

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

D E C I S I O N
of 6 April 2006

Case Number: T 0059/05 - 3.3.04

Application Number: 96944178.1

Publication Number: 0873414

IPC: C12P 19/44

Language of the proceedings: EN

Title of invention:
Galactopyranosides and their use

Applicant:
Procur AB

Opponent:
-

Headword:
Galactopyranosides/PROCUR

Relevant legal provisions:
EPC Art. 123(2), 113(1)
RPBA Art. 11(3)

Keyword:
"Main request, auxiliary requests I to III - added subject-
matter - (yes)"
"Violation of the right to be heard - (no)"

Decisions cited:
G 0004/92, T 0397/89, T 0157/90, T 0892/92

Catchword:
-



Case Number: T 0059/05 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 6 April 2006

Appellant:
(Applicant)

Procur AB
Andjaktsvägen 6
S-226 53 Lund (SE)

Representative:

Henriksson, Dan Ragnar Mikael
Awapatent AB
P.O. Box 5117
S-200 71 Malmö (SE)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 13 August 2004
refusing European application No. 96944178.1
pursuant to Article 97(1) EPC.

Composition of the Board:

Chair: U. Kinkeldey
Members: M. Wieser
R. Moufang

Summary of Facts and Submissions

- I. The appeal was lodged by the Applicant (Appellant) against the decision of the Examining Division to refuse under Article 97(1) EPC the patent application EP 96 944 178.1, international publication number WO 97/23 637. The patent application has the title: "Galactopyranosides and their use".
- II. Claim 1 of the only request before the Examining division read as follows:

1. Saccharide containing compound comprising at least one substance having the formula saccharide-aglycon-NHCO, wherein the saccharide is Gal α 1-3Gal α,β , GalNAc α 1-3(Fuc α 1-2)Gal β (blood group A determinant) or Gal α 1-3(Fuc α 1-2)Gal β (blood group B determinant), wherein the aglycon is an O-, N-, C-, or S-glycosidically bound group comprising one or more of the groups chosen from an aliphatic hydrocarbon, an aromatic hydrocarbon, an amino acid, a peptide, a protein, a monosaccharide, a disaccharide, or an oligosaccharide, wherein said at least one substance is bound via the NHCO group to a polymer, and wherein Gal α,β means that the configuration is α,β or a mixture of α and β .

The Examining Division decided that the requirements of Article 123(2) EPC were not met, as the published WO-application did not contain a basis for compounds, wherein a saccharide, as defined in claim 1, was bound to a polymer via a -NHCO- bond (see point (4) of the decision under appeal).

- III. With the grounds for appeal, submitted with a letter dated 22 December 2004, the Appellant filed a main request and auxiliary requests I and II. Further, oral proceedings were requested.

Claim 1 of the main request differed from claim 1 as considered by the Examining Division (see section (II) above) only in so far as the group from which the aglycon could be chosen was enlarged by "an amino group, a carboxyl group, a ceramide group, a sulphate group, an amino acid".

In claim 1 of auxiliary request I, in addition the polymer was "chosen from the group consisting of agarose, cellulose, polystyrene, polyacrylamide, polyvinylalcohol and polyethylenglycol".

- IV. The Board issued a communication on 3 November 2005, wherein it expressed the preliminary opinion that neither the claims of the main request nor of auxiliary request I met the requirements of Article 123(2) EPC. The Appellant was summoned for oral proceedings.
- V. With letter dated 6 February 2006 the Appellant filed a new auxiliary request II and auxiliary request III. He expressed his belief that the newly filed requests met the requirements of Article 123(2) EPC, that the oral proceedings could be cancelled and that the procedure should be continued in written form.

Claim 1 of auxiliary request II differed from claim 1 of the first auxiliary request (section (III) above) in so far as the polymer was defined as being agarose or cellulose.

Claim 1 of auxiliary request III read as follows:

1. Saccharide containing compound comprising at least one substance having the formula saccharide-aglycon-NHCO, wherein said at least one substance is bound to cellulose or sepharose, and wherein it is chosen from the group consisting of

Gal α 1-3Gal α -O(CH₂)₂PhNHCO-Sepharose^R
Gal α 1-3Gal α -O(CH₂)₂PhNHCO-Cellulose
Gal α 1-3Gal α -OPhNHCO-Sepharose^R
Gal α 1-3Gal α -OPhNHCO-Cellulose
Gal α 1-3Gal β 1-4GlcNAc β -OPhNHCO-Sepharose^R
Gal α 1-3Gal β 1-4GlcNAc β -OPhNHCO-Cellulose
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β OPhNHCO-Sepharose^R
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β OPhNHCO-Cellulose
Gal α 1-3Gal β 1-4GlcNAc β -O(CH₂)₂PhNHCO-Sepharose^R
Gal α 1-3Gal β 1-4GlcNAc β -O(CH₂)₂PhNHCO-Cellulose
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β 1-4Glc β OPhNHCO-Sepharose^R
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β 1-4Glc β OPhNHCO-Cellulose
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β O(CH₂)₂PhNHCO-Sepharose^R
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β O(CH₂)₂PhNHCO-Cellulose
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β 1-4Glc β O(CH₂)₂PhNHCO-Sepharose^R,
Gal α 1-3Gal β 1-4GlcNAc β 1-3Gal β 1-4Glc β O(CH₂)₂PhNHCO-Cellulose, and the compounds above in which the saccharide part is replaced with GalNAc α 1-3(Fuc α 1-2)Gal β - or Gal α 1-3(Fuc α 1-2)Gal β -, and the compounds above containing a spacer based on -O(CH₂)₆-NH₂.

VI. In a further communication, issued on 17 February 2006, the Board informed the Appellant that it was not yet convinced that any of the claim requests on file met the requirements of Article 123(2) EPC. The Board further expressed its conviction that the most expedient way to reach a final decision in the present case was to hear the Appellant in oral proceedings, which therefore would take place as scheduled.

VII. With letter dated 30 March 2006, the Appellant informed the Board that he did not intend to attend the oral proceedings. He requested to set aside the decision under appeal and to grant a patent on the basis of the following sets of claims:

- claims 1 to 25 of the main request, filed on 22 December 2004, or

- claims 1 to 25 of auxiliary request I, filed on 22 December 2004, or

- claims 1 to 26 of auxiliary request II, filed on 6 February 2006, or

- claims 1 to 11 of auxiliary request III, filed on 6 February 2006.

The Appellant's letter finished with the sentence:

"If any of the claim sets in the requests would be regarded as acceptable, but some amendments would be required, we would appreciate to be informed by telephone or in a written statement before a Decision is taken."

VIII. Oral proceedings were held on 6 April 2006 in the absence of the Appellant.

IX. The submissions made by the Appellant as far as they are relevant to the present decision may be summarised as follows:

Page 10, line 13 of the published WO-application referred to saccharides of the form Gal α 1-3Gal α -**R**. Line 18 on the same page stated that R might be a polymer and in lines 29 to 30 several examples of polymers, including agarose and cellulose are listed. The disclosure of compounds having the general formula Gal α 1-3Gal α -**A** on page 12, line 12 corresponds to Gal α 1-3Gal α -**R** on page 10. The discrepancy of terminology, R versus A, resulted from the fusion of eleven priority documents into one PCT application. The compounds disclosed on pages 10 and 12 were further characterised by the general formula saccharide-aglycon-NHCO-R on page 33, line 9. Non-limiting examples were listed from line 10 onwards. Further non-limiting examples of the formula Gal α 1-3Gal α -**A**, wherein **A** represents the -glycon-NHCO-**R** part in the formula of page 33, line 9, were given on pages 39 and 40.

Even though it was not explicitly stated in the published WO-application that compounds having the general formula saccharide-aglycon-NHCO were bound via the NHCO group to a not precisely defined polymer, the subject-matter of claim 1 of the main request, when considering the application as a whole, was implicitly disclosed therein, and thus met the requirements of Article 123(2) EPC.

The subject-matter of claim 1 of each of the three auxiliary requests had an exact basis in the published WO-application and thus was in agreement with the requirements of Article 123(2) EPC.

Claim 1 of auxiliary request I referred to the use of those six polymers which were disclosed on page 10, lines 29 to 30 of the published WO-application.

Claim 1 of auxiliary request II defined that the saccharide-aglycon-NHCO part of the claimed compounds was bound via the -NHCO group to either agarose or cellulose. Specific non-limiting examples of such compounds were given on pages 39 and 40 of the published WO-application.

Claim 1 of auxiliary request III was restricted to sixteen compounds explicitly disclosed on page 39, line 20 to page 40, line 5 of the published WO-application. In addition the claim referred to compounds wherein the saccharide part of these sixteen compounds, namely Gal α 1-3Gal-, was replaced by GalNAc α 1-3(Fuc α 1-2)Gal β - (blood group A determinant), or by Gal α 1-3(Fuc α 1-2)Gal β - (blood group B determinant). Basis for this could be found on page 48, lines 1 to 6 of the published WO-application. A further feature added to claim 1 of auxiliary request III, referring to a specific spacer contained in the claimed compounds, was based on page 39, line 10 of the published WO-application.

Reasons for the Decision

Amendments - Article 123(2) EPC

Main Request - Auxiliary Request I - Auxiliary request II

1. The published WO-application refers only in one place to compounds having the general formula "saccharide-aglycon-NHCO-", which compounds are bound via the -NHCO- group to a substance designated as "R", namely on page 33, line 9. Examples for "R" are indicated on page 10, lines 10 to 29. This list of examples, which does not include the general term "polymer" (claim 1 of the main request) or the specific polymers indicated in claim 1 of auxiliary requests I and II, is designated as being "non-limiting".
2. Page 39, lines 4 to 8 of the published WO-application refers to non-soluble separation products obtained according to the invention with the formula "Gal α 1-3Gal β -A" covalently bound to agarose or cellulose. The Applicant, in the letter dated 6 February 2006, page 1, last paragraph, first sentence, argues that "A" represents the "-aglycon-NHCO-R" part in the formula on page 33, line 9. He moreover argues that "R" in fact corresponds to "A", which can be derived from page 10, lines 12 to 19 and page 12, lines 12 to 17 of the published WO-application. The Appellant states that the inconsequent denomination occurred when eleven priority applications were fused to one PCT application (letter dated 22 December 2004, page 2; letter dated 6 February 2006, passage bridging pages 1 and 2).

3. The Board notes that the -NHCO- group is not mentioned in the cited passages on page 10, 12 and 39 of the published WO-application. The Appellant submitted that two substances, which are defined in the published WO-application differently, namely as "A" and "R", should in fact be considered by the reader as being the same. However, the application, neither explicitly nor implicitly, discloses this.

The Applicant's submission may serve as an explanation for possible mistakes having been made at the filing of the PCT application, they cannot however be used to cure the deficiencies that arise under Article 123(2) EPC, resulting from the fact that specific claims refer to subject-matter not having a basis in the published WO-application.

4. Sixteen separation products consisting of a specific saccharide, namely Gal α 1-3Gal, and of specifically defined aglycon moieties, which are bound to either Sepharose^T or Cellulose via an NHCO group are disclosed on page 39, line 20 to page 40, line 5. This list is also designated as being "non-limiting".
5. According to established case law of the Boards of Appeal, the generalisation of specific embodiments disclosed in the application is considered as an amendment of the patent application in such a way that it contains subject-matter which extends beyond the content of the application as filed contrary to the requirements of Article 123(2) EPC (cf. decisions T 157/90 of 12 September 1991, point (2) of the reasons, and T 397/89 of 8 March 1991, point (2) and (3) of the reasons).

This cannot be circumvented by an Applicant by designating the specific embodiments in the published WO-application as being "non-limiting".

6. In consequence the main request, which refers to compounds of the formula "saccharide-aglycon-NHCO-", wherein the terms "saccharide" and "aglycon" are defined as in claim 1, and which compounds are bound via the NHCO group to a polymer, does not have basis in the WO-application and does not meet the requirements of Article 123(2) EPC.
7. The same applies to auxiliary request I, in which claim 1 relates to the same compounds, which are bound via the -NHCO- group to a polymer chosen from the group consisting of agarose, cellulose, polystyrene, polyacrylamide, polyvinylalcohol and polyethylenglycol.
8. Also auxiliary request II, in which claim 1 refers to the same compounds, which are bound via the -NHCO- group to agarose or cellulose, does not meet the requirements of Article 123(2) EPC.

Auxiliary Request III

9. Claim 1 of auxiliary request III, in the first part, refers to sixteen specific compounds which are explicitly disclosed on page 39, line 20 to page 40, line 5 of the published WO-application. This first part is followed by the expression:

"..., and the compounds above in which the saccharide part is replaced with GalNAc α 1-3(Fuc α 1-2)Gal β - or Gal α 1-3(Fuc α 1-2)Gal β -, and the compounds above containing a spacer based on -O(CH₂)₆-NH₂."

The Appellant identifies page 48, lines 1 to 6 and page 39, line 9 of the published WO-application as basis for the terms introduced into claim 1.

10. The two saccharides mentioned in this term are blood group related substances and are designated in the application as "blood group A determinant" (GalNAc α 1-3(Fuc α 1-2)Gal β -) and "blood group B determinant" (Gal α 1-3(Fuc α 1-2)Gal β -) (see page 1, lines 17 to 20).

11. Page 48, lines 1 to 6 reads as follows:

"What has been mentioned above for the xenotransplantation application of saccharides can, according to the inventions also be applied to the case of donation of an organ from a human donor to a patient of blood group B or A, in which case blood group A saccharides or blood group B saccharides and/or immobilised derivatives thereof, are used in, for example, a manner corresponding to that mentioned above for the xeno case."

The Appellant argues that the expression "mentioned above" in this citation refers back almost twenty pages in the description to the paragraph bridging pages 29 and 30, where compounds comprising Gal α 1-3Gal- are described. These soluble compounds are said to be used in vivo to inhibit the hyperacute reaction in human

patients receiving xenotransplants from pigs. The compounds bind to antibodies directed towards Gal α 1-3Gal-, an antigen on the endothelium of the donor organ. Thus, the reaction between the patient's antibodies and the Gal α 1-3Gal- antigen is prevented, which is said to activate the complement system of the patient and to trigger the hyperacute reaction. Moreover, the Appellant argues (letter dated 6 February 2006, page 2, last full sentence) that the application on page 44, lines 10 to 11, discloses a specific example of a compound containing blood group B determinant.

12. The Board judges that the disclosure on page 48, lines 1 to 6 is not a basis for the specific compounds disclosed on page 39, line 20 to page 40, line 5, wherein the indicated saccharide parts are replaced by GalNAc α 1-3(Fuc α 1-2)Gal β - or Gal α 1-3(Fuc α 1-2)Gal β -.

Even if the Board would accept that the formulation "mentioned above" on page 48 of the application has to be interpreted in a way as to refer exactly to a specific passage almost twenty pages before, this cannot be used to establish a basis for the subject-matter of claim 1 in the published WO-application. As discussed in point (11) above, the passage bridging pages 29 and 30 refers to soluble compounds for in vivo use in human patients. Contrary to this the sixteen specific compounds listed in claim 1 are non-soluble products which are used to separate specific antibodies from a patient's plasma in a separation device outside the patient's body (page 38, last paragraph to page 39, line 19).

The specific example containing blood group B determinant on page 44, lines 10 to 11, mentioned by the Appellant, has the formula $\text{Gal}\alpha 1-3(\text{Fuc}\alpha 1-2)\text{Gal}\beta\text{-O}(\text{CH}_2)_2\text{PhNH}_2\text{-p}$. This compound is not one of the sixteen compounds of claim 1 and does not even contain the -NHCO- group.

13. Page 39, first full paragraph, refers to non-soluble separation products having the formula $\text{Gal}\alpha 1-3\text{Gal}\beta\text{-A}$ covalently bound to agarose or cellulose. In lines 8 to 9 it is said that "A contains a spacer; non-limiting examples of this are $\text{-O}(\text{CH}_2)_6\text{-NH}_2$, or...".

Claim 1 refers to compounds "containing a spacer **based on** $\text{-O}(\text{CH}_2)_6\text{-NH}_2$ ", (emphases added by the Board).

14. The insertion of the expression "based on" not only obscures the scope of the claim in that it is unclear and open to interpretation contrary to the requirements of Article 84 EPC, it also effects that the scope of the claim encompasses compounds containing a spacer which is different from the one specifically disclosed on page 39, lines 9 to 10 and for which no basis can be found in the published WO-application.

15. The Board judges that, for the reasons given in points (12) and (14) above, claim 1 of auxiliary request III contains subject-matter which extends beyond the content of the WO-application and therefore does not meet the requirements of Article 123(2) EPC.

Appellant's inquiry for further information

16. In a letter dated 30 March 2006, one week before the date scheduled for oral proceedings, the Appellant asked to be provided with information by telephone or in writing before a decision is taken by the Board (see section (VII) above.

17. The Board informed the Appellant in two written communications dated 3 November 2005 and 17 February 2006 of its preliminary opinion. In both said communications it was expressed that all of Appellant's claim requests suffer from shortcomings with regard to the requirements of Article 123(2) EPC. In the second communication (17 February 2006) it was emphasised that the Board was convinced that the most expedient way to reach a final decision was to hold oral proceedings.

18. Article 113(1) EPC ensures that the parties have the opportunity, during the proceedings, to present their comments on the grounds on which the subsequent decision will be based. The right to be heard is intended to ensure, in particular, that the parties to proceedings are not taken by surprise by grounds mentioned in an adverse decision, on which they have not had the opportunity to comment (cf. decision T 892/92, OJ EPO 1994,664).

19. The right to be heard remains in existence even in cases where a party who has been duly summoned nonetheless fails to appear to the oral proceedings. In decision G 4/92 (OJ EPO 1994, 149; cf. conclusion), the Enlarged Board of Appeal laid down the following principles:

- "1. A decision against a party who has been duly summoned but who fails to appear at oral proceedings may not be based on facts put forward for the first time during those oral proceedings.
2. Similarly, new evidence may not be considered unless it has been previously notified and it merely supports the assertions of the party who submits it, whereas new arguments may in principle be used to support the reasons for the decision."
20. According to the amended Article 11(3) of the Rules of Procedure of the Boards of Appeal, adopted by the decision of the Presidium of 28 October 2002 and approved by decision of the Administrative Council of 12 December 2002 (OJ EPO 2003, 60), the Board shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case.
21. In the present case, the Appellant was informed by the Board already in the first communication dated 3 November 2005 (see point (7)) that claims referring to compounds having the general formula "saccharide-aglycon-NHCO-" have no basis in the WO-application, and that therefore claims not being restricted to the specifically disclosed examples were not considered to meet the requirements of Article 123(2) EPC.

Therefore, in the light of the established case law and under consideration of the Rules of Procedure of the Boards of Appeal, the Board is in the position to reach

a final decision at the oral proceedings in the absence of the Appellant without violating Appellant's right to be heard (Article 113(1) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

Registrar:

Chair:

P. Cremona

U. Kinkeldey