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**Datasheet for the decision  
of 6 April 2021**

**Case Number:** T 0437/15 - 3.3.08

**Application Number:** 04820001.8

**Publication Number:** 1654361

**IPC:** C12N15/10

**Language of the proceedings:** EN

**Title of invention:**

METHODS AND COMPOSITIONS FOR PREPARING RNA FROM A FIXED SAMPLE

**Patent Proprietor:**

Life Technologies Corporation

**Opponent:**

König Szynka Tilmann von Renesse (opposition withdrawn)

**Headword:**

Digestion buffer/LIFE TECHNOLOGIES

**Relevant legal provisions:**

EPC Art. 111(1), 123(2)

RPBA 2020 Art. 11

**Keyword:**

Main request - added matter (no)

Remittal to opposition division (yes)

**Decisions cited:**

G 0002/10

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0437/15 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 6 April 2021**

**Appellant:** Life Technologies Corporation  
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**Representative:** Taylor, Kate Laura  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted on 23 December  
2014 revoking European patent No. 1654361  
pursuant to Article 101(3)(b) EPC.

**Composition of the Board:**

**Chairman** B. Stolz  
**Members:** M. R. Vega Laso  
D. Rogers

## Summary of Facts and Submissions

- I. The appeal of the patent proprietor (appellant) lies from a decision of an opposition division posted on 23 December 2014, revoking the European patent No. 1 654 361 with the title "Methods and compositions for preparing RNA from a fixed sample". The patent was granted on the European application No. 04820001.8 which was filed under the Patent Cooperation Treaty and published as WO 2005/054466 (in the following "the application as filed").
- II. The patent was opposed on the grounds for opposition of Article 100(a) in conjunction with Articles 54 and 56 EPC, and Article 100(c) EPC.
- III. In the decision under appeal, the opposition division found that the subject-matter of claim 1 of the main request (amended claims 1 to 25 filed on 6 September 2013) extended beyond the content of the application as filed and thus offended against Article 123(2) EPC. The same conclusion was reached with respect to claim 1 of the auxiliary requests 1 and 2. With respect to the auxiliary request 3, the opposition division found that the clarity requirement of Article 84 EPC was not met.
- IV. Claim 1 according to the **main request** reads as follows:
- "1. A method for isolating RNA from a fixed tissue sample comprising:
- (a) contacting the fixed tissue sample with a digestion buffer, comprising a polyanion, a protease, and optionally guanidinium, to produce a lysate, wherein if guanidinium is present in the

digestion buffer it is present at a concentration of at most 1.8 M;

(b) extracting RNA from the lysate,

wherein the polyanion is a polycarboxylate, selected from the group consisting of sodium citrate, 1,4-cyclohexanedicarboxylic acid, 1,3,5-cyclohexanetricarboxylic acid, isocitric acid, and succinic acid, preferably sodium citrate."

Dependent claims 2 to 23 are directed to different embodiments of the method of claim 1. Claims 24 and 25 are directed to a kit for isolating full-length RNA from a fixed tissue sample.

- V. The appellant submitted a statement setting out the grounds of appeal and maintained the requests underlying the decision under appeal. As a subsidiary request, it requested oral proceedings.
- VI. The opponent replied to the statement of grounds of appeal. However, by letter dated 10 October 2019 it withdrew the opposition.
- VII. In reply to the summons to oral proceedings, the appellant withdrew its request for oral proceedings and instead requested a decision in writing on the basis of its statement of grounds.
- VIII. The oral proceedings were cancelled.
- IX. The submissions made by the appellant, as far as they are relevant to the present decision, were essentially as follows:

*Main request - Article 123(2) EPC*

The decision under appeal was fundamentally flawed. The opposition division had taken an inappropriate and overly literal view of the requirements imposed by Article 123(2) EPC when viewing the disclosure of the application as filed. It had failed to consider the disclosure of the application as a whole, and what a skilled person with a mind willing to understand would have understood from that disclosure.

Specifically, the opposition division erred in finding that there was no basis in the passage on page 6, lines 4 to 10 of the application as filed for a digestion buffer in which the concentration of guanidinium was at most 1.8 M, but other denaturants could be present at any concentration. Since the aim of the invention was to increase the quality and yield of RNA isolated from a fixed tissue sample, the skilled person reading the passage in question would understand that, in order to provide an increased amount of unfragmented RNA compared to the prior art methods, the method of the invention used a lower concentration of guanidinium. The specific disclosure on page 6 therefore tied in with the underlying understanding that the skilled person would have of the purpose of the invention from reading the application.

Furthermore, the opposition division had decided that in order to arrive at the subject-matter of claim 1, it was necessary to select features from three lists. However, the first two "lists" (firstly whether or not a denaturant is present and secondly the nature of the denaturant) were not in fact lists at all. Both of the options disclosed in the first full paragraph on page 6

of the application as filed, i.e. presence and absence of a denaturant, were encompassed by claim 1. Guanidinium was the sole denaturant mentioned in the passage on page 6 of the application as filed. Hence, the sole selection required in order to arrive at the method of claim 1 was the specific maximum concentration of guanidinium which may be present in the digestion buffer (1.8 M). Making a selection from a single list did not amount to presenting new technical information to the skilled person, as deemed unallowable by decision G 2/10 (OJ EPO 2012, 376). Hence, Article 123(2) EPC was not contravened.

- X. The appellant (patent proprietor) requested that the decision under appeal be set aside and the case be remitted to the opposition division for further examination on the basis of any of the main request and auxiliary requests 1 to 3 underlying the decision under appeal.

## **Reasons for the Decision**

### *Main request - Article 123(2) EPC*

1. In the decision under appeal, the opposition division found that the passage on page 6, lines 4 to 10 of the application as filed did not provide a basis for a method of isolating RNA using a digestion buffer as defined in claim 1, "*... wherein only guanidinium is limited at 1.8 M and any other denaturant can be present at any concentration*" (see point 1.6 of the decision, in particular the paragraph bridging pages 3 and 4).
2. The passage of the application as filed to which the opposition division referred reads as follows:

*"In further embodiments, it is specifically contemplated that the digestion buffer and/or any other steps of the invention involves a denaturant such as guanidinium. In some embodiments, a digestion buffer includes a denaturant at a concentrations of about or at most about 0.1, 0.2, 0.3, 0.4, 0.5, 0.6, 0.7, 0.8, 0.9, 1.0, 1.1, 1.2, 1.3, 1.4, 1.5, 1.6, 1.7, 1.8, 1.9, 2.0, 2.1, 2.2, 2.3, 2.4, 2.5 M or more, or any range therein. Methods and compositions of the invention will also be understood to exclude compounds, or limit their amount, that result in fragmented or truncated RNA molecules."*

3. Even though it is not mentioned in point 1.6 of the decision, it appears that for the assessment of the disclosure in the passage quoted above, the opposition division took into account the following statement on page 10, lines 18 to 20 of the application as filed (paragraph [0045] of the patent as granted):

*"Following long-standing patent law, the words "a" and "an," when used in conjunction with the word "comprising" in the claims or specification, denotes one or more, unless specifically noted."*

4. In view of this statement and in the absence of any specific indication to the contrary in the passage on page 6, lines 4 to 10, a person skilled in the art reading the first sentence in this passage understands the wording "a denaturant" to mean that "one or more denaturant(s)" can be used in the digestion buffer and/or "any other steps of the invention", i.e. the RNA extraction step b) in the method of present claim 1. From the statement "a denaturant such as guanidinium",



the skilled person derives that, according to the invention, either the digestion buffer or any buffer used for extracting RNA from the lysate, or both may contain guanidinium, a protein denaturant well known at the priority date as a component of buffers used for nucleic acid isolation from tissue samples.

5. The second sentence in the passage on page 6 of the application as filed concerns the concentration of "a denaturant" in the digestion buffer. The board observes that the various concentrations/concentration ranges disclosed in this sentence are molar concentrations. As it was well known in the art at the relevant date, molar concentration or molarity is a measure of the concentration of a single chemical species, in particular of a solute in a solution. The most commonly used unit for molarity is the number of moles of a (single) chemical species per litre of solution (mol/L), which in the chemical literature is denoted as "M".
  
6. From the use of molar concentrations in the passage on page 6, it is immediately apparent to a person skilled in the art that the figures disclosed in this passage represent concentrations/concentration ranges for a single denaturant. Since guanidinium has been mentioned in the previous sentence as a possible denaturant for use in the method of the invention, there is no doubt that the skilled person understands the disclosed denaturant concentrations/concentration ranges to apply also to guanidinium, if this denaturant is included in the digestion buffer. Hence, contrary to the opposition division's view, there is a specific disclosure of guanidinium being included in the digestion buffer at any of the concentrations/concentration ranges

specified in the same passage of the application as filed.

7. The opposition division held further that the particular embodiment of claim 1 was not disclosed in the passage on page 6 because, in order to arrive at the specific combination of features characterizing the method of claim 1, it was necessary to select each feature from a list of possible embodiments (see first full paragraph on page 4 of the decision under appeal).
8. As a first "list", the opposition division regarded the statement on page 6, line 5 that a denaturant can be included in the digestion buffer and/or any other step of the method. However, the board observes that the disclosure of different denaturant concentrations/concentration ranges in lines 6 to 9 is limited to the digestion buffer. Hence, contrary to the opposition division's view there is a specific disclosure concerning the digestion buffer and selection from an alleged first "list" is not required.
9. As a selection from a second "list", the opposition division considered the choice between guanidinium and any other denaturant, as disclosed in line 6 of page 6. The board disagrees. Apart from the general disclosure of a denaturant, guanidinium is the sole specific denaturant compound disclosed in the passage. Thus, also in this respect there is no list from which guanidinium would have to be "selected".
10. In the board's view, the sole selection that is actually from a list is the choice of the specific feature "*at a concentration of at most **1.8 M***" (emphasis added) from a list of possible molar concentration ranges disclosed in lines 7 and 8 of page 6. In this

passage, there is a direct and unambiguous disclosure of various specific concentrations ranges ("at most about") defined by (and including) their upper limit ("about"). Apart from these "open" concentration ranges, there is no specific disclosure of any other "range therein". Hence, the number of elements of the sole list from which the concentration of guanidinium of "at most 1.8 M" is selected is clear and finite.

11. In view of the above, the board considers that the subject-matter of claim 1 does not represent a selection from different lists of embodiments disclosed in the application, contrary to the opposition division's view.
12. Hence, neither reason given in the decision under appeal for the adverse finding with respect to claim 1 of the main request is persuasive. The board therefore concludes that the subject-matter of claim 1 of the main request does not extend beyond the content of the application as filed and, thus, conforms to Article 123(2) EPC.

*Remittal for consideration of further issues raised in opposition (Article 111(1) EPC)*

13. In the decision under appeal, the opposition division decided on the main request only with respect to claim 1 and the issue of Article 123(2) EPC. Objections raised in the notice of opposition with respect to other claims or concerning further requirements of the EPC were not considered.
14. The appellant, which is the sole remaining party, has requested remittal to the opposition division for consideration of the further issues raised in

opposition. If the board were not to grant this request, a full examination of the main request with regard to the grounds for opposition and the requirements of the EPC would have to be carried out for the first time in appeal proceedings. Since this would run contrary to the very purpose of the appeal proceedings, the board considers that in the present case there are special reasons for remittal to the opposition division (Article 11 of the Rules of Procedure of the Boards of Appeal, as in force as from 1 January 2020).

## 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 consideration of the main request.

The Registrar:

The Chairman:



L. Malécot-Grob

B. Stolz

Decision electronically authenticated