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Datasheet for the decision of 15 July 2022

Case Number: T 1421/18 - 3.3.08

Application Number: 10181535.5

Publication Number: 2322655

IPC: C12Q1/68

Language of the proceedings: EN

Title of invention:
Methods and sequences for the detection and identification of methicillin-resistant Staphylococcus aureus MREJ type viii strains

Patent Proprietor:
Geneohm Sciences Canada, Inc.

Opponents:
Beckman Coulter, Inc.
R-Biopharm AG

Headword:
Detection methicillin-resistant Staphylococcus aureus/GENEOHM SCIENCES CANADA

Relevant legal provisions:
EPC Art. 76(1), 123(2), 123(3)
RPBA 2020 Art. 15(8)
RPBA Art. 12(4)

Keyword:
Main request, auxiliary requests 3 and 5 to 9 - added subject-matter (yes);
Auxiliary requests 1 and 2 - addmission into the appeal proceedings (no);
Auxiliary request 4 - extension of the scope of protection (yes);

Decisions cited:
T 2002/13, T 1146/15, T 2255/18

Catchword:

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Beschwerdekammern

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Case Number: T 1421/18 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 15 July 2022

Appellant: (Patent Proprietor)	Geneohm Sciences Canada, Inc. 2555 Boul. du Parc Technologique Québec, QC G1P 4S5 (CA)
Representative:	Schlörb, Christian Vossius & Partner Patentanwälte Rechtsanwälte mbB Siebertstrasse 3 81675 München (DE)
Respondent I: (Opponent 1)	Beckman Coulter, Inc. 250 S. Kraemer Boulevard Brea, CA 92821 (US)
Representative:	Spencer, Matthew Peter Boult Wade Tennant LLP Salisbury Square House 8 Salisbury Square London EC4Y 8AP (GB)
Respondent II: (Opponent 2)	R-Biopharm AG An der neuen Bergstrasse 17 64297 Darmstadt (DE)
Representative:	Buchanan, Luke Hertin und Partner Rechts- und Patentanwälte PartG mbB Kurfürstendamm 54/55 10707 Berlin (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 27 March 2018 revoking European patent No. 2322655 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	B. Stolz
Members:	P. Julià
	D. Rogers

Summary of Facts and Submissions

I. European patent no. 2 322 655 is based on European patent application no. 10 181 535.5 (hereinafter, "the patent application"), a divisional application of the earlier European patent applications nos. 09 174 581.0 and 02 740 158.7 (published as EP 2 236 621 and EP 1 397 510, respectively), the earliest application originally filed under the PCT and published as International patent application WO 02/099034 (hereinafter, "the parent application"). The patent was granted with 14 claims.

II. Two oppositions were filed on the grounds set forth in Articles 100(a), 100(b) and 100(c) EPC. The opposition division considered that the main request and auxiliary requests 1 and 3 to 7 contravened Articles 76(1) and 123(2) EPC, and that auxiliary requests 2, 5 and 7 did not comply with Article 123(3) EPC. Thus, the patent was revoked.

III. An appeal was lodged by the patent proprietor (appellant). In the statement setting out their grounds of appeal, the appellant filed a main request and auxiliary requests 1 to 9.

IV. Whilst opponent 01 (respondent I) replied to the statement of grounds of appeal and filed new evidence, no submissions were filed by opponent 02 (respondent II).

V. As an auxiliary measure, oral proceedings were requested by both the appellant and respondent I.

VI. The parties were summoned to oral proceedings. In a communication issued in preparation of these proceedings, they were informed of the board's provisional opinion on the issues of the case. The main points of this communication were summarised as, *inter alia*, the main request and auxiliary request 3 contravened Article 76(1) EPC, auxiliary requests 1 and 2 were not to be admitted into the proceedings, auxiliary request 4 contravened Article 123(3) EPC, and none of auxiliary requests 5 to 9 overcame the objections raised against the main request and auxiliary requests 3 and 4.

VII. None of the parties replied in substance to the board's communication and all of them informed the board of their intention not to attend the oral proceedings.

VIII. The oral proceedings were cancelled.

IX. Claims 1 and 8 of the main request read as follows:

"1. A method for detecting the presence of MREJ type i, ii, iii and viii methicillin-resistant *Staphylococcus aureus* (MRSA) strains comprising:

a) contacting a sample to be analyzed for the presence of said MREJ type i, ii, iii and viii MRSA strains, each of said MRSA strains including a Staphylococcal cassette chromosome *mec* (SCC*mec*) element containing a *mecA* gene inserted into chromosomal DNA, thereby generating a polymorphic right extremity junction (MREJ) type i, ii, iii or viii sequence that comprises sequences from both the SCC*mec* element right extremity and chromosomal DNA adjoining said SCC*mec* element right extremity, with a first primer and a second primer for each of said MREJ type i, ii, iii and viii,

wherein each said first primer hybridizes with said SCC*mec* element right extremity of an MREJ type i, ii, iii or viii sequence selected from the group consisting of: SEQ ID NOs: 1, 20 to 25, 41 and 199, and complements thereof, for MREJ type i, SEQ ID NOs: 2, 17 to 19, 26, 40, 173 to 183, 185, 186 and 197, and complements thereof, for MREJ type ii, SEQ ID NOs: 4 to 16, 104, 184 and 198, and complements thereof, for MREJ type iii, and SEQ ID NO: 167, and the complement thereof, for MREJ type viii; and

wherein each said second primer hybridizes with said chromosomal sequence of *S. aureus* to specifically generate an amplicon(s) if such MREJ type i, ii, iii or viii MRSA strain is present in said sample; and

b) detecting the presence of said amplicon(s).

8. A kit for detecting the presence of MREJ type i, ii, iii and viii MRSA strains in a sample comprising:

a) a first set of primers which hybridize with the SCC*mec* element right extremity of MREJ type i, ii, iii and viii sequences selected from the group consisting of SEQ ID NOs: 1, 20 to 25, 41 and 199, and complements thereof, for MREJ type i, SEQ ID NOs: 2, 17 to 19, 26, 40, 173 to 183, 185, 186 and 197, and complements thereof, for MREJ type ii, SEQ ID NOs: 4 to 16, 104, 184 and 198, and complements thereof, for MREJ type iii, and SEQ ID NO: 167, and the complement thereof for MREJ type viii; and

b) a second primer which hybridizes with a chromosomal sequence of *S. aureus* adjoining said SCC*mec* element

right extremity of MREJ type i, ii, iii and viii sequences;

wherein said primers of a) and b) enable the selective generation of an amplicon(s) which comprises sequences from both the SCC*mec* element right extremity and chromosomal DNA adjoining said right extremity of said MREJ type i, ii, iii and viii MRSA strains."

Claims 2 to 7 are directed to preferred embodiments of the method of claim 1. Claims 9 to 11 and 13 are directed to preferred embodiments of the kit of claim 8. Claim 12 is directed to the method of any one of claims 1 to 7 or the kit of any one of claims 8 to 11, wherein said second primer has a sequence as set forth in SEQ ID NO: 64.

X. Claims 1 and 8 of auxiliary request 1 read as claims 1 and 8 of the main request, except for the additional sentence: "wherein each said first primer is specific for MREJ type i, ii, iii or viii, and ..." at the beginning of the second paragraph in part a) of claim 1 and at the end of part a) of claim 8.

XI. Claim 1 of auxiliary request 2 reads as claim 1 of auxiliary request 1, except for the last paragraph in part a) which reads as follows:

"wherein each said second primer hybridizes with said chromosomal sequence of *S. aureus* selected from the group consisting of: SEQ ID NOs: 1, 20 to 25, 41 and 199, and complements thereof, for MREJ type i, SEQ ID NOs: 2, 17 to 19, 26, 40, 173 to 183, 185, 186 and 197, and complements thereof, for MREJ type ii, SEQ ID NOs: 4 to 16, 104, 184 and 198, and complements thereof, for MREJ type iii, and SEQ ID NO: 167, and the

complement thereof, for MREJ type viii to specifically generate an amplicon(s) if such MREJ type i, ii, iii or viii MRSA strain is present in said sample; and ...".

This sentence is also present at the end of part b) of claim 8 of auxiliary request 2. Otherwise, claim 8 is identical to claim 8 of auxiliary request 1, except for the beginning of part a) which reads: "a) a first set of primers with a first primer for each of said MREJ type i, ii, iii and viii, wherein each said first primer is specific for MREJ type i, ii, iii or viii, wherein each said first primer hybridize with the SCC*mec* element right extremity of MREJ type i, ii, iii or vii sequences selected ...".

XII. Claim 1 of auxiliary request 3 reads as claim 1 of the main request, except for the beginning of the second paragraph and the last paragraph of part a) which read, respectively, as follows:

"wherein each said first primer is specific for MRSA strains and hybridizes with ..." and "wherein each said second primer hybridizes with said chromosomal sequence of *S. aureus*, wherein said chromosomal sequence of *S. aureus* is *orfX*, to specifically generate an amplicon(s) if such MREJ type i, ii, iii or viii MRSA strain is present in said sample; and ..."

Claim 7 of auxiliary request 3 is identical to claim 8 of the main request, except for the beginning of part a) and the end of part b) which, respectively, read as follows: "a) a first set of primers which are specific for MRSA strains and hybridize with ..." and "wherein said chromosomal sequence of *S. aureus* is *orfX*; ..."

XIII. Claim 1 of auxiliary request 4 reads as claim 1 of the main request, except for the beginning of the second paragraph and the last paragraph of part a) which read, respectively, as follows:

"wherein each of said first primer is specific for MREJ type i, ii, iii or viii, and wherein each of said first and second primer hybridizes with an MREJ type i, ii, iii or viii sequence selected from ..." and "to specifically generate an amplicon(s) which comprise(s) sequences from both the SCC*mec* element right extremity and chromosomal DNA adjoining said SCC*mec* element right extremity, if such MREJ type i, ii, iii or viii MRSA strain is present in said sample ..."

Claim 7 of auxiliary request 4 reads as follows:

"7. A kit for detecting the presence of MREJ type i, ii, iii and viii MRSA strains in a sample comprising:

a set of primers comprising a first primer for each of MREJ types i, ii, iii or viii, wherein said first primers are specific for MREJ type i, ii, iii or viii, wherein said set of primers hybridize with MREJ type i, ii, iii and viii sequences selected from the group consisting of SEQ ID NOs: 1, 20 to 25, 41 and 199, and complements thereof, for MREJ type i, SEQ ID NOs: 2, 17 to 19, 26, 40, 173 to 183, 185, 186 and 197, and complements thereof, for MREJ type ii, SEQ ID NOs: 4 to 16, 104, 184 and 198, and complements thereof, for MREJ type iii, and SEQ ID NO: 167, and the complement thereof for MREJ type viii;
wherein said primers enable the selective generation of an amplicon(s) which comprises sequences from both the SCC*mec* element right extremity and chromosomal DNA

adjoining said right extremity of said MREJ type i, ii, iii and viii MRSA strains."

XIV. Claims 1 and 8 of auxiliary request 5 read as claims 1 and 8 of the main request, except for the additional sentence "wherein said first and second primers are at least 10 nucleotides in length, ..." at the end of the first paragraph of part a) of claim 1, and for the beginning of the last paragraph of claim 8 which reads "wherein said primers of a) and b) consist of at least 10 nucleotides in length and enable ...".

XV. Claims 1 and 7 of auxiliary request 6 read as claims 1 and 8 of the main request, except for the last paragraph of part a) of claim 1 and for part b) of claim 7 which read as in claims 1 and 7 of auxiliary request 3, respectively.

XVI. Claim 1 of auxiliary request 7 reads as claim 1 of the main request, except for the beginning of the second paragraph of part a) which reads as follows: "wherein each of said first and second primer hybridizes an MREJ type i, ii, iii or viii sequence selected from ...", and for the last paragraph of part a) which reads as in claim 1 of auxiliary request 4.

Claim 7 of auxiliary request 7 reads as claim 7 of auxiliary request 4, except for the beginning of the first paragraph which reads as follows: "a set of primers, wherein said set of primers hybridize with MREJ type i, ii, iii and viii sequences selected from ...".

XVII. Claim 1 of auxiliary request 8 reads as claim 1 of auxiliary request 5, except for the last paragraph of part a) which reads as in claim 1 of auxiliary

request 6. Claim 7 of auxiliary request 8 reads as claim 8 of auxiliary request 5, except for part b) which reads as in claim 7 of auxiliary request 3.

XVIII. Claim 1 of auxiliary request 9 reads as claim 1 of auxiliary request 7, except for the first paragraph of part a) which reads as in claim 1 of auxiliary request 5. Claim 7 of auxiliary request 9 reads as claim 7 of auxiliary request 7, except for the beginning of the last paragraph which reads as follows: "wherein said primers consist of at least 10 nucleotides in length and enable ...".

XIX. The parties' arguments are dealt with in the reasons for the decision below.

XX. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or, in the alternative, any one of the auxiliary requests 1 to 9.

XXI. The respondent I (opponent 01) requested that the appeal be dismissed. There are no requests on file from respondent II (opponent 02).

Reasons for the Decision

1. The present decision is based on the same grounds, arguments and evidence on which the board's provisional opinion was based. They were neither questioned by the parties, nor does the board see any reason to re-consider them.

2. According to Article 15(8) RPBA 2020, if the board agrees with the finding of the department which issued the decision under appeal, the board may put the

reasons for its decision in abridged form in respect of that issue. As noted in its communication, the board agrees with the findings of the opposition division as regards the main request and the auxiliary requests underlying the decision under appeal and the appeal proceedings.

Main request

3. The main request is identical to the main request underlying the decision under appeal and thus, it forms already part of the appeal proceedings. The request was considered by the opposition division to contravene Articles 76(1) and 123(2) EPC.

Article 76(1) EPC

4. The opposition division decided that claim 1 contravened Articles 76(1) and 123(2) EPC because: (i) the method of claim 1 relates to the detection of specific MREJ types but the primers are not defined as being MREJ-type specific, and (ii) the second primers are not derived from MREJ sequences with particular SEQ ID NOs. The same reasoning applied to the kit of claim 8 (cf. pages 7 to 12, points 3.4.1 and 3.4.2 of the decision under appeal). The opposition division considered that there is a general basis in the parent application for primers without a specific length limitation (cf. paragraph bridging pages 11 and 12 of the decision under appeal) and that the other objections raised under Articles 76(1) and 123(2) EPC against claims 1, 7 and 8 were not relevant (cf. pages 12 and 13, point 3.4.3 of the decision under appeal).

5. Whilst the appellant contested the decision of the opposition division and addressed reasons (i) and (ii) (cf. pages 7 to 10, point 1 in the statement of grounds of appeal), the respondent I maintained all the objections raised under these articles against the main request at the proceedings before the first instance. In particular, respondent I provided arguments to support reasons (i) and (ii) and, in the context of the latter, referred to decision T 2002/13 of 17 May 2017 of this board in a different composition (cf. pages 14 to 24, points 8.1.1 and 8.1.2 of the respondent I's response to the statement of grounds of appeal). The respondent I contested the opposition division's decision on the absence of a length limitation in the definition of the primers as well as on the other objections raised under these articles against claims 7 and 8 of the main request (cf. pages 24 to 28, points 8.1.3 to 8.1.6 of the respondent I's response to the statement of grounds of appeal).

6. In its communication, the board confirmed the decision of the opposition division and further referred to the following issues:

6.1 Decisions T 1146/15 of 22 November 2021 and T 2255/18 of 23 November 2021 of this board in the same composition, are concerned with the related divisional European patent applications nos. 09 174 581.0 and 14 168 420.9 (published as EP 2 236 621 and EP 2 781 604, respectively), both based on the same parent application as the present patent. The subject-matter of those divisional applications concerns MREJ **type vii** instead of MREJ **type viii** of the present appeal proceedings.

6.2 Claims 1 and 9 of the main request underlying decision T 1146/15 were directed to "a method for detecting the presence of MREJ type i, ii, iii and vii MRSA strains" and "a kit for detecting the presence or absence of an MREJ type vii MRSA strain in a sample", respectively. The steps and definitions in these claims were similar, if not identical, to those in claims 1 and 8 of the main request in the present appeal proceedings and, in that decision, the board decided that these claims contravened Article 76(1) EPC.

6.3 The reasons given in decision T 1146/15 concerned: (i) the features "specifically generate (an) amplicon(s)" and "selective generation of an amplicon" in claims 1 and 9, respectively; and (ii) the definition of the second primer in claim 1. These reasons correspond to the reasons (i) and (ii) referred to above and they apply to a large extent, if not completely, to the subject-matter of claims 1 and 8 of the main request.

6.4 In the present case, as in that underlying decision T 1146/15, there is no basis in the parent application for the features "specifically generate an amplicon(s)" and "selective generation of an amplicon(s)" in claims 1 and 8 of the main request. Neither are the first primers defined as being MREJ type specific nor is the second primer limited to the *S. aureus* chromosomal sequence of *orfX* adjoining the polymorphic sequences from the SCC*mec* element right extremity, let alone to those chromosomal sequences within the specific MREJ type (SEQ ID NOs) sequences cited in claims 1 and 8, or to SEQ ID NO: 64 disclosed in the parent application as the sole sequence - from all those tested - capable of providing the required MRSA specificity over methicillin-sensitive *S. aureus*

(MSSA), methicillin-resistant and methicillin-sensitive coagulase-negative staphylococci (MCRNS and MSCNS, respectively) (cf. page 24, lines 10 to 16 of the parent application; and T 1146/15, *supra*, point 19 of the Reasons). Moreover, in the present case and contrary to the set of claims underlying decision T 1146/15, neither the first nor the second primer are limited by being at least 10 nucleotides in length.

6.5 In light of these considerations, the main request was considered to contravene Article 76(1) EPC.

7. As stated above, the provisional finding of the board has neither been subsequently commented on by the parties nor contested by the appellant. Under these circumstances, the board sees no reason to deviate from its provisional opinion.

Consideration/admission of new auxiliary requests 1 and 2

8. In view of the object of appeal proceedings (cf. "Case Law of the Boards of Appeal of the European Patent Office", 9th edition 2019, V.A.1, 1133), a party's appeal case shall be directed to, *inter alia*, requests on which the decision under appeal was based (Article 12(2) RPBA 2020). Since the statement of grounds of appeal was filed before the date of entry into force of the RPBA 2020, Article 12(4) RPBA 2007 applies to the present case for the purpose of establishing admittance (Article 25(2) RPBA 2020). According to Article 12(4) RPBA 2007, the board may hold inadmissible, *inter alia*, requests that could have been presented at first instance proceedings.

9. For the admission of new auxiliary requests 1 and 2 into the appeal proceedings, the appellant referred to

the auxiliary requests admitted into the proceedings of the related divisional patent applications EP 2 322 661, EP 2 322 663 and EP 2 322 664 (underlying the appeals T 1521/18, T 1522/18 and T 1582/18, respectively, pending before this board in a different composition), and to the claims corresponding to the wording of the auxiliary request 2 maintained by the opposition divisions in these cases.

10. The respondent I referred to several opportunities given to the appellant for filing new requests, in particular at the oral proceedings at first instance when the concerns of the opposition division on MREJ specificity and the requirements of the second primer were already known to the parties. The circumstances surrounding the filing of these auxiliary requests at the oral proceedings of the related divisional patent applications were also mentioned. In this context, the respondent I argued that auxiliary request 1 was never properly examined by the opposition division in the proceedings of the related divisional patent applications and that auxiliary request 2, as far as claim 8 is concerned, is not identical to that filed in the related divisional patent applications. Reference was also made to the criteria established in the case law for the admission into the appeal proceedings of requests not examined at first instance as well as to the deficiencies of these auxiliary requests as regards the requirements of the EPC, in particular Articles 76(1), 123(2),(3) and 84 EPC.

11. In its communication, the board stated that the feature introduced into auxiliary request 1 is already found in one of the auxiliary requests examined by the opposition division (see auxiliary request 4 in the present appeal proceedings) and that, as argued by the

respondent I, the wording of claim 7 of auxiliary request 2 is not identical to that of claim 8 of the auxiliary request 2 filed in the related divisional patent applications. The parties were further informed that, in light of the course of events at the first instance proceedings and of the parties' arguments submitted in appeal, the board, in line with the case law referred to by the respondent I, was minded not to admit the new auxiliary requests 1 and 2 into the appeal proceedings.

12. As stated above, the provisional finding of the board has neither been subsequently commented on by the parties nor contested by the appellant. Under these circumstances, the board sees no reason to deviate from its provisional opinion.

Auxiliary request 3 (*auxiliary request 1 at first instance*)
Article 76(1) EPC

13. The opposition division considered that the amendments introduced into claims 1 and 7 of this auxiliary request did not overcome the deficiencies of the corresponding claims of the main request and thus, decided that this auxiliary request did not comply with the requirements of Articles 76(1) and 123(2) EPC (cf. page 14, point 5 of the decision under appeal).

14. Whilst the appellant contested this decision, in particular the reasons given by the opposition division concerning the second primer (cf. page 17, point 2 in the statement of grounds of appeal), respondent I maintained all objections raised under these articles at first instance, in particular those against the definition of the second primer and the absence of a minimum length in the definition of both primers (cf.

page 78, point 11.1 *et seq.*, of the respondent I's response to the statement of grounds of appeal).

15. In its communication, the board confirmed the decision of the opposition division and further referred to the following issues:

15.1 In the definition of the first primer, the wording of the amendment introduced into claims 1 and 7 refers to MRSA specificity ("specific for MRSA strains") and not, as observed by the opposition division, to any MREJ type specificity, let alone each of the specific MREJ types mentioned in these claims. Thus, the objection raised against the main request for lack of MREJ specificity of the first primer is not overcome. Moreover, according to the disclosure of the parent application, MRSA specificity is always associated with, and linked to, the second primer and not the first primer. In this sense, claims 1 and 7 are also for this reason not supported by the parent application.

15.2 The question remains whether the amended definition of the second primer in claims 1 and 7 requires this primer to provide said MRSA specificity, the more so since the second primer is not limited to the *orfX* chromosomal sequence of *S. aureus* within the specific sequences mentioned in these claims, let alone to SEQ ID NO: 64 used in the parent application. The question remains also on the relevance of the absence of a minimum length for defining the first and second primers as well as of the other objections raised by the respondent I under Articles 76(1) and 123(2) EPC. However, in view of the relevance of the objection concerning the first primer, there is no need for the

board to enter into a detailed discussion of these objections.

15.3 In light of these considerations, the parties were informed that the board sees no reason to deviate from the finding of the opposition division that auxiliary request 3 contravenes Article 76(1) EPC.

16. As stated above, the provisional finding of the board has neither been subsequently commented on by the parties nor contested by the appellant. Under these circumstances, the board sees no reason to deviate from its provisional opinion.

Auxiliary request 4 (*auxiliary request 2 at first instance*)
Article 123(3) EPC

17. The opposition division considered this request, in particular claim 1, to contravene Article 123(3) EPC. Reference was also made to the definition of the second primer as comprising primers that were not embraced by the definition of the second primer in granted claim 1, namely primers hybridising "with the insertion (junction) site itself, as well as with the SCC*mec* right extremity part of said MREJ sequence insofar as this second primer, together with an appropriate first primer" fulfils the functional requirement of that claim. In this context, reference was made to points 23 to 26 of the Reasons of the decision T 2002/13 (cf. page 16, point 7.3 of the decision under appeal).

18. The appellant contested the decision of the opposition division and argued that the requirement in claim 1 of auxiliary request 4 that the first and second primers "specifically generate an amplicon(s), which comprise(s) sequences from both the SCC*mec* element

right extremity and chromosomal DNA adjoining said SCC*mec* element right extremity, if such MREJ type i, ii, iii or viii MRSA strain is present", excludes the second primers referred to by the opposition division and requires them to hybridise necessarily with the chromosomal sequence; otherwise, the amplicon(s) defined in the claim could not be generated. Whilst the structural properties of the amplicon, in particular the reference to "chromosomal DNA adjoining said SCC*mec* element right extremity", were defined in claim 1 of auxiliary request 4, this was not the case for the claim underlying the decision T 2002/13 (*supra*) (cf. pages 18 and 19, point 2 in the statement of grounds of appeal).

19. The respondent I disputed appellant's arguments and, with reference to the decision of the opposition division and to decision T 2002/13 (*supra*), argued that a second primer hybridising across the junction to primarily target SCC*mec* sequence may still generate the amplicon(s) as defined in claim 1 of auxiliary request 4; such a primer was however not embraced by granted claim 1. Moreover, claim 7 of this auxiliary request was also objected to under this article because, contrary to the corresponding claim as granted, there is neither a reference to, and definition of, a second primer, nor is the first primer required to hybridise with the SCC*mec* element right extremity sequences of MREJ type i, ii, iii and viii sequences (cf. pages 81 to 85, point 12.2 *et seq.*, of the respondent I's response to the statement of grounds of appeal).

20. In its communication, the board agreed with the decision of the opposition division and shared the respondent I's view on claim 7 of auxiliary request 4.

Moreover, the board further stated that a kit is understood as comprising a set of articles, things, elements, etc. The kit in the claims as granted comprises a first set of oligonucleotides (first primer) and a second oligonucleotide (second primer). In auxiliary request 4, the kit is defined as comprising only a set of primers comprising a first primer. In auxiliary request 4 the absence of a second oligonucleotide (second primer), regardless of the (structural and functional) properties of this (second) oligonucleotide/primer, changes the nature of the claimed kit.

21. In light thereof, the parties were informed that the board sees no reason to deviate from the finding of the opposition division that auxiliary request 4 contravenes Article 123(3) EPC.

22. As stated above, the provisional finding of the board has neither been subsequently commented on by the parties nor contested by the appellant. Under these circumstances, the board sees no reason to deviate from its provisional opinion.

Auxiliary requests 5 to 9
(*auxiliary request 3 to 7 at first instance*)

23. As stated by the opposition division in the decision under appeal, none of these auxiliary requests overcomes the objections raised under Articles 76(1), 123(2) EPC against the main request. Moreover, auxiliary requests 7 and 9 (auxiliary request 5 and 7 at first instance) have also the same deficiencies as auxiliary request 4 (auxiliary request 2 at first instance) and thus, contravene Article 123(3) EPC (cf.

pages 16 and 17, points 8 to 13 of the decision under appeal).

24. In its communication, the board informed the parties that, in view of the observations and comments made above as regards the main request and auxiliary requests 3 and 4, the board refrains from any further comments on auxiliary requests 5 to 9 and that there is no reason to deviate from the decision of the opposition division on these requests.

25. As stated above, the provisional finding of the board has neither been subsequently commented on by the parties nor contested by the appellant. Under these circumstances, the board sees no reason to deviate from its provisional opinion.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Vodz B. Stolz

Decision electronically authenticated