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**Datasheet for the decision  
of 4 August 2021**

**Case Number:** T 1699/17 - 3.3.01

**Application Number:** 07800215.1

**Publication Number:** 2061482

**IPC:** A61K31/7105, A61K48/00,  
A61K31/711, A61P35/00,  
C12N15/113

**Language of the proceedings:** EN

**Title of invention:**

Method of modulation of expression of epidermal growth factor  
receptor (EGFR) involving miRNA

**Patent Proprietor:**

The University Of Western Australia

**Opponent:**

Müller Fottner Steinecke Rechtsanwalts- und  
Patentanwaltpartnerschaft mbB

**Headword:**

Modulation of EGFR with miRNA/UNIVERSITY OF WESTERN AUSTRALIA

**Relevant legal provisions:**

RPBA Art. 12

RPBA 2020 Art. 13

**Keyword:**

**Decisions cited:**

**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 1699/17 - 3.3.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.01**  
**of 4 August 2021**

**Appellant:** Müller Fottner Steinecke Rechtsanwalts- und  
(Opponent) Patentanwaltspartnerschaft mbB  
P.O. Box 11 40  
Römerstrasse 16b  
52428 Jülich (DE)

**Representative:** Witthoff Jaekel Steinecke Patentanwälte PartG mbB  
Postfach 1140  
52412 Jülich (DE)

**Respondent:** The University Of Western Australia  
(Patent Proprietor) Nedlands  
Western Australia 6907 (AU)

**Representative:** Modiano, Micaela Nadia  
Modiano Josif Pisanty & Staub Ltd  
Thierschstrasse 11  
80538 München (DE)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
22 May 2017 concerning maintenance of the  
European Patent No. 2061482 in amended form**

**Composition of the Board:**

**Chairman** A. Lindner  
**Members:** T. Sommerfeld  
P. de Heij

## **Summary of Facts and Submissions**

I. European patent 2061482 is based on application 07800215.1, which was filed as an international application published as WO 2008/025073. The patent is entitled "Method of modulation of expression of epidermal growth factor receptor (EGFR) involving miRNA" and was granted with 15 claims.

II. Opposition was filed against the granted patent, the opponent requesting that the patent be revoked in its entirety on the grounds of lack of novelty and of inventive step (Articles 54(2) and 56 EPC and Article 100(a) EPC), insufficiency of disclosure (Article 100(b) EPC) and added subject-matter (Article 100(c) EPC).

III. By an interlocutory decision announced at oral proceedings on 6 April 2017, the opposition division decided that the patent could be maintained in amended form on the basis of set of claims of the "new second auxiliary request" filed during the oral proceedings (Articles 101(3) (a) and 106(2) EPC).

The opposition division considered that the claims according to the main request did not comply with Rule 80 EPC and that the claims according to the first auxiliary request and the then-second auxiliary request (also designated "third auxiliary request" in the decision) did not comply with Article 123(2) EPC.

IV. The opponent (appellant) lodged an appeal against the decision of the opposition division, requesting that it be set aside and the patent be revoked in its entirety.

It moreover requested reimbursement of the appeal fee in view of a substantial procedural violation.

- V. By letter dated 19 February 2018, filed in reply to the grounds of appeal, the patent proprietor (respondent) requested that the patent be maintained on the basis of the claims allowed by the opposition division (main request) or, alternatively, on the basis of the first or second auxiliary requests filed with the same letter.
- VI. A summons to oral proceedings before the board, scheduled for 4 August 2021, was issued. In a subsequent communication pursuant to Article 15(1) RPBA, the board provided a preliminary opinion on some issues, including the request for reimbursement of the appeal fee.
- VII. Oral proceedings before the board took place as scheduled, by videoconference with the agreement of both parties.

During the oral proceedings, the respondent filed a new third auxiliary request and then a corrected third auxiliary request (the latter hereinafter "third auxiliary request"). In addition, the respondent raised an objection regarding the identity of the appellant. At the end of the oral proceedings the chairman announced the board's decision.

Claim 1 of the **third auxiliary request** is identical to claim 6 as maintained by the opposition division as communicated in the "Druckexemplar". It reads:

"1. An agent comprising an miRNA comprising a nucleic acid molecule which comprises a sequence having at least 90% identity with at least one sequence selected from the group consisting of: SEQ ID NOs: 37 to 54, for use in treating a disease or disorder associated with an abnormal level of expression of EGFR, wherein the disease or disorder is selected from among lung cancer, gastrointestinal cancer, glioblastoma, cervical cancer, ovarian cancer, bladder cancer, breast cancer, brain cancer, prostate cancer, colon cancer, colorectal cancer, endometrial carcinoma, esophageal cancer and head and neck cancer, wherein: the agent is capable of interacting with a sequence set forth in any one of SEQ ID NOs: 31 to 36 present in the 3'-UTR of EGFR; and said nucleic acid molecule comprises said miRNA that binds to a sequence set forth in any one of SEQ ID NOs: 31 to 36 present in the 3'-UTR of EGFR and downregulates expression of EGFR."

VIII. The appellant's submissions, in so far as they are relevant to the present decision, may be summarised as follows:

*Change of identity of the appellant*

The identity of the appellant had not changed, only the representative of the appellant.

*Admission of the third auxiliary request*

The request was very late-filed and should have been filed earlier.

*Admission of objections against the third auxiliary request*

Although the present claim 1 was worded differently from claim 1 as maintained, the same arguments still applied since the same features were present. The appellant had requested that the patent be revoked in its entirety, which implied that all claims had been objected to, even if this had not been explicitly stated. It would not be in the public interest to uphold a patent that clearly did not meet the EPC requirements. The respondent had not previously filed a request directed to this subject-matter, therefore the appellant had not seen the need to directly attack these claims.

- IX. The respondent's arguments, in so far as they are relevant to the present decision, may be summarised as follows:

*Change of identity of the appellant*

As could be inferred from the appellant's letter dated 12 July 2021, the identity of the appellant had been changed. The case law of the boards of appeal acknowledged the possibility of a transfer of the status of opponent, but only together with a transfer of the opponent's business. No proof of the latter was provided.

*Admission of the third auxiliary request*

It was clear from the letter of reply to the grounds of appeal that it had been the respondent's intention to submit such a claim request as the second auxiliary

request. It was only by mistake that a wrong version was submitted instead.

*Admission of objections against the third auxiliary request*

The appellant had only substantiated objections against claim 1 as maintained, a claim which was no longer part of the present claim request. Claim 6 as maintained, while comprising the same features as claim 1, further specifically defined the mRNA sequences by reciting their SEQ ID NOs. This claim had never been objected to. There was therefore no appeal pending for the present request. It was foreseeable that the respondent might legitimately react to the appellant's objections by deleting the attacked claims while maintaining those that had not been attacked, as in the present third auxiliary request. The new Rules of Procedure required that the parties set out their complete case at the beginning, so to allow new objections to be raised against this request would go against the Rules of Procedure.

X. The parties' final requests were:

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The respondent requested that the decision under appeal be set aside and the patent be maintained on the basis of the third auxiliary request, filed as the corrected third auxiliary request during the oral proceedings of 4 August 2021.



## Reasons for the Decision

1. The appeal is admissible.
2. Change of identity of the appellant
3. The opposition and the appeal are filed in the name of Müller Fottner Steinecke Rechtsanwalts- und Patentanwaltspartnerschaft mbB. The notice of appeal is signed by an associate of association number 163. In light of the letterhead, this association was apparently the appellant itself. The appellant's letter of 12 July 2021 on the other hand is signed by the same associate on behalf of Witthof Jaekel Steinecke Patentanwälte PartG mbB.

The respondent infers from this letter that the opposition has been transferred to Witthof Jaekel Steinecke Patentanwälte PartG mbB. However, no such transfer has been requested nor is the letter an indication of such transfer. The letter might indicate that the registered association had changed its name - in which case it is the same legal entity as before - or that, as submitted by the appellant, the appellant had changed its representative. In either case, there has been no change in the identity of the appellant. The respondent's objection concerning the identity of the appellant is therefore rejected.

4. Admission of the third auxiliary request
  - 4.1 The respondent filed the third auxiliary request during oral proceedings before the board of appeal. Pursuant to Article 13(2) RPBA 2020, any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into

account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

4.2 The third auxiliary request was filed as a reaction to the appellant's remark, made for the first time at oral proceedings, that, contrary to the appellant's statement in the reply to the grounds of appeal, the claims of the second auxiliary request submitted with the letter of reply were not identical to claims 6 to 11 of the claim request that had been considered allowable by the opposition division ("claims as maintained"). In fact, claim 1 of the second auxiliary request comprised a reference to Raf-1 which was not present in claim 6 of the claims as maintained.

4.3 The board agreed with the respondent's arguments that it was clear from the reply to the grounds of appeal (page 13, lines 2 to 4) that it had been the intention of the respondent to submit a claim set which comprised claims 6 to 11 of the claims as maintained by the opposition division. It was thus only inadvertently that a request with an incorrect wording had been submitted instead. Hence the board considered that either there were exceptional circumstances (namely the unintentional filing of an incorrect set of claims) justifying the admission of the claim set under Article 13(2) RPBA or alternatively that the submission of the present claim set was merely a correction of a document that had been duly submitted under Article 12(2) RPBA. In any case, the board came to the conclusion that there was no amendment of the case, and therefore decided to admit the third auxiliary request into the proceedings.

5. Admission of objections against the third auxiliary request

5.1 Article 12(2) RPBA stipulates that appeal proceedings shall be based *inter alia* on the notice of appeal and statement of grounds of appeal filed pursuant to Article 108 EPC. According to Article 12(3) RPBA, the statement of grounds of appeal and the reply shall contain a party's complete appeal case: they shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on. Pursuant to Article 13(2) RPBA, any amendment to a party's appeal case made after notification of a summons to oral proceedings shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

5.2 The set of claims which had been considered allowable by the opposition division ("claims as maintained") comprised 11 claims, of which claims 1 and 6 were independent claims. With the statement of grounds of appeal, the appellant raised objections under Articles 123(2), 84, 54, 56 and 83 EPC against the set of claims that had been considered allowable by the opposition division. However, in the substantiation of the objections under Article 123(2) and 84 EPC the appellant only referred to claim 1 as maintained, while as regards Article 54, 56 and 83 EPC there is not even any reasoning as to why the decision of the opposition division should be reversed.

5.3 There were thus no objections directed to independent claim 6 "as maintained" or to its dependent claims 7 to

11 in the grounds of appeal, nor any statement that the objections raised against claim 1 also applied to these claims. It is not apparent at all from the grounds of appeal that the appellant had also intended to attack these claims. The fact that the appellant had requested revocation of the patent in its entirety does not mean that each and every claim of the maintained claims was objected to because, clearly, it is enough that only one claim is considered unallowable for the whole patent to be revoked. In addition, although claim 1 of the third auxiliary request comprises the same features that were objected to in claim 1 of the claims as maintained, it is nevertheless directed to a different subject-matter because the agent to be used for treatment is not solely defined as comprising an miRNA having the disputed functional features, but rather the miRNA is further defined structurally by reference to the corresponding nucleic acid sequences and their SEQ ID NOs. Hence, while the objections may still apply to individual features, it is not clear how they apply to the new combination of features, in particular in view of the structural limitation.

5.4 Accordingly, the board considers that the added-matter objection raised during the oral proceedings against independent claim 6 (and dependent claims 7 to 11) represents an amendment of the appellant's appeal case. Hence the objection directed to the present third auxiliary request, which consists of claims which are identical to claims 6 to 11 as maintained, cannot be taken into account unless the amendment is justified. However, the appellant did not provide any justification.

5.5 In addition, it appears to the board that the parties would most likely have to present new arguments that

have not been discussed either in the appeal or in the opposition proceedings. Moreover, the board considers that it was a legitimate reaction of the respondent to assume that claim 6, being more restricted than claim 1, was not a target of the appellant's objections and that therefore a request based on said claim would not have to be discussed. Allowing a discussion of said subject-matter to take place at oral proceedings would have required the respondent to be given the opportunity to react, possibly by filing new requests, which might have led to a need to postpone oral proceedings. Finally, while the board agrees that it is not in the public interest to uphold a patent that does not meet the EPC requirements, the board notes that, without a discussion of the objections possibly to be raised by the appellant, it is not clear to the board that a patent based on the present third auxiliary request does not meet the EPC requirements.

- 5.6 For the above reasons, the board decided not to admit any objections against the subject-matter of the third auxiliary request.

## **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 with the order to maintain the patent with the following claims and a description to be adapted thereto:

claims 1 to 6 of the third auxiliary request, filed as corrected third auxiliary request during the oral proceedings of 4 August 2021.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated