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D E C I S I O N
of 19 February 2003

Case Number: T 0086/01 - 3.3.8

Application Number: 91919303.7

Publication Number: 0552267

IPC: C12N 15/34

Language of the proceedings: EN

Title of invention:

Engineered bacteriophages and vaccines containing them

Patentee:

Acambis Research Limited

Opponent:

DYAX CORP.

Headword:

Engineered bacteriophages/ACAMBIS

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"Allowability of an amendment (no)"

Decisions cited:

G 0011/91, T 0260/95

Catchword:

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Case Number: T 0086/01 - 3.3.8

D E C I S I O N
of the Technical Board of Appeal 3.3.8
of 19 February 2003

Appellant: Acambis Research Limited
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Respondent: DYAX CORP.
(Opponent) 300 Technology Square
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Representative: Bassett, Richard
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 22 November 2000
revoking European patent No. 0 552 267 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: L. Galligani
Members: T. J. H. Mennessier
S. C. Perryman

Summary of Facts and Submissions

- I. The patent proprietors (the appellants) lodged an appeal against the decision of the opposition division dated 22 November 2000, whereby the European patent No. 0 552 267, was revoked. Basis for the revocation were a main request and three auxiliary requests in two versions, one for all designated Contracting States except ES and GR (non-ES, non-GR States) and one for ES and GR. None of them were found by the opposition division to comply with the requirements of Articles 84 and 123(2) EPC. They also offended Rule 57a EPC.
- II. The appellants filed a statement of grounds of appeal requesting that the decision of the opposition division be set aside and the patent be maintained on the basis of one of a new main and new four auxiliary requests for the non-ES, non-GR States filed with said statement. They requested the opportunity to submit "process claims" for ES and GR at an appropriate stage of the proceedings. Oral proceedings were also requested.

Claims 1 and 2 of the **main request** read:

"1. A filamentous bacteriophage exhibiting multiple display of a foreign peptide, including, in a proportion of its major coat protein sub-units, display of a foreign peptide of at least 9 amino-acids that elicits a biological response, and including, in balance, unmodified (wild-type) filamentous phage major coat protein, said bacteriophage having only one copy of the major coat protein gene VIII in its genome."

"2. A bacteriophage according to claim 1, wherein **the**

peptide has 9 to 20 amino-acids."

Claims 1 and 2 of the **first auxiliary request** read exactly as claims 1 and 2 of the main request.

Claim 1 of the **second auxiliary request** was also directed to a filamentous bacteriophage and differed from claim 1 of the main request essentially in that the expression "*the remaining proportion of its major coat proteins consists of*" was introduced between the terms "*balance*" and "*unmodified*".

Claim 2 of the second auxiliary request read exactly as claim 2 of the main request.

Claims 1 and 2 of the **third auxiliary request** read:

"1. A method for preparing a filamentous bacteriophage including, in at least a proportion of its major coat protein sub-units, multiple display of a foreign peptide of at least 9 amino-acids that elicits a biological response, which comprises introducing a unique restriction enzyme site into gene VIII, subcloning the thus modified gene VIII into a controllable expression vector, inserting one or more cassettes encoding the or each peptide into the vector, and assembling the protein product of the resultant vector into the wild-type bacteriophage."

"2. A method according to claim 1, wherein **the peptide has 9 to 20 amino-acids.**"

Claim 1 of the **fourth auxiliary request** was also directed to a method for preparing a filamentous bacteriophage and essentially differed from claim 1 of

the third auxiliary request in that (i) the portion of the claim "*including [...] display of*" was amended to read "*exhibiting multiple display of a foreign peptide, wherein a proportion of its major coat protein sub-units display*" and (ii) the expression "*and wherein, in balance, the remaining proportion of its major coat proteins consist of unmodified, wild type, filamentous phage proteins, and wherein said bacteriophage has only one copy of the major coat protein gene VIII in its genome,*" was added between the terms "*response*" and "*which*".

Claim 2 of the fourth auxiliary request read exactly as claim 2 of the third auxiliary request.

- III. With letter dated 30 May 2002, the opponents (the respondents) submitted that the new main request contravened the requirements of Articles 123(2) and (3), 84 and Rule 57a EPC. They also requested oral proceedings.
- IV. On 2 December 2002, the board issued a communication pursuant to Article 11(2) of the rules of procedure of the boards of appeal with a preliminary view of some of the issues to be discussed.

In particular (see point 10 of the communication), the board noted that in their letter of 4 September 2000, the appellants had referred to a passage of the **priority document**, namely, page 4, 12 lines from the bottom, which, according to their views, provided an adequate support for the amino-acid range of "9 to 20" as referred to in claim 2 of the **main request** and each of the **auxiliary requests**.

The board indicated that this passage appeared not to have any implicit or explicit support in the application as originally filed. In this respect, the board drew the attention of the appellants to the fact that, for the purpose of Article 123(2) EPC, the content of the application as filed did not include any priority document (cf T 260/95 OJ EPO 1989, 105 and G 11/91 OJ EPO 1993, 125, in particular point 7).

- V. With letter dated 3 February 2003, the appellants informed the board that they did not intend to appear at the oral proceedings scheduled to take place on 7 March 2003.
- VI. With letter dated 7 February 2003, the respondents conditionally withdrew their request for oral proceedings and provided additional comments with respect to the third auxiliary request, said request being said to contain abandoned subject-matter.
- VII. With communication dated 17 February 2003, the board informed the parties that oral proceedings were cancelled.
- VIII. The appellants requested that the decision under appeal be set aside and the patent be maintained on the basis of one of the five requests on file.
- IX. The respondents requested that the appeal be dismissed and the patent be revoked. They also made the auxiliary request that the case be remitted to the opposition division for consideration of compliance with Articles 100(a) and (b) EPC if any request was found to comply with Articles 123(2) and (3), 84 and Rule 57a EPC.

Reasons for the Decision

Procedural matters

1. The appellants' announcement of their intention not to attend oral proceedings is to be seen as an implicit withdrawal of their request that these be appointed. The appellants have also chosen not to file a reply to the board's communication and not to file amended claim requests.
2. As the respondents' request for oral proceedings is conditional, and the matter is decided in their favour, the provisions of Article 113(1) EPC are complied with.

Article 123(2) EPC

3. The amino-acid range of "9 to 20", found as an essential feature in claim 2 of all requests on file, was first introduced as an amendment in the claims during the opposition proceedings and was found in all claim requests on the basis of which the decision to revoke the patent was taken.
4. Although neither the opposition division nor the respondents have objected to this particular feature, the board has the power to assess inter alia whether this amendment, which is present in each of the requests on file, complies with the requirements of Article 123(2) EPC.
5. The appellants indicated a passage of the **priority document**, namely, page 4, 12 lines from the bottom, as a support for the feature of the amino-acid range of "9

to 20" in claim 2 of all requests. Said passage reads:
"The peptide may be antigenic, (...). Its length should be sufficient to raise the response but insufficient to modify the bactiophage's (sic) properties undesirably or to prevent incorporation, e.g. 9 to 20 amino-acids."

6. However, according to the case law of the boards of appeal, for the purpose of Article 123(2) EPC, 'the content of the application as filed' **does not include** any priority document (see T 260/85 supra and G 11/91 supra). It has thus to be assessed whether the application as originally filed contains the same passage or provides a support of a different kind.
7. The application as filed does not contain the same passage but a related passage (see lines 25 to 32 on page 5 of the published international application WO 92/07077) which differs from the passage of the priority document in that it does not end with the terms, "e.g. 9 to 20 amino-acids" but with the only terms "e.g. at least 9 amino acids", no range being given. This corresponds to claim 2 as originally filed which similarly made reference to "at least 9 amino-acids".
8. Moreover, there is no information whatsoever in the application as filed on the basis of which a person skilled in the art would directly and unambiguously understand that in order 'to be sufficient to raise the response but insufficient to modify the bacteriophage's properties undesirably or to prevent incorporation' (as mentioned in the priority document) the peptide's length **must** be in the range of 9 to 20 amino-acids.

9. The board concludes that, while the lower limit ("at least 9 amino-acids") finds a basis in the application as filed, the limitation to 20 amino-acids as upper value finds no basis. Nor have the appellants been able to provide such a basis.

10. Thus, the introduction of the feature in question in claim 2 of each and every of the requests at issue resulted in the patent being amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

11. Therefore, already for the above reason none of the requests on file comply with the requirements of Article 123(2) EPC. Under these circumstances, there is no need to examine all other outstanding issues.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani