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**Datasheet for the decision
of 12 October 2006**

Case Number: T 0412/06 - 3.3.02

Application Number: 00951521.4

Publication Number: 1207876

IPC: A61K 31/38

Language of the proceedings: EN

Title of invention:

Use of proteinase inhibitor in order to inhibit the cleavage
of growth factor precursor

Applicant:

Max-Planck-Gesellschaft zur Förderung

Opponent:

-

Headword:

Proteinase inhibitor/MAX-PLANCK-GESELLSCHAFT ZUR FOERDERUNG

Relevant legal provisions:

EPC Art. 83

Keyword:

"Sufficiency of disclosure - yes: objection not sufficiently
established"

Decisions cited:

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Catchword:

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Case Number: T 0412/06 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 12 October 2006

Appellant: Max-Planck-Gesellschaft zur Förderung der
Wissenschaften e.V.
Hofgartenstraße 8
D-80539 München (DE)

Representative: Weiss, Wolfgang
Weickmann & Weickmann
Patentanwälte
Postfach 86 08 20
D-81635 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 October 2005
refusing European application No. 00951521.4
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
J. Willems

Summary of Facts and Submissions

- I. European patent application No. 00 951 521.4 was refused by a decision of the Examining Division pronounced at the end of the oral proceedings of 27 September 2005 on the grounds of lack of clarity under Article 84 EPC and insufficiency of disclosure under Article 83 EPC.
- II. The decision was based on the set of claims of the main request and auxiliary requests 1 and 2, all filed with the appellant's letter dated 29 August 2005.

Independent claim 1 of the main request reads as follows:

"1. Use of a modulator which acts on a growth-factor precursor to inhibit the activation of the extracellular domain of a growth factor receptor for the manufacture of a medicament for the prevention or treatment of cancers which are induced by G-protein mediated signal transduction wherein the medicament comprises the modulator in an amount sufficient to inhibit growth-factor receptor activation at least partially."

- III. According to the decision under appeal, the Examining Division was of the opinion that the main request and auxiliary requests 1 and 2 did not fulfil the requirements of Articles 84 and 83 EPC.

The Examining Division rejected these requests because, in its opinion, they did not comply with the requirements of Article 84 EPC since the term

"modulator" was unclear because it was not defined in terms of structural features.

It moreover held that the absence of any structural teaching in the application on how to find further modulators infringes the requirements of Article 83 EPC, because, in the absence of such a teaching, it was an undue burden to test every candidate compound in order to determine whether it is a "modulator" according to the present claims.

IV. The appellant (applicant) lodged an appeal against this decision.

The appellant held in substance that according to the claims the modulator was further defined by the feature that it acts on a growth factor precursor to inhibit the activation of the extracellular domain of a growth factor receptor and that the application provided tests for determining this feature, so that it was possible to know whether a given compound was comprised within the scope of the claims.

As to objections under Article 83 EPC, it further argued that the skilled person would be able to determine the ability of a compound to act as a modulator according to the claims without undue burden because it could eliminate most of the compounds from the list of potential candidates solely on the basis of its general knowledge in the field (eg all compounds which are not proteins or which are not inhibitors of intracellular targets) even before starting to test the claimed functional features.

It added that thousands of products a day could be screened during the first screening tests just to determine if they were potential inhibitors of extracellular targets and that the end tests described in the application to determine whether the selected product acts to inhibit the activation of the extracellular domain of a growth factor receptor were easy and routine tests.

- V. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution on the basis of the set of claims of the main request or auxiliary request 1 submitted to the Examining Division, or on the basis of the sets of claims of auxiliary requests 2 to 6, filed with letter of 22 February 2006.

Reasons for the Decision

1. The appeal is admissible.
2. Main request
 - 2.1 Article 84 EPC.

The sole objection as to clarity with respect to claim 1 of the main request concerned the term "modulator" used in the claim.

The Board agrees with the findings of the Examining Division that the application as filed does not provide a structural definition for this term except for the

several specific compounds mentioned on page 8, second paragraph, of the description.

The Board observes however that the term "modulator" is further defined in terms of a functional feature, ie by the feature that "it acts on a growth factor precursor to inhibit the activation of the extracellular domain of a growth factor receptor".

Moreover, in its decision (point 3.3, second sentence) the Examining Division explicitly confirmed the appellant's view that examples of the description provided suitable tests for determining the ability of a compound to "act on a growth factor precursor to inhibit the activation of the extracellular domain of a growth factor receptor".

Under these circumstances and in the absence of any other argument from the Examining Division in that respect, it must be concluded that the claimed subject-matter is clear since it is possible for the skilled person to determine whether a given compound is comprised within the scope of the claims.

2.2 Article 83 EPC

Again, the sole objection under Article 83 EPC with respect to claim 1 of the main request concerned the term "modulator" used in the claim.

Again, the Board agrees with the findings of the Examining Division that the application as filed does not provide any structural teaching on how to find further modulators, so that every possible candidate

compound must be tested using the experiments disclosed in the application in order to determine whether it is a "modulator" according to the present claims.

The decision of the Examining Division does however not provide any further explanation as to why, in the absence of such a structural teaching, testing every possible candidate compound in order to determine whether it is a "modulator" according to the present claims represents an undue burden.

Under these circumstances and in the absence of concrete evidence or verifiable facts to the contrary, the explanations provided by the appellant during the oral proceedings that finding a further modulator does not constitute an undue burden cannot be refuted (see above, point IV, paragraphs 2 and 3).

Accordingly, it must be concluded that the application as filed fulfils, *a priori*, the requirements of Article 83 EPC.

3. Remittal

It follows from the above that the subject-matter of claim 1 of the main request fulfils the requirements of Articles 84 and 83 EPC. The examination of the present application should therefore proceed on the basis of the text according to the appellant's main request.

Having so decided, the Board has not taken a decision on the whole matter since the decision under appeal was solely based on deficiencies in claim 1 with respect to Articles 84 and 83 EPC. It is noted that the Examining

Division has not yet ruled on the other requirements for granting a European patent, and these issues clearly require careful consideration; in particular novelty.

In the light of the above findings, it is necessary to remit the case to the first instance for further prosecution.

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