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Datasheet for the decision of 2 September 2013

Case Number: T 2311/09 - 3.3.08

Application Number: 94926324.8

Publication Number: 719331

IPC: C07K 14/52, C07K 16/24

Language of the proceedings: EN

Title of invention:
Eotaxin - Eosinophil Chemotactic Cytokine

Patent Proprietor:
Imperial Innovations Limited

Opponents:
IPO Therapeutics Inc.
Cambridge Antibody Technology Limited Milstein Building

Headword:
Eotaxin/IMPERIAL INNOVATIONS LTD.

Relevant legal provisions:
EPC Art. 54, 84, 87

Keyword:
"Main and auxiliary request 1 - novelty (no)"
"Auxiliary requests 2-6 - clarity (no)"

Decisions cited:
G 0009/92, G 0002/98

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 2311/09 - 3.3.08

D E C I S I O N
of the Technical Board of Appeal 3.3.08
of 2 September 2013

Appellant: (Patent Proprietor)	Imperial Innovations Limited Level 12 Electrical and Electronic Engineering Building Imperial College London SW7 2AZ (GB)
Representative:	Potter Clarkson LLP The Belgrave Centre Talbot Street Nottingham NG1 5GG (GB)
Respondent: (Opponent 1)	IPO Therapeutics Inc. 760-777 Hornby Street Vancouver BC V6Z 1S4 (CA)
Respondent: (Opponent 2)	Cambridge Antibody Technology Limited Milstein Building Granta Park Cambridge CB1 6GH (GB)
Representative:	Sutcliffe, Nicholas Robert Mewburn Ellis LLP 33 Gutter Lane London EC2V SAS (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted 28 September 2009 concerning maintenance of European patent No. 719331 in amended form.**

Composition of the Board:

Chairman: M. Wieser
B. Stolz
C. Heath

Summary of Facts and Submissions

I. The patent proprietor (appellant) filed an appeal against the interlocutory decision of the opposition division to maintain European patent No. 719331 on the basis of auxiliary request IV filed during oral proceedings on 22 July 2009.

The opposition division decided that the main request before it (the claims as granted) lacked novelty (Article 54 EPC), that auxiliary request I did not meet the requirements of Article 123(3) EPC, that auxiliary request II lacked novelty (Article 54 EPC), and that auxiliary request III did not meet the requirements of Article 123(2) EPC.

II. With its statement setting out the grounds of appeal, the appellant filed 7 auxiliary requests.

Auxiliary request 7 is the request as maintained by the opposition division. Auxiliary requests 1, 2, 5 and 6 are new requests. Auxiliary requests 3 and 4 are identical with auxiliary requests II and III, respectively, of the opposition proceedings.

III. With their response to the grounds of appeal, opponents I and II (respondents I and II) filed new documents D46 to D55).

IV. The parties were summoned to oral proceedings to be held on 20 August 2013. A communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to the summons, informed them of the preliminary non-binding opinion of the board

that neither the claims as granted nor any of auxiliary requests 1 to 6 seemed to meet the requirements of the EPC and that the appeal was likely to be dismissed.

V. With letter dated 17 June 2013, the appellant informed the board that it did not intend to attend the oral proceedings.

VI. On 12 July 2013, the board informed the parties that oral proceedings were cancelled.

VII. Claim 1 of the main request and of auxiliary requests 1 to 6 read (emphasis added for comparison):

Main request (claims as granted):

"1. An isolated chemoattractant protein capable of attracting eosinophils and of inducing eosinophil accumulation and/or activation in vitro and in vivo and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1, or a fragment of said chemoattractant protein which retains its biological activities."

Auxiliary request 1:

"1. An isolated chemoattractant protein capable of attracting eosinophils and of inducing eosinophil accumulation ~~and/or activation~~ in vitro and in vivo and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence having at least 40% identity with

the amino acid sequence set out in SEQ ID NO. 1, or a fragment of said chemoattractant protein which retains its biological activities."

Auxiliary requests 2 and 3:

"1. An isolated chemoattractant protein capable of attracting eosinophils and of inducing eosinophil accumulation ~~and/or activation~~ in vitro and in vivo and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence from a species other than guinea-pig having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1 or a guinea-pig amino acid sequence having at least 50% identity with the amino acid sequence set out in SEQ ID NO. 1, or a fragment of said chemoattractant protein which retains its biological activities."

Auxiliary request 4:

"1. An isolated chemoattractant protein, not being MCP-3, capable of attracting eosinophils and of inducing eosinophil accumulation ~~and/or activation~~ in vitro and in vivo and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence from a species other than guinea-pig having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1 or a guinea-pig amino acid sequence having at least 50% identity with the amino acid sequence set out in SEQ ID NO. 1, or a fragment of said chemoattractant protein which retains its biological activities."

Auxiliary request 5:

"1. An isolated chemoattractant protein, not being MCP-3, capable of attracting eosinophils and of inducing eosinophil accumulation ~~and/or activation~~ in vitro and in vivo when administered in vivo and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence from a species other than guinea-pig having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1 or a guinea-pig amino acid sequence having at least 50% identity with the amino acid sequence set out in SEQ ID NO. 1, or a fragment of said chemoattractant protein which retains its biological activities."

Auxiliary request 6:

"1. An isolated chemoattractant protein capable of attracting eosinophils and of inducing eosinophil accumulation ~~and/or activation~~ in vitro and in vivo when injected intradermally into assay guinea-pigs previously given intravenous injections of ^{111}In-eosinophils and which shows substantially no attractive effect for neutrophils in vivo, consisting of or comprising an amino acid sequence from a species other than guinea pig having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1 or a guinea-pig amino acid sequence having at least 50% identity with the amino acid 10 sequence set out in SEQ ID NO. 1 or a fragment of said chemoattractant protein which retains its biological activities.

VIII. The following document is cited in this decision:

Dl: Jose et al., J. Exp. Med. (1994) 881-887

IX. The arguments of the appellant as far as relevant for the present decision can be summarized as follows:

Articles 123(2), 123(3) and 84 EPC

The OD acknowledged in section 5.1 of its decision that deletion of the term "and/or activation" from claim 1 of the auxiliary requests did not lead to a violation of the requirements of Articles 123(2), (3) and 84 EPC.

In addition to the amendments made in auxiliary request 1, claim 1 of the subsequent requests was amended so that the reference to at least 40% identity related to amino acid sequences from a species other than guinea-pig, and reference to at least 50% identity related to a guinea-pig amino acid sequence. These amendments were present in auxiliary request I considered at the oral proceedings on 22 July 2009 and the OD acknowledged in Section 4 of its Decision that these amendments satisfied the requirements of Articles 123(2), (3) and 84 EPC.

Articles 87 and 54 EPC

Claim 1 of the main request and of auxiliary request 1 referred to sequences having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1. Basis for this could be found at least on page 3, lines 12 to 14 and lines 32 to 35 of both priority documents, GB9318984.3 and GB9408602.2, respectively, where it was

stated that other guinea-pig eotaxins "will generally have at least 50% overall identity" with the given sequence. The skilled person would in no way consider that anything new was added by referring to the 40% identity mentioned in lines 32-35 for eotaxins in general. The skilled person would see that intra-species variation (for example variation amongst eotaxin sequences obtained from different guinea-pig species) was expected to be as marked as inter-species variation (for example variation between eotaxin sequences obtained from other species and eotaxin sequences obtained from guinea-pig species).

In view of the entitlement of the claimed subject matter to priority, document Dl was not available as prior art. Accordingly, the claims were novel.

X. Respondents I and II submitted a joint response. Their arguments can be summarized as follows:

Article 84 EPC

The feature "an amino acid sequence from a species other than guinea-pig having at least 40% identity with the amino acid sequence set out in SEQ ID NO. I or a guinea-pig amino acid sequence having at least 50% identity with the amino add sequence set out In SEQ ID NO. 1" was unclear and prevented the skilled person from determining the scope of the claim and establishing unambiguously whether or not a chemoattractant protein fell within it.

Articles 87 and 54 EPC

Claim 1 of the main request and of auxiliary request 1 were not entitled to the claimed priority date due to the characteristic that the chemoattractant protein consisted of or comprised "an amino acid sequence having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1". The only Eotaxins which were disclosed in priority documents GB9318984.3 and GB9408602.2, respectively, which had at least 40% sequence identity to the sequence of Figure 3b, were Eotaxins from a species other than guinea pig. There was no basis in either of the priority documents for Eotaxins in general having at least 40% identity with the sequence set out in Figure 3b.

Due to the lack of entitlement to priority, documents D1 and D2 were prior art under Article 54(2) EPC, and the main request and auxiliary request 1 lacked novelty.

XI. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted or, in the alternative, a patent be granted on the basis of one of auxiliary requests 1 to 6.

XII. The respondents requested that the appeal be dismissed and that oral proceedings be held, should the board feel unable to dismiss the appeal.

Reasons for the decision

Main request and auxiliary request I

Priority

1. The requirement for claiming priority of "the same invention", referred to in Article 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Article 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole (Headnote of decision G 2/98 (OJ 2001, 413)).

2. The chemoattractant protein according to claim 1 of the main request and auxiliary request 1 is characterised as "consisting of or comprising an amino acid sequence having at least 40% identity with the amino acid sequence set out in SEQ ID No. 1".

3. The relevant paragraphs on page 3 of the first priority and the second priority document document, GB 9318984.3 (P1) and GB 9408602.2 (P2), respectively, state that "other guinea pig eotaxins will generally have at least 50% overall identity with the sequence shown in Figure 3b" (lines 12-13) and that "an eotaxin from a species other than guinea pig will have at least 40% overall identity with the sequence set out in Figure 3b. (lines 32-33)". Figure 3b of document P1 discloses SEQ ID No. 1 of the patent application. However, documents P1 and P2 do not provide a direct and unambiguous disclosure of any further eotaxin variants, such as for

instance non-naturally occurring variants, i.e. sequences which cannot be found in a guinea pig or a species other than guinea pig, which are also encompassed by claim 1 as granted.

The subject matter of claim 1 of the main request and of auxiliary request 1 therefore extends beyond the disclosure of documents P1 and P2.

4. In the present case, claim 1 as a whole is not entitled to the claimed priority date. There is no partial priority right for the protein with 100% sequence identity with SEQ ID No. 1 because the claim does not comprise a limited number of clearly defined alternative subject matters (cf. decision G 2/98, Reasons 6.7).

5. Therefore, the relevant date for assessing novelty of claim 1 of the main request and auxiliary request 1 is the filing date of the international patent application, i.e. 14 September 1994.

Novelty

6. Document D1 was published in March 1994. It discloses eotaxin defined by a sequence with 100% identity with SEQ ID No. 1 of claim 1 (Figure 3b).

This document anticipates the subject matter of claim 1 of the main request and auxiliary request 1.

7. The board therefore decides, that the main request and auxiliary request 1 lack novelty according to Article 54(2) EPC.

Auxiliary requests 2 to 6

Article 84 EPC

8. Claim 1 of auxiliary requests 2 to 6 refers to a chemoattractant protein defined i.a. as

"consisting of or comprising an amino acid sequence from a species other than guinea-pig having at least 40% identity with the amino acid sequence set out in SEQ ID NO. 1 or a guinea-pig amino acid sequence having at least 50% identity with the amino acid sequence set out in SEQ ID NO. 1"

9. The claim is thus limited to chemoattractant proteins comprising an amino acid sequence from a species other than guinea pig ... or from a guinea pig species. Amino acid sequences which are not from a guinea pig species or not from a non-guinea pig species fall outside the claims. In other words, claim 1 is limited to sequences which can be found in living beings while non-naturally occurring or artificial synthetic sequences are excluded from the scope of protection. A skilled person is however not in a position to distinguish an amino acid sequence from a guinea pig or a non-guinea pig species from an artificial amino acid sequence, because not all naturally-occurring sequences are (and will ever be) known. The restriction of the claimed subject matter to sequences from a guinea pig or from a species other than guinea pig therefore imposes structural limitations of an unclear or undefined nature on top of the requirement of the at least 40% or 50% identity with SEQ ID No. 1.

The person of skill is thus not in a position to unambiguously establish the scope of protection of claim 1. Therefore, this claim language must be regarded as unclear within the meaning of Article 84 EPC.

10. For this reason, the board decides that none of auxiliary requests 2 to 6 meets the requirements of Article 84 EPC.

11. If the patent proprietor is the sole appellant against the interlocutory decision maintaining a patent in amended form, neither the Board of Appeal nor the non-appealing opponents may challenge the maintenance of the patent as amended (decision G 9/92 (OJ EPO 1994, 875, see the Order). This applies to auxiliary request 7 (prohibition of reformatio in peius).

12. Since none of auxiliary requests 1 to 6 meets the requirements of the EPC, the appeal is dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

A. Wolinski M. Wieser