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**Datasheet for the decision
of 5 May 2026**

Case Number: T 0324/24 - 3.3.08

Application Number: 16890284.9

Publication Number: 3447137

IPC: C12N9/96, C12N9/10

Language of the proceedings: EN

Title of invention:

Liquid enzyme preparation and preparation method thereof

Patent Proprietor:

Kinry Food Ingredients Co., Ltd.
Kinry Biotech (Jinan) Co., Ltd.

Opponent:

International N&H Denmark ApS

Headword:

Liquid enzyme preparation/KINRY

Relevant legal provisions:

EPC Art. 56, 104(1), 123(2)
RPBA 2020 Art. 13(2), 16(1)

Keyword:

Inventive step - (no)

Amendments - undisclosed disclaimer - allowable (no)

Amendment after summons - cogent reasons (no) - taken into account (no) - exceptional circumstances (no)

Apportionment of costs - (no)

Decisions cited:

G 0001/03, T 1137/97, T 1218/14, T 1480/16, T 0981/17,
T 0995/18, T 1151/18, T 2243/18, T 1792/19, T 2201/19,
T 1800/21, T 1402/22, T 1701/22, T 0578/24



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 0324/24 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 5 May 2026

Appellant:

(Opponent)

International N&H Denmark ApS
Paralleelvej 16
2800 Kongens Lyngby (DK)

Representative:

D Young & Co LLP
3 Noble Street
London EC2V 7BQ (GB)

Respondent:

(Patent Proprietor 1)

Kinry Food Ingredients Co., Ltd.
4th Floor (West) Building A
No.258 of Jiamei Road
Jiading District
Shanghai 201802 (CN)

Respondent:

(Patent Proprietor 2)

Kinry Biotech (Jinan) Co., Ltd.
Changan Industrial Park of Longsansi Town
Shanhe County
Jinan, Shandong 251606 (CN)

Representative:

dompatent
Partnerschaft von
Patentanwälten und Rechtsanwälten mbB
Deichmannhaus am Dom
Bahnhofsvorplatz 1
50667 Köln (DE)

Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted/
electronically transmitted on 2 January 2024
concerning maintenance of the European Patent
No. 3447137 in amended form**

Composition of the Board:

Chairwoman	T. Sommerfeld
Members:	A. Schmitt
	L. Bühler

Summary of Facts and Submissions

- I. The appeal of the opponent (appellant) is against the opposition division's interlocutory decision concerning the maintenance of European patent No. 3 447 137 (the patent) in amended form.
- II. The patent, entitled "*Liquid enzyme preparation and preparation method thereof*", was granted on the basis of European patent application No. 16 890 284.9, which had been filed as an international application under the PCT, was published as WO 2017/140051 and then published as European patent application in accordance with Article 153(4) EPC as EP 3 447 137 A1 (the application).
- III. The opposition proceedings were based on the grounds for opposition under Article 100(a) EPC in relation to novelty (Article 54 EPC) and inventive step (Article 56 EPC), as well as those under Article 100(b) and (c) EPC.
- IV. In the decision under appeal, the opposition division found, *inter alia*, that the introduction of an undisclosed disclaimer into claim 1 of the main request was allowable under Article 123(2) EPC in order to restore novelty over an accidental disclosure, and that the subject-matter of the claims of the main request involved an inventive step (Article 56 EPC).
- V. With the statement of grounds of appeal the appellant filed nine documents (D24 to D32).
- VI. With the reply to the appeal the patent proprietors (respondents) maintained the claim sets of the main

request and auxiliary request I filed in the opposition proceedings and filed a new auxiliary request II.

VII. Claim 1 of the main request reads as follows:

"1. A liquid enzyme preparation, characterized in that the liquid enzyme preparation is a liquid enzyme preparation of transglutaminase EC2.3.2.13 having an enzyme activity of 10-1000 u/ml characterized in that the liquid enzyme preparation has the following physicochemical properties:

- 1) having a pH of 5.0-9.0;
- 2) having a water activity A_w of ≤ 0.89 ; and
- 3) having a redox potential of -400mv to +50mv, except a solution of 60 U/100 μ l transglutaminase in 50% glycerol, 1 mM glutathione, 150 mM NaCl, 25 mM Tris-HCl, pH 8.0."

Claim 1 of auxiliary request I reads as follows:

"1. A liquid enzyme preparation, characterized in that the liquid enzyme preparation is a liquid enzyme preparation of transglutaminase EC2.3.2.13 having an enzyme activity of 10-1000 u/ml characterized in that the liquid enzyme preparation has the following physicochemical properties:

- 1) having a pH of 5.0-7.5;
- 2) having a water activity A_w of ≤ 0.89 ; and
- 3) having a redox potential of -400mv to +50mv."

Claim 1 of auxiliary request II reads as follows:

"1. A liquid enzyme preparation, characterized in that the liquid enzyme preparation is a liquid enzyme preparation of transglutaminase EC2.3.2.13 having an enzyme activity of 10-1000 u/ml characterized in that

the liquid enzyme preparation has the following physicochemical properties:

- 1) having a pH of 5.0-7.5;
- 2) having a water activity A_w of 0.6-0.85; and
- 3) having a redox potential of -400mv to +0mv."

VIII. On 12 December 2024, the appellant filed a response to the respondents' reply to the appeal.

IX. The board summoned the parties to oral proceedings in accordance with their requests and, in a communication under Article 15(1) RPBA, expressed its preliminary opinion on some of the matters raised.

X. On 7 April 2026, the respondents filed an auxiliary request III and six documents (D33 to D38). Auxiliary request III differs from auxiliary request II in that the product claims 1 to 7 are deleted. Auxiliary request III contains a single claim which reads as follows:

"1. A method for preparing a liquid enzyme preparation, characterized in that the liquid enzyme preparation is a liquid enzyme preparation of transglutaminase EC2.3.2.13 having an enzyme activity of 10-1000 u/ml characterized in that the liquid enzyme preparation has the following physicochemical properties:

- 1) having a pH of 5.0-7.5;
- 2) having a water activity A_w of 0.6-0.85; and
- 3) having a redox potential of -400mv to +0mv,

the method characterized by the following steps:

- 1) purification of an enzyme solution: subjecting a crude enzyme solution to pressure filtration, microfiltration, and secondary ultrafiltration, to obtain a purified concentrated enzyme solution;

2) mixing: weighing the purified concentrated enzyme solution, a water activity regulator, and a redox potential regulator quantitatively, adding a food preservative if present, and mixing; adding a pH regulator to a final volume of 100%; after mixing homogeneously, testing and adjusting the liquid enzyme preparation for the following parameters: a pH of 5.0-7.5, a water activity A_w of 0.6-0.85, and a redox potential of -400mv to 0mv;

3) bacteria removal: filtering the resulting mixture through a 0.1-0.22 μ m membrane for sterilization, followed by sterile filling;

4) package: packaging the liquid enzyme preparation by sterile filling or another relevant liquid package process."

- XI. With a submission dated 9 April 2026, the respondents filed an experimental report (D39).
- XII. The appellant replied to the respondents' latest submissions on 28 April 2026.
- XIII. Oral proceedings were held as scheduled.
- XIV. The documents referred to in this decision include the following:

- D1 Fuchs, S., "Gelatin Nanoparticles as a Modern Platform for Drug Delivery", Dissertation, LMU Munich, 2010, Chapter 3, 61-73
- D17 Barron J. et al., "The Effects of Temperature on pH Measurement" 2011, TSP-01(2), 1-7
- D19 Kölling, M., Chapter 4 "Comparison of Different Methods for Redox Potential Determination in Natural Waters" 2000, in "Redox", Springer, Berlin, Heidelberg, 42-54

D20 Topcu A. et al., "Measurement of the Oxidation-Reduction Potential of cheddar Cheese", 2008, Journal of Food Science, 73(3), C198-C203

XV. The arguments of the parties relevant to the board's decision are referred to, where appropriate, in the Reasons for the Decision.

XVI. The parties' requests relevant for the decision are as follows.

The appellant requested that the decision under appeal be set aside and the patent be revoked and that auxiliary requests II and III and documents D33 to 39 not be admitted into the proceedings. The appellant further requested apportionment of costs.

The respondents requested that the appeal be dismissed, i.e. that the patent be maintained in amended form on the basis of the main request or, in the alternative, that the patent be maintained in amended form on the basis of auxiliary request I filed on 15 October 2021 or of auxiliary request II submitted with the reply to the appeal or on the basis of auxiliary request III submitted on 7 April 2026. The respondents further requested that documents D24 to D28, D31 and D32 not be considered in the appeal proceedings.

Reasons for the Decision

Admittance of documents D24 to D28 and D31 to D32 filed by the appellant (Article 12(4) RPBA)

1. It was not necessary for the board to decide on admittance of documents D24 to D28 and D31 to D32,

which had been submitted by the appellant with the statement of grounds of appeal, as these documents were irrelevant to the board's decision.

Admittance of documents D33 to D39 (Article 13(2) RPBA)

Documents 33 to D38

2. The respondents filed documents D33 to D38 after notification of the board's communication under Article 15(1) RPBA. Under Article 13(2) RPBA, an amendment to a party's appeal case made this late in the appeal proceedings should, in principle, not be taken into account, unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
3. With respect to documents D33 to D38, the respondents asserted that these documents were filed in response to the board's preliminary opinion expressed in the communication under Article 15(1) RPBA that the redox potential was an unusual parameter. These documents reflected common general knowledge and demonstrated that the redox potential was in fact a common parameter in biotechnology, including in the context of enzyme preparations.
4. However, the assertion that the redox potential was not a parameter commonly measured in enzyme preparations was not a new argument raised by the board for the first time in the communication under Article 15(1) RPBA. Instead, it had been raised by the appellant in its notice of opposition and was discussed in the decision under appeal (point 13.2.2). The fact that the board followed the appellant's view in this matter rather than that of the opposition division and the respondents does not constitute exceptional

circumstances within the meaning of Article 13(2) RPBA. Moreover, the relevance of D33 to D38 with respect to this alleged common general knowledge is not apparent from the respondents' submission as no page or line reference in any of these documents had been provided. Without this information, it is not even possible to assess the respondents' assertion that these documents, comprising a total of 95 pages, support the respondents' allegation.

5. Consequently, contrary to the respondents' assertion, the filing of documents D33 to D38 was not a direct response to new facts or objections put forward for the first time by the board in the communication under Article 15(1) RPBA. Additionally, the relevance of these documents for the issue in question could not be ascertained based on the respondents' submission. In view of this, the board could not identify any exceptional circumstances justified by cogent reasons for admitting any of documents D33 to D38 into the appeal proceedings at this very late stage. These documents were thus not admitted into the appeal proceedings under Article 13(2) RPBA.

Document D39

6. Document D39 is an experimental report filed by the respondents even later, on 9 April 2026. The respondents asserted that it was filed in direct response to experimental report D28 submitted by the appellant with the statement of grounds of appeal and the board's preliminary opinion that it was inclined to consider D28 on appeal. It was hence an appropriate response to the board's surprising preliminary opinion. D39 demonstrated that the enzyme preparation and the concentration differences had large effects on the

redox potential. If D28 was admitted, D39 should also be admitted.

7. Both D28 and D39 relate to experimental data relevant for the disclosure in document D2. However, the board arrived at the present decision without considering document D2. It was therefore not necessary to decide on the admittance of D28 into the appeal proceedings (see point 1. above). In consequence, the board decided to not consider D39 submitted in reply to D28 in the appeal proceedings under Article 13(2) RPBA.

Admittance of a new line of argument regarding the disclosure in documents D1 and D1b (Article 13(2) RPBA)

8. During the discussion of inventive step of claim 1 of auxiliary request I in the oral proceedings before the board, the respondents argued that the physicochemical properties, in particular the redox potential, of the transglutaminase solution disclosed in document D1 were not known because the experiments presented in document D1b had been carried out with a liquid preparation that lacked transglutaminase. The redox potential recited in claim 1 of auxiliary request I was therefore a further difference of the claimed liquid transglutaminase preparation to that disclosed in D1.
9. This allegation was raised for the first time during the oral proceedings before the board and thus, under Article 13(2) RPBA, should only be admitted by the board under exceptional circumstances, justified by cogent reasons. However, this allegation is in contradiction to the respondents' arguments submitted in the context of the allowability of the undisclosed disclaimer in claim 1 of the main request when the teaching in D1 was presented as being accidentally

novelty-destroying to the claimed subject-matter without the disclaimer. Additionally, D1b was filed by the opponent with the notice of opposition, i.e. from the start of the opposition proceedings. It is therefore evident that this line of argument could have been raised much earlier in the opposition proceedings and that the respondents should have done so if they wished to rely on it.

10. In view of these facts, the board cannot recognise any exceptional circumstances of the appeal proceedings that would allow admittance of this line of argument into the proceedings under Article 13(2) RPBA and hence decided not to admit it.

Main request

Amendments (Article 123(2) EPC)

Claim 1 - undisclosed disclaimer

11. Claim 1 concerns a liquid enzyme preparation that has a basis in claims 1 and 3 of the application as filed, further amended by the introduction of the disclaimer "*except a solution of 60 U/100 µl transglutaminase in 50% glycerol, 1 mM glutathione, 150 mM NaCl, 25 mM Tris-HCl, pH 8.0*".
12. The opposition division considered that this disclaimer was allowable because it excluded an accidental disclosure in document D1, a doctoral thesis entitled "*Gelatin Nanoparticles as a Modern Platform for Drug Delivery - Formulation Development and Immunotherapeutic Strategies*".
13. According to the criteria laid down in G 1/03, a disclaimer which is not disclosed in the application as filed is allowable to restore novelty by delimiting a

claim against, *inter alia*, an accidental anticipation under Article 54(2) EPC. An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention (G 1/03; Headnote 2.1 and Reasons 2.3.3); and it must appear "*from the outset that the anticipation has nothing to do with the invention*" (G 1/03; Reasons 2.3.4; see also T 1218/14, Catchword and Reasons 2 and 7).

14. In view of this definition of an accidental anticipation, the appellant is right that the disclosure in D1 does not qualify as an accidental disclosure. D1 discloses the enzymatic cross-linking of gelatin nanoparticles with a transglutaminase preparation that contained 60 U/100 µl transglutaminase in 50% glycerol, 150 mM NaCl, 25 mM Tris-HCl at pH 8.0 (section 3.2.4 on page 65 of D1). It teaches that transglutaminase is a known non-toxic cross-linking agent routinely used to cross-link proteins in food chemistry and that therefore, it is a promising non-toxic and safe means for producing pharmaceutical gelatin nanoparticles for future application in humans (section 3.1 on page 61; section 3.5 on page 73 of D1).
15. As uncontested, the liquid transglutaminase preparation used in D1 for cross-linking gelatin nanoparticles falls under the definition of claim 1 of the main request. D1 is therefore concerned with the preparation and use of a liquid transglutaminase solution for non-toxic cross-linking of a product for use in humans. This is a similar purpose as that described in the patent for the claimed preparation which the cross-linking of proteins in food industry (paragraphs [0002] and [0003] of the patent). The disclosure in D1 is

hence not so unrelated and remote from the patent that a skilled person would never have taken it into account when working on the invention, as required by G 1/03 (*supra*).

16. The respondents asserted that an accidental disclosure did not have to be unrelated to the invention at all, but that it was sufficient that the skilled person would not have taken it into account when making the invention. Otherwise, no disclaimer for an accidental disclosure was possible at all. D1 was a large document concerned with the production of means for delivery of pharmaceuticals. It was not concerned with storage stability of transglutaminase at all. Instead, it merely contained a short description of a composition containing transglutaminase for immediate use. However, the subject-matter of the patent was not the transglutaminase enzyme or its use but was a liquid transglutaminase composition that could stably be stored at room temperature. The skilled person would never have considered D1 when attempting to solve this technical problem as D1 did not give any pointers to storage stability.
17. The board does not follow these arguments. As evident from Reasons 2.2.2 of G 1/03, the lack of a common problem alone in the patent and the prior art in question - here storage stability of a liquid transglutaminase preparation at room temperature for at least six months - is not decisive for a document being an accidental disclosure. Instead, as already discussed above (point 13.), the disclosure in the prior art in question must be entirely unrelated from a technical point of view. This is not the case because D1 and the patent both concern transglutaminase enzyme preparations used for cross-linking products for future

use in humans (see also points 14. and 15. above). The board therefore does not agree with the respondents that the skilled person would not have taken D1 into account at all when making the invention.

18. As to the respondents' assertion that if the appellant's arguments were followed, an undisclosed disclaimer could never be drafted, the board notes that an undisclosed disclaimer is indeed an exception that is allowable only under very particular circumstances. The conditions for qualifying as an accidental disclosure are therefore by its very definition rarely met. Hence, this argument is unconvincing.
19. The board therefore concludes that the teaching in D1 regarding the transglutaminase enzyme preparation does not qualify as an accidental disclosure in the sense of the definition in G 1/03. In consequence, claim 1 does not meet the requirements of Article 123(2) EPC because of the addition of an unallowable undisclosed disclaimer.

Auxiliary request I

Article 56 EPC - claim 1

20. Claim 1 of auxiliary request I is amended compared to claim 1 of the main request in that the liquid enzyme preparation has a pH value of 5.0 to 7.5 instead of 5.0 to 9.0, and in that the disclaimer is deleted (see section VII. for the full wording of the claim).
21. As the transglutaminase preparation disclosed in D1 has a pH value of 8.0 (see point 14. above), the claimed liquid enzyme preparation differs from that disclosed in D1 in that it has a pH value of 7.5 instead of 8.0.

22. The appellant asserted that the claim still lacked novelty in view of the temperature-dependency of the pH value, as evidenced by D17, and the fact that the claim did not specify the temperature. However, in view of the board's conclusion that the claim lacks an inventive step even if it is considered novel (see below), it was not necessary for the board to pursue this assertion.
23. The respondents asserted that D1 was not a suitable starting point for the assessment of inventive step because it was neither concerned with nor discussed the problem solved by the present invention, which was the provision of a liquid transglutaminase preparation with an increased stability at room temperature.
24. This argument cannot be followed, however. First, inventive step must be assessed starting from any document of the state of the art put forward and argued by an opponent. Article 56 EPC does not limit the assessment to a single prior art. The practice to select a single starting point as closest prior art is merely an efficiency tool and only appropriate if it can be shown that the same considerations apply, *mutatis mutandis*, when starting from other prior art cited in the proceedings (see e.g. T 1402/22, Reasons 2.8.1. ff).
25. Hence, inventive step cannot simply be acknowledged because the starting point is considered "unsuitable" (i.e. remote). An alleged "unsuitability" or "remoteness" of a prior art document neither replaces nor pre-empts the problem-solution analysis. Instead, starting the problem-solution analysis from a more remote prior art document merely increases the likelihood that an inventive step is acknowledged,

depending also on secondary documents on file and the objective technical problem (see e.g. T 1402/22, Reasons 2.8.4; T 1701/22, Reasons 5.1 and 5.2).

26. Second, as pointed out by the appellant, claim 1 relates to a liquid enzyme composition, i.e. a product, but neither requires a particular stability nor a storage temperature for this composition. It is therefore irrelevant for the assessment of inventive step of the claimed liquid enzyme composition that D1 is not concerned with storage stability of the disclosed enzyme preparation. According to the problem-solution analysis established by the boards of appeal, the problem to be solved is determined based on the difference of the claimed subject-matter to the disclosure in the prior art and the technical effect of that difference.
27. As indicated above (point 21.), the claimed liquid enzyme preparation differs from that disclosed in D1 in that it has a pH value of 7.5 instead of 8.0. No technical effect is known for this difference. The respondents asserted that the technical effect of this difference was an increased stability of the enzyme at room temperature, as evident from Table 1 of the patent that demonstrated that the pH value alone had a substantive effect on stability of the transglutaminase even when the composition was stored for only two days at room temperature.
28. However, Table 1 of the patent does not demonstrate this effect for the claimed enzyme composition compared to that of document D1. Instead, in the experiment described in Table 1 of the patent, the pH value is varied in concentrated enzyme solutions which neither contain a redox potential regulator nor a water

activity regulator and for which neither the redox potential nor the water activity is known. The fact that the preservation rate in this concentrated enzyme solutions was slightly higher after two days at room temperature when the pH value was 7.5 (93,80%) than when the pH value was 8.0 (90.10%) does not allow to draw any conclusions on the preservation rate of the claimed enzyme composition compared to that disclosed in D1.

29. In view of this, the board is not persuaded that the technical effect of an increased storage stability can be attributed to the change of the pH value from 8.0 to 7.5 in a liquid enzyme solution according to the claim. In the absence of a technical effect, the objective technical problem is the provision of an alternative liquid enzyme preparation.
30. A slight variation of the pH value in a liquid enzyme preparation is a standard procedure in the technical field and, in the absence of any technical effect associated with the changed pH value, amounts to an arbitrary modification that does not require any inventive activity.
31. Consequently, the subject-matter of claim 1 of auxiliary request I lacks an inventive step over the disclosure in document D1 (Article 56 EPC).

Auxiliary request II

Inventive Step (Article 56 EPC)

32. Claim 1 of auxiliary request II differs from claim 1 of auxiliary request I in that the water activity A_w of the liquid enzyme preparation is 0.6-0.85 instead of $\leq$

0.89, and in that the redox potential is -400mv to +0mv instead of -400mv to +50mv.

33. According to document D1b, the water activity of the liquid enzyme preparation of D1 is 0.801 and the redox potential is -37.9 mv (table on page 2 of D1b). As these values fall within the amended ranges recited in claim 1 of auxiliary request II, the subject-matter of claim 1 of auxiliary request II lacks an inventive step over the disclosure in document D1 for the same reasons as the subject-matter of claim 1 of auxiliary request I (Article 56 EPC; see points 21. to 31. above).
34. In view of this conclusion, it is not necessary for the board to provide its reasons for admitting auxiliary request II into the proceedings (Article 12(4) RPBA).

Auxiliary request III

Admittance (Article 13(2) RPBA)

35. The respondents filed auxiliary request III after notification of the board's communication under Article 15(1) RPBA (see section X. above). Under Article 13(2) RPBA, an amendment to a party's appeal case made this late in the appeal proceedings should, in principle, not be taken into account, unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
36. Auxiliary request III is amended compared to the previous claim requests in that the product claims are deleted and only the method claim is retained. This amendment shifts the focus of the opposition proceedings from the product claim to a method claim that was not considered in the opposition proceedings.

37. In case of deletion of claims, boards have held in several decisions 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, and did not prejudice procedural economy and procedural fairness (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).
38. However, the prevailing view is now that even a straightforward amendment, such as the deletion of claims, always constitutes an amendment to the appeal case within the meaning of Article 13 RPBA (see in particular, decision T 1800/21, Reasons 3.3 and 3.4, and the decisions cited in that decision). It needs therefore to be established whether the respondents presented any exceptional circumstances, justified with cogent reasons, which could justify the admittance and consideration of auxiliary request III in the appeal proceedings.
39. The respondents argued that the amendment was a straightforward reaction to the board's preliminary opinion that the appellant's novelty attacks were considered to be admissible. Auxiliary request III limited auxiliary request II to method claim 8 in which the subject-matter of claim 1 had been incorporated. Deletions of claims should be admitted also late in appeal proceedings. The amendments were immediately apparent to the appellant and did not require further substantiation. The argumentation for inventive step was expected to be similar to that for auxiliary request II. Hence no new discussion was needed.

40. The appellant argued that no exceptional circumstances had been invoked and there were none. No new issues had been raised in the board's communication under Article 15(1) RPBA. No inventive step arguments relating to the method claim had been put forward by the respondents in the written proceedings. Should different considerations apply compared with the previous request, the argumentation would be entirely new, as no technical context had been provided for the method claim. Such new argumentation should not be admitted either.
41. The board agrees with the appellant that there are no exceptional circumstances that could justify the admittance of auxiliary request III into the appeal proceedings. The board's preliminary opinion did not raise any new issues. The preliminary view on the admissibility of the appellant's novelty objections is not relevant to the board's finding of lack of inventive step in respect of auxiliary request II. No arguments on inventive step of the subject-matter of auxiliary request III are on file. The admittance of this request would therefore either require a completely new discussion or, in the absence of specific arguments, lead to the same conclusion as in the case of auxiliary request II. Consequently, the admittance would be contrary to either procedural fairness or procedural economy. For these reasons, the board did not admit auxiliary request III into the appeal proceedings.
42. For the sake of completeness, the following is noted in respect of the respondents' argument that deletion of claims should be admitted also late in appeal proceedings. It is true that, in case of deletion of claims, boards have in several decisions come to the

conclusion that exceptional circumstances were present and admitted the requests when the admittance of the amendments was neither detrimental to procedural economy nor to the legitimate interests of a party to the proceedings (see e.g. T 578/24, point 5.3.4, citing further decisions).

43. However, it cannot be inferred from these decisions that an alleged simplification of appeal proceedings resulting from deletion of claims generally constitutes exceptional circumstances within the meaning of Article 13(2) RPBA, especially in cases where the objections the amendments are purported to overcome have been on file for some time. Rather, exceptional circumstances concern new or unforeseen developments in the appeal proceedings, such as new objections raised by the board or another party. In any case, in the present case, the criterion of safeguarding procedural economy and procedural fairness was not met (see point 41. above).

Apportionment of costs

44. Under Article 104(1) EPC each party to opposition (appeal) proceedings shall, as a rule, bear its own costs. However, the board may for reasons of equity order a different apportionment of costs. In addition, according to Article 16(1) RPBA, the board may at request of a party order a party to pay some or all of another party's costs necessarily and reasonably incurred.
45. Under Article 16(1), second sentence, (a) and (e) RPBA, the appellant requested that the respondents bear the appellant's costs incurred by the late filing of

documents D33 to D39 which necessitated a substantive analysis and the filing of a rebuttal.

46. The appellant argued that the filing of almost one hundred pages of highly complex technical disclosures, without any explanation for their late submission and without any detailed substantiation or specific reference to any disclosure therein, constituted an abuse of procedure. The respondents thereby obscured any alleged relevance or teaching on which they might have sought to rely. The appellant and the board were therefore required to review the documents in full in order to determine whether, and to what extent, they were relevant. Although the appellant requested that these documents not be admitted into the appeal proceedings, it could not be certain that none of the respondents' late submissions would be considered, and, therefore, the appellant had to prepare a rebuttal.
47. The documents were presented as evidence to challenge a key point of the appellant's case, namely that the redox potential was an unusual parameter. This was the first time on appeal that the respondents had filed counterevidence to D19 and D20. Since the appellant risked having to start with a blank slate if one of these documents were found to be relevant, it had to make a considerable effort to identify any potentially relevant passages – which was like trying to find a needle in a haystack. The appellant was thus placed at a procedural disadvantage by having to analyse and pre-emptively respond to unsubstantiated submissions, requiring unnecessary effort. The appellant referred to decision T 1137/97, point 18, in support of their request.

48. The respondents asserted that it was summarised on page 2 of the submission dated 7 April 2026 that documents D33 to D38 merely confirmed the common general knowledge that the redox potential was not an unusual parameter and showed that this parameter had been measured in the technical field of biotechnology. It would not be expected that important information be hidden in the small print or in footnotes. The effort required to analyse documents D33 to D38 was thus reasonable. The information contained in document D39 was already discussed on page 5 of the respondents' letter of 7 April 2026.
49. Article 16(1), second sentence, (a) to (e), RPBA sets out circumstances in which an apportionment of costs may be appropriate. This is not, however, to be understood as meaning that the mere existence of the circumstances listed in Article 16(1), second sentence, (a) to (e), RPBA requires an apportionment of costs. Rather, the second sentence of Article 16(1) RPBA must be read in conjunction with the preceding sentence, which refers to the EPC, a higher-ranking legal instrument. Article 104(1) EPC provides for an apportionment of costs only where this is justified on grounds of equity. Moreover, Article 16(1), second sentence, RPBA makes clear that the board's discretion is not limited by the circumstances listed there. This means that the existence of one of the circumstances listed in Article 16(1), second sentence, points (a) to (e), RPBA does not relieve the board, when exercising its discretion, of the need to examine whether an apportionment of costs is equitable in the specific case.
50. In determining whether there are grounds of equity requiring an apportionment of costs, both the conduct

of the parties and the cost-related consequences resulting from that conduct must be taken into account and weighed against each other. An apportionment of costs on grounds of equity may therefore be considered where, due to the late submission of documents, a party's culpable failure to act with due care has caused unreasonable additional costs of more than an insignificant amount which would not have arisen had the submissions been made in due time.

51. In the present case, the respondents filed new documents only after notification of the board's communication under Article 15(1) RPBA, thereby amending their appeal case within the meaning of Article 16(1), second sentence, point (a), together with Article 13(2) RPBA. However, it is clear from the wording of Article 13(2) RPBA that even an amendment to a party's case at this very late stage of the appeal proceedings is not, in itself, blameworthy or inequitable. Rather, such an amendment may exceptionally be justified. At the same time, the requirement for exceptional circumstances justified by cogent reasons sets a high threshold for admitting such a late amendment to an appeal case. This requirement protects the other party from being surprised by an amendment at the final stage of the appeal proceedings and from having to deal with new matter arising from it. Against this background, the board considers that additional circumstances are required to justify an order for costs on grounds of equity as a result of a late amendment to a party's case.
52. Although, by filing documents D33 to D39 only a few weeks before the oral proceedings, the respondents breached their procedural obligation to conduct the appeal proceedings diligently and expeditiously, the

board considers that this conduct did not amount to an abuse of procedure. Rather, it was a last-minute attempt to fill gaps in the evidence that had become apparent from the board's preliminary opinion, even though those gaps should have been remedied much earlier had due care been exercised. Nevertheless, the volume of the documents filed, the lack of detailed substantiation or specific references to any disclosures therein, and the absence of any justification for the late filing were disrespectful to both the board and the appellant.

53. At the same time, in the absence of any substantiation and any reasonable justification, as expressly required by Article 13 RPBA, it was unlikely that any of the late-filed documents D33 to D39 would be admitted under the stringent criterion of Article 13(2) RPBA. Indeed, according to the jurisprudence of the boards, exceptional circumstances concern new or unforeseen developments in the appeal proceedings, such as new objections raised by the board or another party. A preliminary opinion by the board is not an exceptional circumstance and cannot provide a cogent reason where, as in the present case, it merely assesses what has previously been submitted by the parties.
54. Moreover, while Articles 12(4) and 13(1) RPBA still include criteria that may be regarded as reflecting the merit or relevance of any new matter filed, such as its suitability to address issues, such criteria are absent from the wording of Article 13(2) RPBA, which was deliberately chosen to express the more stringent criterion applicable at this latest stage of the appeal proceedings. Thus, merit or relevance is not subsumed under the criterion of "exceptional circumstances" and may be considered only in addition to cogent reasons.

The strict limitation of new facts and evidence filed after notification of a communication under Article 15(1) RPBA reflects the principle enshrined in Article 113(1) EPC that a party should not be taken by surprise by grounds or evidence used as the basis for an adverse decision.

55. Given these general considerations alone, it was not to be expected that the new evidence would be taken into account in the proceedings. The inadequate justification and the lack of substantiation of the new arguments may well have left the appellant uncertain as to which passages the respondents might rely on. However, the respondents thereby harmed their own case, as these shortcomings could not have assisted them in obtaining a favourable decision on the admittance of documents D33 to D39. The appellant was therefore able to confine itself to challenging the admissibility of documents D33 to D39 and to criticising the respondents' conduct of the proceedings.
56. While the board acknowledges that the appellant was right, out of due diligence and caution, to check the content of documents D33 to D39, a cursory examination would nevertheless have sufficed in the circumstances. Since the respondents characterised documents D33 to D38 as common general knowledge on redox potential, it would have been sufficient to assess whether any of these documents represented such common general knowledge. The appellant was not obliged to scrutinise the almost one hundred pages of documents D33 to D39 in order to identify information that might be detrimental to its case. It certainly did not have to check the footnotes and references in those documents.

57. Thus, despite the considerable volume of documents D33 to D39, the appellant did not have to invest excessive time and effort in dealing with them. Even accepting the appellant's argument that it could not know with absolute certainty that the documents would not be admitted and consequently had to carry out a more in-depth review when applying all due care, the appellant could have focused on the important sections, such as the summary, discussion and conclusion, of documents that could be regarded as review articles. Therefore, while the unsubstantiated filing of documents D33 to D39 constituted misconduct by the respondents, the board was not entirely convinced that the respondents' culpable failure to act with due care had caused unreasonable additional costs when taking Article 13(2) RPBA into account.
58. In decision T 1137/97, the Board admitted four documents filed one month before the oral proceedings on account of their *prima facie* relevance. The late submission by the opponent was considered to have caused unnecessary costs to the proprietor. Therefore, the board considered it equitable to make an apportionment of costs in favour of the proprietor. It should be noted, however, that this decision was issued four days before the adoption of amendments to the RPBA which introduced, *inter alia*, for the first time, provisions on the basis of appeal proceedings (Article 10a), amendments to a party's case (Article 10b) and costs (Article 11a; OJ EPO 2003, 61; see the explanatory memorandum in CA/133/02 submitted to the Administrative Council of the EPO). Following further amendments, those provisions are now Articles 12, 13 and 16 RPBA.

59. Therefore, no provision comparable to Article 13(2) RPBA existed when decision T 1137/97 was issued, which might have led to a different outcome on both admittance and apportionment of costs. Indeed, the board itself commented "*that under the new Rules of Procedure of the Boards of Appeal applicable to appeals filed after 1st January 2003 the criteria for admitting new documents are stricter, and if these rules had already been applicable in this case the result might have been different*" (T 1137/97, Reasons 16).
60. More importantly, in T 1137/97 one of the late-filed documents was considered significantly more relevant than the document that had been "central" to the assessment of novelty and/or inventive step. Indeed, the late-filed documents were considered to bring about a factual change of such weight that the case was remitted to the department of first instance. The late-filed documents therefore not only rendered the previous discussions futile but also made it necessary for the opposition division to consider the matter afresh. The opponent's culpable failure to act with due care therefore plainly resulted in unreasonable additional costs incurred by the proprietor. In view of these legal and factual differences compared to the present case, the conclusions reached in decision T 1137/97 do not apply here.
61. For the above reasons, the board rejected the appellant's request for apportionment of costs.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for apportionment of costs is rejected.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

T. Sommerfeld

Decision electronically authenticated