

**Internal distribution code:**

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

**Datasheet for the decision  
of 26 November 2020**

**Case Number:** T 0340/17 - 3.3.02

**Application Number:** 12792326.6

**Publication Number:** 2713713

**IPC:** A01K67/02, A01N1/02, G01N1/30

**Language of the proceedings:** EN

**Title of invention:**  
COMPOSITIONS AND METHODS FOR IMPROVING THE QUALITY OF PROCESSED  
SPERM

**Applicant:**  
Inguran, LLC

**Headword:**

**Relevant legal provisions:**  
RPBA Art. 12(4)  
RPBA 2020 Art. 25(2)

**Keyword:**  
Late-filed request - request could have been filed in first  
instance proceedings (yes)

**Decisions cited:**

G 0010/93, T 0980/08, T 0065/11

**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 0340/17 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 26 November 2020**

**Appellant:** Inguran, LLC  
(Applicant) 22575 State Highway 6 South  
Navasota, TX 77868 (US)

**Representative:** Jacob, Reuben Ellis  
Maucher Jenkins  
26 Caxton Street  
London SW1H 0RJ (GB)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 29 August 2016  
refusing European patent application No.  
12792326.6 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** M. O. Müller  
**Members:** P. O'Sullivan  
L. Bühler

## Summary of Facts and Submissions

- I. The appeal of the applicant (hereinafter "appellant") lies from the decision of the examining division to refuse European patent application 12792326.6.
- II. The application was refused on the basis that the subject-matter of the then pending claims of the main request, first auxiliary request and second auxiliary request failed to meet the requirements of Article 123(2) EPC.
- III. With the statement of grounds of appeal the appellant filed a sole set of claims as main request.
- IV. The sole independent claim of the main request reads as follows:
- "1. A method of sorting a sperm cell sample comprising the steps of*
- a. providing a sperm cell sample;*
  - b. staining a sperm cell sample with a first media;*
  - c. sorting the sperm cell sample to form at least one subpopulation contained in a second media;*
  - d. freezing the at least one subpopulation in a third media;*
- wherein at least one of the first media, the second media and the third media contains alpha ketoglutarate (AKG) at a final processing concentration in the range of 0.01 to 5 mg/ml."*
- V. A communication of the board pursuant to Article 15(1) RPBA 2020 was sent in preparation for oral proceedings. Therein, the board set out the

reasons why in its opinion, the set of claims of the sole main request was not to be admitted into appeal proceedings pursuant to Article 12(4) RPBA 2007.

VI. Oral proceedings before the board were held on 26 November 2020 by videoconference.

VII. Final requests

The appellant requests that the decision of the examining division be set aside and that a patent be granted on the basis of the set of claims of the main request filed with the statement of grounds of appeal.

VIII. The appellant's arguments, insofar as relevant to the present decision, may be summarised as follows:

Admittance - Article 12(4) RPBA 2007

Rather than representing a "fresh case", the intention behind the filing of the set of claims according to the main request was to expedite the appeal proceedings by reverting to allowable subject-matter comprised within the claims as filed. In this context, none of the prior art cited by the examining division related to alpha ketoglutarate (AKG) as the organic stress reducing agent (OSR), now comprised within independent claim 1.

During examination proceedings, already in response to the communication pursuant to Rule 161(2) EPC, the appellant filed a set of claims comprising independent claim 1 in which AKG was mentioned in a list. It was true that in all sets of claims subsequently filed during examination, the independent claim was limited to reciting vitamin B12. However, this was the preferred embodiment of the appellant, AKG being of

secondary importance. It was only after the decision of the examining division had been issued that the appellant realised that the added subject-matter issues raised by the examining division were more serious than first perceived. Furthermore, from a statement in the annex to the communication of the examining division (page 5, underlined paragraph) dated 7 July 2016 (subsequent to the issuance of the summons to oral proceeding), the appellant had been led to believe that an inventive step could be recognised for the subject-matter of the requests on file. For this reason, the appellant had continued to pursue claim requests specifying vitamin B12 in the independent claim. Additionally, in order to overcome issues concerning Article 123(2) EPC, further auxiliary requests 1 and 2 were submitted with the letter dated 19 July 2016.

The set of claims of the main request should consequently be admitted into appeal proceedings.

### **Reasons for the Decision**

Main request - Admittance - Article 12(4) RPBA 2007

1. In the communication pursuant to Article 15(1) RPBA 2020 sent in preparation for oral proceedings, the board stated that in its preliminary opinion, the filing of the main request constituted a "fresh case". The scope of the sole independent claim had shifted in a different direction to that upon which the contested decision was based, and the main request was therefore unlikely to be admitted into the appeal proceedings.

2. The subject-matter of the main request

2.1 The main and sole claim request, submitted with the statement of grounds of appeal, comprises method claim 1 as the only independent claim. This claim (see section IV above) comprises the feature

*"wherein at least one of the first media, the second media and the third media contains **alpha ketoglutarate (AKG)** at a final processing concentration in the range of 0.01 to 5 mg/ml."* (emphasis added by the board)

2.2 The contested decision was based on a main request and first and second auxiliary requests. Of those requests, the set of claims of the second auxiliary request is most similar to the set of claims of the present main request. In particular, independent claim 1 of that request reads as follows:

*"1. A method of sorting a sperm cell sample comprising the steps of*

- a. staining a sperm cell sample with a first media;*
- b. sorting the sperm cell sample to form at least one subpopulation contained in a second media; and*
- c. freezing the at least one subpopulation in a third media;*

*wherein the first media, the second media and the third media comprise **vitamin B12** at a concentration of 0.15 to 1 mg/ml."* (emphasis added by the board)

2.3 Claim 1 of the present main request therefore differs from this claim *inter alia* in that

- the requirement that **vitamin B12** is present in a specific concentration range has been **deleted**;  
and
- the requirement that **AKG** is present in a specific concentration range has been **added**;

3. File history - examination proceedings

3.1 The application as filed (WO 2012/167151 A1) comprised multiple independent method claims (e.g. claims 1, 46, 55, 71 and 91) all of which comprised *inter alia* the requirement that at least one organic stress reducing agent (OSR) was either present or added, without the nature thereof being specified. A list of specific OSRs was provided in dependent claims (e.g. claim 47).

3.2 In the respective (sole) independent method claim of the sets of claims filed with letter dated 1 August 2014 and subsequently with letter dated 8 June 2015, the OSR was specified as being selected from a list comprising **vitamin B12**, vitamin E, tocopherols, tocotrienols,  $\alpha$ -tocopherol and **alpha ketoglutarate (AKG)**.

3.3 With the set of claims filed with the letter dated 27 January 2016, the sole independent claim was limited to reciting vitamin B12 only. The examining division issued a summons to oral proceedings dated 29 February 2016. In the annex to the summons, it raised objections to said set of claims under Articles 123(2), 54 and 56 EPC. In response, the appellant filed a new set of claims (letter dated 20 June 2016) in which the sole independent claim was again limited to reciting vitamin



B12. With the communication dated 7 July 2016, the examining division maintained objections under Article 123(2) EPC and 56 EPC. With letters dated 19 July 2016, the day before scheduled oral proceedings, the appellant filed two sets of claims as first and second auxiliary requests. Those requests also comprised a sole independent claim limited to reciting vitamin B12 only.

3.4 Hence, during examination proceedings, the appellant chose to progressively restrict the scope of the sole independent claim to subject-matter requiring the presence or addition of **vitamin B12**.

4. Admittance of the main request - "fresh case"

4.1 The board from the foregoing concludes that the filing of the set of claims of the main request with the statement of grounds of appeal constitutes a "fresh case". Specifically, independent claim 1 comprises a feature (AKG) which was not required by any of the independent claims of the requests upon which the contested decision was based, and a feature which was required by said earlier independent claims (vitamin B12) has been deleted.

4.2 The subject-matter of claim 1 consequently diverges towards subject-matter different to that which had been progressively pursued by way of limitation to independent claim 1 during examination proceedings, as set out above.

4.3 According to the principles governing *ex parte* proceedings, the board is not restricted to examination of the grounds for the contested decision nor the facts and evidence on which it is based (G 10/93, reasons,

3). The absence of a restriction however does not amount to a positive obligation for the board to consider any request filed in appeal, especially when the request brings about a new case (T 980/08, reasons 4.4). It is established jurisprudence that proceedings before the Boards of Appeal are primarily intended to review the correctness of the decision of the first instance rather than to reduce the workload of the examining divisions and to continue examination on new matter (G 10/93, reasons, 4; T 980/08, reasons, 4.4; T 65/11, reasons, 2).

- 4.4 These principles are codified in Article 12(4) RPBA 2007, which applies to the present case (Article 25(2) RPBA 2020). According to this provision, the board has discretion to hold inadmissible requests which could have been presented in examination proceedings.
- 4.5 It is evident from the history of the file as set out above that the appellant had multiple opportunities during examination proceedings to file a set of claims corresponding to that of the present main request, should it have wished to pursue subject-matter different to that finally presented to the examining division. Despite the various objections raised during examination by the examining division (paragraph 3.3, above), the appellant nevertheless chose to pursue the subject-matter of the then pending claim requests, and in particular, chose not to file any alternative or auxiliary claim request comprising an independent claim in which vitamin B12 was replaced by AKG.
- 4.6 The appellant was aware of the examining division's objections against the claims on file. Even if it had considered the set of claims of auxiliary requests 1

and 2 to have overcome the examining division's objections pursuant to Article 123(2) EPC raised in the communication dated 7 July 2016, there still existed an objective risk that those requests would not be found allowable at least under Article 56 EPC. Despite this, the appellant chose not to attend oral proceedings before the examining division, thus deprived itself of the possibility of filing new claim requests at the last stage of examination proceedings.

- 4.7 The appellant argued during oral proceedings before the board that a statement in the annex to the communication of the examining division (page 5, underlined paragraph), dated 7 July 2016 (subsequent to the issuance of the summons to oral proceeding) had led the appellant to believe that an inventive step could be recognised for the subject-matter of the requests pending before the examining division. As a consequence, the filing of further claim requests directed to alternative subject-matter, such as the set of claims of the present main request, was not considered necessary.

The board notes however that said statement was conditional, and merely referred to the possibility of inventive step being acknowledged *inter alia* should "evidence of an unexpected effect" be provided. Since no evidence was forthcoming from the appellant in the period between the issuance of said communication and the date of oral proceedings, the appellant had no reason to assume that inventive step would be acknowledged and that one of its pending claim requests would be allowed.

4.8 The appellant furthermore argued that in filing the main request with the statement of grounds of appeal, the intention was in fact to expedite the appeal procedure by reverting to subject-matter which was allowable.

This argument must fail. As noted above, the relevant question for the admittance of the main request is not whether said request might be allowable, but rather whether it could and should have been submitted during examination proceedings.

4.9 Under the circumstances, there is no cogent reason apparent as to why the appellant would not have been in a position to submit the present main request during examination proceedings. Instead, it chose to wait until the appeal proceedings to present such a claim request.

4.10 By filing the main request with the statement of grounds of appeal, the appellant seeks a second examination, before the Boards of Appeal, of the same application in regard of subject-matter diverging with that pursued in examination proceedings. Such filing behaviour represents a misuse of the appeal proceedings as a means of recommencing examination, which if permitted, would be contrary to the intended function of the Boards of Appeal as a judicial instance. Furthermore, admitting such a request would be unacceptable for procedural economy, since not only would it involve likely remittal of the case to the examining division for prosecution of entirely new subject-matter, but also there would be nothing preventing the appellant from pursuing the same strategy in a further appeal if the remitted claim

request were found not to be allowable in continued examination proceedings.

5. Conclusion

5.1 Having regard to the facts and arguments on file, the board decided to exercise its discretionary power pursuant to Article 12(4) RPBA 2007 not to admit the main request into the proceedings.

This decision is also in line with other decisions of the Boards of Appeal in which the situation was similar (e.g. T 980/08, reasons, 4.4; T 65/11, reasons, 2.3 - 2.6).

5.2 Since no other claim requests are pending, the appeal is to be dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated