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**Datasheet for the decision
of 16 May 2008**

Case Number: T 0577/07 - 3.3.10

Application Number: 00911673.2

Publication Number: 1144375

IPC: C07C 327/30

Language of the proceedings: EN

Title of invention:
SYNTHESIS OF OLIGOKETIDES

Patentee:
Kosan Biosciences, Inc.

Opponent:
-

Headword:
Oligoketide synthesis/KOSAN BIOSCIENCES

Relevant legal provisions:
EPC Art. 123(2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"All requests: Amendments (not allowable) - added subject-matter"

Decisions cited:
-

Catchword:
-



Case Number: T 0577/07 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 16 May 2008

Appellant: Kosan Biosciences, Inc.
1450 Rollins Road
Burlingame, CA 94010 (US)

Representative: W.P. Thompson & Co.
Coopers Building
Church Street
Liverpool L1 3AB (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 12 October 2006
refusing European application No. 00911673.2
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: R. Freimuth
Members: J. Mercey
D. S. Rogers

Summary of Facts and Submissions

- I. The appeal lodged on 11 December 2006 lies from the decision of the Examining Division posted on 12 October 2006 refusing European patent application No. 00 911 673.2.
- II. The decision under appeal was based on amended sets of claims according to a main and three auxiliary requests. In its decision, the Examining Decision held that the subject-matter of the main, second and third auxiliary requests extended beyond the content of the application as filed (Article 123(2) EPC) and that the subject-matter of the first auxiliary request did not meet the requirements of unity of invention (Article 82 EPC).
- III. With the Statement of Grounds of Appeal, dated 21 February 2007, the Appellant (Applicant) submitted a main request and two auxiliary requests.

Claim 1 of the main and first auxiliary request reads as follows:

"A method to prepare a chiral diketide or triketide N-acylcysteamine thioester which method comprises treating a 2-oxazolidinone carrying said chiral diketide or triketide on the nitrogen atom of the 2-oxazolidinone moiety with the lithium salt of the thiol anion of an N-acylcysteamine in the presence of Lewis acid to reduce the basicity of the thiol anion so as to form the N-acylcysteamine thioester of said diketide or triketide."

Claim 1 of the second auxiliary request reads as follows:

"A method of preparing a diketide N-acylcysteamine thioester which method comprises treating an imide from a 2-oxazolidinone and said diketide with the lithium salt of the thiol anion of the N-acylcysteamine in the presence of Lewis acid to reduce the basicity of the thiol anion so as to form the N-acylcysteamine thioester of said diketide."

- IV. In a communication dated 8 February 2008 (see points 3.3 and 5) pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal and annexed to the summons to oral proceedings, the Board raised doubts as to whether *inter alia* claim 1 of each of the requests met the requirements of Article 123(2) EPC as regards the deletion of the feature "sufficient".
- V. In reply, without making any substantive submissions in response to this objection, the Appellant informed the Board by letter dated 10 April 2008 that it did not intend to attend oral proceedings and requested a decision on the basis of the written submissions previously presented.
- VI. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for grant of a patent on the basis of the claims of the main request or, alternatively on the basis of the claims of the first or second auxiliary requests, all requests dated 21 February 2007.

VII. At the end of the oral proceedings held on 16 May 2008 in the absence of the Appellant, the Board gave its decision.

Reasons for the Decision

1. The appeal is admissible.
2. Claim 1 of each of the requests on file is based on claim 1, method b) of the application as filed. Amongst the amendments made to claim 1 of each of the requests on file *vis-à-vis* original claim 1 is the deletion of the feature "sufficient" quantifying the amount of Lewis acid to be used.

The feature "sufficient" implies that an adequate amount of Lewis acid must be present. The deletion of said term extends the subject-matter claimed, since in the absence of said term, **any** amount of Lewis acid may be present. The Appellant has not provided any basis in the application as filed for the deletion of said feature, nor can the Board find any basis in the application as filed for this amendment.

3. In the communication dated 8 February 2008, the Board had already indicated to the Appellant that the deletion of the feature "sufficient" raised doubts as to whether the requirements of Article 123(2) EPC were met. The Appellant neither commented on this objection in writing, nor attended the oral proceedings.
4. The content of claim 1 of each of the requests on file thus extends beyond the content of the application as

filed (Article 123(2) EPC). None of the Appellant's requests is therefore allowable.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Cremona

R. Freimuth