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Datasheet for the decision of 4 December 2025

Case Number: T 0364/23 - 3.3.08

Application Number: 17857586.6

Publication Number: 3461274

IPC: C12Q1/68, C12Q1/6806

Language of the proceedings: EN

Title of invention:
Methods for multi-resolution analysis of cell-free nucleic acids

Patent Proprietor:
Guardant Health, Inc.

Opponent:
Margaret Dixon Limited

Headword:
multi-resolution analysis/GUARDANT HEALTH

Relevant legal provisions:
EPC Art. 56
RPBA 2020 Art. 13(2)

Keyword:
Main request - Inventive step (no)
Auxiliary requests - Amendment after communication - cogent reasons (no)

Decisions cited:
T 1480/16, T 0981/17, T 0494/18, T 0914/18, T 0995/18, T 1151/18, T 2091/18, T 2243/18, T 1792/19, T 2201/19, T 0424/21, T 1800/21

Catchword:
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Case Number: T 0364/23 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 4 December 2025

Appellant: (Opponent)	Margaret Dixon Limited 1st Floor, Aurora Building Counterslip Bristol BS1 6BX (GB)
Representative:	Mewburn Ellis LLP Aurora Building Counterslip Bristol BS1 6BX (GB)
Respondent: (Patent Proprietor)	Guardant Health, Inc. 3100 Hanover Street Palo Alto, CA 94304 (US)
Representative:	Carpmaels & Ransford LLP One Southampton Row London WC1B 5HA (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 13 December 2022 rejecting the opposition filed against European patent No. 3461274 pursuant to Article 101(2) EPC**

Composition of the Board:

Chair	M. Montrone
Members:	B. Claes
	L. Bühler

Summary of Facts and Submissions

I. The appeal lodged by the opponent (appellant) lies from the decision of the opposition division rejecting the opposition against European patent No. 3 461 274 (the patent), entitled "*Methods for multi-resolution analysis of cell-free nucleic acids*".

II. On appeal, the appellant invoked the same grounds for opposition and reiterated objections against the patent as granted. The appellant also submitted objections against auxiliary requests 1 to 9 filed with the reply to the notice of opposition

III. In its reply to the appeal, the patent proprietor (respondent) defended the patent as granted (main request, 15 claims), maintained auxiliary requests 1 to 9 as submitted with the reply to the notice of opposition, and submitted sets of claims of four new auxiliary requests designated auxiliary requests 1a, 3a, 5a and 8a.

Claim 1 of the patent as granted, which is the sole independent claim, and dependent claims 9 and 12 of the patent as granted (main request) read as follows.

"1. A method for enriching multiple genomic regions, comprising:

(a) bringing a predetermined amount of nucleic acid from a sample in contact with a bait mixture comprising:

(i) a first bait set that selectively hybridizes to a first set of genomic

regions of the nucleic acid from the sample, which first bait set is provided at a first concentration that is less than a saturation point of the first bait set, and (ii) a second bait set that selectively hybridizes to a second set of genomic regions of the nucleic acid from the sample, which second bait set is provided at a second concentration that is at or above a saturation point of the second bait set; and

(b) enriching the nucleic acid from the sample for the first set of genomic regions and the second set of genomic regions, thereby producing an enriched nucleic acid,

wherein the baits are target-specific oligonucleotides, and wherein the sample comprises cell-free DNA."

"9. The method of any one of claims 6 to 8, wherein the first set of genomic regions and/or the second set of regions have [*] a read depth of between 1,000 counts/base and 50,000 counts/base." ([*] has been inserted by the board to mark the place of insertion of additional wording in other requests)

"12. The method of any one of the preceding claims, wherein the genomic regions comprise: (a) at least a portion of at least 5, at least 10, at least 15, at least 20, at least 25, at least 30, at least 35, at least 40, at least 45, at least 50, at least 55, at least 60, at least 65, at least 70, at least 75, at least 80, at least 85, at least 90, at least 95, or 97 of the genes of Table 3; **and/or** (b) at least a portion of at least 5, at least 10, at least 15, at least 20,

at least 25, at least 30, at least 35, at least 40, at least 45, at least 50, at least 55, at least 60, at least 65, at least 70, at least 75, at least 80, at least 85, at least 90, at least 95, at least 100, at least 105, at least 110, or 115 of the genes of Table 4" (emphasis by the board).

Pending auxiliary request 3 differed from the main request in that claim 9 had the additional wording "a size between 25 kilobases to 1,000 kilobases and" at the position indicated above by [*] and in that claim 12 was limited to the "or" operator.

The set of claims of new auxiliary request 3a was identical to that of auxiliary request 3 but with claim 9 deleted.

The set of claims of each of auxiliary requests 4, 5a, 6 and 7 included claims identical to claims 9 and 12 as granted.

The set of claims of each of auxiliary requests 8a and 9 included a claim identical to claim 9 as granted.

IV. After the parties had been summoned to oral proceedings, the board expressed its preliminary opinion on each of the respondent's claim requests in a communication under Article 15(1) RPBA. The board took the view that, *inter alia*, the ground of opposition under Article 100(a) EPC prejudiced the maintenance of the patent as granted (main request) because the subject-matter of claim 1 lacked an inventive step (Article 56 EPC) and the ground of opposition under Article 100(c) EPC prejudiced the maintenance of the patent as granted (main request) because claims 9 and 12 related to added subject-matter. Concerning

auxiliary requests 4, 5a, 6 and 7, the board noted, *inter alia*, that they included claims identical to claims 9 and 12 as granted, and concerning auxiliary requests 8a and 9 the board noted that they included a claim identical to claim 9 as granted.

V. In response to the board's communication, the appellant stated that it would not be attending the oral proceedings.

VI. Subsequently, on 3 November 2025 the respondent made a further submission and filed a new main request and six new auxiliary requests, which were to replace all of the previously pending claim requests. The new claim requests are as follows.

- The **new main request** is former auxiliary request 3a as submitted with the reply to the appeal (see section III. above).

- The sets of claims of **new auxiliary requests 1 to 4** are identical to the sets of claims of former auxiliary requests 4, 5a, 6 and 7, respectively (see section III. above), but with the claim identical to claim 9 as granted deleted and the claim identical to claim 12 as granted limited to the "or" operator.

- The sets of claims of **new auxiliary requests 5 and 6** are identical to the sets of claims of former auxiliary requests 8a and 9, respectively (see section III. above), but with, *inter alia*, the claim identical to claim 9 as granted deleted.

VII. Oral proceedings were held in the absence of the appellant. At the end of the oral proceedings, the chair announced the decision of the board.

VIII. The parties' submissions and arguments on appeal, insofar as they are relevant for the decision, are taken into consideration in the board's reasons for the decision set out below.

IX. The following documents are mentioned in this decision.

D4: Lanman *et al.*, PLoS ONE, 2025, 10(10): e0140712

D5: US 2012/0208706 A1

X. The parties' requests, where relevant for the decision, were as follows.

The appellant requested that
- the decision under appeal be set aside and
- the patent be revoked.

The respondent requested that
- the decision under appeal be set aside and
- the patent be maintained in amended form with the set of claims of the main request (filed as auxiliary request 3a in reply to the appeal), or alternatively, with the set of claims of one of new auxiliary requests 1 to 6, all filed on 3 November 2025.

Reasons for the Decision

Absence from the oral proceedings

1. The respondent was not present at the oral proceedings, as had previously been announced. Pursuant to Rule 115(2) EPC and Article 15(3) RPBA, in such a situation the oral proceedings may continue and the board may reach a decision without the absent party, which is considered to rely on its written case.

Main request

Admittance (Article 12 RPBA)

2. The new main request is former auxiliary request 3a, which was submitted by the respondent with its reply to the appeal. Claim 1 of this request is identical to claim 1 of the patent as granted (see section III. above).

3. The board admitted the new main request into the appeal proceedings. However, since the request is not allowable in substance (see points 10. to 19. below), it is not necessary to provide reasons for the board's decision to admit the request.

Claim 1

Construction of the feature "a saturation point" *of a first/second bait set*

4. Pivotal for the decision in the case at hand is the meaning of the feature "a saturation point" in claim 1,

in the context of the first and second bait sets that selectively hybridise to a first or second set of genomic regions of a nucleic acid, respectively, from a sample in the claim. In the claimed method, the first bait set is provided at a concentration that is less than "a saturation point" of the first bait set and the second bait set is provided at a concentration that is at or above "a saturation point" of the second bait set.

5. On appeal, the respondent conceded that there was no single mathematically objective point on a binding saturation curve that constituted "the saturation point". However, the respondent agreed with the opposition division and argued that paragraphs [0106] and [0107] of the patent nevertheless describe the term in its conventional and standard binding-kinetics sense, namely that increasing the bait concentration eventually stopped substantially increasing the amount of captured target because the binding approaches equilibrium.

6. According to the respondent, the practical implementation of this definition was straightforward. The saturation point for a given bait set is determined during method configuration using a fixed, predetermined amount of cfDNA. Accordingly, although saturation points may vary between different experiments or bait sets — owing, for example, to differing efficiency requirements or read-budget constraints — within any given embodiment the saturation point is defined consistently. Once a saturation point has been selected for a given experiment, the skilled person can objectively determine whether bait concentrations are below, at, or above that point. The respondent therefore submitted

that a subjective selection followed by an objective application is not inherently contradictory.

7. The board, however, concurs with the appellant that when interpreted in light of the description, the term instead refers to a point or threshold that can be arbitrarily selected by the skilled person in a subjective manner, depending on the intended purpose of the method, such as capture efficiency, cost considerations, assay constraints or experimental objectives (see, for example, dependent claims 3 and 4 and paragraphs [0039], [0047], [0085], [0111] and [0113] of the patent). Furthermore, the passages cited in paragraphs [0107] to [0109] do not provide a definition of a "saturation point" that establishes an objective point on a saturation curve either.

8. On the contrary, the description of the patent explicitly indicates that a given saturation point of a bait set may correspond to a condition in which, for example, as little as 40% of the target sequence is captured:

"[0112] *At the saturation point, the bait set can capture any of at least 40%, at least 50%, at least 60%, (...), at least 97%, at least 98%, and/or at least 99% of a target sequence in a sample. Saturation point can refer to the saturation point of a bait set or of a particular bait, depending on the context in which the term is used.*" (emphasis added by the board)

9. In view of the fact that a saturation point, in the context of the patent, is thus defined as an arbitrary threshold which is subjectively selectable depending on the targets and samples used - neither of which are specified in the claim - the board concludes that it is

not objectively possible, certainly not over the whole breadth of the claim, to determine whether a given bait concentration is below, at, or above a "saturation point".

Inventive step (Article 56 EPC)

Closest prior art and technical difference

10. It is common ground that the disclosure of methods for enriching genomic regions from cfDNA samples in document D4 represents a suitable starting point for the assessment of inventive step and that the technical difference between the subject-matter of claim 1 and the disclosure in document D4, as the closest prior art, is that the bait mixture of the claim comprises two bait sets: a first set at a concentration that is less than a saturation point of the first bait set, and a second set at a concentration that is at or above a saturation point of the second bait set.

Technical effect and objective technical problem

11. The primary technical effect of this difference is that genomic regions are captured to a higher extent by the second bait set than by the first bait set.

12. According to the respondent, the differing extents of capture of the genomic regions with respect to the reference "saturation point" for each bait set have the further technical effect that, in the claimed method, one bait set is included at a concentration at or above its saturation point, i.e. at a concentration defined relative to its target rather than merely relative to the other bait sets. The respondent argued that this additional requirement - namely of operating at or

beyond a bait set's saturation point - *maximised* the capture of particular targets of interest (for example, targets potentially containing rare SNVs), rather than merely increasing their capture relative to other targets, thereby minimising the loss of target molecules containing rare mutations.

13. The board is not, however, persuaded by this argument of the respondent. Indeed, as follows from point 8. above (with reference to paragraph [0112] of the patent), the saturation point of a bait set may correspond to conditions in which as little as 40% of the target sequence present in a sample is captured. A mere requirement in the claim that the concentration of a given bait set is at or above such a saturation point - defined in terms of target capture - cannot therefore justify the conclusion that, over the whole breadth of the claim, the capture of particular targets of interest (for example, those potentially containing rare SNVs) is maximised such that the loss of target molecules containing rare mutations is minimised.

14. Consequently, the alleged secondary technical effect of the difference as submitted by the respondent cannot be taken into account for the formulation of the objective technical problem.

15. Accordingly, based on the above considerations and having regard to the primary technical effect of the claimed invention, the objective technical problem may be formulated as the provision of a method that allows for increased capture of certain genomic regions relative to other genomic regions.

16. The claimed solution is the method for enriching multiple genomic regions with reference to the bait set

saturation points, i.e. one below and the other at or above a saturation point of the respective bait sets. It is undisputed, and the board agrees, that the objective technical problem formulated above is solved. It thus remains to be assessed whether the skilled person would arrive at the solution in an obvious way.

Obviousness

17. It is undisputed that secondary document D5 discloses providing different bait sets at different concentrations, i.e. providing the skilled person with the claimed solution to the objective technical problem formulated above.

18. The board notes in this context that it has already been concluded above that the reference to a saturation point of each of the bait sets referred to in the claim has no effect going beyond the fact that genomic regions are captured to a higher extent by the second bait set than by the first bait set (see points 12. and 13. above).

19. Accordingly, the board must conclude that the subject-matter of claim 1 is obvious to the skilled person and thus lacks an inventive step (Article 56 EPC).

Auxiliary requests 1 to 6

20. The respondent submitted these auxiliary requests, which replaced all of the previously pending auxiliary requests (with the exception of auxiliary request 3a, which is the present main request; see point 2. above) as maintained or filed in reply to the appeal, after the board had issued its preliminary opinion in a communication under Article 15(1) RPBA. In that

communication, the board took the view, *inter alia*, that claims 9 and 12 of the patent as granted (the former main request), the latter in respect of the "and" operator, relate to added subject-matter within the meaning of Article 100(c) EPC (see section IV. above).

21. Each of the newly filed auxiliary requests constitutes a set of claims amended with respect to earlier pending claim sets, which themselves were originally derived from the claims of the patent as granted. Auxiliary requests 1 to 4 correspond to amended versions of former auxiliary requests 4, 5a, 6 and 7, respectively. Compared with those former requests, the claim corresponding to dependent claim 9 as granted has been deleted, and the claim corresponding to claim 12 as granted has been restricted to the "or" operator (see section VI. above). Auxiliary requests 5 and 6 correspond to amended versions of former auxiliary requests 8a and 9, respectively. In these requests, too, the claim corresponding to dependent claim 9 as granted has been deleted (see section VI. above). Former auxiliary requests 8a and 9 did not contain a separate dependent claim corresponding to claim 12 as granted since the subject-matter of that claim had already been partially incorporated into claim 1.

Admittance (Article 13(2) RPBA 2024)

22. Where an amendment is made to a party's appeal case after notification of a communication under Article 15(1) RPBA, Article 13(2) RPBA 2024 provides that the amendment will not, as a rule, be taken into account unless the party concerned has shown compelling reasons why the circumstances are exceptional. If such circumstances are shown to exist, the board may decide,

in exercising its discretion, to admit an amendment made to the appeal case at this advanced stage of the proceedings.

23. It is uncontested that the provisions in Article 13(2) RPBA 2024 apply to the filing of auxiliary requests 1 to 6.

Amendments to the respondent's appeal case

24. An amendment to a party's appeal case under Article 13 RPBA is, in analogy with Article 12(4) RPBA (with reference to Article 12(2) RPBA), a submission which is not directed to the requests, facts, objections, arguments and evidence relied on by the party in its statement of grounds of appeal or its reply thereto - in other words, it is a submission which goes beyond the framework established therein (see, for example, decision T 247/20, Reasons 1.3; see also "Case Law of the Boards of Appeal of the EPO", 11th edition, 2025, "CLBA", V.A.4.2.2 a)).

25. The board is aware of several decisions (e.g. T 1480/16, Reasons 2.3; T 981/17, Reasons 3; T 995/18, Reasons 2; T 1151/18, Reasons 2; T 2243/18, Reasons 2; T 1792/19, Reasons 2; T 2201/19, Reasons 5.5) in which it was held that an appeal case had not been amended if the deletion of claims from a previously filed set of claims did not alter the factual and legal framework of the case or the subject-matter of the discussions, nor did this necessitate a reassessment of the issues in dispute. However, in more recent decisions (e.g. T 494/18, Reasons 1.3, and T 2091/18, Reasons 4), the now more prevailing opinion was that the filing of a set of claims which differs from the sets of claims filed with the statement of grounds of appeal or the

reply thereto is to be regarded as an amendment to a party's appeal case within the meaning of Article 13 RPBA. The diverging approaches seem to be converging towards the majority opinion (see, in particular, decision T 1800/21, Reasons 3.3 and 3.4, and the decisions cited in that decision). Since all six auxiliary requests in the case at hand differ from the sets of claims previously filed in the appeal proceedings, they constitute an "amendment to a party's appeal case" within the meaning of Article 13 RPBA.

Exceptional circumstances justified by cogent reasons

26. In light of the above consideration, it also needs to be established whether the respondent presented any "exceptional circumstances, which have been justified by cogent reasons" within the meaning of Article 13(2) RPBA, which could justify the admittance and consideration of the new auxiliary requests in the appeal proceedings.

27. The respondent argued that when filing its reply to the appeal, it had refrained from expanding the number of maintained and newly submitted auxiliary requests to cover all possible combinations and permutations of fall-back positions in line with the approach endorsed by the board in decision T 424/21 because, as it put it, it "*enhances procedural economy as doing so clearly overcomes existing objections without giving rise to any new issues*" and provides "*cogent reasons justifying exceptional circumstances as per Article 13(2) RPBA 2020*" (see point 24 of the decision). Instead, the respondent had explicitly indicated its intention to further amend the claim requests at a later stage, if deemed necessary, by deleting any dependent claim that

might lead to the rejection of a given set of claims containing it.

28. The respondent's submissions under the heading "*Further auxiliary requests*" in points 7.25 to 7.27 of its reply to the appeal, including the announcement of its intention to further amend the claim requests if necessary, read as follows.

"*7.25. As noted above, the opponent has made several amendments to its case compared with the first instance. Some of its new arguments have prompted the patentee to file additional auxiliary requests in reply, but it is not possible to cover* ***all possible permutations of the new arguments*** *which the board might admit and/or accept. For instance, the opponent has raised a new objection against claim 9 of 1AR (see sections 7.3*ff *above). If the board would agree with the objection to claim 9 of the main request and also to the new objection against claim 9 of 1AR then the patentee will have a problem - which means that it already has to decide whether to proliferate its claim requests to deal with every permutation of objections (including new objections), or to rely on future discretion from the board to permit deletions of dependent claims. This point was already addressed by board 3.3.04 in section 23 of T424/21:*

> *Generally prohibiting the deletion of dependent claims in reaction to the development of the appeal proceedings would require a huge number of auxiliary requests to be filed at an early stage, i.e. as early as with the statement of grounds of appeal or the reply, covering all combinations and permutations of possible fall-back positions. This would not be in the interest of procedural economy*

and cannot be deemed to be in line with the "convergent approach" and the aim and purpose of the RPBA 2020.

7.26. In line with this approach from T424/21 the patentee declines to expand the number of claim requests to cover "all combinations and permutations of fall-back positions" *at this stage, but instead announces its intention to request future permission to amend its claim requests to delete any dependent claims which would otherwise lead to rejection of a claim request. This would include, for instance, granted claim 5 (due to the sufficiency objections which have been raised specifically against this claim), or claims 5, 7 & 9 of 5AR (see middle of page 51 of the opponent's appeal), or claim 7 of 8AR (see page 53 of the opponent's appeal, where a new added matter objection was raised against claim 7).*

7.27. This approach will provide the same result as the late deletions which were made in T424/21, which the board endorsed in ¶24 because it "enhances procedural economy as doing so clearly overcomes existing objections without giving rise to any new issues" *and thus provides* "cogent reasons justifying exceptional circumstances as per Article 13(2) RPBA 2020". *See also ¶4.1 of T914/18 where board 3.3.01 similarly held that late claim deletions were allowable under Art.13(2) RPBA because they* "considerably sped up the proceedings by avoiding the discussion of a large number of auxiliary requests and further issues, such as the respondent's objections under Articles 123(3) and 84 EPC." *The patentee hopes that the present board will, if necessary, reach the same view*" (emphasis added by the board).

29. In its communication under Article 15(1) RPBA (see section IV. above) the board had expressed, *inter alia*, the preliminary opinion that, contrary to the finding of the opposition division in the decision under appeal, claims 9 and 12 as granted related to added subject-matter (Article 100(c) EPC). The respondent argued that, accordingly, in response to the board's opinion and conforming with its earlier announcement in its reply to the appeal, the newly filed auxiliary requests now had the claim corresponding to claim 9 as granted deleted and/or the claim corresponding to claim 12 as granted limited to the "or" operator as compared with the sets of claims filed with the reply to the appeal. The respondent submitted, furthermore, that the same deletions were in fact already contained in the set of claims of auxiliary request 3a (now the new main request), which had been filed early in the appeal proceedings with the reply to the grounds of appeal. Hence, the deletions were not new amendments.

30. However, the board is not convinced that exceptional circumstances are present in the case at hand, for the following reasons.

31. The objections of added subject-matter concerning claims 9 and 12 of the patent as granted had already been raised and addressed in the opposition proceedings, and a positive conclusion had been reached in this respect in the decision under appeal (see the appealed decision, points 14 to 20). However, these objections were reiterated by the appellant at the start of the appeal proceedings, namely in the appellant's grounds of appeal (see section II. above) and were considered in the board's communication under Article 15(1) RPBA (see section IV. above). It is established in the jurisprudence of the Boards of

Appeal, that the mere fact that a board comes to a different conclusion from the opposition division in respect of an objection already raised by an opponent in the opposition proceedings does not, as such, constitute exceptional circumstances. Indeed, it is a possible outcome that the respondent could have expected and thus had to take it into account.

32. Contrary to the situation underlying the current decision, where the amendment was submitted by the respondent in response to the board's opinion on an *existing objection*, the decision under Article 13(2) RPBA of the board in case T 424/21 concerned the deletion of two dependent claims (claims 4 and 5) in a claim set which was in fact submitted by the patent proprietor in response to a *newly raised objection* of the board concerning added subject-matter in its communication under Article 15(1) RPBA (see Reasons 19; see also point 18 of the board's communication dated 18 January 2022, and the patent proprietor's submission dated 21 February 2022). Accordingly, in the board's opinion, any of the reasons referred to in decision T 424/21 for endorsing the approach of admitting late deletions of dependent claims and holding this to enhance procedural economy and thus provide cogent reasons for a decision under Article 13(2) RPBA 2020 must also be read and interpreted in the context of this fundamental difference, i.e. the deletions being a reaction to a new objection (see also CLBA, V.A.4.5.4 b)).

33. Furthermore, the board disagrees with the respondent's argument, again with reference to decision T 424/21, that the deletions in the case at hand would enhance procedural economy because they overcame existing objections *without* giving rise to any new issues.

Indeed, in decision T 424/21, when admitting the newly filed set of claims the board took into account the fact that the deletion of the two dependent claims did not affect the objections to the other claims, which had all been addressed in the grounds of appeal, in the reply to the appeal and, importantly, in the board's communication under Article 15(1) RPBA, and the board could therefore conclude that the appellant (opponent) was not disadvantaged by the admittance of the request.

34. However, in the case at hand the circumstances are different and not conducive to the board being in a position to conclude without further ado that the appellant would not be disadvantaged by the admittance of the new auxiliary requests. Indeed, the constellation of the main request and the auxiliary requests submitted and maintained by the respondent with the reply to the appeal was such that, when drafting its communication under Article 15(1) RPBA, the board was in a position to limit the preliminary opinion expressed on each of these requests in essence to the issues of added subject-matter and inventive step, as addressed in the grounds of appeal and in the reply thereto, and nevertheless to conclude that *none* of these requests would likely be admitted and/or allowed. At the same time, however, the board noted the following in that communication:

"25. *Although the appellant has also submitted objections to the patent as granted under the grounds for opposition concerning novelty and sufficiency of disclosure, the board sees at this point no need to express its opinion on these issues, having regard to the negative opinions expressed above on the grounds of opposition concerning added subject-matter and inventive step*".

Therefore, in the case at hand, it could not be straightforwardly excluded and thus concluded that the appellant (opponent) was not disadvantaged by the admittance of the new auxiliary requests. Accordingly, although the board can agree with the respondent that the deletions overcome existing objections on added subject-matter, the board is not persuaded that the deletions do not give rise to any new issues, at least in respect of issues not addressed by the board in its communication. The board thus cannot conclude in this respect either that the new auxiliary requests enhance procedural economy.

35. The board notes as a final point that none of the explicitly announced exemplary deletions in future sets of claims (see point 7.26 of the reply to the appeal; see also point 28. above) actually concerns the deletion of claim 9 and/or part of claim 12 as granted as a general measure. In fact, claim 9 as granted is only mentioned in the specific context of former auxiliary request 5 in combination with the additional claims 5 and 7. Claim 12 is not mentioned at all. Accordingly, also on account of this circumstance, the board sees no gain in procedural economy by virtue of the early announcement of future amendments in the reply to the appeal.

36. Apart from relying on the principles adhered to in decision T 424/21, when considering the filing of the current auxiliary requests under Article 13(2) RPBA the appellant also referred to decision T 914/18, which, similarly, had decided in Reasons 4.1, in respect of a claim request having two dependent claims deleted, that the "*late claim deletions were allowable under Art. 13(2) RPBA because they* 'considerably sped up the

proceedings by avoiding the discussion of a large number of auxiliary requests and further issues, such as the respondent's objections under Articles 123(3) and 84 EPC'" (see point 28 above and point 7.27 of the reply to the appeal).

37. However, the underlying circumstances in case T 914/18 for the decision under Article 13(2) RPBA in respect of auxiliary request 7 filed during the oral proceedings were different from the circumstances in the case at hand with respect to current auxiliary requests 1 to 6. Indeed, contrary to the situation in the case at hand (see point 34. above), the admittance in case T 914/18 of auxiliary request 7 led to a set of claims which overcame all the contentious issues on appeal and put the competent board in a position to completely review the decision under appeal and remit the case to the opposition division for further prosecution (see Reasons 4.4.). Furthermore, also contrary to the situation in the case at hand, the admittance of this request avoided the need to discuss amendments in a large number of other auxiliary requests in respect of Article 123(3) EPC and Article 84 EPC. Therefore, having regard to the differing circumstances in the decision referred to, the board is not persuaded that a similar conclusion under Article 13(2) RPBA must be reached in the case at hand in respect of current auxiliary requests 1 to 6.

38. Owing to the above considerations, the board is not convinced that exceptional circumstances are present that justify admitting auxiliary requests 1 to 6 into the appeal proceedings under Article 13(2) RPBA.

39. As a result, there are no requests on file which could form the basis for the respondent's request for a patent to be granted.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

The Registrar: The Chair:

C. Rodríguez Rodríguez M. Montrone

Decision electronically authenticated