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**Datasheet for the decision  
of 24 September 2025**

**Case Number:** T 1461/23 - 3.3.04

**Application Number:** 14761477.0

**Publication Number:** 3036332

**IPC:** C12N15/82

**Language of the proceedings:** EN

**Title of invention:**

Plant genome modification using guide RNA/CAS endonuclease systems and methods of use

**Patent Proprietors:**

E. I. du Pont de Nemours and Company  
Pioneer Hi-Bred International, Inc.

**Opponent:**

N.V. Nederlandsch Octrooibureau

**Headword:**

Plant genome modification by guide RNA/CAS systems/E. I. DU  
PONT

**Relevant legal provisions:**

EPC Art. 54(3)

**Keyword:**

Novelty - main request (no) - auxiliary request 4 (yes)  
Late-filed auxiliary requests 1 and 2 - admitted (no) 3 and 4  
- admitted (yes)  
Claims - clarity - auxiliary request 3 (no)  
Remittal - (yes)



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Case Number: T 1461/23 - 3.3.04

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.04**  
**of 24 September 2025**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 June 2023  
revoking European patent No. 3036332 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairwoman**            M. Pregetter  
**Members:**            A. Chakravarty  
                              A. Bacchin

## **Summary of Facts and Submissions**

- I. European patent 3 036 332 was granted on application EP 14 761 477.0, filed as an international application and published as WO 2015/026883 was opposed by a single opponent. The opposition division revoked the patent.
- II. The patent proprietors (appellants) filed an appeal against this decision. The opponent is respondent to the patent proprietors' appeal.
- III. In the decision under appeal, the opposition division considered sets of claims of a main and twenty-one auxiliary requests. The subject-matter of claims 1, 10 and 15 of the main request and of claim 1 of auxiliary request 1 was held to lack novelty. No other auxiliary request (i.e. none of auxiliary requests 2 to 21) was admitted into the proceedings.
- IV. With its statement of grounds of appeal, the appellants submitted a set of claims of a new main request and of auxiliary requests 1 to 6. The main request is identical to auxiliary request 1 considered in the decision under appeal. Auxiliary requests 1 to 6 were newly filed on appeal.
- V. The respondent submitted a reply to the statement of grounds of appeal.
- VI. Oral proceedings before the board were held as scheduled. During the oral proceedings, the board decided not to admit auxiliary requests 1 and 2. Auxiliary request 3 was admitted. Furthermore, a new auxiliary request 4 was submitted by the appellants and was admitted into proceedings by the board. Former

auxiliary requests 4 to 6 were renumbered as auxiliary requests 5 to 7.

VII. The Chairwoman announced the board's decision that auxiliary request 3 was not allowable. A new line of argument raised by the appellants against claim 1 of auxiliary request 4 based on a newly cited passage of D9 was not admitted into the proceedings. At the end of the oral proceedings the Chairwoman announced the decision of the board.

VIII. The main request has 13 claims. They read as follows:

1. A method for modifying a target site in the genome of a plant cell, the method comprising providing a guide RNA to a plant cell having stably integrated into its genome a Cas9 endonuclease gene, wherein said guide RNA and the Cas9 endonuclease encoded by said gene are capable of forming a complex that enables the Cas9 endonuclease to introduce a double-strand break at said target site, and wherein the method does not comprise an essentially biological process for the production of plants, and wherein the plant is a monocot or a dicot selected from the group consisting of soybean, canola, alfalfa, sunflower, cotton, tomato, peanut, potato, and safflower.

2. The method of claim 1, wherein the Cas9 endonuclease gene is a plant-optimized Cas9 endonuclease.

3. The method of claim 1 or claim 2, further comprising providing a donor DNA to said plant cell, wherein said donor DNA comprises a polynucleotide of interest.

4. The method of claim 3, further comprising identifying at least one modified plant cell comprising

in its genome the polynucleotide of interest integrated at said target site.

5. The method of any one of claims 1 to 4, wherein said guide RNA is introduced directly by particle bombardment.

6. The method of any one of claims 1 to 5, wherein the Cas9 endonuclease gene is operably linked to a SV40 nuclear targeting signal upstream of the Cas9 codon region and a VirD2 nuclear localization signal downstream of the Cas9 codon region.

7. The method of claim 1 to 6, wherein the monocot is selected from the group consisting of maize, rice, sorghum, rye, barley, wheat, millet, oats, sugarcane, turfgrass, and switchgrass.

8. A plant comprising a recombinant DNA construct, said recombinant DNA construct comprising a promoter operably linked to a nucleotide sequence encoding a plant-optimized Cas9 endonuclease, wherein said plant-optimized Cas9 endonuclease is capable of binding to and creating a double-strand break in a genomic target sequence of said plant genome, and wherein said plant does not comprise a guide RNA, and wherein the plant is a monocot or a dicot selected from the group consisting of soybean, canola, alfalfa, sunflower, cotton, tomato, peanut, potato, and safflower.

9. A method for editing a nucleotide sequence in the genome of a plant cell, the method comprising introducing at least one guide RNA and at least one polynucleotide modification template into a plant cell having stably integrated into its genome a Cas9 endonuclease gene, wherein the Cas9 endonuclease

encoded by said gene is capable of introducing a double-strand break at a target site in the genome of said plant cell, wherein said polynucleotide modification template comprises at least one nucleotide modification of said nucleotide sequence.

10. The method of claim 9, wherein the nucleotide sequence in the genome of said plant cell is selected from the group consisting of a promoter, a regulatory sequence, a splice site, a coding sequence, a polyubiquitination site, an intron site, an intron enhancing motif and a gene of interest, preferably wherein the gene of interest is an enolpyruvylshikimate-3-phosphate synthase (EPSPS) gene or an acetolactate synthase (ALS) gene.

11. The method of claim 9 or 10, wherein the plant cell is a monocot plant cell or a dicot plant cell.

12. The method of any one of claims 9 to 11, wherein the at least one nucleotide modification is not a modification at said target site.

13. A transgenic plant comprising a Cas9 endonuclease gene stably integrated into its genome, wherein the Cas9 endonuclease gene is present in the absence of a guide RNA, and wherein the plant is a monocot or a dicot selected from the group consisting of soybean, canola, alfalfa, sunflower, cotton, tomato, peanut, potato, and safflower."

*Auxiliary request 1*

Auxiliary request 1 has 11 claims. Claim 1 of auxiliary request 1 is identical to claim 1 of the main request. Claims 8 and 13 of the main request have been deleted

and the remaining claims have been renumbered accordingly. Claim 8 of auxiliary request 1 is identical to claim 9 of the main request.

*Auxiliary request 2*

Auxiliary request 2 has 10 claims. Claim 1 differs from claim 1 of auxiliary request 1 in that it includes the feature from claim 5 of the main request, i.e. "wherein the guide RNA is introduced directly by particle bombardment". The remaining claims are adapted accordingly.

*Auxiliary request 3*

Auxiliary request 3 has 9 claims. Claim 1 of auxiliary request 3 is the same as claim 1 of auxiliary request 2. Moreover, the limitations of claim 10 of the main request ("wherein the nucleotide sequence in the genome of said plant cell is a gene of interest, wherein the gene of interest is an enolpyruvylshikimate-3-phosphate synthase (EPSPS) gene or an acetolactate synthase (ALS) gene") have been introduced into amended claim 7. Claim 10 of main request is accordingly deleted in auxiliary request 3. The claim numbering is amended accordingly.

*Auxiliary request 4 (filed during the oral proceedings before the board)*

The claims of auxiliary request 4 read:

"1. A method for modifying a target site in the genome of a plant cell, the method comprising providing a guide RNA to a plant cell having stably integrated into its genome a Cas9 endonuclease gene, wherein said guide

RNA and the Cas9 endonuclease encoded by said gene are capable of forming a complex that enables the Cas9 endonuclease to introduce a double-strand break at said target site, and wherein the plant is a monocot or a dicot selected from the group consisting of soybean, canola, alfalfa, sunflower, cotton, tomato, peanut, potato, and safflower, and wherein said guide RNA is introduced directly by particle bombardment.

2. The method of claim 1, wherein the Cas9 endonuclease gene is a plant-optimized Cas9 endonuclease.

3. The method of claim 1 or claim 2, further comprising providing a donor DNA to said plant cell, wherein said donor DNA comprises a polynucleotide of interest.

4. The method of claim 3, further comprising identifying at least one modified plant cell comprising in its genome the polynucleotide of interest integrated at said target site.

5. The method of any one of claims 1 to 4, wherein the Cas9 endonuclease gene is operably linked to a SV40 nuclear targeting signal upstream of the Cas9 codon region and a VirD2 nuclear localization signal downstream of the Cas9 codon region.

6. The method of claim 1 to 5, wherein the monocot is selected from the group consisting of maize, rice, sorghum, rye, barley, wheat, millet, oats, sugarcane, turfgrass, and switchgrass".

IX. The following document is referred to in this decision:

D9: WO 2013/176772

X. The appellants' submissions are summarised as follows:

*Novelty (Article 54(3) EPC)  
Over Document D9*

The subject-matter of claim 1 of the main request was novel over the disclosure in D9. In order to arrive at the claimed subject-matter from D9, a skilled person would have needed to select multiple features from separate lists:

- "Cas9" from a list of multiple types of "site-directed modifying polypeptides" which included "Cas9" and "Csn1" in paragraph [0026] of D9;
- the option of "plant cell" from a separate list of 20 different types of cells recited in paragraph [0026] of D9;
- the option of (stable) integration from the list of alternative meanings of the term "genetically modified" in paragraph [00122] of D9; and
- the specific plant species from paragraph [00377] of D9.

According to established case law, such a combination of features from separate embodiments was not a direct and unambiguous disclosure of the resulting subject-matter unless the document itself suggested the combination. However, D9 did not provide a direct and unambiguous disclosure of the claimed combination.

Furthermore the claimed subject-matter differed from the disclosure of D9 in its requirement of the capability of the guide RNA and Cas9 endonuclease to

form a complex that enables the Cas9 endonuclease to introduce a double-strand break, which paragraph [0026] of D9 was silent about.

Moreover, D9 was not an enabling disclosure for the claimed combination because it did not disclose the finding that Cas9 pre-integration provides the benefit of "the ability to create and maintain a cell line or transgenic organism capable of efficient expression of the Cas9 protein with little or no consequence to cell viability".

Therefore, claim 1 and its dependent claims were novel over D9.

*Admittance of auxiliary requests*

The appellants made no separate submissions on the admittance of auxiliary requests 1 and 2.

Auxiliary request 3 should be admitted because the opposition division should have admitted a claim request amended to overcome the lack of novelty objection in view of D9. Accordingly, the admission of an auxiliary request with appropriate amendments to address the lack of novelty objection, such as auxiliary request 3, was entirely appropriate. The opposition division's finding at the oral proceedings that the subject-matter of claim 1 of the main request lacked novelty in view of D9 represented a change of view compared to the one expressed in the opposition division's communication annexed to the summons to oral proceedings dated 18 March 2022 (see item 13 therein).

Auxiliary request 4, submitted during the oral proceedings before the board, should be admitted under Article 13(2) RPBA due to exceptional circumstances. It was a version of auxiliary request 3, which had been amended in claim 1 to take the board's view on the clarity of the disclaimer into account. This view had only been announced at the oral proceedings. The other amendment was the deletion of claim 7 in which the board had seen problems under Article 123(2) EPC, which also had only become apparent at the oral proceedings.

XI. The respondent's submissions are summarised as follows:

The appellants were not correct in their assertion that the claimed subject-matter was novel over the disclosure in document D9. D9 disclosed the method recited in claim 1 in paragraph [0026] in combination with paragraph [00377] which listed specific plant species, including those recited in the claims.

The appellants had asserted that:

- i) the claimed subject-matter was only derivable from D9 by making undisclosed selections;
- ii) that the method disclosed on D9 was not disclosed in an enabling manner.

These assertions were not correct.

Re. i) : Cas9 did not need to be selected from a list of multiple types of "site-directed modifying polypeptides" because the terms "Csn1" and "Cas9" denoted the same polypeptide, having an amino acid sequence as shown in Figure 3. Moreover the sequences of "corresponding portions" having SEQ ID NO: 1-256 and

795-1346 as mentioned in paragraph [0026] were all "naturally occurring Cas9/Csn1 endonucleases", as explained in para [00229] of D9.

Paragraph [00377] disclosed specific examples of the plant cells from the species recited in the claims.

Finally, the option of stable integration was not selected from a list of alternative meanings of the term "genetically modified". According to paragraph [00122] there were merely two options about what happens after the introduction of a Cas9-encoding DNA, i.e. it may or may not be integrated (covalently linked) into the genome. This was not a list "of some length" nor a "relatively long list" in the sense of decisions T 12/81 and T 401/94. The disclosure of the claimed subject-matter in D9 was direct and unambiguous in a way such that it met the standards established in the case law. The appellants' submission that D9 did not teach that the guide RNA and the Cas9 endonuclease could form a complex also failed because the first sentence of paragraph [0026] taught that the disclosed method was a method "of modifying target DNA", meaning that the Cas9 had to be able to form a complex with the guide RNA.

Re. ii):

The argument that D9 was not an enabling disclosure was incorrect because D9 disclosed the same technical features as recited in the claims. If D9 was not an enabling disclosure, then method claimed in the patent was also not enabled. In any case, the appellants had not made a reasoned case why the method disclosed in D9 was not enabled.

*Admittance of auxiliary requests*

Six new auxiliary claim requests were filed with the statement of grounds of appeal. Pursuant to Article 12(2) and (4) RPBA, each of these new auxiliary requests was an amendment of the appellants' case. Under Article 12(4) RPBA the appellants had to provide the reasons as to why each amendment had been filed and why it was not already filed in the proceedings leading to the decision under appeal. Article 12(3) RPBA required that the aforementioned substantiation was provided in the statement of grounds of appeal.

However the appellants had merely described the amendments made in each of the new auxiliary requests, without providing any substantiation for the reasons. They alleged that the new requests were convergent and did not introduce complexity or surprise for the opponent, and offered some explanations regarding the problems of novelty and inventive step they aimed to address. However, they provided no justification for submitting these requests only during the appeal proceedings and not in the first instance. Consequently, the appellants had failed to provide their complete appeal case as required under Article 12(3) RPBA.

Furthermore, the requests should also not be admitted under Article 12(6) RPBA, as they should have been filed during the earlier proceedings before the opposition division. At the oral proceedings, the opposition division decided that the claims of the (then) main request lacked novelty over the D9, relying on reasoning already set out in the Notice of Opposition. The appellants were given an opportunity during the oral proceedings to file a new auxiliary

request to address the identified deficiency. The appellants accordingly filed a new first auxiliary request, which later became the main request on appeal. It was immediately apparent that this request also lacked novelty over the prior art, a conclusion the opposition division confirmed.

The opposition division then allowed the appellants to submit yet another auxiliary request. This was the latest point at which the appellants could and should have filed the new auxiliary requests 1 to 6. Instead, the proprietors chose to file a second auxiliary request, which the opposition division correctly did not admit because it was divergent.

There were no circumstances in the case before the opposition division or on appeal that justified the admittance of any of auxiliary request 1 to 6. Under Article 12(2), 12(4), and 12(6) RPBA, appeal proceedings served to review the decision under appeal, not to extend opposition proceedings.

These objections applied to auxiliary request 4 filed at the oral proceedings before the board. The objection concerning the disclaimer in claim 1 of the auxiliary requests had been raised and substantiated with the reply to the statement of grounds of appeal, points 31. to 33. Thus such a request could and should have been filed earlier in the proceedings. Its admittance would unnecessarily prolong the proceedings.

XII. The appellants request that:

- the decision under appeal be set aside and that the case be remitted to the opposition division for further

prosecution based on the set of claims of the main request;

- alternatively, the case be remitted on the basis of the set of claims of one of auxiliary requests 1 to 3, or of auxiliary requests 5 to 7, submitted as auxiliary requests 4 to 6, all filed with the statement of grounds of appeal, or on the basis of the set of claims of auxiliary request 4, filed in appeal oral proceedings.

- in case the board were to decide not to remit the case, the patent should be maintained on the basis of the set of claims of the main request or of one of auxiliary requests 1 to 7;

XIII. The respondent requests that:

- appeal of the appellants be dismissed and that the patent remain revoked in its entirety;

- auxiliary claim requests 1 to 7 not be admitted into the proceedings;

- in the event that the board were to decide to set aside the decision, the case not be remitted to the opposition division for further prosecution but that that the board itself decides on the remaining objections raised.

XIV. The parties also have requests concerning the admittance and non-admittance of various documents (see minutes of the oral proceedings). These are not repeated here as they are not relevant to the decision.

## **Reasons for the Decision**

*Main request - claim 1*

*Novelty over D9 (Article 54(3) EPC)*

1. There is no dispute that document D9 is prior art under Article 54(3) EPC for the patent in suit (see the decision under appeal, point 26). The respondent has also argued that the claimed subject-matter cannot validly claim priority and that D9 is also prior art under Article 54(2) EPC. In view of its decision in the case, the board did not need to decide on this issue.
2. There is no dispute either about the opposition division's finding that D9 specifically discloses a method of modifying target DNA in a genetically modified "target" cell comprising an exogenous site-directed modifying polypeptide, by introducing a guide RNA (termed "DNA-targeting RNA", see paragraph [0008]).
3. There is however dispute about whether document D9 directly and unambiguously discloses the claimed subject-matter, specifically the claimed combination of features. The appellants submit that the claimed subject-matter can only be arrived at by making (undisclosed) selections from separate unrelated disclosures (lists) in D9, whereas the respondent disputes thus. The lists identified by the appellants are:
  - i) Cas9 from a list of multiple types of "site-directed modifying polypeptides" which include "Cas9" and "Csn1" in paragraph [0026] of D9;

ii) the option of "plant cell" from a separate list of 20 different types of cells recited in paragraph [0026] of D9;

iii) the option of (stable) integration from the list of alternative meanings of the term "genetically modified" in paragraph [00122] of D9; and

iv) the specific plant species from paragraph [00377] of D9.

4. The board is not persuaded by the appellants' arguments and considers that no selection from more than one list in D9 is needed to arrive at the claimed subject-matter. Regarding point i), Cas9 and Csn1 designate the same enzyme. There is therefore no selection to be made in specifying that the relevant gene encodes Cas9.
5. Regarding points ii) and iii), it is true that plant cells are first presented in a list of different cell types in paragraph [0026]. However, the section headed "*Transgenic plants*" starting at paragraph [00371], explicitly discloses methods where plants (and plant cells) are transformed to "*generate a transgenic plant that produces a site-directed modifying polypeptide Cas9*" for use in the method of the invention.
6. There is also disclosure of "stable" integration of the Cas9 endonuclease gene in the plant cell's genome by reference to "transgenic plants", which by definition have the exogenous nucleic acid sequence stably integrated. Furthermore, the board holds that opposition division correctly noted that reference to reproductive material and progeny plants in paragraph [00381] makes it clear that stably transformed plants are disclosed. It follows that no selection is needed

to derive the claimed subject-matter from the disclosure in paragraph [00371] of D9.

7. Finally in relation to point iv), paragraph [00377] provides the a list of plants species to be modified according to the invention. The paragraph reads "*Specific examples of plants which can be modified follow: maize, banana, peanut, field peas, sunflower, tomato, canola, tobacco, wheat, barley, oats, potato, soybeans, cotton, carnations, sorghum, lupin and rice.*". Of these soybean, canola, sunflower, tomato and potato are mentioned in the present claim. Thus, at most a selection of this list of plant species is needed to arrive at the claimed subject-matter.
8. The appellants had two further reasons why D9 did not disclose the claimed subject-matter. The first was that D9 did not disclose in paragraph [0026] the capability of the guide RNA and Cas9 endonuclease to form a complex that enables the Cas9 endonuclease to introduce a double-strand break. The second was that the generic disclosure in D9 was not an enabling disclosure for the specific combination of features of present claim 1.
9. The board was not convinced by these arguments either. With respect to the first argument, D9 makes it clear in the general teaching of previous paragraph [0025] that "*Features of the present disclosure include a method of producing a genetically modified cell in a subject, the method comprising: (I) introducing into a cell: (i) a DNA-targeting RNA, or a DNA polynucleotide encoding the same, wherein the DNA-targeting RNA comprises: (a) a first segment comprising a nucleotide sequence that is complementary to a sequence in the target DNA; and (b) a second segment that interacts with a site-directed modifying polypeptide; and (ii) a*

*site-directed modifying polypeptide, or a polynucleotide encoding the same, wherein the site-directed modifying polypeptide comprises: (a) an RNA-binding portion that interacts with the DNA-targeting RNA; and (b) an activity portion that exhibits nuclease activity that creates a double strand break in the target DNA; wherein the site of the double strand break is determined by the DNA-targeting RNA" (emphasis added).* From this passage it is apparent that the DNA-targeting RNA and the site-directed modifying polypeptide interact to form a complex that enables the Cas9 endonuclease to introduce a double-strand break at said target site.

10. The objection of lack of enablement of the method disclosed in D9 is not successful either. The only argument brought forward by the appellants in this regard is that D9 does not disclose "*the ability to create and maintain a cell line or transgenic organism capable of efficient expression of the Cas9 protein with little or no consequence to cell viability*". However, this is not a feature of the claim and in any case would be achieved by following the method disclosed in D9, which has the same technical features (steps) as the claimed method.
11. In view of the above considerations D9 discloses a method for modifying a target site in the genome of a plant cell falling within claim 1 of the the main request, which therefore lacks novelty.

*Auxiliary requests 1 and 2*

*Admittance (Article 12(4) RPBA)*

12. These claim requests were filed with the statement of grounds of appeal and thus their admittance into the proceedings is subject to the discretion of the board under Article 12(4) RPBA. The board decided not to consider them in appeal as they suffered from the same deficiencies as the main request and auxiliary request 3.
13. Claim 1 of auxiliary request 1 is identical to claim 1 of the main request and suffers from the same lack of novelty in view of D9.
14. In auxiliary request 2, claim 7, directed to a method of editing a nucleotide sequence in the genome of a plant cell comprising the same steps as defined in claim 1 of the main request (absent the disclaimer and the plant species) lacks novelty for the same reason as claim 1 of the main request. In addition, claim 1 of auxiliary request 2 is identical to claim 1 of auxiliary request 3 and thus suffers from the same lack of clarity as specified below.

*Auxiliary request 3*

15. The board admitted the claim, but since it is not allowable, there is no need to provide reasons for its admittance.

*Clarity (Article 84 EPC)*

16. Claim 1 is amended compared to granted claim 1 and is therefore open to objections of lack of clarity in the opposition (appeal) proceedings.
17. The amendment specifying that "and wherein said guide RNA is introduced directly by particle bombardment" renders the disclaimer "and wherein the method does not comprise an essentially biological process for the production of plants" moot because it was introduced to exclude methods for introducing the guide RNA other than particle bombardment. This renders the claim as a whole unclear because it is not apparent what it now excludes.

As such claim 1 does not meet the requirements for clarity under Article 84 EPC. Auxiliary request 3 is therefore not allowable.

*Auxiliary request 4*

18. Auxiliary request 4 is identical to auxiliary request 3 except that the disclaimer in claim 1 and the whole of claim 9 is deleted.

*Admittance of auxiliary request 4 (Article 13(2) RPBA)*

19. The board admitted the claim request because the lack of clarity due to the presence of the disclaimer had not been an issue in the proceedings up to this point, representing exceptional circumstances within the meaning of Article 13(2) RPBA.
20. The introduction of the disclaimer had been required by the opposition division, which had raised an objection

under Article 53(b) EPC *ex officio*. The respondent only substantiated its objections to this under Article 123(2) or Article 84 EPC in the appeal proceedings. It was therefore fair to admit auxiliary request 4 into the proceedings. Moreover, the amendments made consist of the deletion of the disclaimer in claim 1 and of the whole claim 9. Moreover, these amendments resolve both the lack of clarity of claim 1 and the objection of added subject-matter in claim 9. The amendments are also straightforward and do not give rise to new objections.

*Admittance of a line of argument (Article 13(2) RPBA)*

21. The respondent submitted that the amendment to claim 1, concerning the introduction of the guide RNA directly by particle bombardment was not suitable to confer novelty on the subject-matter of claim 1 in view of the disclosure in document D9, and referred to the disclosure in paragraph [00468] of D9. It submitted that this line of argument was foreshadowed in the notice of opposition, page 7, where novelty objections were raised against granted claim 5.
22. The appellants objected that this was a line of argument that had not been made before in the appeal proceedings and was raised for the first time in the oral proceedings before the board. As such it was an amendment to the respondent's appeal case and was not to be taken into account under Article 13(2) RPBA.
23. The board decided not to take this line of argument into account. Since the argument in question has not been made in any of the written submissions in the appeal proceedings, it represents an amendment to the respondent's appeal case. Such an amendment is, under

Article 13(2) RPBA, not to be taken into account except under exceptional circumstances, justified with cogent reasons.

24. The respondent provided no cogent reasons why the amendment to its case should be taken into account, other than referring to a submission made in its notice of opposition. However, the submissions in the proceedings before the opposition division do not form part of the appeal case as defined in Article 12 RPBA.

*Conclusion on novelty*

25. In view of the above considerations, the subject-matter of new auxiliary request 4 is novel.

*Remittal (Article 111(1) EPC, Article 11 RPBA)*

26. The appellants requested that if the board were to set aside the decision under appeal because of opposition division's finding of lack of novelty over D9 being overturned, then the case be remitted to the opposition division for further prosecution.
27. The respondent on the other hand requested that the case not be remitted to the opposition division for further prosecution, but that the board decide on the remaining issues in the opposition case itself.
28. The board considered whether to remit the case to the opposition division and decided to remit the case to the opposition division for further prosecution.
29. The factors taken into consideration were that the decision under appeal dealt with objections of lack of novelty under Article 100(a) EPC. It did not deal with

objections of lack of inventive step (Article 100(a) EPC and Article 56 EPC) or lack of sufficient disclosure (Article 100(b) EPC). The board also notes that the inventive step assessment would not follow straightforwardly from the analysis made for the question of novelty because the novelty objection was based on D9, which is relevant under Article 54(3) EPC. Prior art different from that considered in the decision under appeal would have to be taken into account.

30. Thus, considering that under Article 12(2) RPBA, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner, the board considers that the circumstances of the case represent "special reasons" within the meaning of Article 11 RPBA for remittal.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.

The Registrar:

The Chairwoman:



A. Wille

M. Pregetter

Decision electronically authenticated