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D E C I S I O N
of 15 March 2006

Case Number: T 0560/04 - 3.3.02

Application Number: 99947427.3

Publication Number: 1117393

IPC: A61K 31/22

Language of the proceedings: EN

Title of invention:

Use of acylcarnitines as antitumour agents

Applicant:

Universita' Degli Studi Di Catania

Opponent:

-

Headword:

Antitumour agent/UNIVERSITA' DEGLI STUDI DI CATANIA

Relevant legal provisions:

EPC Art. 54, 111

Keyword:

"Novelty - yes: second medical use"

"Remittal - yes: undecided issues"

Decisions cited:

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Catchword:

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Case Number: T 0560/04 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 15 March 2006

Appellant: Università' Degli Studi Di Catania
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Representative: Minoja, Fabrizio
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 December 2003
refusing European application No. 99947427.3
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
P. Mühlens

Summary of Facts and Submissions

I. European patent application No. 99 947 427.3 was refused by a decision of the Examining Division dated 2 December 2003 under Article 97(1) EPC with regard to Article 54 EPC (lack of novelty).

II. The decision was based on claims 1 to 4 of the main request and on claims 1 to 4 of the auxiliary request filed with letters of 26 September 2000 and 17 July 2002 respectively.

Independent claim 1 of the main request reads as follows:

"1. Use of acetylcarnitine alone or in combination with other antitumour substances, for the preparation of a medicament for the treatment or prevention of tumours."

Independent claim 1 of the auxiliary request reads as follows:

"1. Use of acetylcarnitine alone or in combination with other antitumour substances, for the preparation of a medicament for the chemoprevention of tumours."

III. The following document, cited during the proceedings before the Examining Division and the Board of Appeal, is relevant for the present decision:

(1) WO-A-9734596

IV. The arguments in the decision may be summarised as follows:

The Examining Division considered that the subject-matter of the application was anticipated by the disclosure in document (1), since this document mentioned the use of L-acetylcarnitine for the treatment of cancer.

V. The appellant (applicant) lodged an appeal against the said decision. He filed a main request and an auxiliary request together with grounds of appeal.

VI. In a communication dated 23 December 2005, the Board expressed its view that the requests on file lacked novelty vis-à-vis document (1).

VII. In reply to this communication, the appellant filed a new main request with two claims as single request 6 with its letter dated 2 February 2006.

The claims of the request read:

"1. The use of L-acetylcarnitine for the preparation of a medicament for controlling tumour relapse in resected carcinoma patients.

2. The use of L-acetylcarnitine for the treatment of patients with urinary bladder multirecurrent neoplasia."

VIII. The attention of the appellant was drawn to the wording of claim 2 of this request in a telephone conversation with the Board on 10 February 2006.

IX. A new set of claims replacing the previous one was filed on 10 February 2006.

The claims of the request read:

"1. The use of L-acetylcarnitine for the preparation of a medicament for controlling tumour relapse in resected carcinoma patients.

2. The use of L-acetylcarnitine for the preparation of a medicament for the treatment of patients with urinary bladder multirecurrent neoplasia."

X. The appellant essentially argued in its written submission that, since document (1) was silent as to the curative effects of L-acetylcarnitine on patients with urinary bladder multirecurrent neoplasia and resected carcinoma patients and also as to the glutamate levels for these patients, the subject-matter of the claims of the new request was not anticipated by document (1).

XI. The appellant requested that the decision under appeal be set aside and that the patent be granted on the basis of the set of claims filed on 10 February 2006.

Reasons for the Decision

1. The appeal is admissible.

2. *Novelty*

Document (1) discloses the use of alkanoyl L-carnitine (eg L-acetylcarnitine) for the treatment or prophylaxis of glutamate-mediated disturbance and diseases.

According to this document such high levels of glutamate were observed in individuals with tumors in the digestive apparatus, bronchial carcinomas, malignant lymphomas, Hodgkins disease and breast and ovary tumours (page 1, lines 1 to 4 and 21 to 24). The treatment of cancer is moreover mentioned on page 2, lines 7 and 8).

Document (1) is however totally silent as to the curative effects of L-acetylcarnitine on patients with urinary bladder multirecurrent neoplasia and resected carcinoma patients and also as to the glutamate levels for these patients.

Accordingly, the subject-matter of the single request on file is novel vis-à-vis the disclosure in document (1).

3. *Remittal to the first instance*

3.1 Although Article 111(1) EPC does not guarantee an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party should where possible be given the opportunity to have two readings of the important

elements of the case. The essential function of an appeal is to consider whether the decision which has been issued by the first instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is taken into consideration by the boards in cases where a first instance department issues a decision solely upon one particular issue which is decisive for the case and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issue is allowed, the case is normally remitted to the first-instance department for consideration of the undecided issues.

3.2 The observations and comments made above apply fully to the present case. The Examining Division decided that the requests were not patentable on the grounds of lack of novelty (Article 54 EPC) over a single document, but left out other essential issues such as inventive step (Articles 52(1), 56 EPC) and the remaining numerous X quoted documents cited in the search report. These issues, however, form, *inter alia*, the basis for the examination of the application and must therefore be considered as essential substantive issues in the present case.

3.3 Thus, in view of the above considerations the Board has reached the conclusion that, in the circumstances of the present case, it is necessary to remit the case to the Examining Division for further prosecution on the

basis of the set of 2 claims filed on the 10 February
2006.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

A. Townend

U. Oswald