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**Datasheet for the decision
of 15 May 2008**

Case Number: T 1202/06 - 3.3.08

Application Number: 95943378.0

Publication Number: 0799314

IPC: C12N 15/54

Language of the proceedings: EN

Title of invention:

Protein tyrosine kinases (PYK2) its cDNA cloning and its uses

Patentee:

Sugen, Inc., et al

Opponent:

Merck Serono International S.A.

Headword:

Protein tyrosine kinase/SUGEN et al.

Relevant legal provisions:

EPC Art. 56
RPBA Art. 12, 13

Relevant legal provisions (EPC 1973):

-

Keyword:

"Inventive step - yes"

Decisions cited:

T 0019/90

Catchword:

see points 1 to 11 of the Reasons



Case Number: T 1202/06 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 15 May 2008

Appellant: Merck Serono International S.A.
(Opponent) Chemin des Mines, 9
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Representative: Helbig, Christian
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Respondent: Sugen, Inc.
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Representative: Smith, Stephen Edward
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
24 May 2006 concerning maintenance of European
patent No. 0799314 in amended form.

Composition of the Board:

Chairman: L. Galligani
Members: F. Davison-Brunel
C. Rennie-Smith

Summary of Facts and Submissions

- I. European patent No. 0 799 314 with the title "Protein tyrosine kinase (PYK2), its cDNA and its uses" was granted on the basis of the European patent application No. 95943378.0 with 27 claims.

Claims 1 and 11 read as follows:

"1. An isolated, purified or enriched nucleic acid molecule encoding a polypeptide comprising at least 35 contiguous amino acids of the amino acid sequence of SEQ ID NO:2.

11. An isolated, purified, or enriched proline rich tyrosine kinase 2 (PYK2) polypeptide having a phosphorylation activity, wherein said polypeptide comprises at least 35 contiguous amino acids of the polypeptide sequence of SEQ ID NO:2."

Claims 2 to 10 and claims 12 to 16 respectively related to further features of the nucleic acid molecule and the polypeptide of claims 1 and 11. Claims 17 to 21 were directed to various recombinant host cells containing the DNA of SEQ ID NO:2 whereas claims 22 and 23 related to an antibody having specific binding activity to a PYK2 polypeptide, and to the corresponding antibody-producing cell line. Claims 24 to 26 were directed to various methods making use of the PYK2 polypeptide whereas claim 27 was directed to a kit making use of a DNA encoding PYK2.

- II. An opposition was filed under Article 100(a) to (c) EPC for lack of novelty and inventive step, insufficiency

of disclosure and added subject-matter. The Opposition Division maintained the patent on the basis of the fifth auxiliary request then on file. This request was identical to the granted claim request except for the fact that granted claims 2 ,3, 12 and 26 were deleted as well as the feature "at least 35 contiguous amino acids of" in claims 1, 11, 22, 24 and 26 (claims 1, 9, 19, 21 and 23 of auxiliary request V).

Thus claim 1 and 9 (previously 11) read as follows:

"1. An isolated, purified or enriched nucleic acid molecule encoding a polypeptide comprising the amino acid sequence of SEQ ID NO:2.

9. An isolated, purified, or enriched proline rich tyrosine kinase 2 (PYK2) polypeptide having a phosphorylation activity, wherein said polypeptide the amino acid sequence of SEQ ID NO:2."[sic]

- III. The appellant (opponent) filed an appeal, paid the appeal fee and submitted a statement of grounds of appeal.
- IV. The respondent (patentee) submitted a reply thereto.
- V. The Board sent a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, indicating its preliminary, non binding-opinion.
- VI. The appellant answered this communication *inter alia* raising a new objection under Article 83 EPC.
- VII. On 23 April 2008, the respondent informed the Board that it would not attend the oral proceedings due to

take place on 15 May 2008. On 14 May 2008, a clean copy of the request accepted by the Opposition Division was submitted in which claim 9 was amended by addition of the word "comprises" between the term "polypeptide" and the term "the amino acid sequence of SEQ ID NO: 2".

VIII. The documents on file which are mentioned in this decision are the following:

- (1) : Hanks, S.K. et al., Science, Vol. 241, pages 42 to 52, 1 July 1988;
- (2) : Wilks, A.F., Proc.Natl.Acad.Sci.USA, Vol. 86, pages 1603 to 1607, March 1989;
- (12) : Huang, Xin-Hun et al., Cell, Vol. 75, pages 1145 to 1156, 17 December, 1993;
- (34) : Sutcliffe, J.G., Ann.Rev.Neurosci., Vol. 11, pages 157 to 198, 1988.

IX. The appellant's arguments in writing and during oral proceedings insofar as relevant to the present decision may be summarised as follows:

Admissibility into the proceedings of the document Manser et al., Nature, Vol.363, pages 364 to 367, 1993

The appellant sought at the oral proceedings to introduce this document which it wished to rely on as closest state of the art for the purposes of its case on lack of inventive step. It argued that as this document (hereafter referred to as "Manser") was mentioned in the patent application, it was part of the

proceedings although not previously cited and although no copy had been filed. Since the respondent had mentioned it in its patent application, it must know the document so would not be prejudiced. The EPO had *ex officio* powers in opposition proceedings and the Opposition Division should have introduced the document into the proceedings and the Board of Appeal, which had the powers of the first instance, should now do so. Since the Boards of Appeal were the last stage in the process of considering validity of European patents, they should consider even late-filed documents to ensure only valid patents are upheld, notwithstanding Articles 12 and 13 RPBA which the Board drew to the appellant's attention. When asked by the Board to identify the *prima facie* relevance of Manser, the appellant referred to the fact that the words "tyrosine kinase" appeared in the title and to the sentence on page 364, left-hand column, which read: "Screening of a human hippocampal expression library with [γ -³²P] GTP-Cdc42Hs (which gives the strongest signal in tissue extracts) yielded a positive clone..."

Referral of questions to the Enlarged Board of Appeal

The appellant then requested that, if the Board was not minded to admit the Manser document into the proceedings, it should refer the following questions (subject to any appropriate re-wording) to the Enlarged Board of Appeal:

"I. A reference (prior art reference) cited in a patent application and the consequent patent not discussed under one of the grounds of opposition (e.g. Art.56 EPC) (a) does it represent late filed evidence when

used as the closest prior art in the appeal proceedings after summons to oral proceedings or during the appeal hearing for the first time? or (b) does it represent prior art to be considered part of the proceedings due to the fact that it was cited in the opposed patent whereupon a legal argument within a ground of opposition raised when filing the opposition can be based also after summons to oral proceedings at the appeal stage or during the oral proceedings of the appeal?

II. If the question I(a) is answered in the sense that such an argument cannot be made based on such a document because considered late-filed, does literature cited in a patent application/patent only represent prior art citable during proceedings if submitted as print out during the proceedings before the summons to appeal hearing in order to comply with the rules of proceedings of the Boards of Appeal?

III. If considered as late filed (I(a)) under what circumstances can such a document considered prima facie evidence relevant and be thus admissible to the proceedings at such a late stage of the appeal proceedings?"

The appellant argued that, against the application by the Board of strict rules of procedure, there was a public interest in not upholding invalid patents. Even if a document mentioned in a patent was cited in proceedings, a copy should not have to be filed since anyone could retrieve it from accessible literature. The document (but not its actual content) was part of the description of the patent. When asked by the Board

why it would be necessary to have the opinion of the Enlarged Board of Appeal on the proposed questions in order to decide the present case, the appellant did not make any submissions.

Article 56 EPC; inventive step

Sole request on file (claims accepted by the Opposition Division)

Document (2) could be considered as the closest prior art since it concerned the isolation of novel protein-tyrosine kinases (PTKs) as well as a method for cloning members of the PTK family. Starting from document (2), the technical problem to be solved was the cloning of additional members of the PTK family.

At the priority date, the cloning of numerous PTK genes had already been achieved (document (1)). Document (12) gave the motivation to use the PCR-based method of document (2) to screen a brain cDNA library in order to clone further PTKs since it taught on page 1153, left-hand column, lines 31 to 40 that there were tyrosine kinases that remained to be identified in neural tissues such as brain. In addition it was well-known in the art at the time the opposed patent was filed that foetal brain tissue expressed a large number of mRNAs. This was evidenced e.g. by document (34), page 164, line 4. Indeed this fact was equally reflected in the great number of scientific articles published in the years immediately preceding the priority date of the patent in suit describing the cloning of numerous genes from brain tissue.

In addition, there were no documents on file to show that the claimed subject-matter could not be arrived at using some other tissues than brain tissue as the starting material for cloning.

Finally, in view of the "comprising..." claim language, claims 1 and 9 encompassed embodiments beyond those consisting of the sequence of PYK2 as depicted in the claims. One example thereof would be a fusion protein consisting of a claimed sequence and e.g. part of an antibody. The domain representing the PYK2 function as such may very well be non functional due to the interactions of the combined sequences. Hence the claims encompassed embodiments which would not solve the problem and, thus, contravened Article 56 EPC.

Articles 83 and 84 EPC; sufficiency of disclosure, support in the description

The opposed patent did not give any guidance on how to arrive at all embodiments covered. The description provided neither a single example of e.g. fusion proteins, nor any general notion of such fusion proteins. The skilled person was, thus, not put in a position to reproduce the subject-matter as claimed. He/she would have to apply undue burden to work all possible embodiments. The same argument was equally valid under Article 84 EPC as there was no support in the description for e.g. fusion proteins which were nonetheless comprised within the claim.

- X. The respondents (patentees)'s arguments in writing insofar as relevant to the present decision may be summarised as follows:

Document (2) related to the cloning of PTK cDNA from hemopoietic cells of murine origin. Although it was speculated that PCR-based methodologies might lead to the identification of PTK-related sequences, it was not suggested to isolate PTK DNA from neural tissue, let alone from a human brain cDNA library as used in the identification of the PTK2 polypeptide of the present invention.

In its grounds of appeal, the appellant had made reference to documents (1), (12) or (34) which it alleged would provide motivation for a skilled person to use a human brain cDNA library. However, given that document (1) disclosed a high number of PTK family members isolated from cDNA libraries other than brain, it could not be regarded as obvious to select a brain cDNA library from the different cDNA libraries available. Likewise, document (12) merely speculated that other PTK members may exist. The appellant's reliance upon the review article, document (34), was completely ill-founded since that document was in an unrelated field and would not have been considered by the person seeking to clone a new PTK family member.

The choice of a human brain cDNA library for starting the cloning of PTK was not an obvious choice.

- XI. The appellant requested that the document Manser et al., Nature Vol. 363, 27 May 1993, pages 364 to 367 be admitted into the proceedings and, if not, that the questions mentioned in IX *supra* be referred to the Enlarged Board of Appeal; and also requested that the

decision under appeal be set aside and that the patent be revoked.

The respondent requested that the appeal be dismissed.

Reasons for the decision

Admissibility of the document Manser et al., (supra) in the proceedings

1. In considering the appellant's request made during the oral proceedings before the Board to admit Manser into the proceedings, the Board must apply the provisions of both the Rules of Procedure of the Boards of Appeal ("RPBA") and the case-law relating to late-filed evidence and related matters (see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, VI.F "Late submission", pages 388 to 406). Those provisions make clear that the Board has a discretion to admit such evidence and that, in exercising that discretion, it must consider a range of factors including the degree of lateness, any reasons for the lateness and the possible relevance of the new evidence. The following paragraphs 2 to 6 summarise the effect, as the Board sees it, of the various provisions of the law on the appellant's request.
2. The request would, if allowed, mean the appeal proceedings would be based on more than its case as filed in its grounds of appeal and its reply to the Board's communication (see Article 12(1) RPBA). Thus the provisions of the Article 13 RPBA regarding amendment of a party's case are immediately engaged

(see 5 *infra*). The Board notes that Manser is a document which is not just publicly available but which has been known to all parties since before the opposition proceedings. The appellant stressed that it was known to the respondents since it was cited in their patent application (now the patent in suit), but it must equally be the case that it was also known to the appellant from at least the time it considered the patent and prepared its opposition. The appellant acknowledged it had not cited or relied on Manser in its notice of opposition or subsequently in the opposition proceedings or in its grounds of appeal or in its reply to the Board's communication or at any other time until the oral proceedings.

3. Article 12(2) RPBA requires that the statement of grounds of appeal shall contain the appellant's complete case and set out clearly and concisely the reasons why it requests that the decision under appeal be reversed or amended or upheld; and that it should specify expressly all the facts, arguments and evidence relied on, and that all documents referred to shall be attached as annexes unless previously filed or produced by the Office in any EPO proceedings. It is clear that the appellant did not comply with Article 12(2) in that, although it could have done so, it did not refer to Manser in its grounds of appeal and did not annex a copy of the document. Accordingly its grounds of appeal did not contain its complete case, did not contain all its reasons why the decision under appeal should be amended, and did not set out all the facts, arguments and evidence it relied on.

4. It follows from the appellant's own acknowledgment that Manser could have been relied on at first instance that the Board's power, referred to in Article 12(4) RPBA to hold inadmissible facts, evidence or requests which could have been present in the first instance proceedings, may be applicable. That apart, Article 12(4) says the Board shall take into account everything presented under Article 12(1) RPBA if and to the extent it relates to the case under appeal - in other words, if it is relevant - and meets the requirements in (2) - in other words, if Article 12(2) RPBA has been complied with. Those requirements are cumulative i.e. both must be satisfied. As already indicated (see 3 *supra*), the appellant did not comply with Article 12(2) RPBA although it could have done so. As regards the possible relevance of Manser, this is considered in 6 *infra* but it must follow from the Board's conclusion there, to the effect that Manser is not *prima facie* relevant, that it would not necessarily have been considered even if relied on in, and filed with, the grounds of appeal.
5. The appellant's request to admit Manser (and its clear intention to present new arguments based thereon) formed beyond any doubt a proposed amendment to its case. Article 13 (1) RPBA provides that any such amendment after (in the case of an appellant) filing the grounds of appeal may be admitted and considered at the Board's discretion which shall be exercised in view of *inter alia* three matters - first, the complexity of the new subject matter submitted which, since Manser is in the Board's view not even *prima facie* relevant, need be taken no further; second, the current state of the proceedings which in this case is the very last moment

- there can be no later point in *inter partes* proceedings than the oral proceedings in an appeal - and this must count against the appellant; and third, the need for procedural economy as to which it is self-evident that there would be no such economy if this request were to be allowed. As regards Article 13(2) RPBA, it is clear that by only presenting this request at the oral proceedings (which the respondents had already announced they would not attend) the appellant would have made it impossible for the respondents to submit their observations without an adjournment of the oral proceedings; and it is therefore equally clear that, if the request were to be considered allowable for any other reason, it would have to be refused under Article 13(3) RPBA.

6. A further factor consistently considered by Boards of Appeal in deciding the admissibility of late-filed evidence is the relevance of such evidence (see "Case Law etc", *op cit*, VI.F.3 "Examination as to relevance", pages 392 to 400; Article 12(4) RPBA and 4 *supra*). In this respect, the appellant appeared to view Manser as *prima facie* relevant because the words "tyrosine kinase" in the title and the sentence on page 364, left-hand column (see IX *supra*) indicated **broadly** to the appellant how to isolate any and all PTK gene. In the Board's view this disclosure is in fact so **specific** that it would require detailed consideration by a skilled person before being of any use - it deals with the screening process for identifying the DNA encoding a tyrosine kinase that specifically binds Cdc42Hs in its GTP bound form. Accordingly, it cannot be considered even *prima facie* relevant.

7. As appears from paragraphs 2 to 6 *supra*, the appellant made no attempt to argue in favour of its request by reference to the established provisions of the law relating to late-filed evidence. As already indicated, it freely acknowledged the extreme lateness of the request, it offered no reasons why Manser had not been relied on previously, and it only commented on the relevance of Manser when asked by the Board to do so. Rather, the appellant relied on arguments which, if accepted, would override all other considerations including the relevant provisions of the law of evidence.

8. The first argument was that, as Manser was mentioned in the patent application, it was part of the proceedings although not previously cited and although no copy had been filed. The Board cannot agree. There are often many references in a patent or patent application and such references may range from highly pertinent items of prior art to manuals cited for their description of a known technique. Similarly, the amount and the importance of relevant information to be drawn from any one particular reference may vary enormously. In the present case, in the description (not including sequence listings) of the patent as published the Board has counted 232 references (Manser being the 222nd) to other works including other patent literature, scientific publications, textbooks and manuals, some of those works being the subject of more than one reference. It would be almost absurd to suggest that all those referenced works automatically formed part of the proceedings. It is always possible that one or more of the works referenced in a patent may include an item of prior art, whether identified as such or not but, if

an opponent wishes to rely on such a work, it must be his responsibility to consider whether it assists its case and, if so, to cite it in his notice of opposition and to file a copy - in short, to treat it like any other item of documentary evidence relied on.

9. The appellant's second argument was that, since the respondents had mentioned Manser in their patent application, they must know the document so would not be prejudiced by its late admission into the proceedings. The case-law of the Boards of Appeal does acknowledge that, when considering late-filed evidence, there may be a slightly stronger case for admitting prior art documents which are already known to the patentee such as those mentioned in the patent under attack and/or the search report (see "Case Law etc", *op cit*, VI.F.7 "Documents cited in the patent or the search report", pages 402 to 403). There is however nothing in that case-law which suggests that if late-filed such documents should be given any special treatment just because they are so mentioned - on the contrary it is their relevance as prior art which merits their possible late admission, the patentee's knowledge of them being at most a secondary consideration. This is far removed from the present case in which Manser was cited in the patent but not referred to as close prior art and did not appear to the Board to have any particular relevance as prior art. Moreover, if knowledge of the prior art resulting from citation in the patent in suit should be a consideration, it must be borne in mind that the opponent has been familiar with the patent at least since it filed opposition in April 2004 yet, as it

acknowledges, it never sought to rely on Manser until now.

10. The appellant then argued that, although it never took any steps until the last day of the appeal proceedings to rely on Manser, the Opposition Division should have introduced the document into the proceedings *ex officio* and, since it did not, the Board of Appeal should now do so. While it is correct both that the Opposition Division has the power to introduce objections *ex officio* and that the Board can exercise the powers of the first instance (see Article 111(1) EPC), such powers are discretionary and the discretion must be exercised in accordance with the guidance provided by the law. None of the appellant's arguments even begins to address the established legal considerations, rather they purport to bypass those considerations in favour of some general right of opponents to a belated change of attack. The Board however, while it has a large measure of discretion in relation to late-filed evidence, must exercise that discretion by assessing the facts of the case according to the established principles which must lead to refusal of the request. The Manser document is not admissible.

Request to refer questions to the Enlarged Board of Appeal

11. The appellant's arguments in support of this request added very little to those in support of the request to admit Manser into the proceedings. It said not only that there was a public interest in not upholding invalid patents, which is undeniably correct, but also that this should prevail over the application by the Boards of rules of procedure, which is undeniably

incorrect (and clearly demonstrated that the appellant could only succeed if allowed to side-step the existing legal principles). The further argument - that a document mentioned in a patent was part of the description and, if cited in proceedings, a copy should not have to be filed since anyone could retrieve it from accessible literature - does not in the Board's view assist the appellant: if the argument that mere reference to a document in a patent makes it part of the proceedings cannot prevail over the principles of the RPBA and the case-law, the distinction between actual filing of the document and not cannot make any difference. However, these observations are only *obiter* since the appellant did not address the key question, specifically posed by the Board namely, even if the appellant's proposed questions for the Enlarged Board might involve an important point of law (see Article 112(1) EPC), why would the Enlarged Board of Appeal's opinion be necessary to decide the present case (see "Case Law etc", *op cit*, VII.D.13.2 "Important point of law", pages 638 to 639)? As is clear from the reasons in 1 to 10 *supra*, the Board felt that the appellant's request to admit late-filed evidence could be disposed of entirely adequately according to the established law. In the Board's opinion there is no point of law which needs to be referred and, further, no need in any event to do so to decide the present case. Therefore the request to make a referral to the Enlarged Board of Appeal must be refused.

Article 56 EPC; inventive step

Sole claim request on file (claims accepted by the opposition division)

12. The opposition division and both parties considered that of all documents on file, document (2) represented the closest prior art. The Board also shares this opinion.

13. Document (2) teaches the isolation of two novel putative PTK coding sequences /PTK proteins, using the polymerase chain reaction (PCR). The clones carrying these sequences are obtained as PCR-amplified products of cDNA generated by using the mRNA of a murine hemopoietic cell line as template and polynucleotides based upon the consensus sequences derived from highly conserved regions of 13 PTKs as primers. The two cloned sequences are considered as being representative members of a new PTK sub-family (page 1606, left-hand column, end of first paragraph). Further attempts at isolating more members of this sub-family using mouse brain cDNA as template are said to have failed which led the authors to conclude:

"Because of the complexity of brain RNA and the sensitivity of the amplification technique, it can be tentatively concluded that the existence of other related sequences is unlikely..."

In contrast, in the "Prospects" part of the article, it is observed that:

"It seems unlikely that the precise protocol employed in this study provides an exhaustive catalogue of all

of the PTKs present within a cell, and many variations suggest themselves as potential improvements to the approach..."

The Board understands the teachings of this document as being on the one hand that there should be more PTKs to be identified and, on the other, that there would be no point in turning to brain tissue as an alternative starting material for their isolation.

14. Starting from the closest prior art, the problem to be solved could be defined as the provision of further PTK encoding DNA sequences.
15. The solution provided is a PTK coding sequence derived from human brain cDNA libraries (patent as granted [0290]). It is readily evident that the above mentioned teaching of the closest prior art taken on its own does not render obvious the specific choice of brain tissue.
16. The appellant argues that it would have been obvious to choose human brain tissue as a starting material on the basis of the suggestion in document (12) of the existence of a PTK of neural origin (page 1153, left-hand column, middle paragraph). The Board is not convinced by the argument. Document (12) is a biochemical study of the ability of the specific m1 mAChR receptor to modulate the activity of a delayed rectifier type K⁺ channel whereby m1 mAChR utilizes a signal transduction pathway involving in particular a cellular tyrosine kinase. It is not concerned with identification of new sub-groups of the PTK family members nor with the identification of any potential new PTK enzymes. In fact, it is only "in passing " on

page 1153, left-hand column that the potential existence of such a new enzyme in the **leech** is mentioned in rather vague terms:

"an **undefined** tyrosine kinase activity **may be** involved in the modulation of cation channels induced by neuronal contacts in the **leech**..." (emphasis added by the board)

In the Board's judgment, this statement even if taken in combination with the teachings of document (2) does not render obvious the choice of human brain tissue as a starting point for the cloning of a PTK gene.

17. Furthermore, reliance was placed on document (34) and alternatively - for the first time at oral proceedings - on the sum total of the cloning work done in the years immediately preceding the priority date of the patent in suit starting from brain tissue libraries, as evidence that the common general knowledge of the skilled person would obviously lead him/her to use such libraries for cloning PTK genes.
18. Document (34) is indeed a review article on "mRNA in the mammalian central nervous system" which may be regarded as common general knowledge. It does not mention PTK enzymes and the alleged relevant passage is on page 164 under the heading "Many mRNAs are expressed in the brain":

"The brain is a very complex entity with about one third of the mammalian genome exclusively dedicated to function..."

The information goes no further than that provided by document (2) (see 13 *supra*) concerning the complexity of brain RNA - RNA being the cellular intermediate in the synthesis of proteins which then ensure function. While acknowledging brain RNA complexity, the authors of document (2) nonetheless concluded that brain tissue would not be the source of additional PTK DNAs. For this reason, the very scant teaching of document (34) which is referred to is not considered relevant.

19. Another document which was referred to as making obvious the cloning of the PTK2 gene from human brain tissue was document (1). Table 2 of this document published in 1988 lists very many protein tyrosine-kinase family members. Yet, of the 21 PTKs of human origin which are mentioned, none of them originates from brain tissue. Accordingly, document (1) cannot be relevant to inventive step.

20. As already mentioned in 17 *supra*, the further argument that the number of cloning experiments achieved from brain cDNA libraries in the years preceding the priority date was evidence that it would be obvious for the skilled person to use such libraries for the isolation of any genes and, more specifically, PTK genes was raised for the first time at oral proceedings and, furthermore, it was not substantiated on the basis of any documents on file. For this reason, the Board has no way to assess its validity. Yet, there again, the same reasoning as developed as regards the relevance of document (34) applies. It may well be that much cloning was done starting from brain cDNA libraries in the year preceding the priority date but

- the skilled person aware of document (2) would not obviously consider such an approach as a sensible one.
21. The point was also made that, in any case, one would have come to the same solution, i.e. the PTK sequence of SEQ ID NO: 2, starting from a number of other tissues than brain tissue. Unfortunately, this is a mere assumption and, thus, it cannot have any bearing on inventive step.
 22. Finally, the appellant argued that the "comprising.." claim language used in claims 1 and 9 (see II, supra) implied that the claims must cover embodiments which did not have the property of encoding a functional PTK (claim 1) or would not have the activity expected from a protein tyrosine kinase (claim 9), i.e. that inventive step would not be achieved over the scope of the claim.
 23. The argument is irrelevant as regards claim 9 which is clearly restricted to those polypeptides with tyrosine kinase activity. As regards the same objection raised against claim 1, it is necessary to keep in mind that the use of the term "comprising" in claim drafting is an absolutely common practice. In most cases, this practice is considered acceptable and even necessary to give due recognition to the fact that the contribution to the art made by the patent goes beyond the literal disclosure of the invention as exemplified. Of course, one may always theoretically conceive of embodiments which would not have those properties required for inventive step to be acknowledged. Here, no evidence is provided as to which specific embodiments would not

work; it is merely assumed that some of them (e.g. some unidentified fusion proteins) might not.

24. In the board's judgment, this lack of evidence is clearly inappropriate to justify deviating from the common practice. Thus, the corresponding argument does not deprive of inventive step the subject-matter of claim 1, nor that of the other claims.
25. In the written part of the procedure, further arguments were raised by the appellant against inventive step, e.g. on the basis of the cloning process *per se*. Since inventive step is already acknowledged on the basis of the choice of the starting material for cloning, these further arguments need not be considered.
26. For the reasons given in points 12 to 24, it is concluded that the requirements of Article 56 EPC are fulfilled.

Articles 83 and 84 EPC; sufficiency of disclosure, support in the description

27. In its answer to the board's communication dated 14 April 2008, the appellant raised a new objection under Article 83 EPC. The earlier objections raised in opposition proceedings under this provision of the law were different and not directed to the same subject-matter. The grounds of appeal do not at all refer to Article 83 EPC. In this situation, it is unavoidable that reference is made to the Articles 12(2) and 13(1) RPBA (see points 3 and 5 *supra*) which have not been complied with as regards this new objection also.

28. In any case, this objection is also not relevant taking into account the established case law (T 19/90 OJ EPO, 1990, 476) that an argument as regards lack of sufficient disclosure is only likely to succeed if there are serious doubts substantiated by verifiable facts that the claimed subject-matter cannot be reproduced without undue burden. This is clearly not the case here since the appellant simply observes that "the description does not give any guidance in how to arrive at all embodiments covered".
29. At oral proceedings, the same objection as raised under Article 83 EPC was raised under Article 84 EPC - on the basis that the claim request on appeal was not the granted claim request. It fails if only for the same reasons as given just above.
30. There is no evidence on file that the claimed subject-matter could only be reproduced over the whole scope of the claims with undue burden nor that the description does not provide adequate support for that which is claimed taking into account the common general knowledge of the skilled person at the priority date. The requirements of Articles 83 and 84 EPC are fulfilled.

Order:

For these reasons, it is decided that:

1. The document Manser et al., Nature, Vol. 363, 27 May 1993, pages 364 to 367 is not admitted into the proceedings;
2. The request to refer questions to the Enlarged Board of Appeal is refused;
3. The appeal is dismissed.

The Registrar

The Chairman

A. Wolinski

L. Galligani