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Datasheet for the decision of 25 March 2022

Case Number: T 0969/18 - 3.3.08

Application Number: 08832899.2

Publication Number: 2217711

IPC: C12P7/04, C12P23/00, C12N15/52

Language of the proceedings: EN

Title of invention:
PRODUCTION OF ISOPRENOIDS

Patent Proprietor:
Amyris, Inc.

Opponent:
Ajinomoto Co., Inc.

Headword:
Isoprenoids/AMYRIS

Relevant legal provisions:
EPC Art. 123(2), 123(3), 84
RPBA Art. 12(4)

Keyword:
Main request - admission into the proceedings - (yes)
Requirements of the EPC met - (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

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Case Number: T 0969/18 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 25 March 2022

Appellant: (Opponent)	Ajinomoto Co., Inc. 15-1 Kyobashi 1-Chome Chuo-ku, Tokyo 104-8315 (JP)
Representative:	Zeman, Steven M. Grünecker Patent- und Rechtsanwälte PartG mbB Leopoldstraße 4 80802 München (DE)
Respondent: (Patent Proprietor)	Hayes, Emily A. L. Amyris, Inc. 5885 Hollis Street, Suite 100 Emeryville, CA 94608 (US)
Representative:	Mewburn Ellis LLP Aurora Building Counterslip Bristol BS1 6BX (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 9 February 2018 concerning maintenance of the European Patent No. 2217711 in amended form.**

Composition of the Board:

Chair	B. Stolz
Members:	M. R. Vega Laso
	R. Winkelhofer

Summary of Facts and Submissions

I. European patent No. 2 217 711 with the title "Production of isoprenoids" was granted from European application No. 08832899.2 which had been filed under the Patent Cooperation Treaty and published as WO 2009/042070 A2 (in the following "the application as filed").

II. An opposition was filed based on the grounds for opposition of Article 100(a) in conjunction with Articles 54 and 56 EPC, and Article 100(b) and (c) EPC.

III. In an interlocutory decision posted on 9 February 2018, an opposition division found that, account being taken of the amendments introduced into the claims according to the main request then on file and the amended description filed during the oral proceedings, the patent and the invention to which it relates meet the requirements of the EPC. In particular, the opposition division found that Article 123(2) and (3) EPC were not contravened (see last three paragraphs on page 6 of the decision under appeal), and the requirements of Article 83 EPC were fulfilled (see page 13, first and second paragraph). While the priority was found not to be validly claimed (see passage bridging pages 7 and 8), the claimed subject-matter was considered to be novel (see paragraph bridging pages 8 and 9) and to involve an inventive step (see pages 11 and 12).

IV. The opponent (appellant) filed an appeal.

V. On 2 November 2018, the patent proprietor (respondent) replied to the appeal and filed 40 sets of claims as

main request and auxiliary requests 1 to 12, including variants a-c for auxiliary requests 4 to 12.

VI. The appellant submitted observations on some of the requests filed by the respondent.

VII. Pursuant to their subsidiary requests, the parties were summoned to oral proceedings before the board.

VIII. Subsequently, the appellant announced that they would not attend the oral proceedings.

IX. In a communication issued in preparation of the oral proceedings, the board provided observations on procedural issues concerning the admittance and consideration of the auxiliary requests in the proceedings, and substantive issues related to Articles 123(2)(3), 83, 87, 54 and 56 EPC.

X. Oral proceedings were held on 25 March 2022 in the presence of the respondent. During the oral proceedings, the respondent withdrew the previous main request and made auxiliary request 1 the current main request.

XI. Claims 1 to 3 of the current main request read:

"1. A method for making an isoprenoid compound comprising:

(a) obtaining a plurality of host cells that are capable of making the isoprenoid compound, wherein each host cell comprises a plurality of heterologous nucleic acid sequences encoding all of the MEV pathway enzymes;

(b) culturing the host cells in a medium under conditions wherein the host cells use ethanol as a carbon source and make the isoprenoid compound, and under oxygen limited conditions, wherein the dissolved oxygen concentration in the medium is less than 20%; and

(c) recovering the isoprenoid compound produced by the host cells from the medium.

2. The method of claim 1 wherein the medium comprises exogenously provided ethanol.

3. The method of claim 1, wherein the medium comprises a non-ethanol carbon source that is converted by the host cells into ethanol."

Claims 4 to 16 are directed to further variants of the method of claim 1.

XII. The submissions made by the appellant in writing, as far as they are relevant to the present decision, were essentially as follows:

Admittance and consideration of the main request, submitted as auxiliary request 1 on 2 November 2018, in the proceedings

This request had been filed for the first time just before the oral proceedings in opposition proceedings, but had never been formally admitted by the opposition division. The request was intended to address an objection that had been raised already in the notice of opposition. There was no reason why such a request could not have been filed by the deadline set by Rule 116 EPC. According to Article 12(4) RPBA 2007, it

was within the discretion of the board not to admit late-filed requests. While this referred to late-filing during appeal, by analogy, this principle had to apply also to requests that had been late-filed in opposition and were never formally admitted by the opposition division.

Moreover, it was explicitly required by Article 12(2) RPBA 2020, which applied to this case by virtue of Article 25(1) RPBA 2020, that the appeal be directed to requests on which the decision under appeal was based. Since the decision under appeal in the current case had not been based on this particular request, the request should not be a subject in the appeal proceedings.

Main request - Articles 123(2), 123(3), 84, 83, 87, 54 and 56 EPC

The appellant did not make any substantive submissions in this respect.

XIII. The relevant submissions by the respondent were essentially as follows:

Admittance and consideration of the main request, submitted as auxiliary request 1 on 2 November 2018, in the proceedings

The current main request was identical to the auxiliary request 1 filed during the opposition proceedings. Since the opposition division had decided to maintain the patent on the basis of the main request then on file, the auxiliary request 1 was not dealt with in the decision under appeal. Nevertheless, the request was on

file and, consequently, was a subject of the appeal proceedings.

Main request - Article 123(2) and (3) EPC

Basis for the amendment introduced into claim 1 was found in, at least, paragraphs [0009], [0146] and [0155], and in claim 1 of the application as filed. The amendment introduced into claim 2 was derivable from paragraphs [0010] and [0155], and claim 3 of the application as filed. The amendment introduced into claim 3 was based on the disclosure in paragraphs [0010] and [0155] of the application as filed.

XIV. The appellant requests that the decision under appeal be set aside and the patent be revoked. Further, the appellant requests that the auxiliary requests filed by the respondent not be admitted and considered.

XV. The respondent requests that the decision under appeal be set aside and the patent be maintained based on claims 1 to 16 of the main request, submitted as auxiliary request 1 on 2 November 2018.

Reasons for the Decision

Admittance and consideration of the main request, submitted as auxiliary request 1 on 2 November 2018, in the proceedings

1. Pursuant to Article 12(4) RPBA 2007, which applies to the present case by virtue of Article 25(2) RPBA 2020, the board has the discretionary power to hold inadmissible requests which could have been presented or were not admitted in the first instance proceedings. Without prejudice to this discretionary power,

everything presented by the parties under Article 12(1) RPBA 2007 shall be taken into account if and to the extent it relates to the case under appeal and meets the requirements in Article 12(2) RPBA 2007.

2. The present main request is identical to the auxiliary request 1 filed on 24 November 2017 in preparation of the oral proceedings before the opposition division. Hence, the request was in fact presented in the first instance proceedings.

3. The opposition division found that the main request then on file fulfilled the requirements of the EPC and, thus, did not take a decision on the admittance of the auxiliary requests presented by the patent proprietor (the present respondent). The lack of a decision on the admittance of the requests cannot however be equated to an adverse decision by the first instance. Hence, there is no room for disregarding the current main request.

4. In view thereof, also nothing can be gained for the appellant from Article 12(2) RPBA 2020 which has to be read, moreover, in conjunction with Article 12(4) RPBA 2020 not yet applicable in the current case.

5. Consequently, the main request is to be considered in the appeal proceedings.

Main request
Rule 80 EPC

6. The amendments introduced into claims 1 to 3 are occasioned by a ground for opposition under Article 100(c) EPC invoked by the opponent. Hence, they conform to Rule 80 EPC.

Article 123(2) and (3) EPC

7. Claim 1 differs from the corresponding claim of the patent as granted in that in step (b) the host cells are cultured in a medium "... under conditions wherein the host cells use ethanol as a carbon source and make the isoprenoid compound ...". This feature is disclosed literally in claim 1 of the application as filed, and is found also in paragraphs [0009] and [0146] of the original application.

8. In claims 2 and 3, the wording "the carbon source" has been replace by "the medium". The embodiment claimed in dependent claim 2 is disclosed in paragraphs [0010] and [0155], as well as in claim 3 of the application as filed. The subject-matter of claim 3 is disclosed in paragraphs [0010] and [0155] of the application as filed.

9. The appellant did not present any substantive observations concerning the current main request. In view of the uncontested findings on Article 123(2) EPC in the decision under appeal and the findings above, the amended claims cannot be considered to contain subject-matter that extends beyond the content of the application as filed. Thus, Article 123(2) EPC is not contravened.

Article 123(3) EPC

10. The feature introduced into claim 1 limits the scope of protection conferred by claim 1 as granted and the dependent claims. Hence, the amendment does not offend against Article 123(3) EPC.

Article 84 EPC

11. The amended claims are clear and concise. They are also supported by the description. Article 84 EPC is complied with.

Articles 83, 54 and 56 EPC

12. The appellant did not dispute the allowability of the current main request in the light of Articles 83, 54 and 56 EPC. Since no reasons to depart from the findings in the decision under appeal appear from the file, the subject-matter and the invention as claimed according to the current main request meet the patentability requirements of the EPC.

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 on the basis of claims 1 to 16 of the main request, submitted as auxiliary request 1 on 2 November 2018, and a description to be adapted.

The Registrar: On behalf of the Chair (according to Art.8(3) RPBA 2020):

L. Malécot-Grob R. Winkelhofer

Decision electronically authenticated