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**Datasheet for the decision
of 14 November 2023**

Case Number: T 0556/21 - 3.3.02

Application Number: 15177779.4

Publication Number: 2959774

IPC: A01N1/02

Language of the proceedings: EN

Title of invention:

METHOD OF CRYOPRESERVING SPERM CELLS

Patent Proprietor:

Inguran, LLC

Opponent:

ABS Global, Inc.

Headword:

Relevant legal provisions:

EPC Art. 76(1), 111, 123(2)
RPBA 2020 Art. 11

Keyword:

Divisional application - added subject-matter
Amendments
Remittal

Decisions cited:

Catchword:



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Case Number: T 0556/21 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 14 November 2023

Appellant: Inguran, LLC
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 25 February
2021 revoking European patent No. 2959774
pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: S. Bertrand
B. Burm-Herregodts

Summary of Facts and Submissions

- I. The appeal by the patent proprietor ("appellant") lies from the opposition division's decision to revoke European patent No. 2 959 774.
- II. Claim 1 of the patent relates to a method of cryopreserving sorted sperm cells.
- III. In the impugned decision, the opposition division's conclusions included the following:
 - The subject-matter of the claims according to the main request did not involve an inventive step.
 - The claims of the sole auxiliary request did not meet the requirements of Article 123(2) EPC.
- IV. In the statement of grounds of appeal, the appellant contested the opposition division's reasoning. It submitted sets of claims according to auxiliary requests 1 and 2. The set of claims according to auxiliary request 1 was identical to that according to the auxiliary request filed before the opposition division.
- V. In the reply to the grounds of appeal, the opponent ("respondent") raised an objection to added matter in the claims according to the main request and auxiliary request 1, and to the admittance of auxiliary request 2.
- VI. The board summoned the parties to oral proceedings, as requested by the parties, and issued a communication under Article 15(1) RPBA 2020. In the communication, the board gave its preliminary view on the requirements

of Articles 76(1) and 123(2) EPC and informed the parties that objections under these articles could be discussed during oral proceedings.

VII. Oral proceedings before the board were held by videoconference on 14 November 2023.

VIII. The parties' requests, where relevant to the decision, were as follows:

The appellant requested in writing and at the beginning of the oral proceedings

- that the decision under appeal be set aside and that the opposition be rejected, or
- that, alternatively, the patent be maintained in amended form on the basis of one of the sets of claims of auxiliary requests 1 and 2 filed with the statement of grounds of appeal.

After the chairman had announced that the discussion of the main request would start with added matter, the appellant requested that the case be remitted to the opposition division for further prosecution with regard to added matter and sufficiency of disclosure.

The respondent requested:

- that the decision to revoke the patent be upheld and that the appeal be dismissed,
- that document A018 not be admitted into the proceedings,
- that auxiliary request 2 not be admitted into the proceedings, and

- should claim 1 of the main request be found to fulfil the requirements of Article 56 EPC, that the ground of opposition under Articles 100(b), 100(c), 76(1) and 123(2) EPC be considered in the appeal proceedings instead of remitting the case to the opposition division.

IX. The appellant's case and the respondent's case are summarised in the Reasons below.

Reasons for the Decision

1. Remittal - Article 11 RPBA 2020

1.1 The history of the case

The only ground for opposition which the opposition division addressed in its decision was lack of inventive step under Article 100(a) EPC.

In its reply to the grounds of appeal (point A on pages 2 to 4), the respondent addressed the ground for opposition under Article 100(c) EPC with regard to the claims as granted.

In its communication under Article 15(1) RPBA (point 12 and in particular 12.2), the board also addressed this ground for opposition and observed that added matter may be discussed during the oral proceedings.

During the written appeal proceedings the appellant had not requested any remittal of the case to the opposition division. The respondent had explicitly made a request against remittal of the case to the opposition division.

During the oral proceedings, when the board announced that it would start the discussion on substantive issues with added matter, the appellant requested that the case be remitted to the opposition division for further prosecution with regard to added matter and sufficiency of disclosure.

The board rejected this request.

- 1.2 Parties do not have a fundamental right to have their case examined at two levels of jurisdiction. Article 111(1), second sentence, EPC instead leaves it to the board's discretion to decide on an appeal either by exercising any power conferred on the department of first instance or by remitting the case to that department (Case Law, 10th edition, V.A.9.2.1).

According to Article 11 RPBA 2020, the board will not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

In the present case, however, special reasons were present for not remitting the case. More specifically, as set out above, since added-matter objections formed part of the appeal proceedings from the start (reply to the grounds of appeal) and in the absence of any request made during the written appeal proceedings to remit the case for discussion of added matter, the board dealt with this issue in detail in its communication and announced that this issue might be discussed during the oral proceedings. Both parties must thus have been prepared for such a discussion. In fact, the appellant did not state anything to the contrary during the oral proceedings.

Furthermore, as set out by the respondent during the oral proceedings, the opposed patent will expire in March 2024. Hence, the age of the patent also goes against remittal.

1.3 In view of the above, there are special reasons against remittal rather than in favour of it.

1.4 Under these circumstances, the board exercised its discretion under Article 111(1), second sentence, EPC not to remit the case to the opposition division and to decide on the respondent's objections raised under Article 100(c) EPC.

Main request

2. Articles 100 (c) and 76(1) EPC - claim 1

2.1 The patent was granted on the basis of a divisional application. The divisional application is derived from parent application EP 10 184 303.5.

Claim 1 of the main request reads as follows:

"1. A method of cryopreserving sorted sperm cells including the steps of:

forming a staining mixture comprising sperm cells, a buffer and a dye;

sorting the sperm cells according to X/Y chromosome content;

adjusting the concentration of the sorted sperm cells in a solution;

adding a cryoprotectant and a protein source to the sorted sperm cells in a solution;

loading the sorted sperm cells into a container;

cooling the sorted sperm cells to a holding temperature;

maintaining the sorted sperm cells at the holding temperature for a period;

cooling the sorted sperm cells to a temperature approaching a critical temperature zone, wherein the critical temperature zone is a zone at which ice crystal formation and changes in osmotic pressure would damage the sorted sperm cells;

cooling the sorted sperm cells through the critical temperature zone at a cooling rate that is faster than the cooling rate used to cool the sorted sperm cells from the holding temperature to the temperature approaching the critical temperature zone; and

immersing the sorted sperm cells in liquid nitrogen."

2.2 The respondent objected that the subject-matter of claim 1 of the main request extended beyond the content of the parent application.

2.3 The appellant submitted that claim 1 of the main request was based on the combination of the disclosures on page 27, lines 18 and 19, and page 126, lines 6 to 10 of the parent application as filed.

2.4 The passage on page 27, lines 18 and 19 reads:
"Generally, sperm cells may be stained by forming a staining mixture comprising sperm cells, a buffer, and a dye."

The passage on page 126, lines 6 to 10 reads: "For example, according to one embodiment of the present invention, a batch of sperm cells (e.g., an ejaculate)

is from a male mammal (e.g., bull), evaluated for quality control, stained, sorted according to a specified DNA characteristic, loaded into one or more containers (e.g., straws), and cryopreserved within a period of about 12 hours from the time of collection."

2.5 Even assuming (wrongly; see points 2.6 and 2.7 below) that the combination of the above two passages of the parent application as filed discloses all features of claim 1, this combination still does not form a proper basis for claim 1. More specifically, as submitted by the respondent, page 126, lines 6 to 10 of the parent application mentions a step of evaluating the batch of sperm cells for quality control and a "*period of about 12 hours from the time of collection*" for the cryopreservation step, none of which forms part of the method in claim 1 of the main request. Therefore, claim 1 represents an intermediate generalisation of the process disclosed in the passage on page 126, lines 6 to 10 of the parent application. Such an intermediate generalisation is allowable only in the absence of any clearly recognisable functional relationship between the features disclosed in the originally disclosed passage and omitted from the claim in question and the remaining features of this passage contained in the claim; however, the appellant did not put forward that any such functional relationship was absent, either in writing or during the oral proceedings.

2.6 Irrespective of the above, the combination of the two passages cannot provide a basis for the additional reason that two features of claim 1 are missing from these passages.

First, as submitted by the respondent, claim 1 of the main request comprises the step of adding a cryoprotectant and a protein source to the sorted sperm

cells in a solution. This step is not disclosed in the passages referred to by the appellant (2.4, *supra*). This was not contested by the appellant either in writing or during the oral proceedings.

Second, as also submitted by the respondent, claim 1 comprises the step of "*cooling the sorted sperm cells through the critical temperature zone at a cooling rate that is **faster** than the cooling rate used to cool the sorted sperm cells from the holding temperature to the temperature approaching the critical temperature zone*" (emphasis added). As not disputed by the appellant, this feature of faster cooling is not disclosed in either of the two passages cited above.

In fact, in this respect, the appellant referred to another passage as a basis, namely page 118, lines 21 to 35 of the parent application as filed. This passage reads as follows:

"Step 2515 involves **rapidly** cooling the cells through the critical temperature zone to limit the time sperm cells dwell [sic] therein. Thus, according to one embodiment of the present invention, the cooling rate through the critical temperature zone about [sic] (e.g., -18 to about -30°C) is selected to be **much faster** than the cooling rate used to cool sperm cells to the holding temperature and the cooling rate used to cool sperm cells to the temperature approaching the critical temperature zone" (emphasis added by the board).

However, it is not clear whether, and if so, how, this passage can be combined with the other two above-discussed passages of the parent application as filed. Even ignoring this, this additional passage cannot provide a basis for the step missing from the two other

passages of the parent application as filed. More specifically, in contrast to claim 1, which requires faster cooling, the cooling rate of the step of cooling the sperm cells through the critical temperature zone on page 118, lines 21 to 35 of the parent application is performed "**rapidly**" (line 21, "*rapidly cooling ...*") or is "*selected **much faster** than the cooling rate used to cool sperm cells to the holding temperature and the cooling rate used to cool sperm cells to the temperature approaching the critical temperature zone*" (lines 24 to 26, emphasis added). Therefore, the cooling rate through the critical temperature zone in claim 1 of the main request is not defined in the same way as it is on page 118, lines 21 to 35 of the parent application.

2.7 The appellant submitted that the term "faster" was similar to the term "much faster" and the cooling rates of cooling the sorted sperm cells through the critical temperature zone in claim 1 of the main request was thus based on page 118, lines 21 to 35 of the parent application.

The board does not agree. As submitted in writing by the respondent, the term "faster" in claim 1 of the main request only requires the cooling rate to be slightly increased, while the terms "rapidly" and "much faster" mean that the cooling rate must be significantly faster. Therefore the term "faster", used in claim 1 of the main request, does not have the same meaning as the terms "rapidly" and "much faster", used in the parent application.

2.8 In view of the above, the board concludes that claim 1 of the main request does not meet the requirements of Article 76(1) EPC.

3. Articles 100(c) and 123(2) EPC - claim 1

Since the passages cited by the appellant as a basis in the parent and divisional application are identical, the same conclusion applies with regard to the divisional application.

Claim 1 of the main request thus does not meet the requirements of Article 123(2) EPC.

4. Hence, the ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent as granted.

Auxiliary requests 1 and 2

5. Claim 1 of auxiliary request 1 corresponds to claim 1 of the main request except for the fact that it was specified that the step of sorting the sperm cells according to X/Y chromosome content is performed using a sheath fluid comprising a cryoprotectant.

6. Claim 1 of auxiliary request 2 corresponds to claim 1 of the main request except for the fact that the step of cooling the sorted sperm cells to a temperature approaching a critical temperature zone was specified in that the temperature approaching the critical temperature zone is -15°C, wherein the step of cooling the sorted sperm cells to the temperature approaching the critical temperature zone comprises cooling the sorted sperm cells from the holding temperature to the temperature approaching the critical temperature zone at a cooling rate in the range of 1.0-5.0°C/min.

7. Articles 76(1) and 123(2) EPC

During the oral proceedings, the chairman expressed the board's preliminary view that the conclusion given for

the main request applied to auxiliary requests 1 and 2. This was not contested by the appellant.

The board thus concludes that claim 1 of auxiliary requests 1 and 2 contains added matter under Articles 76(1) EPC and 123(2) EPC.

8. Admittance of auxiliary request 2

The respondent requested that auxiliary request 2 not be admitted into the proceedings; however, since the board concluded that claim 1 of this auxiliary request did not fulfil the requirements of Articles 76(1) EPC and 123(2) EPC, there was no need to address admittance in this regard.

9. None of the appellant's claim requests is allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

M. O. Müller

Decision electronically authenticated