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Datasheet for the decision of 4 April 2023

Case Number: T 0235/20 - 3.3.08

Application Number: 14761444.0

Publication Number: 3030905

IPC: G01N33/569

Language of the proceedings: EN

Title of invention:
Botulinum toxin assay with improved sensitivity

Patent Proprietor:
Biomadison, Inc.

Opponent:
Merz Pharma GmbH & Co. KGaA

Headword:
Botulinum toxin assay/BIOMADISON

Relevant legal provisions:
EPC Art. 56, 107, 108
EPC R. 99(2)
RPBA 2020 Art. 13(2)

Keyword:
Inventive step - (no)
Amendment after summons - exceptional circumstances (no)
Opponent's appeal - admissibility of appeal (no)

Decisions cited:
J 0014/19, T 0009/81, T 1294/16, T 1598/18

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Case Number: T 0235/20 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 4 April 2023

Appellant I: (Patent Proprietor)	Biomadison, Inc. 1568 Luneta Drive Del Mar, CA 92014 (US)
Representative:	Pallini Gervasi, Diego Notarbartolo & Gervasi S.p.A. Viale Achille Papa, 30 20149 Milano (IT)
Appellant II: (Opponent)	Merz Pharma GmbH & Co. KGaA Eckenheimer Landstraße 100 60318 Frankfurt/Main (DE)
Representative:	Altmann Stößel Dick Patentanwälte PartG mbB Theodor-Heuss-Anlage 2 68165 Mannheim (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 29 November 2019 concerning maintenance of the European Patent No. 3030905 in amended form**

Composition of the Board:

Chairwoman	T. Sommerfeld
Members:	R. Morawetz
	M. Blasi

Summary of Facts and Submissions

I. European patent No. EP 3 030 905 ("the patent") is based on European patent application No. 14 761 444.0, which was filed as an international patent application published as WO 2015/021433 ("the application as filed"). The patent is entitled "Botulinum toxin assay with improved sensitivity".

II. One opposition to the granted patent was filed. The patent was opposed in its entirety under Article 100(a) EPC on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC), and under Article 100(b) EPC.

III. By way of an interlocutory decision, the opposition division decided that the patent in amended form on the basis of auxiliary request VI, and the invention to which it relates met the requirements of the EPC. The opposition division also held that the invention as defined in claims 1 and 9 of the main request (patent as granted), in claims 1 and 9 of auxiliary requests I and II, in claims 1 and 8 of auxiliary request III and in claim 1 of auxiliary request IV was not disclosed in a manner sufficiently clear and complete for it to be carried out (Article 100(b) EPC and Article 83 EPC) and that the subject-matter of claim 13 of auxiliary request V lacked an inventive step (Article 56 EPC).

IV. The patent proprietor (appellant I) and the opponent (appellant II) filed notice of appeal against the opposition division's decision and paid the required fee.

V. With its statement setting out the grounds of appeal, appellant I maintained the request to reject the opposition as its main request, re-submitted sets of claims of auxiliary requests I, II, III, IV and V and submitted claims of a new auxiliary request 1A. Except for auxiliary request 1A, the claim requests were identical to the corresponding claim requests considered in the decision under appeal. Appellant I submitted arguments, *inter alia*, to the effect that the independent claims directed to a kit, i.e. claim 14 of the main request and the corresponding claims of auxiliary requests I, 1A, II, III, IV and V, met the requirements of Article 56 EPC.

VI. In its statement setting out the grounds of appeal, appellant II submitted arguments to the effect that the claims of auxiliary request VI underlying the decision under appeal did not comply with the requirements of Articles 56 and 83 EPC.

VII. The board scheduled oral proceedings in accordance with the parties' requests and subsequently issued a communication under Article 15(1) RPBA, in which it indicated its preliminary opinion with respect to, *inter alia*, the construction of claim 14 of the main request, sufficiency of disclosure of the invention defined in claim 1 of the main request and auxiliary requests I, 1A, II, III and IV, inventive step in relation to claim 13 of auxiliary request V, and the admissibility of appellant II's appeal.

VIII. Oral proceedings before the board took place as scheduled. During the oral proceedings, appellant I withdrew the main request and auxiliary requests I, 1A, II, III and V, made auxiliary request IV, as filed with the statement of grounds of appeal, its main request,

submitted a set of claims of a new auxiliary request I and made auxiliary request VI, considered allowable in the decision under appeal, its auxiliary request II.

Claims 1, 9 and 14 of the main request, filed as auxiliary request IV with the statement of grounds of appeal, read as follows:

"1. A method of increasing the sensitivity of cell-based detection of a botulinum toxin/A (BoNT/A), comprising:
(i) providing a transfected cell that produces a construct comprising;
(a) a first terminus comprising a reporter-containing portion, wherein the reporter-containing portion exhibits a signal; and,
(b) a cleavage site that interacts with the botulinum toxin in a manner that produces a cleavage of the reporter-containing portion from a remainder of the construct;
(ii) exposing the transfected cell to the botulinum toxin at a toxin exposure temperature of from 38°C to 41°C, wherein sensitivity of the transfected cell's response to the Botulinum toxin at the toxin exposure temperature increases at least 2 fold compared to the transfected cell's sensitivity to the botulinum toxin at 37°C;
(iv) obtaining the signal from the reporter-containing portion.

9. A method of increasing the sensitivity of cell-based detection of a botulinum toxin/A (BoNT/A), comprising:
(i) providing, in a first media having a sodium concentration greater than 65 mM, a transfected cell that produces a construct comprising;
(a) a terminus comprising a reporter-containing

portion, wherein the reporter-containing portion exhibits a signal; and,
(b) a cleavage site that interacts with the botulinum toxin in a manner that produces a cleavage of the reporter-containing portion from a remainder of the construct;
(ii) transferring the transfected cell to a second media having a sodium concentration of less than 50 mM;
(iii) contacting the transfected cell with the botulinum toxin; and
(iv) obtaining the signal from the reporter-containing portion.

14. A kit for improving the sensitivity of a cell-based detection of botulinum toxin/A (BoNT/A), comprising; a first media comprising a botulinum toxin at a first non-zero concentration and sodium at a concentration of less than or equal to 50 mM; and a second media comprising a botulinum toxin at a second non-zero concentration and sodium at a concentration of less than or equal to 50 mM."

The set of claims of auxiliary request I, filed at the oral proceedings before the board, differs from that of the main request in that independent claim 14 and claim 15, which is dependent on claim 14, have been deleted.

Auxiliary request II is auxiliary request VI, considered allowable in the decision under appeal.

IX. At the end of the oral proceedings the Chairwoman announced the board's decision.

X. Appellant I's arguments, insofar as they are relevant to the decision, are summarised below.

Main request - claim 14

Inventive step

Document D18 represented the closest prior art. The claimed kit differed from the kit disclosed in document D18 on account of the sodium concentration of the first and second media.

The technical effect of the distinguishing feature was that, by applying the kit in a method for cell-based detection of botulinum neurotoxin, the sensitivity of the assay was enhanced. As explained throughout the application as filed, and in accordance with method claim 9, in a method for enhancing the sensitivity of cell-based detection of a botulinum neurotoxin, during implementation of the assay the transfected cell had to be transferred "*to a second media having a sodium concentration of less than 50mM*". Following this step, the transfected cell had to be contacted "*with the botulinum neurotoxin*" in this medium. By providing the medium required for the above-mentioned method step in form of a kit together with the required botulinum toxin to be detected, suitable conditions for enhancing the sensitivity of the cell-based assay were provided and assured by the kit according to claim 14. The kit was clearly suitable for carrying out the method according to claim 9. The application as filed demonstrated that the effect of the claimed sodium concentration appeared to be specific to sodium (see paragraph [0072] and Figure 11 of the application as filed).

The objective technical problem was to provide a kit for improving the sensitivity of cell-based detection of BoNT/A.

It was not obvious to use sodium at a concentration which was less than or equal to 50 mM. In document D18 the sodium concentration of the differentiation medium could be higher than 50 mM. Document D18 did not include any pointer which would have prompted the skilled person to provide a kit having two media with the specific sodium concentrations as claimed. Instead, document D18 referred to a specific impact of osmolality of the cell culture media. The choice of 50 mM was not arbitrary (see claim 9(ii) as granted [note by the board: corresponds to claim 9(ii) of the main request]).

Claim 14 complied with the requirements of Article 56 EPC.

Auxiliary request I

Admittance (Article 13(2) RPBA)

Addressing each and every objection raised by appellant II in the opposition proceedings would have required numerous auxiliary requests to be filed with the statement of grounds of appeal. The hope was that the board would not give a negative opinion on the claim directed to a kit. The claim request resolved the issue that the claim directed to a kit was not considered to comply with Article 56 EPC. Admitting auxiliary request I would have meant that no new matter would have needed to be addressed and no new discussion would have arisen.

XI. Appellant II's arguments, insofar as they are relevant to the decision, are summarised below.

Main request - claim 14

Inventive step

Document D18 represented the closest prior art. Paragraph [0059] disclosed a kit adapted for carrying out the method in document D18. The claimed subject-matter differed from the kit disclosed in D18 on account of the sodium concentration of the culture media.

Claim 14 did not refer to the method in claim 9 and the claimed kit was not suitable for the method in claim 9 either because it did not provide for a first medium having a sodium concentration greater than 65 mM and a second medium having a sodium concentration of less than 50 mM, let alone a transfer from a first medium having a sodium concentration greater than 65 mM to a second medium having a sodium concentration of less than 50 mM before contacting the transfected cell with the botulinum toxin. A technical effect was demonstrated in the patent only for BOCELL™ cells and not for any other cells (see paragraph [0053] and Figures 6 and 11 of the patent).

The objective technical problem to be solved was to provide a kit for the detection of BoNT/A.

The skilled person knew that sodium ions were present in cell culture media and the choice of a concentration of less than or equal to 50 mM was arbitrary.

The claimed solution was obvious to the skilled person and the subject-matter of claim 14 therefore lacked an inventive step.

Auxiliary request I

Admittance (Article 13(2) RPBA)

Auxiliary request I was submitted too late and was not to be admitted into the proceedings. There were no extraordinary circumstances. Lack of inventive step in relation to the claim directed to a kit had been an issue in the opposition proceedings. A set of claims based on auxiliary request IV before the opposition division, but without the claims directed to a kit, could and should have been filed as a fallback position earlier in the appeal proceedings, e.g. with the statement of grounds of appeal.

Admissibility of appellant II's appeal

It was correct that appellant II had stated at the oral proceedings before the opposition division that it had no objections under Article 83 and Article 56 EPC in relation to auxiliary request VI; however, in view of its request for the patent to be revoked *in toto* (see section I.2 of the decision under appeal and point 1.b) of the minutes of the oral proceedings before the opposition division), appellant II was adversely affected by the opposition division's decision pursuant to Article 107 EPC. At the oral proceedings before the opposition division, the parties' final requests had not been established before the decision was announced, as was usual in such oral proceedings.

Appellant II's request for reimbursement of the appeal fee

The opposition division's decision not to admit appellant II's submissions regarding BoNT/H constituted a violation of its right to be heard.

XII. Appellant I requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of claims of the main request, filed as auxiliary request IV with the statement of grounds of appeal, or on the basis of auxiliary request I, filed at the oral proceedings before the board, or alternatively, that appellant II's appeal be dismissed and that the patent be maintained as amended according to auxiliary request II, which is auxiliary request VI, considered allowable in the decision under appeal.

Appellant II requested that the decision under appeal be set aside, that the patent be revoked in its entirety and that the appeal fee be reimbursed because of a substantial procedural violation.

Reasons for the Decision

Main request - claim 14

Claim construction

1. Claim 14 is directed to a kit comprising a first and a second media, the kit being "*for improving the sensitivity of a cell-based detection of botulinum toxin/A (BoNT/A)*" (for the exact wording of the claim, see section VIII. above).

2. Claim 14 is drafted as a product claim. As a consequence, the statement of purpose merely implies that the kit has to be "suitable for" the stated purpose (see also the Case Law of the Boards of Appeal, 10th edition, 2022 ("CLBA"), I.C.8.1.5.), while achieving the stated purpose is not a functional technical feature of the claim.

3. In a product claim, the indication of the intended purpose is generally regarded as technically meaningful and hence limiting to the extent that characteristics that are not explicitly stated in the claim, but are recognised by the skilled person to be necessarily implied by the stated purpose, are to be taken into account in the construction of the claim (see also T 9/81, OJ EPO 1983, 372, Reasons 7).

4. From the indication that the kit has to be suitable for the "*cell-based detection of botulinum toxin/A (BoNT/A)*", the skilled person would derive that the botulinum toxin in the first and the second media is BoNT/A; however, since claim 14 does not refer to the method of claim 9 or to any other specific method to be used in the "*cell-based detection of botulinum toxin/A (BoNT/A)*", the intended purpose does not limit the claim with respect to the method or the cells to be used.

Inventive step

5. Claim 14 of the main request is identical to claim 13 of auxiliary request V underlying the decision under appeal. The opposition division held, with respect to the subject-matter of that claim, that the claimed kit did not solve the problem of improving the sensitivity of a cell-based detection of botulinum toxin/A (BoNT/A)

and that providing a kit for calibration purposes was obvious to the skilled person and hence was not inventive.

6. In the appeal proceedings, appellant I contested the opposition division's finding that the claimed kit did not solve the problem of improving the sensitivity of a cell-based detection of BoNT/A; however, it did not dispute the opposition division's finding that providing a kit for calibration purposes would have been obvious to the skilled person.

Closest prior art and technical problem to be solved

7. Document D18 concerns cellular test systems for the determination of the biological activities of neurotoxin polypeptides such as BoNTs and discloses methods for the generation of neurotoxin-sensitive, neuronal differentiated cells having an increased sensitivity to BoNT by reducing the osmolality of the differentiation medium (see paragraph [0015] of document D18). Document D18 furthermore discloses a kit adapted for carrying out these methods, the kit comprising cell culture media which contain sodium and BoNT/A in different concentrations (see paragraph [0059] and the example in document D18).

8. The parties were in agreement that the kit disclosed in document D18 represents the closest prior art and that the claimed subject-matter differs from this disclosure on account of the sodium concentration of the first and second media.

9. With respect to the technical effect(s) achieved by the distinguishing features, appellant I submitted that media containing sodium at a concentration of less than

or equal to 50 mM ensured that by applying the kit in a method for cell-based detection of BoNT/A, the sensitivity of the assay was enhanced.

10. For the reasons which follow, the board agrees with appellant II that, with respect to the sodium concentration of the first and second media of the kit in claim 14, appellant I cannot rely on any technical effect purportedly achieved by the method in claim 9 or demonstrated in the application as filed.

11. First, as regards the method of increasing the sensitivity of cell-based detection of BoNT/A disclosed in the application as filed and recited in claim 9 (for the exact wording of the claim, see section VIII. above), the board notes that, pursuant to this method, the transfected cell is provided in a first media having a sodium concentration greater than 65 mM (step (i)), is then transferred to a second media having a sodium concentration of less than 50mM (step (ii)) and only subsequently, in a further, separate step, is the transfected cell contacted with the botulinum toxin (step (iii)).

12. However, claim 14 does not refer to the method in claim 9 and the claimed kit is not particularly adapted for carrying out the method in claim 9, either. Indeed, the structural features recited in claim 14 in fact render the kit unsuitable for carrying out the method in claim 9. The first media provided in the kit in claim 14 contains sodium at a concentration of less than or equal to 50mM instead of greater than 65 mM, as required by step (i) of the method in claim 9. In addition, both media in claim 14 contain botulinum toxin, making them unsuitable for carrying out

steps (ii) and (iii) of the method in claim 9 as well.

13. Second, as regards the application as filed, it is disclosed that reduction of sodium concentration in the culture medium results in an increased sensitivity of cell-based assays for BoNT/A which is independent of osmolarity (see paragraph [0072] and Figure 11); however, the cell-based assays reported in the application as filed were all performed with one particular type of transfected cells, BOCELL™ cells (see paragraph [0065] and Figure 6A).

14. The claimed kit is not restricted with respect to the method or the cells to be used (see also point 4. above) and the application as filed provides no evidence that the sodium concentration effect observed with BOCELL™ cells in the context of one assay would be achieved under any other circumstances, i.e. is independent of the method and the transfected cells used for the cell-based detection of BoNT/A.

15. The board concludes from the above observations that neither the application as filed nor the method recited in claim 9 supports appellant I's submission that the sodium concentration of the claimed media provides suitable conditions that result in the technical effect of "improving the sensitivity of a cell-based detection of BoNT/A". The objective technical problem as formulated by appellant I, i.e. that of providing a kit for improving the sensitivity of cell-based detection of BoNT/A, therefore cannot be accepted.

16. Appellant I did not argue that any other technical effect would be attributable to media having a sodium concentration of less than or equal to 50 mM. As a result, the board concludes that the objective

technical problem to be solved can be formulated as that of providing an alternative kit for the cell-based detection of BoNT/A.

Obviousness of the claimed solution

17. Document D18 already provides a kit for the cell-based detection of BoNT/A which comprises cell culture media which contain sodium and BoNT/A in different concentrations (see point 7. above). The skilled person starting from the kit of document D18, faced with the technical problem identified above and without a requirement to achieve any specific technical effect, had at their disposal all known cell culture media, *inter alia*. Accordingly, kits comprising any one of these known cell culture media furthermore containing BoNT/A in different concentrations and which are consistent with the general teaching of document D18 were possible solutions available to the skilled person and were hence obvious. As the claimed kit is the result of an arbitrary choice from these equally obvious alternatives, it lacks an inventive step (see also CLBA, I.D.9.21.9 and the decisions cited in it).

18. Appellant I did not contest that cell culture media comprising sodium at a concentration of less than or equal to 50 mM were known to the skilled person; however, it submitted that document D18 provided no pointer to the use of cell culture media having a lower sodium concentration than the cell culture media used in document D18 and that the chosen sodium concentration of less than or equal to 50 mM was not arbitrary.

19. Appellant I's line of argument based on the absence of a pointer to media having the claimed sodium

concentration fails because the objective technical problem to be solved is that of providing a mere alternative and no pointer is required for the skilled person to select the claimed solution from all the available possible solutions in order to arrive at the claimed solution in accordance with the problem-solution approach.

20. Appellant I's additional line of argument regarding the choice of the sodium concentration not being arbitrary likewise fails because appellant I cannot rely on any technical effect purportedly achieved by the method in claim 9 (see points 10. to 15. above) and the absence of any technical effect associated with the chosen sodium concentration renders it arbitrary by definition.

21. In conclusion, the subject-matter of claim 14 of the main request does not meet the requirements of Article 56 EPC.

Auxiliary request I

Admittance (Article 13(2) RPBA)

22. Appellant I submitted auxiliary request I at the oral proceedings before the board, after the board had announced its negative conclusion regarding inventive step in relation to claim 14 of the main request. This claim request differed from the main request in that the claims directed to a kit had been deleted.

23. Under Article 12(3) RPBA, the statement of grounds of appeal and the reply must contain a party's complete appeal case. All claim requests filed with appellant I's statement of grounds of appeal included

claims directed to a kit (see section V. above). By submitting auxiliary request I, appellant I for the first time on appeal pursued a claim request that was restricted to method claims. Auxiliary request I therefore constituted an amendment to appellant I's appeal case within the meaning of Article 13 RPBA (see also J 14/19, Reasons 1.1 to 1.5). This was not disputed by appellant I.

24. According to Article 13(2) RPBA, any amendment to a party's appeal case after notification of a summons to oral proceedings is, in principle, not to be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.

25. When asked by the board for its justification for submitting auxiliary request I at this late stage in the appeal proceedings, appellant I submitted (i) that addressing each and every objection raised by appellant II in the opposition proceedings would have required numerous auxiliary requests to be filed with the statement of grounds of appeal, (ii) that it had hoped that the board would not give a negative opinion on the claims directed to a kit and (iii) that, by removing the claims directed to a kit, auxiliary request I overcame the inventive-step issue of the main request, with no new issues needing to be addressed and no new discussion arising.

26. For the reasons which follow, the board was not persuaded that any of these lines of argument were indicative of exceptional circumstances, justified with cogent reasons within the meaning of Article 13(2) RPBA, which would justify the admittance of auxiliary request I at this late stage in the appeal

proceedings.

27. The claims directed to a kit had already been held not to comply with Article 56 EPC in the decision under appeal in the context of what was then auxiliary request V (see point 5. above). In the board's view, submitting a claim request restricted to the method claims pursued with auxiliary request I only at the oral proceedings before the board was therefore too late because such a claim request could evidently have been submitted at an earlier stage in the appeal proceedings.

28. The fact that appellant II had raised several objections in the opposition proceedings has no bearing on this finding because appellant I's appeal is directed against the opposition division's decision. As regards inventive step, only the claim directed to the kit had been considered negatively by the opposition division. Accordingly, filing a limited number of auxiliary requests based on the auxiliary requests before the opposition division, but without the claims directed to a kit, would have been sufficient to address the findings in the impugned decision regarding inventive step.

29. Exceptional circumstances within the meaning of Article 13(2) RPBA have been acknowledged to exist provided the admittance of amendments to a party's appeal was not detrimental to the procedural economy of the appeal proceedings and did not adversely affect any other party (see e.g. T 1294/16, Reasons, points 18.1 to 18.3 and T 1598/18, Reasons, point 25.1). However, in the case at hand, pursuing a claim request restricted to method claims at this very advanced stage in the appeal proceedings did not simplify the

proceedings or enhance procedural economy either. Indeed, the set of claims of auxiliary request I was not *prima facie* allowable as sufficiency of disclosure of the invention defined in claim 1 of auxiliary request I had not yet been discussed and the board had given a negative preliminary opinion regarding this issue in its communication pursuant to Article 15(1) RPBA as well (see section VII. above).

30. The fact that the board was not persuaded by appellant I's arguments in favour of inventive step did not come as a surprise at the oral proceedings. Indeed, the board had given a negative preliminary opinion regarding inventive step in relation to a claim directed to a kit in its communication pursuant to Article 15(1) RPBA (see section VII. above). It was therefore foreseeable that the board was likely to find any claim request comprising a claim directed to the kit not to comply with Article 56 EPC.

31. Finally, these being *inter partes* proceedings, appellant II, which had requested that auxiliary request I not be admitted into the appeal proceedings, would have been adversely affected by the admittance and consideration of auxiliary request I.

32. The board therefore decided not to admit auxiliary request I into the appeal proceedings.

Admissibility of appellant II's appeal

33. Pursuant to Article 107, first sentence, EPC any party to proceedings adversely affected by a decision may appeal.

34. At issue in the case at hand was whether appellant II was adversely affected by the opposition division's decision, according to which the patent as amended in the form of auxiliary request VI (which is auxiliary request II in the appeal) complied with the requirements of the EPC.

35. According to the decision under appeal "[t]here were no objections from the opponent against the claims of Auxiliary Requests [sic] VI" (see decision under appeal, point 15.2) and the opposition division "also considers the claims of Auxiliary Requests [sic] VI to meet the requirements of the EPC" (ibid.; see point 15.3).

36. Furthermore, also according to the minutes of the oral proceedings before the opposition division, appellant II "did not have any objections to said request [auxiliary request VI]" (see minutes, point 22.).

37. Appellant II has not submitted a request for correction of the minutes of the oral proceedings or submitted at any point that the minutes did not correctly reflect the relevant statements made during the oral proceedings (Rule 124(1) EPC), and in addition appellant II has not, in its statement of grounds of appeal or at any stage thereafter, taken issue with the fact that, in the decision under appeal, the opposition division had not given any reasons as to why auxiliary request VI complied with the requirements of the EPC. To the contrary, during the oral proceedings before the board, appellant II confirmed that the minutes of the oral proceedings before the opposition division correctly reflected its statements made during the oral

proceedings.

38. For the reasons which follow, appellant II's submission that it was nevertheless adversely affected by the opposition division's decision because it had requested that the patent be revoked *in toto* in the opposition proceedings is not found to be persuasive.

39. It is apparent from the decision under appeal (see section I.2) and the minutes of oral proceedings (see point 1.b) that revoking the patent *in toto* represented appellant II's initial request made both in the notice of opposition and at the beginning of the oral proceedings. Appellant II's subsequent statement that it had "no objections" to the then auxiliary request VI made in the course of the oral proceedings before the opposition division can therefore only be understood to mean that it agreed to the patent being maintained in amended form on the basis of auxiliary request VI, implying that the initial request for the patent to be revoked *in toto* had been withdrawn and that appellant II's final position was that the patent should be upheld neither as granted nor in any version broader in scope than auxiliary request VI.

40. The fact that the opposition division did not establish the final requests of the parties at the end of the oral proceedings has no bearing on this conclusion. As acknowledged by appellant II, the final requests are usually not established at the end of the oral proceedings before the opposition division, and appellant II was aware of this. It would therefore have been up to appellant II to state any objections it had against auxiliary request VI when it was given the opportunity to do so by the opposition division.

41. In the board's view, appellant II therefore cannot be considered to be adversely affected within the meaning of Article 107 EPC by the opposition division's decision according to which the patent could be maintained in amended form according to auxiliary request VI, in respect of which appellant II had declared that it had no objections at the end of the opposition proceedings.

42. The board therefore held appellant II's appeal to be inadmissible.

Appellant II's request for reimbursement of the appeal fee

43. Pursuant to Rule 103(1)(a) EPC, the appeal fee will be reimbursed where the board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

44. One of the prerequisites for reimbursement of the appeal fee under Rule 103(1)(a) EPC is therefore that the board deems the appeal to be allowable. However, in the case at hand, the board has found appellant II's appeal to be inadmissible (see point 42. above). Consequently, the prerequisite that appellant II's appeal be deemed allowable cannot possibly be met.

45. For this reason alone, appellant II's request for reimbursement of the appeal fee must fail.

Auxiliary request II

46. Auxiliary request II is auxiliary request VI, considered allowable in the decision under appeal.

47. As a consequence of appellant II's appeal being inadmissible, appellant I (the patent proprietor) is the sole appellant against the opposition division's interlocutory decision, according to which the patent as amended in the form of auxiliary request VI (auxiliary request II on appeal) meets the requirements of the EPC.

48. In the proceedings before the boards of appeal the principle of the prohibition of reformatio in peius applies. Accordingly, in cases where the patent proprietor is the sole appellant against an interlocutory decision, neither the board nor the non-appealing opponent may challenge the opposition division's decision according to which the patent as amended meets the requirements of the EPC (see also CLBA, V.A.3.1.4).

49. The board or appellant II therefore cannot object to auxiliary request II.

Order

For these reasons it is decided that:

1. Appellant I's appeal is dismissed.

2. Appellant II's appeal is rejected as inadmissible.

The Registrar: The Chairwoman:

L. Malécot-Grob T. Sommerfeld

Decision electronically authenticated