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**Datasheet for the decision
of 17 March 2023**

Case Number: T 0042/22 - 3.3.04

Application Number: 15184520.3

Publication Number: 3002289

IPC: C07H19/06, C07H19/10,
C07H19/16, C07H19/20,
C07H21/00, C12Q1/68

Language of the proceedings: EN

Title of invention:

Modified nucleotides for polynucleotide sequencing

Patent Proprietor:

Illumina Cambridge Limited

Opponents:

Hoffmann Eitle
MGI Tech HONG KONG CO., LIMITED

Headword:

3'-azidomethyl nucleotides/ILLUMINA

Relevant legal provisions:

EPC Art. 76(1) sentence 2, 112
RPBA 2020 Art. 13(2)

Keyword:

Divisional application - subject-matter extends beyond content of earlier application (yes)

Auxiliary requests - Amendment after summons - exceptional circumstances (no)

Request to refer questions to the Enlarged Board of Appeal - rejected

Decisions cited:

T 0454/89, T 1018/02, T 1023/02, T 0056/04, T 1404/05,

T 1172/08, T 0197/10, T 2221/10, T 1896/11, T 1646/12,

T 0935/14, T 1127/16, T 1480/16, T 1569/17, T 0494/18,

T 2091/18

Catchword:



Beschwerdekammern

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Case Number: T 0042/22 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 17 March 2023

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
22 December 2021 concerning maintenance of the
European Patent No. 3002289 in amended form**

Composition of the Board:

Chairwoman M. Pregetter
Members: D. Luis Alves
 M. Blasi

Summary of Facts and Submissions

- I. Opponent 1 (appellant I) and opponent 2 (appellant II) filed appeals against the decision of the opposition division that, account being taken of the amendments in the form of the main request, European patent No. 3 002 289 and the invention to which it related met the requirements of the EPC. The patent, entitled "*Modified nucleotides for polynucleotide sequencing*", had been granted on European patent application No. 15 184 520.3, a divisional application of European patent application No. 12 180 077.5 ("parent application"), in turn a divisional application of European patent application No. 03 792 519.5, which was filed as an international application published as WO 2004/018497 ("grandparent application as filed").
- II. Originally, one party had filed an opposition. During the opposition proceedings, a notice of intervention was filed by a third party (opponent 2).
- III. The patent was opposed as a whole on the grounds under Article 100(a), (b) and (c) EPC.
- IV. In the decision under appeal, the opposition division held, *inter alia*, that the subject-matter of claims 1, 4, 5, 6, 8 and 9 of the main request did not extend beyond the content of the grandparent and parent applications as filed (Article 76(1) EPC).
- V. With the statement setting out the grounds of appeal, appellant I filed documents D72a and D87 to D91 and documents D82 to D86, which appellant II also filed.

- VI. With the statement setting out the grounds of appeal, appellant II filed documents D82 to D86.
- VII. With the reply to the statements setting out the grounds of appeal, the patent proprietor (respondent) filed sets of claims of a main request and auxiliary requests 1 to 3, all identical to the sets of claims of the corresponding auxiliary requests filed in opposition proceedings, and document D92.
- VIII. The board appointed oral proceedings as requested.
- IX. With the letter dated 16 December 2022, appellant I made further submissions and filed documents D93a and D93b.
- X. In a communication pursuant to Article 15(1) RPBA, the board informed the parties of its preliminary opinion that, *inter alia*, it did not concur with the opposition division on the interpretation of claim 1 and accordingly it considered that claim 1 related to subject-matter extending beyond the content of the parent and grand-parent applications as filed (Article 76(1) EPC).
- XI. With the letter dated 27 February 2023, the respondent submitted sets of claims of auxiliary requests I and II and questions to be referred to the Enlarged Board of Appeal.
- XII. With the letter dated 9 March 2023, appellant I made further submissions.
- XIII. The oral proceedings, attended by all parties to the appeal proceedings, took place as scheduled on 16 and 17 March 2023.

At the end of the oral proceedings, the Chair announced the board's decision.

XIV. The **main request** consists of nine claims, including independent claims 1, 4, 5 and 6. Claims 1 and 6 read:

"1. A modified nucleotide triphosphate molecule comprising a purine or pyrimidine base and a deoxyribose sugar moiety having a 3'-azidomethyl group."

"6. A method for determining the sequence of a target single-stranded polynucleotide, comprising monitoring the sequential incorporation of complementary nucleotides, wherein at least one incorporation is of a nucleotide comprising a purine or pyrimidine base and a deoxyribose sugar moiety having a 3'-azidomethyl group where the nucleotide has a base that is linked to a detectable label via a cleavable linker and wherein the identity of the nucleotide is determined by detecting the label linked to the base and the blocking group and label are removed prior to introduction of the next complementary nucleotide."

Claims 1 and 6 of **auxiliary request I** read as claims 1 and 6 of the main request, respectively, with "3'-azidomethyl" replaced by "3'-O-azidomethyl".

The set of claims of **auxiliary request II** corresponds to that of the main request where claims 1 to 5 were deleted and claims 6 to 9 were renumbered to claims 1 to 4, respectively.

XV. The following documents are referred to in this decision:

D11: WO 01/92284

D13: WO 91/06678

D14: US 5,547,839

D15: WO 00/53805

D54: Metzker, M.L. et al., Nucleic Acids Research
22(20), 1994, pages 4259-4267

D60: Extract from Pure and Applied Chemistry, 68(10),
Nomenclature of Carbohydrates, 1996, pages 1919-2008

D69: Declaration of Dr Floyd Romesberg dated
28 June 2021, 45 pages

D70: Secrist III, J.A., Current Protocols in Nucleic
acid Chemistry, Nucleoside and Nucleotide Nomenclature,
Appendix 1D, 2000, pages A.1D.1-A.1D.3

D71: WO 2018/129214

XVI. The appellants' arguments relevant to this decision may
be summarised as follows.

Main request

Claim construction - Claim 1

Claim 1 should be read at face value. Accordingly, the
term "3'-azidomethyl" meant an azidomethyl group
directly bound to the 3' carbon atom of the deoxyribose
(interpretation (1) of claim 1).

The term "3'-azidomethyl"

No reasons had been put forward why interpretation (1) did not reflect a reasonable interpretation of the term.

Two alternatives were encompassed by "deoxyribose having an 3'-azidomethyl group", depending on which hydroxyl group was absent: a 3'-deoxyribose having an azidomethyl group at its position 3' and a hydroxyl group at position 2' (formula I), and a 2'-deoxyribose having in its position 3' both an azidomethyl group and a hydroxyl group (formula II). Regardless of which alternative was considered, the meaning of "3'-azidomethyl" was clear, namely, an azidomethyl group bound directly to the 3' carbon. This followed from IUPAC nomenclature as well as from common general knowledge. Document D70 referred to three sources of nomenclature, with source (1) applying to the purine and pyrimidine rings, source (2) applying to the convention for numbering the positions on the sugar moiety (in the current case, 3' for the azidomethyl group) and source (3) applying to any other peer-reviewed nomenclature. However, there were no such peer-reviewed documents on file supporting that "3'-azidomethyl" was to be read as "3'-O-azidomethyl".

The argument that the azidomethyl group must be bound to the 3' oxygen because it was a removable blocking group did not apply to the compound defined in claim 1 since the claim did not mention any blocking or removable group.

Interpretation in light of the description

The term "3'-azidomethyl" was clear, as put forward above. The claim was clear and without any internal contradictions. The fact that two embodiments of the claimed nucleotide were encompassed by the claim did not amount to a lack of clarity. Instead, it merely represented two alternatives. In view of these considerations, there was no need to use the description to interpret claim 1.

Irrespective of different lines in the case law on the extent to which the description could be used to interpret the claims, it was established that when a claim was clear and technically reasonable the description should not be used to interpret it differently (see T 1791/16, Reasons 11; T 1127/16, Reasons 2.6.1 to 2.6.3; T 1473/19, Reasons 4.3 to 4.6 and T 169/20, Reasons 1.4).

Furthermore, the interpretation of claim 1 should not result in excluding subject-matter positively recited in the claim.

Interpretation in the context of claim 6

Independent claims, in particular when there was no reference between them, as was the case with current claims 1 and 6, did not have to be interpreted the same way. Interpreting claim 1 together with claim 6 could lead to different interpretations of claim 1 depending on whether claim 6 was present or not in the claim set. As an example, the interpretation of claim 1 could differ between the main request and requests which did not include claim 6, such as auxiliary requests 2 and 3 filed with the reply to the appeals.

It was contrary to legal certainty to interpret a claim differently throughout the lifetime of the patent depending on which other independent claims were present.

The passage in Case Law of the Boards of Appeal of the European Patent Office, 10th edn. 2022, page 341, last paragraph, cited by the respondent, summarised decision T 1646/12. However, the situation underlying this decision was factually different because the competent board had considered an independent claim with its dependent claims, in contrast to the current case in which two independent claims were being considered.

Additionally, claims 1 and 6 should be interpreted independently of each other because they belonged to different claim categories - product and process, respectively. The method did not necessarily use a product sharing all the features present in the product claim. In the current case, when compared to the product defined in claim 1, the product used in claim 6 had additional components such as a linker, a label and a blocking group.

In line with the Enlarged Board of Appeal's decision G 2/88, Reasons 5, a claim for a physical entity conferred absolute protection. Thus, the claim construction of a product claim should not be affected by process features of other claims.

It was an established principle that a claim should be given its broadest reasonable interpretation. It was incorrect to make a narrower interpretation by interpreting that there were product limitations

deriving from the suitability for use in the method of claim 6.

Even if claim 6 was taken into account, this would not lead to a different interpretation of claim 1.

Firstly, claim 6 referred to a compound comprising a label, a linker and a blocking group. All of these features were not present in claim 1, which defined a different compound. Secondly, the meaning of the term "3'-azidomethyl" as a group bound directly to the 3' carbon atom of the deoxyribose (as reflected in interpretation (1)) was compatible with the method of claim 6. Possible interpretations of claim 6 were that the blocking group was at position 2' or that it was bound via an oxygen atom at position 3', in which it coexisted with the azidomethyl group directly bound to the carbon atom. These interpretations were compatible with the interpretation of claim 1 and the wording of claim 6, which defined neither the position of the blocking group nor that the azidomethyl was the blocking group.

The assertion that this compound could not be incorporated by polymerase was not part of the common general knowledge. Moreover, this argument was contradicted by the disclosure of very large blocking groups in paragraph [0015] of the patent.

Even if the feature "blocking group" in claim 6 was regarded as unclear, this should not lead to a reinterpretation of the clear feature "3'-azidomethyl". The blocking group as defined in claim 6 must be removable and thus must be bound to an oxygen group. It was therefore not the azidomethyl group. If there was any lack of clarity arising from the lack of precedence

for the expression "the blocking group", this would not be resolved by reinterpreting the clear term "3'-azidomethyl".

Subject-matter extending beyond the earlier applications as filed (Article 76(1) EPC) - Claim 1

Basis in the earlier applications as filed for the feature "3'-azidomethyl" in claim 1

There was no basis in the grandparent and parent applications as filed for a nucleotide having the azidomethyl group directly bound to the 3' carbon atom, as claimed.

Admittance into the appeal proceedings of a line of argument presented for the first time at the oral proceedings - Basis in the earlier applications as filed for the feature "3'-azidomethyl" according to interpretation 1 of claim 1

The respondent's argument that a nucleotide according to interpretation (1) had a basis in the grandparent and parent applications as filed had not been brought forward in appeal before the oral proceedings. It constituted a change of case and was a surprising development.

Paragraph 3.13 of the respondent's reply to the appeals referred to a passage of the patent (paragraph [0140]) and related to claim interpretation. Hence, it was a different argument to that presented at the oral proceedings.

Article 13(2) RPBA required exceptional circumstances. However, none had been pointed out.

Auxiliary request I
Admittance into the appeal proceedings

This request was a response to issues raised in opposition proceedings in 2018. It could and should have been filed in opposition proceedings. Instead of submitting the auxiliary request in time the respondent had chosen not to reply by amendment but rather by argument.

Requests must be filed at the earliest point in time (see T 136/16).

The criteria under Article 13(1) RPBA applied in addition to those under Article 13(2) RPBA. Amendments to a party's case should *prima facie* not give rise to new objections. However, the request raised new issues under Article 123(3) EPC. In accordance with decision T 317/20, the request should improve procedural efficiency without changing the factual situation.

No exceptional circumstances had been presented as required by Article 13(2) RPBA. A preliminary opinion of the board in a communication pursuant to Article 15(1) RPBA did not constitute exceptional circumstances (T 1455/19).

A request for correction was to be filed without delay (G 1/12 and T 2058/18).

Auxiliary request II
Admittance into the appeal proceedings

The submission of this request represented an amendment to the respondent's case. The request was meant to

address objections under Article 76(1) EPC which had been raised in opposition proceedings. Hence, the request could and should have been filed earlier.

Furthermore, the request should not be admitted into the proceedings since it did not improve procedural economy without changing the factual situation. All previous claim requests included product claims meaning that this request changed the focus to different subject-matter. In the current case, method steps would need to be discussed which had not been the focus in the decision of the opposition division. In decisions T 317/20 (Reasons 36 and 37), T 2222/15 (Reasons 29), T 1569/17 (Reasons 4.34) and T 482/19, the boards did not admit requests in which claims had been deleted.

This request was not convergent with the main request and auxiliary request I.

The board should not admit the request because it did not solve the issue under Article 76(1) EPC since the method claim referred to 3'-azidomethyl.

No exceptional circumstances and no cogent reasons had been put forward, as required by Article 13(2) RPBA (see T 1455/19, Reasons 20 and T 3002/19, Reasons 8).

Objections to the method claim under Article 76(1) EPC had been presented in opposition proceedings and a general reference to the independent claims had been made in appellant II's statement of grounds of appeal (pages 2, 6 and 7).

Request to refer questions to the Enlarged Board of Appeal

The request for referral was conditional on the board adopting "an interpretation which is not consistent across the claims as a whole". Since this condition was not fulfilled, there was no request outstanding.

Moreover, the board should not refer the questions because they were not decisive for the current case.

Furthermore, it was not appropriate to refer questions on claim interpretation because this issue was case specific.

There was no conflicting case law on this issue. The board had discretion to decide on claim interpretation. In view of the request for acceleration of the appeal, the proceedings should not be delayed and therefore the board should not refer any questions.

As regards the wording of the questions, question 1 was too general, whereas question 3 was too specific.

- XVII. The respondent's arguments relevant to this decision may be summarised as follows.

Main request

Claim construction - Claim 1

Claim 1 was to be interpreted such that the term "3'-azidomethyl" meant "3'-O-azidomethyl" (interpretation (2) of claim 1), i.e. it was to be interpreted as referring to nucleotides having an azidomethyl group bound to an oxygen at position 3' of

the deoxyribose. This interpretation was consistent with the description of the invention and claim 6.

The term "3'-azidomethyl"

There was no requirement in the EPC to use IUPAC nomenclature. Claim 1 did not use IUPAC nomenclature to define the claimed compound, and therefore there was no need to interpret the term "3'-azidomethyl" using IUPAC rules. In fact, the (') prime notation in 3' was not IUPAC terminology. Therefore, the term was not necessarily to be read as azidomethyl directly bound to the carbon atom.

The prior art included documents referring to an oxygen-bound azidomethyl group without using the terminology 3'-O (see documents D11, D13 to D15, D54 and D71). Document D70 confirmed that, in the field of the invention, IUPAC terminology was not necessarily used.

Interpretation by the skilled person in the context of the invention

The case law was consistent in that claims are to be interpreted in the context of the invention (see T 2221/10). In the current case, the technical field of the invention was sequencing by synthesis (SBS), and the description stated that a removable blocking group was required and that 3'-O-azidomethyl was such a group. When the claim was read in context, the appellants' interpretation (interpretation (1)) was not reasonable.

It was also established case law that the claims are to be read by the skilled person. In the current case,

this was a team as defined in declaration D69, point 7. The skilled person in this case was focused on SBS. It was not relevant that claim 1 did not mention a blocking group because the claim was directed at the skilled person. Therefore, interpretation (2) was correct.

Decision T 1791/16, cited in support of the argument that all reasonable interpretations need to be considered, did not lead to a different interpretation because, for the skilled person, the only reasonable interpretation of claim 1 was interpretation (2). In accordance with decision T 1127/16, a feature should be interpreted in the context of all the features in a claim (see Reasons 2.6.3).

Furthermore, a technically sensible interpretation of the claim required that there be no incompatibilities or technical inconsistencies between terms in the claim (see decisions T 935/14 and T 1896/11).

Interpretation in light of the description

A claim should not be interpreted in contradiction with the invention in the description (see T 1603/13). However, the appellants' interpretation was in contradiction with the description of the invention. It was moreover speculative because it was not known whether such nucleotides would be incorporated by a polymerase.

The appellants identified multiple embodiments encompassed by claim 1. This showed that the claim was ambiguous. Specifically, the reference in claim 1 to "deoxyribose" and "3'-azidomethyl" gave rise to ambiguity as to whether the azidomethyl group was bound

to an oxygen atom. The skilled person would seek clarification as to whether a hydroxyl group was present at position 3' because the reference to deoxyribose implied on the one hand that a hydroxyl group was missing at position 2' and on the other that it was not absent at position 3' since in such a case the sugar would be designated "dideoxyribose" instead. In case of ambiguity, the description should be used to interpret the claim (see decisions T 2210/10, T 1023/02 and T 935/14).

Interpretation in the context of claim 6

In Article 69 EPC, the reference to the "claims" meant that it was the scope of the claims as a whole that was to be determined (see decision of the Enlarged Board of Appeal G 2/88). Also, Article 84 EPC required that the claims as a whole be clear. From this it could be derived that the claims were to be interpreted as a whole.

That claims should be interpreted as a whole was also confirmed in Case Law of the Boards of Appeal of the European Patent Office, 10th edn. 2022, page 341, last paragraph.

Conversely, if a term were to be interpreted differently in two claims, the claims as a whole would lack clarity.

Thus, claim 1 should be interpreted such that the term "3'-azidomethyl" be given the same meaning in claims 1 and 6.

There was no case law dealing with different interpretations of the same term in different claims.

Interpreting a given term the same way across both claims provided for legal certainty.

The fact that claim 6 did not refer back to claim 1 in accordance with Rule 43(2) EPC did not mean that the two claims should be interpreted independently. In fact, the requirements of clarity under Article 84 EPC prevailed over those under Rule 43(2) EPC.

Interpreting claim 1 in light of claim 6 was not in contradiction with decision G 2/88, Reasons 5, which related to a different issue, namely the possibility to change the claim category from a product to a use claim without extending the scope of protection.

When interpreted by the skilled person, there was no ambiguity that the blocking group in claim 6 was the 3'-azidomethyl group. Indeed, the claim referred to "the blocking group", implying that such a group was previously mentioned in the claim. Since 3'-azidomethyl was the only group mentioned in the claim, it was necessarily the blocking group. It was not compatible with the claim wording that the blocking group was a group other than azidomethyl.

The conclusion that in claim 6 the blocking group was the "3'-azidomethyl" in turn required the term to be interpreted as "3'-O-azidomethyl" since otherwise the group would not be removable.

The compound used in the method as defined in claim 6 had to be such that it could be incorporated by a polymerase. This was, however, not easy to predict (see document D54, column 2, referring to "*formidable obstacles*"). Therefore, the appellants' interpretation of claim 6, according to which a blocking group existed

in addition to or at a different position on the deoxyribose than the 3'-azidomethyl group, was not technically reasonable.

Additionally, the nucleotide according to the appellants' interpretation would not terminate synthesis because a hydroxyl group would still be present at position 3' of the deoxyribose (see declaration D59, paragraph 34). The only technically reasonable interpretation of the term "3'-azidomethyl" was thus "3'-O-azidomethyl".

Decision T 169/20 was not relevant because the issue at stake in the case at hand was not a limitation of the claim but rather its interpretation.

Subject-matter extending beyond the earlier applications as filed (Article 76(1) EPC) - Claim 1

Basis in the earlier applications as filed for the feature "3'-azidomethyl" in claim 1

The claim should be interpreted such that the term read "3'-O-azidomethyl"; for that subject-matter there was basis in the earlier applications. No additional arguments were present in this context.

Admittance into the appeal proceedings of a line of argument presented for the first time at the oral proceedings - Basis in the earlier applications as filed for the feature "3'-azidomethyl" according to interpretation 1 of claim 1

The argument had been put forward in opposition proceedings (letter dated 29 April 2019, page 8, fourth

paragraph) as well as in appeal proceedings (reply to the appeals, point 3.13).

The opposition division, in its preliminary opinion, had agreed with the patent proprietor's claim interpretation, so there had been no need to present the argument anew. A basis for azidomethyl directly bound to the 3' carbon had not been an issue raised previously in appeal meaning that the argument constituted a legitimate response to the board's preliminary opinion.

Auxiliary request I

Admittance into the appeal proceedings

The request was filed as early as possible in view of the possible impact that its filing could have had in litigation proceedings if filed earlier. There had been no reason to file it earlier because the opposition division's decision had supported the respondent's position.

The request did not constitute a change of case because it merely made explicit the claim interpretation that had been argued by the respondent all along. It could not be surprising for the appellants and it addressed the board's preliminary opinion.

The correction had to be considered in light of the application as a whole and was therefore allowable. No issues under Article 123(3) EPC arose because the amendment was merely a correction. Moreover, the claims as granted included as an embodiment the nucleotide having the 3'-O-azidomethyl group and, furthermore, Article 69 EPC was to be taken into account when

assessing the requirements of Article 123(3) EPC (T 131/15).

Auxiliary request II

Admittance into the appeal proceedings

The request did not constitute an amendment to the respondent's case. It included only method claims. These claims had always been present in the patent as granted, having merely been renumbered.

Moreover, since only the deletion of claims had been carried out, the board had no discretion to not admit the request (see T 1480/16).

The request streamlined the procedure because no objections under Article 76(1) EPC had been raised in appeal against the independent method claim. The only outstanding objection applying to this request was under Article 83 EPC.

The request had been filed only at this point in time in the proceedings because it was the first time a judicial authority had adopted the claim interpretation argued by the appellants.

Request to refer questions to the Enlarged Board of Appeal

Claim interpretation was an important point of law. If the board decided on an interpretation of the term "3'-azidomethyl" which was not consistent across the claims as a whole, the questions should be referred. There was no case law supporting that a term could be interpreted differently from one claim to another within the same set of claims.

XVIII. Appellants I and II requested that the decision of the opposition division be set aside and the patent be revoked. They further requested that auxiliary requests I and II not be admitted into the appeal proceedings.

XIX. The respondent requested that the appeals be dismissed and the patent be maintained in the form of the main request found allowable by the opposition division or, alternatively, that the patent be maintained in amended form on the basis of one of the sets of claims of auxiliary requests I and II, submitted on 27 February 2023. The respondent requested that, in case the board were to decide on an interpretation that was not consistent across the claims as a whole, the following questions be referred to the Enlarged Board of Appeal:

"1. Does Article 84 EPC require the language of a claim to be interpreted independently of the remaining claims?

2 Would the fact that the same term is used in another independent claim alter the position?

3. Are there nevertheless any instances when a term used in one claim should be interpreted differently from that of another claim which uses the same term?".

Reasons for the Decision

Main request - Claim 1

Claim construction

1. Claim 1 is a product claim directed to a modified nucleotide, i.e. to a chemical compound as such, which comprises the following components: (i) a purine or pyrimidine base, (ii) a deoxyribose sugar moiety having a 3'-azidomethyl group and (iii) triphosphate.

This appeal turns on the meaning and interpretation of the term "3'-azidomethyl" in claim 1. The opposition division held that the term was to be interpreted as "3'-O-azidomethyl". The appellants contested this interpretation.

2. A first point to consider is what the skilled person understood by the term "3'-azidomethyl" in the context of claim 1.
 - 2.1 Document D70, cited by the parties in this context, is concerned specifically with nucleoside and nucleotide nomenclature. It states: "*Nomenclature systems for the carbohydrate and nitrogen base moieties in nucleosides and nucleotides remain unchanged, except that primed numbers are used to refer to the carbohydrate atoms when the entire molecule is being considered*" (see first page, right-hand column, second paragraph, last sentence). As such, this passage of the document establishes that "3'" in the term "3'-azidomethyl" referred to the atoms on the carbohydrate, thus, to the carbon atom at position 3'.

- 2.2 Moreover, document D70 refers to IUPAC nomenclature recommendations in the context of nucleic acids and nucleosides, specifically in the context of the carbohydrate moiety, citing document D60 as a source of the most recent revision of the IUPAC recommendation, entitled "Nomenclature of Carbohydrates" (see document D70, page A.1D.2, left-hand column, second full paragraph and Table A.1D.1, first row). Document D60 states, on the nomenclature for substituents, that "*[s]ubstituents replacing the hydrogen atom of an alcoholic hydroxy group of a saccharide or saccharide derivative are denoted as O-substituents*" (see page 1965, under the heading "2-Carb-24. O-Substitution"; note by the board: "2-Carb" stands for the chapter on carbohydrates, which is the sole topic of document D60, and "24. O-Substitution" denotes the sub-chapter relevant in the current context). In contrast, the same document states that the symbol "C" is not necessary for a substituent directly on a carbon atom of the sugar: "*Note. C-Locants are essential only where there is potential ambiguity, to make clear whether substitution is at carbon or at a heteroatom [...]*" (see page 1956, line 4).
- 2.3 The board concludes that the symbol "3'" without any letter following the number denotes for the skilled person "3'-C", i.e. being directly bound to the carbon atom at position 3'. Hence, the board construes claim 1 as being directed to nucleotides having the azidomethyl group directly bound to the 3' carbon atom of the deoxyribose sugar moiety (in the following "interpretation (1)").
- 2.4 The board acknowledges that, as argued by the respondent, IUPAC nomenclature is not used in claim 1

to define every component of the claimed nucleotide compound. For example, the terms purine base, pyrimidine base and deoxyribose are not systematic IUPAC names. However, the board does not concur with the respondent that this would imply that IUPAC rules did not apply and that an alternative meaning of "3'-azidomethyl" was "3'-O-azidomethyl" (in the following "interpretation (2)").

2.4.1 The board notes that the terms purine base, pyrimidine base and deoxyribose are generic terms to denote a class of components of the nucleotide compound, whereas "3'-azidomethyl" is a term that defines a chemical group in complete detail.

2.4.2 While the generic terms "purine" and "pyrimidine" seem to be accepted alternatives to the use of IUPAC nomenclature since they are used throughout document D70, for completely defined chemical groups no alternative to IUPAC nomenclature is offered in this document.

2.4.3 Document D70 confirms that the nomenclature in the field of nucleotides did not necessarily follow IUPAC rules and instead made use of a number of evolving sources of nomenclature:

"Current nomenclature in the area of nucleosides, nucleotides, and nucleic acids comprises a mixture of (1) common names that have gained official recognition, (2) guidelines that have been derived and officially recommended by the International Union of Pure and Applied Chemistry (IUPAC)/International Union of Biochemistry and Molecular Biology (IUBMB), and (3) evolving usage that is derived by individual scientists and laboratories and subjected to peer

review through publication." (see document D70, first page, left-hand column, last paragraph).

2.4.4 However, as regards which source of nomenclature applied specifically to completely defined chemical groups (in the current case, azidomethyl) and their position on the sugar moiety of nucleosides or nucleotides, it has not been argued that source (1) applied, out of the three sources listed in the document. In other words, it has not been argued that "3'-azidomethyl" is a common name having gained official recognition for designating "3'-O-azidomethyl".

2.4.5 On the other hand, the evidence on file did not convince the board that source (3) applied. While the respondent argued that documents D11, D13 to D15, D54 and D71 each showed a "3' removable group" without any reference to the oxygen at the 3' position, the board does not find this argument convincing for the reasons that follow.

Document D71 is a patent document published after the date of filing of the patent in suit. It can therefore not be used to establish what belonged to the common general knowledge at the relevant date.

As regards the documents D11, D13 to D15 and D54, the respondent cited the following passages:

"Synthesis of a Nucleotide with an Enzyme (Penicillin Amidase) Cleavable Blocking Group at the 3'-Position".
(document D11, page 27, lines 6 to 7)

"Blocking groups and Methods for Incorporation" and
"the criteria for the successful use of 3'-blocking

groups include" (document D13, page 20, heading and sentences following it) and
"[a]fter successfully incorporating a 3'-blocked nucleotide into the DNA chain, the sequencing scheme requires the blocking group to be removed to yield a viable 3'-OH site for continued chain synthesis" (document D13, page 23) and Figure 2 (document D13)

"(b) The fluorophore is placed in a position other than the 3'OH of the nucleoside, and a different group placed on the 3'OH of the dNTPs to function as a chain terminator. The fluorophore and the 3' blocking group are removed by the same treatment in a single step (preferably), or they may be removed in separate steps." (document D14, column 25, lines 35 to 40)

"The differentially-labeled nucleotides used in the sequencing methods of the present invention have a detachable labeling group and are blocked at the 3' portion with a detachable blocking group."

(document D15, page 4, lines 1 to 3) and

"Panel B depicts an alternative configuration in which the fluorochrome is attached to the base of the nucleotide by way of a photolabile linker. The 3'-OH is blocked by a separate photolabile group."

(document D15, page 14)

"providing four different nucleotides, each nucleotide being differentially-labeled with a detachable labeling group and blocked at the 3' portion with a detachable blocking group, wherein the polymerase extends the primer hybridized to the nucleic acid sample with the differentially-labeled nucleotide that is complementary to the sample nucleic acid" (document D15, page 34, claim 1c) and

"The method of claim 5, wherein the detachable 3' blocking group is a 2-Nitrobenzyl group" (document D15, page 35, claim 6)

"In general, the 3'-modified nucleoside (1.0 equiv.) was dissolved in trimethylphosphate under nitrogen atmosphere" (page 4261, column 2 of document D54) and *"Desilylations were performed by the addition of 1.0 equiv. of tetrabutylammonium fluoride (Bu₄NF) to the 3'-protected-5'-silyl-adenosine or thymidine derivatives"* (document D54, page 4260, column 2)

In the board's view, it is immediately apparent from the passages above that in each passage the substituent in question was provided with context, such that the meaning "3'-O" was clear even when the symbol representing the oxygen atom was omitted. This applies to each of the documents as follows.

In document D11, the quoted text refers to a "cleavable blocking group". The passages quoted from document D13 refer to "blocking groups" and "a blocking group to be removed", and those from document D15 refer to each nucleotide being "blocked at the 3' position with a detachable blocking group" and state that "the 3'-OH is blocked". Such features are not present in claim 1 at hand. The passage quoted from document D14 refers to an OH group. In document D54, the quoted passages refer to a "3'-modified nucleoside" and to "3'-protected" derivatives. However, in this document, these general designations represent abbreviated ways of referring to a group of compounds differing only in the substituent at position 3', with the specific compounds being fully identified elsewhere in the text by the standard nomenclature using "3'-O" (see document D54, Figure 2 and the names of the compounds in the headings on

page 4260, right-hand column, second paragraph to page 4261, left-hand column, last paragraph).

- 2.4.6 Therefore, the respondent's argument that interpretation (2) constitutes an alternative understanding of claim 1 finds support neither in document D70 nor in any of documents D11, D13 to D15, D54 and D71.

In conclusion, the respondent has not convinced the board that interpretation (2) is based on a reading of the term "3'-azidomethyl" that was recognised in the technical field.

- 2.5 The parties were in disagreement as to whether the (') prime notation in the term "3'-azidomethyl" constitutes IUPAC nomenclature. However, the reading of the term resulting in interpretation (1) does not depend on this issue because there is no evidence on file of any rules resulting in the alternative reading put forward by the respondent. There is no evidence that this term should be read differently or specifically that instead of "3'-azidomethyl" it should be read as "3-O-azidomethyl", for the reasons set out in the preceding points.

- 2.6 The parties were further in disagreement as to whether the term "deoxyribose" in claim 1 refers to a 2'-deoxyribose or a 3'-deoxyribose. The board, in its communication pursuant to Article 15(1) RPBA, expressed its preliminary opinion that it interprets the term to mean 2'-deoxyribose, in agreement with the respondent's interpretation. In view of the board's conclusion on the interpretation of claim 1, there is, however, no need to give reasons on this point.

- 2.7 The respondent argued that when read by the skilled person in the context of the technical field of the invention, the term should be given interpretation (2). The technical field of the invention was sequencing by synthesis (SBS), and this implied that for the skilled person the nucleotide necessarily included a removable blocking group.
- 2.7.1 In the board's view, this argument amounts in practice to arguing that the claim is necessarily to be interpreted in light of the description and the claims as a whole. The board addresses both arguments below, under points 3. and 4., respectively.
- 2.7.2 This notwithstanding, the board does not agree that the definitions of the skilled person and technical field put forward by the respondent lead to the conclusion that a nucleotide must have any of the features that the respondent reads into claim 1, such as the presence of a blocking group that is removable. The claim is directed to a nucleotide and is not limited by any use. In other words, irrespective of the definition of the skilled person, there is no reason for reading into claim 1 the features "blocking group" and "removable group".
- 2.7.3 This conclusion does not stand in contradiction to decision T 935/14. The competent board in that decision considered that claim 1 was not clear because it was not possible to arrive at a technically sensible interpretation of the claim since it contained features that were technically inconsistent with each other (Reasons 10 and 10.1). Also, in decision T 1896/11, the competent board referred to the absence of incompatibility between the features of a claim as a requirement for a technically meaningful and plausible

reading of a feature in the claim. However, in the current case, no technical inconsistencies have been identified in interpretation (1) of claim 1.

2.7.4 The respondent additionally referred to decision T 2221/10 in support of the argument that the features of a claim need to be interpreted in context. The competent board in that decision concluded that the term "human embryonic stem cells" found in the claims had a clear meaning to the skilled person. Given this, the description could not be used to interpret the term in a different way (see Reasons 33 and 34, second paragraph). Hence, this decision does not support the respondent's case.

3. A second point to be addressed in this decision is whether the term "3'-azidomethyl" in claim 1 is to be interpreted in light of the description.

3.1 In a number of decisions, the boards held that claims are to be interpreted based solely on their wording without any knowledge from the description (see, e.g. T 454/89, Reasons 4.1 (vii) and T 1404/05, Reasons 3.6). In a number of further decisions, the boards held that the description and drawings may to some extent be used to interpret the claims and that this may even sometimes be necessary, the extent depending on whether the claims read on their own are ambiguous or lack clarity (see e.g. T 1646/12, Reasons 2.1, last paragraph and T 56/04, Catchword 1). It is, however, consistent in the case law of the boards that where a claim is clear and allows a technically sensible interpretation, there is no need to use the description to interpret it (see decisions T 1018/02, Reasons 3.8; T 1172/08, Reasons 14 and T 197/10, Reasons 2.2 and 2.3).

- 3.2 In the case at hand, the board holds that claim 1 is clear for the reasons set out above (see points 2.3 and 2.7.3). No technical inconsistencies between the terms in the claim have been identified. Interpretation (1) is moreover technically sensible because it corresponds to a chemical compound having in position 3' of the deoxyribose both an azidomethyl and an hydroxyl group. It has not been argued that this compound is not a technically sensible interpretation in the sense that it cannot be prepared. While the respondent did argue that only interpretation (2) is technically reasonable, this argument relied on the point of view that the claims and description should not be in contradiction. However, in the board's judgement, the meaning of a term in a claim which is clear cannot vary depending on how well the claim is aligned with the description. Also, in decisions T 1127/16 and T 1896/11, the competent board in each case considered claim wording which imparted a clear and credible technical teaching when interpreted on its own, although this teaching did not correspond to the invention in the description. The board in each case held that the description could not be used to give a different meaning to the claim (see T 1127/16, Reasons 2.3. and T 1896/11, Reasons 2.2.5).
- 3.3 In this context, the respondent referred to decisions T 1603/13 and T 1023/02 for ruling out claim interpretations in contradiction with the invention as disclosed in the description.
- 3.3.1 In case T 1603/13, the competent board considered whether the application provided sufficient disclosure of the claimed invention and concluded that this was not the case because the claims could not be

interpreted in the manner put forward by the patent proprietor since it contradicted the invention as disclosed in the description (see Reasons 2.6). However, it cannot from this decision be inferred that a claim interpretation compatible with the invention as defined in the description can be adopted disregarding the claim wording. Hence, the board concludes that this decision does not support the respondent's case.

3.3.2 The competent board in case T 1023/02 held that a given term in the claim should be interpreted according to the teaching in the description. The board in the current case does not follow this decision and follows instead the line of decisions cited in points 3.1 and 3.2 above.

3.4 In light of the above, the board concludes that there is no reason to use the description to interpret claim 1. In a case such as this one, where the claim and the description relate to different compounds, a technically reasonable interpretation based on the literal wording of the claim should not be discarded and replaced by a different interpretation finding a basis solely in the description.

3.5 The respondent further argued that claim 1 could be seen as ambiguous, referring to the alternative readings "2'-deoxyribose" and "3'-deoxyribose" put forward by the appellants. These readings of "deoxyribose" were a source of ambiguity because the reading "2'-deoxyribose" implied the presence of a hydroxyl group at position 3', otherwise the claim should have read "dideoxyribose". However, in the appellants' interpretation of "3'-azidomethyl", no oxygen was present at the 3' position.

- 3.6 This argument is moot in view of formulas I and II provided with appellant II's statement of grounds of appeal (see page 3) for illustrating what in its view were the two alternatives encompassed by claim 1 for the deoxyribose component of claim 1, namely a 2'-deoxyribose and a 3'-deoxyribose. Formula II depicts a nucleotide with a 2'-deoxyribose, and an azidomethyl as well as a hydroxyl group, directly bound to the 3' carbon. Hence, formula II shows that interpretation (1) of the term "3'-azidomethyl" does not require the sugar moiety to be a dideoxyribose and that there is no ambiguity in this regard.
- 3.7 According to the respondent, also the fact that multiple readings of claim 1 were possible demonstrated a possible ambiguity.
- 3.8 The board considers, however, that a distinction should be made between a claim that encompasses multiple embodiments and one that is ambiguous. An example of the first situation is a definition by a Markush formula. Such a definition is not necessarily ambiguous merely because it encompasses more than one embodiment. In the current case, the board considers that the skilled person can identify which embodiments are encompassed by the claim, and there is therefore no ambiguity that could justify a need to rely on the description for claim interpretation.
4. A last point to be addressed is whether claim 1 is to be interpreted in the context of claim 6 and whether doing so would change the claim interpretation above, i.e. interpretation (1).
- 4.1 The opposition division held that claims 1 and 6 should be interpreted together and that the only technically

sensible reading of claim 6 was that the removable blocking group was the 3'-azidomethyl group.

4.2 The board disagrees that an independent product claim, as is the case of claim 1 at hand, is to be interpreted taking into account a method claim, as is the case of claim 6 at hand. Moreover, there is no reference between claims 1 and 6 in the current case.

4.3 In the board's view, the interpretation of product claim 1 cannot be dependent on whether or not method claim 6 is present in the claim set. Instead, each claim should be interpreted independently. Contrary to the respondent, the board does not find in Article 84 EPC support for the contention that all claims need to be interpreted together.

4.4 In this context, the respondent cited a passage of Case Law of the Boards of Appeal of the European Patent Office, 10th edn. 2022, page 341, last paragraph, which reads:

"It was nevertheless a general principle that a term could be interpreted only in context. Terms in a claim therefore had to be interpreted in the overall context of the claims set and the description (see also T 1817/14)."

4.4.1 This passage refers to decision T 1646/12. Decision T 1817/14, also cited in this passage, addresses aspects other than interpretation in light of the claims as a whole.

4.4.2 In the board's view, decision T 1646/12 is not relevant to the case at issue because it does not address the situation of two independent claims directed to a product and a method.

- 4.5 The respondent argued that irrespective of whether the claims were read together, the same term should not be given different meanings across the claims. Reading the term in the context of claim 6 would lead to interpretation (2).
- 4.5.1 The board finds that interpretation (1) of claim 1 is not incompatible with the method defined in claim 6. The board concurs with the appellants that claim 6 allows the following interpretation: the nucleotide used in the method includes a blocking group bound to the oxygen on the 3' position of the deoxyribose, in addition to the azidomethyl group directly bound to the 3' carbon atom of the deoxyribose.
- 4.5.2 Hence, the technical considerations which according to the respondent showed that interpretation (1) was incompatible with the method defined in claim 6 do not apply, as follows. The requirement for a blocking group, which when present leads to termination of synthesis, is fulfilled by the blocking group bound to the oxygen at position 3'. While it was alleged that such a nucleotide might not be incorporated by polymerase, no evidence of this being part of the common general knowledge has been presented to the board.
- 4.5.3 The board acknowledges that the expression "the blocking group" in claim 6 lacks precedence and leaves undefined the blocking group. The respondent argued that in absence of a definition, only the "3'-azidomethyl group" could be meant. The board instead finds convincing the argument that for the skilled person "3'-azidomethyl" could not be the (removable) blocking group because it was directly

bound to the carbon atom. The board concludes that the appellants provided a technically sensible interpretation of claim 6 which was also compatible with interpretation (1) of claim 1. In line with the case law of the boards, a technically sensible interpretation cannot be disregarded even if additional interpretations are possible. As such, it is not relevant for the current case which additional interpretations may follow from interpreting claim 6.

4.5.4 In light of the above, the term "3'-azidomethyl" may be interpreted in the same way (see point 2.3 above) in claim 1 and claim 6.

4.5.5 In conclusion, even if claims 1 and 6 were to be read together, contrary to what the board set out in points 4.2 to 4.3 above, this would not result in interpretation (2).

Subject-matter extending beyond the content of the earlier applications as filed - Article 76(1) EPC

5. The appellants' case was that claim 1 was directed to nucleotides having an azidomethyl group directly bound to the 3' carbon of the deoxyribose (interpretation (1)) and that such a compound was not disclosed in the parent and grandparent applications as filed. The respondent's case was that claim 1 is directed to nucleotides having an azidomethyl group bound via an oxygen to the 3' carbon of the deoxyribose (interpretation (2)); no submissions other than those made at the oral proceedings, which were however not admitted by the board (see points 7. to 13. below), have been presented by the respondent as regards the question where basis could be found in the earlier applications as filed, for the case that

interpretation (1) was followed. Thus, the decision under appeal on Article 76(1) EPC hinged solely on the interpretation of claim 1.

6. For the reasons set out above (see points 2., 3. and 4.), the board came to the conclusion that claim 1 should be given interpretation (1). In the absence of any further submissions presented by the respondent on appeal as regards the basis for the claimed subject-matter in the grandparent and parent applications as filed, the board concludes that the claim relates to subject-matter extending beyond the content of the earlier applications as filed (Article 76(1) EPC).

Admittance into the appeal proceedings of a line of argument presented for the first time at the oral proceedings - Basis in the earlier applications as filed for the feature "3'-azidomethyl" according to interpretation 1 of claim 1

7. At the oral proceedings, the respondent argued that the subject-matter of claim 1 according to the board's interpretation (interpretation (1), see point 2.3 above) was disclosed in the grandparent application as filed on page 84, line 23 and the corresponding passage of the parent application.
8. Up until the oral proceedings, the respondent had not indicated any passage of the parent and grandparent applications as filed for providing a basis for this subject-matter. Instead, the respondent had argued that the claim should be interpreted according to interpretation (2) and that this subject-matter was disclosed in the parent and grandparent applications as filed.

9. The respondent argued that there was no change of case because the passages in question of the parent and grandparent applications had been pointed out in opposition proceedings as well as with the reply to the appeals.

10. The board does not find this argument persuasive for the following reasons.

10.1 Pursuant to Article 12(3) RPBA, the reply to the appeal must contain a respondent's complete appeal case. As such, submissions made in opposition proceedings to which the respondent did not make specific reference are not part of the respondent's appeal case.

10.2 As regards the submissions in appeal proceedings, the respondent referred to point 3.13 of the reply to the appeals. The passage in question appears under the heading "*Interpretation of 'deoxyribose sugar moiety having a 3'-azidomethyl group'*" and reads as follows:

"3.13 Therefore, and as the OD have correctly stated in their Decision, the Appellants' approach to claim construction 'would constitute a reductio ad absurdum of the principles' of the established case law of the Boards of Appeal (paragraph 31 of the Decision). The skilled person would consult the specification, which consistently refers to the deoxyribose compounds having an oxygen bridging the 3' carbon and the azidomethyl group. Moreover, the specification expressly uses the term '3'-azidomethyl' when referring to an azidomethyl group attached to the 3' carbon of a deoxyribose via the 3' oxygen. For example, under the heading 'Enzyme Incorporation of 3'-Azidomethyl dNTPs', paragraph [0140] describes incorporation of the dNTPs by adding 'compound 6' and polymerase to a DNA primer/template.

Compound 6, disclosed on page 16, has an azidomethyl bonded to the 3' oxygen of the nucleotide's deoxyribose: [Formula]"

10.3 Firstly, the passage refers to paragraph [0140] of the patent specification and thus is not related to a basis for the claimed subject-matter in the earlier applications as filed.

10.4 Secondly, the passage relates to claim interpretation in light of the description and contains the argument that the description discloses at multiple instances an azidomethyl group bound to the deoxyribose via an oxygen atom and thus discloses interpretation (2) as put forward by the respondent. This is in line with the conclusion one paragraph further down in the same letter: *"These disclosures in the specification would further reassure the skilled person that the claim language refers to a compound having an oxygen bridging the 3' carbon atom and the azidomethyl group"* (see paragraph 3.14, last sentence). In the board's view, it cannot be inferred from these passages that the respondent was pointing to disclosure of an azidomethyl group directly bound to the carbon atom of the deoxyribose. The board can therefore not agree with the respondent's contention that the defence made at the oral proceedings had already been presented with the reply to the appeals. The defence presented for the first time at the oral proceedings thus constituted an amendment of the respondent's appeal case within the meaning of Article 13(2) RPBA.

11. In the case at hand the amendment of the respondent's case cannot be justified as being a reaction to the board's preliminary opinion set out in the communication pursuant to Article 15(1) RPBA. Therein,

the board had endorsed the interpretation of claim 1 put forward in the appellants' statements of grounds of appeal. The board's communication cannot, therefore, justify the respondent's defence first made at the oral proceedings.

12. The respondent's argument that it could not have reacted earlier because the arguments in the statement of grounds of appeal did not relate to Article 76(1) EPC and instead related to claim interpretation is not persuasive either. Indeed, the statements of grounds of appeal included objections under Article 76(1) EPC which were precisely based on the claim interpretation adopted by the board, i.e. interpretation (1) above (see e.g. appellant I's statement of grounds of appeal, heading to points 2 and 2.1. and paragraphs 11 to 13; appellant II's statement of grounds of appeal, second heading on page 2 and paragraph bridging pages 1 and 2). Also the argument brought forward by the respondent that there had been no need on the respondent's part to react at an earlier stage because the opposition division had decided in the respondent's favour is not convincing. Pursuant to Article 12(3) RPBA, the presentation of a party's complete appeal case must include the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and all requests, facts, objections, arguments and evidence relied on should be specified. Moreover, no reasons were presented why this defence was presented only at the oral proceedings before the board.

13. In the absence of exceptional circumstances justified by cogent reasons, the board decided to not admit the line of argument into the appeal proceedings (Article 13(2) RPBA).

Auxiliary request I

Admittance into the appeal proceedings

14. This request was submitted after the communication informing the parties of the board's preliminary opinion pursuant to Article 15(1) RPBA.
15. The request incorporates a correction requested by the respondent pursuant to Rule 139 EPC. Accordingly, claim 1 is directed to nucleotides comprising a 3'-O-azidomethyl group.
16. According to the respondent, this request merely reflected what had been argued all along in the appeal proceedings.
17. The board considers the requested correction made under Rule 139 EPC and the submission of the accordingly modified claim wording to be an amendment to the respondent's appeal case, which previously had been to argue on the interpretation of claim 1. Thus, the requirements of Article 13(2) RPBA apply.
18. No exceptional circumstances have been put forward by the respondent, nor were such evident to the board. The respondent's statement that the request had been filed as early as possible in light of national proceedings does not amount to exceptional circumstances and does not present cogent reasons. That the board gave its opinion on claim interpretation, thereby agreeing with the appellants' position expressed in their statements of grounds of appeal, is likewise no justification for withholding this request until after the board expressed an opinion, irrespective of whether or not the other parties were surprised by this request.

Admitting this request into the proceedings would also have required consideration of completely new issues for the first time at an advanced stage of the appeal proceedings, as pointed out by the appellants.

19. In view of the foregoing, the board decided to not admit the request into the appeal proceedings (Article 13(2) RPBA).

Auxiliary request II

Admittance into the appeal proceedings

20. This request was also filed after the communication informing the parties of the board's preliminary opinion pursuant to Article 15(1) RPBA.
21. It differs from the main request filed with the reply to the appeals solely by the deletion of the product claims and the renumbering of the remaining claims.
22. In decision T 1480/16, the competent board held that deleting the independent method claim did not represent an amendment of the party's case because it did not change the legal and factual framework of the case (see Reasons 2.3). Consequently, Article 13(1) RPBA did not apply. However, in line with decisions T 1569/17 (Reasons 4.3.1), T 494/18 (Reasons 1.4) and T 2091/18 (Reasons 3 to 5), the board in the current case considers that deleting all the product claims amounts to an amendment to the respondent's case within the meaning of Article 13(1) and (2) RPBA. Hence, for the question of admittance of auxiliary request II, having been filed after the notification of a summons to oral proceedings, Article 13(2) RPBA is applicable in the present case.

23. The board concurs with the appellants that as the objections addressed by the request were those brought forward in opposition under Article 76(1) EPC, the request could and should have been filed earlier.

24. The board's interpretation of claim 1 in the preliminary opinion pursuant to Article 15(1) RPBA endorsed the appellants' claim interpretation set out in their statements of grounds of appeal (see appellant I's statement of grounds of appeal, paragraphs 11 to 13 and appellant II's statement of grounds of appeal, sentence bridging pages 2 and 3). Hence, it cannot be regarded as having created exceptional circumstances justifying an amendment of the respondent's case.

25. The board has further considered whether this request was suitable to solve all outstanding issues. However, these are not the circumstances of the current case since the appellants raised objections under Article 76(1) and Article 83 EPC against the method claims. Contrary to the respondent's argument, the board considers that objections under Article 76(1) EPC had been raised against all claims of the main request for the following reasons. In the statement setting out the grounds of appeal, appellant II contrasted its interpretation of the term "3'-azidomethyl" in the claims with the one given to it by the opposition division (see paragraph bridging pages 2 and 3, in particular page 2, penultimate paragraph "*the term '3'-azidomethyl' (recited in the independent claims)*" and last sentence "*the term 3'-azidomethyl used in the claims*"). The argument relates to a term used in all independent claims, refers to the "*clear wording of the claims*" using the plural and derives the consequence:

"then the claimed subject-matter clearly lacks basis in the parent and grandparent applications and thus violates Art 76 EPC" (see sentence bridging pages 2 and 3). Hence, the board concludes that all claims were addressed in this passage.

26. Since no exceptional circumstance were identified, as required by Article 13(2) RPBA, the board decided to not admit the request into the appeal proceedings.

Request to refer questions to the Enlarged Board of Appeal

27. The respondent requested that the board refer to the Enlarged Board of Appeal questions on the issue of claim interpretation (see section XIX. above).
28. The respondent's request was conditional on the board adopting an interpretation that was not consistent across the claims as a whole, more specifically an interpretation of the term "3'-azidomethyl" which differed between claims 1 and 6 (letter dated 27 February 2023, point 2.20).
29. As set out above, the board has concluded that the interpretation of the term "3'-azidomethyl" in the context of claim 1 was compatible with claim 6. In other words, interpretation (1) is at least one of the embodiments encompassed by claim 6. This conclusion is independent of alternative readings that might additionally be encompassed by claim 6. Therefore, the answers to the proposed questions were not decisive for the current appeal case. Furthermore, the board does not consider a decision by the Enlarged Board required in the circumstances of the present case and therefore will not refer any questions on its own motion.

30. Thus, the request to refer questions to the Enlarged Board of Appeal was rejected.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is rejected.
2. The decision under appeal is set aside.
3. The patent is revoked.

The Registrar:

The Chairwoman:



I. Aperribay

M. Pregetter

Decision electronically authenticated