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**Datasheet for the decision  
of 6 June 2016**

**Case Number:** T 0996/13 - 3.3.08

**Application Number:** 06120391.5

**Publication Number:** 1792989

**IPC:** C12N15/12, C07K14/705,  
C07K16/28, C12Q1/68, G01N33/68,  
A61P13/08, A61K38/17,  
A61K39/395, A01K67/027

**Language of the proceedings:** EN

**Title of invention:**  
13 Transmembrane protein expressed in prostate cancer

**Applicant:**  
Agensys, Inc.

**Headword:**  
Antibody human choline transporter-like protein CTL4 prostate  
cancer/AGENSYS

**Relevant legal provisions:**  
EPC Art. 114(2)  
RPBA Art. 12(4)

**Keyword:**

Claim request filed with statement of Grounds of Appeal  
(inadmissible)  
Appeal dismissed

**Decisions cited:**

T 0361/08, T 1231/09, T 1306/10

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0996/13 - 3.3.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.08**  
**of 6 June 2016**

**Appellant:** Agensys, Inc.  
(Applicant) 1545 17th Street  
Santa Monica, CA 90404 (US)

**Representative:** WP Thompson  
8th Floor  
1 Mann Island  
Liverpool L3 1BP (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted on 8 October 2012  
refusing European patent application No.  
06120391.5 pursuant to Article 97(2) EPC.

**Composition of the Board:**

**Chairman** M. Wieser  
**Members:** P. Julià  
J. Geschwind

## Summary of Facts and Submissions

I. European patent application no. 06 120 391.5 is a divisional application of European patent application no. 00 922 200.1, which was originally published as International patent application WO 00/61746. The examining division considered the Main Request and the Auxiliary Request, both filed on 10 August 2012, not to fulfil the requirements of Article 83 EPC. Accordingly, the application was refused.

II. Claim 1 of the Main Request and of the Auxiliary Request read as follows:

"1. An antibody or antigen-binding fragment thereof that targets the extracellular portion of a protein that consists of the amino acid sequence of SEQ ID NO:2 for use in a method to treat patients suffering from prostate cancer." (Main Request)

"1. ... [as claim 1 of the Main Request] ..., wherein said antibody or fragment is conjugated to a toxic agent or to a therapeutic agent." (Auxiliary Request)

Claims 2-8 of the Main Request were directed to preferred embodiments of claim 1, and claims 2-7 of the Auxiliary Request were identical to claims 3-8 of the Main Request.

III. With the statement setting out the Grounds of Appeal, the appellant (applicant) filed a new claim request. Claim 1 of this request read as follows:

"1. An antibody or fragment thereof that specifically binds to the extracellular portion of a protein that comprises the amino acid sequence of SEQ ID NO:2 for

use in a method to inhibit growth of a prostate cancer cell comprising said protein on its surface."

Claims 2-8 were identical to claims 2-8 of the Main Request before the examining division.

IV. On 26 February 2016, the board issued a communication pursuant to Article 17(2) of the Rules of Procedure of the Boards of Appeal (RPBA) informing the appellant of the board's preliminary, non-binding opinion on the issues of the present case.

Appellant's attention was drawn to Article 12(4) RPBA and the appellant was informed that, in the board's opinion, *"appellant's claim request filed with the statement of Grounds of Appeal is not admissible (Article 12(4) RPBA). Therefore, in the absence of an admissible request, the appeal cannot succeed"*.

With this communication, the board also introduced three new documents into the procedure:

(i) National Center for Biotechnology Information (NCBI), Reference Sequence NP\_079533.2 (D8);  
(ii) Uniprot Consortium, Accession number Q53GD3 (D9);  
and (iii) S. O'Regan *et al.*, Proc. Natl. Acad. Sci. USA, 15 February 2000, Vol.97, No. 4, pages 1835-1840 (D10).

The board noted that the amino acid sequence of the 24P4C12 protein (FIG 1A-1D, SEQ ID NO: 2) disclosed in the application as filed was identical to the sequence of the human choline transporter-like protein 4 (CTL4, isoform 1) or soluble carrier family 44 member 4 (SLC44A4) (also known under the alternative names NG22 protein, TPPT, chromosome 6 open reading frame 29 (C6orf29) and FLJ14491 protein) disclosed in these

post-published documents and identified therein as a sodium-dependent transmembrane transport protein involved in the uptake of choline by cholinergic neurons.

The board noted also that the transmembrane (TM) and extracellular (E) domains of the CTL4 isoform 1 identified in D8-D9 differed from the TM/E domains of the 24P4C12 protein identified in the application as filed. The board expressed the opinion, that the disclosure in the application as filed did *"not enable a skilled person to work the claimed invention as it is, at best, incomplete or insufficient, or, at worst, misleading or simply wrong (Article 83 EPC)"*. The board further noted that *"the references in the application as filed to the function of the 24PC12 protein may yet aggravate the deficiencies and shortcomings arising from the structural characterization of the 24P4C12 protein"*. Therefore, the board saw no reason to deviate from the decision of the examining division regarding Article 83 EPC.

- V. On 19 May 2016, upon an inquiry made by the board's registrar, the appellant's attorney informed the board that no submissions had and would not be filed in reply to the board's communication. The appellant was informed that the board, as stated in its communication, intended to issue a decision in line with its preliminary opinion.
- VI. The appellant (applicant) requested that the decision under appeal be set aside and that a patent be granted on the basis of the claim request filed with its statement of Grounds of Appeal.

## Reasons for the Decision

1. According to the case law of the Boards of Appeal, the function of an appeal is to give a judicial decision upon the correctness of a separate earlier decision taken by a department of first instance. It is not the purpose of appeal proceedings to give the appellant the opportunity to recast its claims as it sees fit and to have such claim requests admitted as of right into the appeal proceedings. Appeal proceedings are not a second chance to re-run the proceedings before the first instance. This principle is mirrored in Articles 12(4) and 13 RPBA (cf. "Case Law of the Boards of Appeal of the EPO", 7th edition 2013, IV.E.1 and IV.E.4, pages 934 and 984, respectively). In particular, Article 12(4) RPBA empowers the board not to admit requests that could have been presented in the first-instance proceedings.
2. In the present case, after issuing the "*extended European Search Report*" with the "*European Search Opinion*" on 7 May 2007, the examining division sent two communications to the applicant (10 January 2008 and 8 October 2009) before issuing the "*Summons to attend oral proceedings*" on 8 June 2012. In reply to each of these communications and to the Summons, the applicant filed new sets of claims (with letters dated 18 July 2008, 18 February 2010 and 10 August 2012).
3. The claim request filed by the appellant with its statement of Grounds of Appeal is identical to the Main and sole claim request filed with letter dated 18 February 2010. Indeed, also the statement of Grounds of Appeal is almost identical to the submissions filed on

18 February 2010. In the "*Summons to attend oral proceedings*" issued on 8 June 2012, the examining division raised several objections under Articles 123(2), 54, 56, 84 and 83 EPC against this claim request and referred also to the objections raised in the examination of the parent application against claims directed to antibodies. In reply thereto and in preparation of the oral proceedings before the examining division, the applicant/appellant filed a new Main Request and an Auxiliary Request on 10 August 2012. Thereby, the Main Request filed on 18 February 2010 was withdrawn from the examination procedure.

4. According to the "*Minutes of the oral proceedings before the examining division*" (hereinafter "*the Minutes*"), the examination division, after informing the applicant/appellant of its negative opinion on the Main Request and Auxiliary Request filed on 10 August 2012, invited it to file new claim requests. The applicant/appellant did not avail this opportunity and did not file any further claim request (cf. points 7-8 of the Minutes).
5. The reintroduction of a claim request into the appeal procedure, which has been withdrawn at an earlier stage of the procedure, is not in line with the function of an appeal as referred to in point 1 above (cf. *inter alia*, T 361/08 of 3 December 2009, point 13 of the Reasons, T 1231/09 of 12 December 2012, point 1 of the Reasons, T 1306/10 of 17 March 2015, point 2 of the Reasons, and "Case Law", *supra*, IV.E.4.3.3.c), page 1001).
6. In a communication pursuant to Article 17(2) RPBA, the appellant has been informed that the claim request filed with the statement of Grounds of Appeal seemed



not to be admissible (Article 12(4) RPBA) and that, therefore, in the absence of an admissible request, the appeal cannot succeed. In addition, the appellant has been informed of the relevance of the objection raised by the examining division under Article 83 EPC (cf. point IV *supra*).

7. The appellant has not replied to the communication and has not provided any argument or evidence to challenge the board's preliminary opinion and to prove it wrong (cf. point V *supra*).
8. Thus, according to Article 114(2) and Article 12(4) RPBA, the board decides that appellant's claim request filed with the statement setting out the Grounds of Appeal is not admitted into the appeal procedure. As there is no other request defining the subject-matter of the appeal, the appeal is dismissed.

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:



A. Wolinski

M. Wieser

Decision electronically authenticated