. In any case it would be inappropriate, in view of the length of the proceedings so far, and the most likely issuance of a better reasoned decision to the same effect.

XIII. Appellant I requested that the decision under appeal be set aside, the case be remitted to the opposition

division for further prosecution, and for its appeal fee to be reimbursed.

XIV. Appellant II requested that the decision under appeal be set aside, the case be remitted to the opposition division for further prosecution, and for its appeal fee to be reimbursed.

XV. The respondent requested that the appeals be dismissed and that the case not be remitted to the opposition division for further prosecution.

### **Reasons for the Decision**

#### *Right to be heard (Article 113(1) EPC)*

1. Article 113(1) EPC requires that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This implies that a decision should adequately state the reasons on which it is based in order to show that the parties were heard, i.e. it should assess the facts, evidence and arguments submitted as to their relevance and correctness. Although this cannot be understood as requiring a detailed answer to every argument, Article 113(1) EPC is infringed if a decision does not substantively consider submissions of the parties that are relevant for the decision (see R 8/15 of 18 July 2016, catchword and point 2.2.2 of the Reasons).
2. It is uncontested that the decision under appeal with regard to the part setting out the reasons is silent on documents D3 and D19. These documents were cited by appellant II in support of its case on sufficiency of disclosure of document D1 and the patent (document D3),

and inventive step (document D19 in combination with documents D6 or D8).

3. It is first necessary to deal with the respondent's arguments concerning (a) the non-correction of the minutes of the oral proceedings before the opposition division by appellant II, (b) that the opposition division's decision implicitly dealt with appellant II's arguments based on documents D3 and D19, and (c) that appellant II's written statement of grounds of appeal did not refer to document D3 in relation to the enabling disclosure of document D1.
  
4. As regards the minutes of the oral proceedings, these state at point 2.3.3 that "*O2 considered that the lack of enablement was substantiated by verifiable facts in view of D24, **D3** and D32*" (emphasis added). Further at point 3.2 the minutes note that opponent "O2" argued for a lack of inventive step based upon the disclosure of document D19. These are precisely the points whose non-inclusion in the opposition division's decision is complained of by appellant II (i.e. "O2" before the opposition division). The board cannot therefore see any reason why appellant II should have sought to have these minutes corrected or amended.
  
5. As regards the respondent's argument that documents D3 and D19 were implicitly dealt with in the opposition division's decision, this argument appears to be based upon the respondent's view that appellant II's arguments based on these documents are wrong. This is clearly neither an explanation nor an excuse for the failure of the opposition division to address these documents including any arguments based thereon in its decision.

6. As regards the argument that appellant II did not refer to document D3 in its statement of grounds of appeal in connection with an enabling disclosure of document D1, the board notes that appellant II refers in this context to document D3 at point 0.3 in its statement of grounds of appeal, and also refers to point 2.3.3 of the minutes (which refers to document D1, see point 0.1 of the statement of grounds of appeal). In view thereof, the respondent's argument that appellant II has failed to present its complete case in the statement of grounds of appeal does not convince the board either.
  
7. In a further line of argumentation under Article 113(1) EPC, the respondent submitted that even if documents D3 and D19 were considered by the opposition division, the outcome of the decision under appeal would be the same since (a) the disclosure of documents D3 and D19 was either not relevant for assessing enablement of the priority document and the patent or inventive step (documents D3 and D19), and/or (b) represented at best a substitute for the documents taken into account by the opposition division (document D19 instead of D25).
  
8. Insufficiency of disclosure (Article 100(b) EPC) and lack of inventive step (Article 100(a) EPC in conjunction with Article 56 EPC) are independent grounds of opposition. Accordingly, objections raised on the grounds of any of these two Articles may result in the revocation of the patent in suit. As set out above, the opposition division's reasoning in the decision under appeal neither addresses documents D3 and D19 in the context of these grounds of opposition nor any arguments of appellant II based thereon.

9. In these circumstances, the respondent's assertion that the consideration of documents D3 and D19 would have no impact on the result of the first instance proceedings, holds true only if there are clear indications derivable from the decision under appeal or the minutes that the opposition division held both documents to be irrelevant, or if both documents are technically completely unrelated to the claimed invention. However, neither are such indications derivable from the documents on file, nor has the respondent submitted that both documents are unrelated. On the contrary, the respondent discussed the use of document D19 as an alternative to document D25, i.e. the closest prior art document selected by the opposition division.
10. Thus, it cannot be ruled out that the opposition division taking account of documents D3 and/or D19 may come to a different conclusion than in the decision under appeal. The respondent's assertion that it would not remain speculative.
11. As regards the relevance of documents D3 and D19, the board refrains deliberately from going into the merits of the parties' substantive arguments in order not to pre-empt the consideration of this matter by the opposition division.
12. Hence, the opposition division has failed to consider arguments based on documents D3 and D19 that could have led it to a different conclusion. In these circumstances, the procedural deficiency is substantial since it is causal for the final decision. Thus, appellant II's right to be heard has been violated.

*Remittal (Article 111(1) EPC)*

13. Since, as set out above, a substantial procedural violation has occurred in respect of the specific issues of the present case, the decision under appeal is set aside.
14. After consideration of the parties' arguments regarding remittal, in view of the reasons leading to the finding of a substantial procedural violation and despite the length of the proceedings so far, the board, exercising its discretion under Article 111(1) EPC, remits the case to the opposition division for further prosecution in respect of these issues.
15. When resuming its examination of the case, the opposition division should take:
  - due account of appellant II's arguments relating to the sufficiency of disclosure of document D1 and the patent in suit in view of document D3; and
  - due account of appellant II's arguments relating to inventive step in the light of the disclosure of document D19 in combination with documents D6 or D8.

*Reimbursement of appeal fee (Rule 103(1) (a) EPC)*

16. According to the established jurisprudence of the boards of appeal, a violation of the right to be heard may also constitute a substantial procedural violation justifying a reimbursement of the appeal fee (see Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, III.B.1).

17. In the present case, appellant II's right to be heard was substantially violated. A consequence of this is a remittal to the first instance for further prosecution.
  
18. As it is necessary to remit the case, the board grants the requests of both appellants for a reimbursement of the appeal fee pursuant Rule 103(1)(a) EPC, since it is equitable also to refund appellant I's appeal fee (see T 552/97 of 4 November 1997, point 6 of the Reasons).



## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution, upon the basis of claims 1 to 19 filed on 12 February 2014, in respect of the following issues:
  - i) the sufficiency of disclosure of document D1 and the patent in suit in view of document D3; and
  - ii) inventive step in the light of the disclosure of document D19 in combination with documents D6 or D8.
3. It is at the opposition division's discretion to consider further requests.
4. The appeal fees of appellant I and II are to be reimbursed.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated