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**Datasheet for the decision
of 22 May 2024**

Case Number: T 1005/22 - 3.3.08

Application Number: 14838384.7

Publication Number: 3037822

IPC: G01N33/569, C07K16/12,
G01N33/558

Language of the proceedings: EN

Title of invention:

Mycoplasma pneumoniae immunological detection method and kit

Patent Proprietor:

Tauns Laboratories, Inc.

Opponent:

Hoffmann Eitle Patent- und Rechtsanwälte
Partnerschaftsgesellschaft mbB

Headword:

Mycoplasma pneumoniae/TAUNS

Relevant legal provisions:

EPC Art. 100(c), 112(1)(a), 123(2)
RPBA 2020 Art. 12(4), 13(1)

Keyword:

Grounds for opposition - added subject-matter (yes)
Amendment to appeal case - justification by party (no)
Amendment to case - need for procedural economy
Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0004/92, G 0009/91, T 0710/15



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Case Number: T 1005/22 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 22 May 2024

Appellant: Hoffmann Eitle Patent- und Rechtsanwälte
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 February 2022 concerning maintenance of the
European Patent No. 3037822 in amended form.**

Composition of the Board:

Chairwoman T. Sommerfeld
Members: R. Morawetz
D. Rogers

Summary of Facts and Submissions

- I. The appeal lodged by the opponent (appellant) lies from the opposition division's interlocutory decision that European patent No. 3 037 822 ("the patent"), with the set of claims of the main request, submitted by letter dated 19 November 2020, and the invention to which it relates met the requirements of the EPC. The patent with the title "*Mycoplasma pneumoniae immunological detection method and kit*" was granted for European patent application No. 14 838 384.7, which was filed as international application under the PCT and published in accordance with Article 153(4) EPC as European application No. 3 037 822 A1 (referred to herein as "application as filed").
- II. In the statement setting out the grounds of appeal, the appellant argued *inter alia* that, contrary to the opposition division's decision, claim 6 of the main request contravened Article 123(2) EPC and claim 1 of the main request lacked an inventive step (Article 56 EPC).
- III. In reply to the statement of grounds of appeal, the patent proprietor (respondent) maintained the set of claims found allowable by the opposition division as its main request, withdrew auxiliary requests 1 and 2 that had been filed before the opposition division and submitted a new auxiliary request 3. It argued *inter alia* that the appeal was not admissible and that paragraph [0038] of the application provided a basis for the subject-matter of claim 6 of the main request.
- IV. In response, the appellant argued that the appeal was admissible and maintained *inter alia* its added matter

objection against claim 6 of the main request and auxiliary request 3.

- V. With letter dated 3 May 2023, the respondent submitted sets of claims of a new main request 1' and new auxiliary request 3' and arguments that the objection of added matter against claim 6 of the main request was inadmissible.
- VI. The board scheduled oral proceedings in accordance with the parties' requests and subsequently issued a communication under Article 15(1) RPBA.
- VII. With letter dated 21 March 2024, the respondent withdrew auxiliary request 3 and provided its inventive step arguments for claim 1 of the main request and for claim 1 of auxiliary request 3'.
- VIII. The appellant announced that it would not attend the oral proceedings.
- IX. Oral proceedings were held in the absence of the appellant in accordance with Rule 115(2) EPC and Article 15(3) RPBA.
- X. During the oral proceedings, the respondent submitted the following question for referral to the Enlarged Board of Appeal:

"When an opposition has been explicitly filed against claims 1 and 2 on the ground of Article 123(2) EPC, can this ground of opposition be implicitly extended against a claim 7 which is not dependent of claim 1 or 2, but only dependent from an independent claim 6?"

XI. Claims 5 and 6 of the main request, the sole claim request dealt with in substance in this decision, read as follows:

"5. A *Mycoplasma pneumoniae*-detecting immunochromatographic test strip, at least comprising first and second antibodies against P30 protein of *Mycoplasma pneumoniae* and a membrane carrier, wherein the first antibody is previously immobilized at a predetermined position of the membrane carrier so as to form a capturing zone; and the second antibody is labeled with an appropriate labeling substance and is provided at a position separated from the capturing zone so as to be chromatographically developed together with a test sample in the membrane carrier, wherein first and second antibodies are each a monoclonal antibody recognizing an epitope of P30 protein present in a region of the amino acid sequence of SEQ ID NO: 2, and said test sample is a biological sample.

6. The immunochromatographic test strip according to claim 5, wherein said monoclonal antibody recognizes a region having an amino acid sequence containing a large number of proline."

XII. The arguments of the parties relevant for the decision are dealt with in detail in the reasons for the decision.

XIII. The parties' requests relevant to the present decision were as follows.

The appellant requested that the decision under appeal be set aside and that the patent be revoked in its

entirety and that main request 1' and auxiliary request 3' not be admitted into the appeal proceedings.

The respondent requested that the appeal be deemed not admissible and the patent be maintained in amended form on the basis of the main request or, alternatively, that the patent be maintained in amended form on the basis of the set of claims of one of the main request 1' and auxiliary request 3'; and that the main request 1' and auxiliary request 3' be admitted into the appeal proceedings.

Reasons for the Decision

Admissibility of the appeal (Article 108 and Rule 99(2) EPC)

1. Pursuant to Article 108, third sentence, EPC in conjunction with Rule 99(2) EPC, in the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned. Article 12(3) RPBA further stipulates that the statement of grounds of appeal shall contain a party's complete case and shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on.
2. The respondent considered that the appeal was inadmissible and that the statement of grounds of appeal infringed Article 12(3) RPBA because of a lack of reference to case law cited by the opposition division in the context of the question of whether P30 was an obvious alternative target antigen to P1 for detection of *Mycoplasma pneumoniae* and a lack of

explanation why the opposition division's conclusion as regards inventive step was wrong.

3. In section 3 of the statement setting out the grounds of appeal, the appellant provided reasons why the decision under appeal was wrong with respect to inventive step of all claims of the main request. These reasons include in section 3.5.2, entitled "*P30 is an equally suitable alternative to P1*", an explanation why the skilled person looking for an alternative antigen would have identified P30 as an equal alternative to P1 and why the skilled person would not even have needed a motivation to employ the alternative, thus also addressing Reasons 5.7 to 5.9 of the decision under appeal. The decisions cited by the opposition division in that context are dealt with explicitly in section 3.5.2 of the grounds of appeal.
4. The appellant's submissions in the statement of grounds of appeal therefore enable the board to understand the reasons why the impugned decision is alleged to be incorrect as regards inventive step of the claims of the main request, and on what facts, arguments and evidence the appellant bases their case. Thus, the board concludes that the appellant's objection as to lack of inventive step of the main request has been substantiated in the statement of grounds of appeal and the respondent's objection is therefore unfounded.
5. It is moreover established case law of the boards of appeal that appeals by opponents - as opposed to appeals by proprietors, which would need to address all objections withstanding the maintenance of the patent - are sufficiently reasoned where they make a substantiated case for the decision under appeal being wrong on one of the objections or grounds for

opposition.

6. The board is satisfied that the appellant's objection as regards added matter in claim 6 of the main request has also been substantiated in the statement of grounds of appeal (page 7, fifth paragraph to page 8, fourth paragraph). Indeed, this was not contested by the respondent. Therefore, in the case at hand, a lack of substantiation of inventive step would in any case not have led to inadmissibility of the appeal.
7. The appeal is admissible.

Main request

Admissibility and consideration of the objection under Article 100(c) EPC in conjunction with Article 123(2) EPC against claim 6 of the main request in the appeal proceedings

8. In the notice of opposition, the opponent opposed the patent under Article 100(a) EPC on the ground that all claims lacked an inventive step (Article 56 EPC) and under Article 100(c) EPC in conjunction with Article 123(2) EPC on the ground that "at least" claims 1 and 2 added matter and requested that the patent be revoked in its entirety. In particular, it submitted that the feature "*said monoclonal antibody recognizes a region having an amino acid sequence containing a large number of proline*" in claim 2 as granted added matter (notice of opposition, page 6, second and third paragraphs).
9. During the oral proceedings before the opposition division, the opponent raised the same objection under Article 123(2) EPC as regards the feature "*said monoclonal antibody recognizes a region having an amino*

acid sequence containing a large number of proline" against claim 6 of the main request which corresponds to claim 7 as granted (minutes of the oral proceedings before the opposition division, points 7 and 8).

10. The opposition division considered that claim 6 of the main request refers to the same feature as granted claim 2 which had been objected to under Article 100(c) EPC in conjunction with Article 123(2) EPC in the notice of opposition. It thus admitted the objection into the proceedings and dealt with it in the impugned decision (decision under appeal, Reasons 3.4).
11. In the grounds of appeal, the appellant maintained the objection that the subject-matter of claim 6 of the main request extends beyond the content of the application as filed (Article 123(2) EPC).
12. In a first line of argument the respondent submitted that the appellant's objection under Article 123(2) EPC against claim 6 of the main request is inadmissible on appeal because the corresponding granted claim (claim 7) had not been objected to under Article 100(c) EPC (respondent's letter dated 3 May 2023, page 2, second paragraph).
13. However, this line of argument is not found persuasive because it ignores that the opposition division already dealt with the objection of added matter as regards the feature "*said monoclonal antibody recognizes a region having an amino acid sequence containing a large number of proline*" in claim 6 of the main request in the decision under appeal (point 10. above). Since the impugned decision is based on this objection, it forms part of the appeal proceedings (Article 12(1)(a) and 12(2) RPBA). The EPC does not provide any legal basis

for retroactive exclusion - in appeal proceedings - of documents, requests, objections or evidence already correctly admitted into the opposition proceedings (see also Case Law of the Boards of Appeal of the European Patent Office, 10th edition 2022, ("CLBA"), V.A.3.4.4) and the respondent has not argued otherwise.

14. In the board's judgement, the objection under Article 123(2) EPC against claim 6 of the main request was correctly admitted into the proceedings by the opposition division. The reasons are as follows. First, the new objection under Article 123(2) EPC against claim 6 of the main request concerned the same amendment which had been mentioned in the notice of opposition and the underlying reasons were the same as those submitted in respect of claim 2 as granted. Since the objection against claim 6 was based on facts and evidence which had already been put forward in the notice of opposition and did not introduce new facts or evidence, it merely introduced a new argument (see also G 4/92, OJ EPO 1994, 149, Reasons 10) under a ground of opposition already validly raised in the notice of opposition. According to the case law of the boards of appeal, Article 114(2) EPC provides no legal basis for disregarding late-filed arguments in opposition proceedings (CLBA IV.C.4.6.2). As a consequence, the opposition division had no discretion to disregard the new argument. The board considers that its findings are in line with the findings in T 710/15 (Reasons 1.4.1) while it is not aware of any conflicting case law.
15. In a further line of argument, submitted during oral proceedings before the board, the respondent submitted that in line with the findings in G 9/91 (OJ EPO 1993, 408) claim 7 as granted (corresponding to claim 6 of the main request) was not subject to any opposition

because it had not been attacked in the notice of opposition under Article 100(c) EPC.

16. However, in the board's judgement, the respondent's reliance on G 9/91 is misplaced. In G 9/91, the Enlarged Board of Appeal distinguished the situation where the patent is opposed as a whole from the situation where the patent is opposed only to a certain extent (G 9/91, Reasons 8). It held that in the latter situation, the power of an opposition division or a board of appeal to examine and decide on the maintenance of a European patent under Article 101 and 102 EPC 1973 (now merged in Article 101 EPC) depends on the extent to which the patent is opposed in the notice of opposition (Rule 55(c) EPC 1973; Rule 76(2)(c) EPC) (G 9/91, Order).
17. In the case in hand, the opposition was not limited to only a certain part of the patent, instead the patent as a whole was opposed (point 8. above). Therefore, the findings in G 9/91 as regards the situation wherein a patent is only opposed in part have no bearing on the present case. It was within the power of the opposition division and it is within the power of the board to examine and decide on added subject-matter of claim 6 of the main request.
18. The objection under Article 123(2) EPC against claim 6 of the main request is in the appeal proceedings.

Amendments (Articles 100(c) and 123(2) EPC) - claim 6

19. Claim 6, which depends on claim 5, requires that "*said monoclonal antibody recognizes a region having an amino acid sequence containing a large number of proline*" (see section XI. above for the full wording of

claims 5 and 6). This feature thus defines a sub-region of SEQ ID NO: 2 having an amino acid sequence containing a large number of proline residues.

20. The opposition division held that paragraph [0026] of the application discloses "*a site having the repeating structure of the amino acid sequence containing a large number of proline in an extracellular region of P30 protein*" and provides a basis for the subject-matter of claim 6 of the main request. The "repeating" feature, while not explicitly recited in claim 6, was considered by the opposition division to be implicit to the large number of proline residues (decision under appeal, Reasons 3.5).
21. The board notes, in agreement with the appellant, that paragraph [0026] of the application, referred to in the decision under appeal, contains a different disclosure and further, that the disclosure relied on in the decision under appeal as providing a basis for claim 6 of the main request is to be found in paragraph [0039] of the application.
22. For the following reasons, the board furthermore agrees with the appellant that the decision under appeal is not correct on this point.
23. In paragraph [0039], the application discloses that the "*antibody used in the present invention is likely to be an antibody recognizing a site having the repeating structure of the amino acid sequence containing a large number of proline in an extracellular region of P30 protein*".
24. Paragraph [0039] of the application thus requires that the site recognised by the antibody has (i) a repeating

structure of (ii) the amino acid sequence containing a large number of proline.

25. By contrast, claim 6 of the main request merely requires that the antibody recognises a region having an amino acid sequence containing a large number of proline, i.e. feature (ii). There are no further requirements regarding the order or relative positioning of the proline residues in claim 6.
26. Contrary to what was held in the decision under appeal, the board considers that the "repeating" feature is therefore not implicit to the feature of a large number of proline residues recited in claim 6 of the main request. Omission of the "repeating" feature from claim 6 therefore results in a generalisation of the disclosure in paragraph [0039] of the application as filed because only some parts of the sub-region of SEQ ID NO: 2 having an amino acid sequence containing a large number of proline residues also contain a repeating structure.
27. The respondent did not dispute that paragraph [0039] of the application requires that the antibody recognise a site having the repeating structure. It submitted however that paragraph [0038] of the application provided a separate basis for the subject-matter of claim 6 because it discloses that the P30 protein includes the "*amino acid sequence containing a large number of proline*" as the region that forms a three-dimensional conformation and thus becomes an epitope that is reactive with or "recognized" by an antibody.
28. For the reasons set out below, the respondent's arguments in support of allowability of the amendment

at issue are not considered persuasive.

29. Paragraph [0038] of the application reads as follows
"[t]he P30 protein has a molecular weight of 30 KDa and is one of the adhesive proteins involved in adhesion and pathogenicity, like P1 protein. In the Mycoplasma pneumoniae cell, the P30 protein is localized on the cell surface at an end of the adhesive organ and is a transmembrane protein having the N-terminal embedded in the cell membrane and the C-terminal present outside the cell membrane. The P30 protein includes an amino acid sequence containing a large number of proline on the C-terminal side and has a repeating structure of the amino acid sequence containing a large number of proline. In general, a region having an amino acid sequence containing proline is known to form a three-dimensional conformation and is known to have a possibility of becoming an epitope reactive with an antibody."

30. First, the board agrees with the appellant that paragraph [0038] of the application concerns the general background and presents the two options of having a large number of proline residues and having a repeating structure as distinct alternatives.

31. Second, after paragraph [0038] of the application introduces the two options generally, paragraph [0039] of the application, which concerns the antibody of the invention (see also point 23. above) defines the site having the repeating structure of the amino acid sequence containing a large number of proline residues as being the epitope recognised by the antibody of the present invention.

32. In sum, the board concludes from the above that the skilled person would not derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing from paragraphs [0038] and [0039] of the application as filed when read in the context of the application as filed as a whole, that the antibody of the invention recognises a region having an amino acid sequence containing a large number of proline.
33. The board therefore agrees with the appellant that claim 6 of the main request presents the skilled person with new technical information and contravenes Article 123(2) EPC.

Main request 1'

Admittance and consideration (Article 12(4) and 13(1) RPBA)

34. Main request 1' was submitted by the respondent after it had filed its reply to the appeal. It differs from the main request in that claim 6 was deleted.
35. The appellant requested that this claim request not be admitted and considered in the appeal proceedings on the grounds that it was filed late and no justification had been provided by the respondent for the late filing of the request (Article 13(1) RPBA).
36. It is undisputed that main request 1' constitutes an amendment to the respondent's appeal case within the meaning of Article 13(1) RPBA. As such, the amendment is subject to the respondent's justification for its submission while its admittance into the proceedings is at the discretion of the board. The criteria to be considered by the board when exercising its discretion under Article 13(1) RPBA include the criteria set out

in Article 12(4) RPBA and hence the need for procedural economy.

37. When it filed the request, the respondent did not provide any reasons for submitting main request 1' only after it had filed its reply to the appeal, contrary to the requirements of Article 13(1) RPBA.
38. While the board noted the lack of justification (board's communication under Article 15(1) RPBA, point 41), the respondent did not provide any justification at any later point during the written phase of the appeal proceedings.
39. During the oral proceedings before the board, the respondent submitted that main request 1' should be admitted for reasons of fairness since the need to file main request 1' arose from an error of the opponent who had omitted to attack granted claim 7 (corresponding to claim 6 of the main request) under Article 100(c) in conjunction with Article 123(2) EPC in the notice of opposition. In addition, they submitted, there was no reason to delete claim 6 earlier or to submit main request 1' earlier because the opposition division had decided that claim 6 met the requirements of Article 123(2) EPC. Admitting main request 1' was moreover procedurally efficient since it addressed the Article 123(2) EPC problem of the main request.
40. For the following reasons, the board was not persuaded by any of the respondent's arguments.
41. First, the purpose of the provision that the statement of grounds of appeal and any reply to it must contain the party's complete case (Article 12(3) RPBA) is precisely to ensure fair proceedings for all parties

and to enable the board to start working on the case on the basis of each party's complete submissions (CLBA, V.A.4.3.5a). In other words, fairness is built into the RPBA and is not something the board adds later on. Articles 12 and 13 RPBA lay out the criteria by which the boards have to exercise their discretion when considering amendments to a party's appeal case; whether the late filing of an amendment was justified is one of the factors to be considered by the board in exercising its discretion.

42. Second, none of the respondent's submissions amount to providing a justification for not submitting main request 1' in reply to the statement of grounds of appeal, when the respondent should have made its appeal case (Article 12(3) RPBA). Thus, the fact that claim 7 had not been objected to under Article 100(c) in conjunction with Article 123(2) EPC in the notice of opposition is irrelevant and cannot serve as a justification because the opposition division admitted the objection into the opposition proceedings and dealt with it in the decision under appeal (point 10. above) and the appellant maintained the objection in the statement of grounds of appeal (section II. above). When filing the reply, the respondent was therefore aware that the objection of added matter against claim 6 of the main request was part of the appellant's appeal case and it could and should have filed its fall-back positions addressing that objection then (CLBA, V.A.4.4.4).

43. Third, contrary to the respondent's assertion, admittance of main request 1' would not have helped procedural economy either because the objection under Article 123(2) EPC was not the sole objection as there were outstanding objections under Article 56 EPC

against claim 1 (board's communication under Article 15(1) RPBA, point 42). For this reason alone, main request 1' was therefore also not *prima facie* clearly allowable and required further discussion.

44. Fourth, these appeal proceedings are *inter partes* proceedings, and the appellant, which requested that main request 1' not be admitted into the appeal proceedings, would have been adversely affected by the admittance and consideration thereof.
45. In light of the above considerations, the board, exercising its discretion pursuant to Article 13(1) RPBA, decided not to admit main request 1' into the appeal proceedings.

Auxiliary request 3'

Admittance and consideration (Article 12(4) and 13(1) RPBA)

46. Auxiliary request 3' was also submitted by the respondent after it had filed its reply to the appeal. It differs from the main request in that claim 6 was deleted and in that claims 1 and 5 were amended to include the expression "*and said first and second antibodies are in a 'hetero' combination in which the two antibodies recognize respective antigenic determinants different in both position and conformation on an antigen.*"
47. The appellant requested that this claim request not be admitted and considered in the appeal proceedings on the grounds that it was filed late and no justification had been provided for the late filing of the request (Article 13(1) RPBA) and because the respondent had only substantiated the reason for their amendment of claims 1 and 5 after the board issued their preliminary

opinion (Article 13(2) RPBA).

48. Again, it is undisputed that also auxiliary request 3' constitutes an amendment to the respondent's appeal case (Article 13(1) RPBA).

49. While the board noted the lack of justification for the late filing of the request (board's communication, point 41) and the lack of substantiation of the amendments made in claims 1 and 5 (board's communication, point 43), the respondent did not provide any justification at any later point during the written phase of the appeal proceedings for submitting auxiliary request 3' only after its reply to the appeal. The substantiation for the amendments made in claims 1 and 5 of auxiliary request 3' was submitted in response to the board's communication under Article 15(1) RPBA.

50. During the oral proceedings before the board, the respondent relied on its submissions for main request 1' as regards the requirements of Articles 12 and 13 RPBA but it made no further comments regarding these Articles with respect to auxiliary request 3'. The respondent argued however that the only "real" objection to the patentability of the main request had been the objection to claim 6 under Article 123(2) EPC which objection was addressed by deletion of claim 6 in auxiliary request 3'. The remaining objection was under Article 56 EPC but it was "not real" because it was not well founded. They argued that once the board agreed that claim 1 of auxiliary request 3' was inventive, there was no outstanding objection, such that auxiliary request 3' could then be admitted into the proceedings.

51. Insofar the respondent relied on the submissions made for main request 1', these were not found persuasive for the reasons set out above (points 41. to 44.). In short, none of the respondent's submissions provided a justification for not submitting auxiliary request 3' in reply to the statement of grounds of appeal, when the respondent should have made its appeal case (Article 12(3) RPBA). Admittance of auxiliary request 3' would not have helped procedural economy either because the objection under Article 123(2) EPC was not the sole objection as there were outstanding objections under *inter alia* Article 56 EPC which needed to be discussed.
52. Given that for any substantive discussion of auxiliary request 3' to take place this request had first to be admitted into the appeal proceedings, the respondent's proposal to enter into a substantive discussion of Article 56 EPC before deciding on the admittance of auxiliary request 3' also failed.
53. In light of the above considerations, the board, exercising its discretion pursuant to Article 13(1) RPBA, decided not to admit auxiliary request 3' into the appeal proceedings.
54. The respondent was given several opportunities during the oral hearing before the board to present their comments on the admittance of auxiliary request 3' (see minutes of oral proceedings). As a consequence of the board's decision not to admit auxiliary request 3' into the appeal proceedings, this request was not discussed in substance. Against this backdrop, not hearing the respondent on inventive step of auxiliary request 3' does not constitute a violation of its right to be

heard.

The respondent's request for referral of a question to the Enlarged Board of Appeal

55. Under Article 112(1)(a) EPC, the boards of appeal can refer questions to the Enlarged Board of Appeal either of their own motion or upon request from a party, in order to ensure uniform application of the law or if a point of law of fundamental importance arises, if they consider that a decision is required for the above purposes and if the answer to that question is relevant for deciding the case in question.
56. The respondent requested the referral of one question filed during the oral proceedings (see section X. above for the exact formulation) to the Enlarged Board of Appeal.
57. The board understands that the question asks whether the opposition division was entitled to consider the new objection under Article 123(2) EPC against claim 6 of the main request raised by the then opponent during oral proceedings before the opposition division.
58. On account of the reasons given above (points 14. and 17.) it follows that this question could be answered by the board itself without doubt.
59. The requirements for a referral are not therefore fulfilled. Accordingly, the board decided to reject the respondent's request.

Conclusion

60. The main request is not allowable so that the decision under appeal must be set aside. Main request 1' and auxiliary request 3' are not admitted into the appeal proceedings. Therefore, in the absence of an allowable and admissible request, the patent must be revoked.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairwoman:



L. Malécot-Grob

T. Sommerfeld

Decision electronically authenticated