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**Datasheet for the decision
of 7 October 2015**

Case Number: T 1537/14 - 3.3.01
Application Number: 11181133.7
Publication Number: 2439196
IPC: C07D233/86, A61K31/4166,
A61P35/00
Language of the proceedings: EN

Title of invention:

Diarylthiohydantoin compounds for use in a method for the treatment of a hyperproliferative disorder

Applicant:

The Regents of the University of California

Headword:

Diarylthiohydantoin in hormone refractory prostate cancer treatment/UNIVERSITY OF CALIFORNIA

Relevant legal provisions:

RPBA Art. 15(3)
EPC Art. 113(1), 123(2), 76(1)

Keyword:

Right to be heard - non-attendance at oral proceedings
Amendments - added subject-matter (yes)
Divisional application - added subject-matter (yes)

Decisions cited:

T 0288/92, T 0859/94, T 0609/95, T 0823/96, T 0801/02,
T 0823/04, T 1704/06, T 0590/07, T 0991/07

Catchword:



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Chambres de recours**

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Case Number: T 1537/14 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 7 October 2015

Appellant: The Regents of the University of California
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Representative: Campbell, Patrick John Henry
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 21 February 2014 refusing European patent application No. 11181133.7 pursuant to Article 97(2) EPC.**

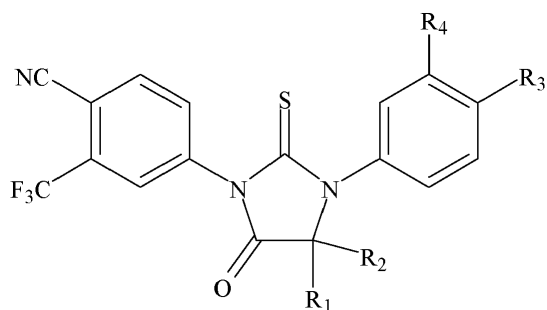
Composition of the Board:

Chairman A. Lindner
Members: G. Seufert
L. Bühler

Summary of Facts and Submissions

- I. The applicant lodged an appeal against the decision of the examining division refusing European patent application No. 11181133.7, which is a divisional application from earlier European patent application No. 07754380.9 (hereinafter parent application; published as international patent application WO 2007/127010).
- II. The examining division held that the subject-matter of the sole request contravened Article 123(2) EPC. In particular, the division was of the opinion that the replacement of the generic alkylcarbamoylealkyl residue in the general formula of claim 1 by the specific N,N-dimethylbutanamide residue, which was taken from a single example, created a new subgroup which had no basis in the application as filed.
- III. With the notice of appeal, the appellant resubmitted the set of claims underlying the decision under appeal as main request.
- IV. In a communication accompanying the summons to oral proceedings, the board indicated in its preliminary opinion that it was inclined to follow the examining division's decision with respect to added matter. The board also had additional objections under Articles 123(2) and 76(1) EPC.
- V. With letter of 7 September 2015, the appellant filed a new main request and a first and a second auxiliary request. Claim 1 of the main request and first auxiliary request was identical to claim 1 of the main request filed with the notice of appeal and reads as follows:

"1. A compound for use in a method for treating a hyperproliferative disorder, the compound having the formula



wherein R₁ and R₂ are, together with the carbon to which they are linked, a cycloalkyl group of 4 to 5 carbon atoms;

wherein R₃ is selected from the group consisting of N,N-dimethylbutanamide, and cyanoalkyl; and

wherein R₄ is hydrogen or fluorine,

or a pharmaceutically acceptable salt thereof."

In claim 1 of the second auxiliary request, the N,N-dimethylbutanamide residue has been deleted. The variable R₃ is defined as cyanoalkyl.

VI. With letter of 5 October 2015, the appellant withdrew its request for oral proceedings.

VII. The appellant's arguments provided in writing can be summarised as follows:

The amendments in claim 1 of the main request and first auxiliary request complied with Articles 123(2) and 76(1) EPC, as these were at least implicitly disclosed to the person skilled in the art, using common general knowledge, in the application as originally filed.

The skilled reader would have realised the inconsistency between the general group of compounds defined in claim 1 and dependent claim 8 (of the parent application and claim 2 of the present application; annotation by the board). The latter referred to the compound "NC56", which would be part of the general class of compounds, but for the fact that it had an N,N-dimethylbutanamide residue at the R₃ position. The skilled person would also have realised that it was intended to define a class of compounds with the variables R₁, R₂, and R₄ as defined in claim 1 and having a definition, for the variable R₃, which at least included N,N-dimethylbutanamide. Thus, the skilled person was provided with a clear understanding that a group of compounds with R₁, R₂ and R₄ as defined in claim 1 and N,N-dimethylbutanamide at the position of R₃ was part of the invention. In support, decision T 609/95 was cited.

The inclusion of the N,N-dimethylbutanamide residue in the definition of R₃ was a clear and unambiguous consequence of what was explicitly disclosed, and therefore in full accordance with the decisions T 823/96 and T 590/07 cited by the board.

Decision T 288/92 referred to by the board was not applicable in the present case in view of the different circumstances. In the case underlying T 288/92 the specific chemical compounds in question were intermediates of the compounds covered by the original Markush formula, and were intentionally excluded from the compounds initially claimed, whilst in the present case the specific compound giving rise to the amendment was specifically set forth as a compound intended to be within the original generic scope of the claims.

In the second auxiliary request, the disputed residue had been deleted. Therefore, the findings with regard to added matter due to the presence of this feature did not apply.

VIII. The appellant requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request, or, alternatively, of the first or second auxiliary requests, all requests having been filed with letter dated 7 September 2015.

IX. At the end of the oral proceedings, which took place as scheduled in the absence of the appellant, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request and first auxiliary request

2. Amendments (Article 123(2) EPC)

2.1 Claim 1 of the main request has been amended by replacing the alkylcarbamoylalkyl residue in the definition of the variable R_3 with the residue N,N-dimethylbutanamide (see point V above).

2.2 There is no explicit disclosure in the application as filed indicating that N,N-dimethylbutanamide represents a preferred embodiment of the alkylcarbamoylalkyl residue in the generically defined group of compounds according to the invention. The N,N-dimethylbutanamide

residue can only be found in one individual compound (cf. "NC56"), where it is disclosed in combination with specific substituents R_1 , R_2 and R_4 (i.e. R_1/R_2 being cyclobutyl and R_4 being hydrogen; see table 5 on pages 42 to 44 and claim 2 of the application as originally filed). From this individual compound, the skilled person derives nothing more than the bare disclosure of a structural element in combination with other structural elements. Hence, isolating the N,N-dimethylbutanamide residue from this specific compound and combining it with the general disclosure of claim 1 provides the skilled person, in the board's judgement, with technical information that is not directly and unambiguously disclosed in the application as filed (see T 288/92, point 3.4 of the Reasons, in particular, the fourth and sixth paragraphs).

2.3 According to the appellant, decision T 288/92 is not applicable in the present circumstances. The board does not share this opinion for the following reasons:

2.3.1 In said decision, the board dealt with the question of whether or not it was permissible to amend a generic formula defining a class of compounds by restricting an originally disclosed generic definition of a substituent (R^4 equal to substituted phenyl) to a specific one (R^4 equal to 2,6-difluorophenyl), which was derived from two individual compounds (B1 and B3), without at least some support for such restriction in the general part of the description (see T 288/92, point 3.4 of the Reasons). A similar question arises in the present case, where the board has to decide whether the restriction of the generic definition "alkylcarbamoylalkyl" to the specific "N,N-dimethylbutanamide", which is derived from a single compound, is a permissible amendment. In these circumstances, the

board sees no reason why the reasoning of T 288/92 is not applicable.

- 2.3.2 Concerning the alleged differences between the present case and the case underlying T 288/92 pointed out by the appellant (see point VII above), the board notes that the passage of T 288/92 referred to by the appellant in this context (second paragraph of point 3.4) relates to triazolopyrimidines, which are structurally remote from the triazoles defined in the amended claims, and for that reason not suitable as a basis for the amendments made. This factual constellation has no bearing at all on the point to be decided in the present decision. What is important is the ratio decidendi of T 288/92, which is set out in point 3.4, third to sixth paragraphs relating to compounds B1 and B3. The applicability of the reasoning applied therein to the present case has been dealt with in points 2.2 and 2.3.1 of the present decision.
- 2.4 The board also does not accept the appellant's argument that the amendment was at least implicitly disclosed (see point VII above).
- 2.4.1 It is established jurisprudence of the boards of appeal that the term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. The term "implicit disclosure" relates solely to matter which is not explicitly mentioned, but is a clear and unambiguous consequence of what is explicitly mentioned (see T 823/96, point 4.5 of the Reasons, T 590/07, point 2.4.3 of the Reasons).

- 2.4.2 The board notes that the definition "alkylcarbamoylalkyl" in claim 1 of the application as filed does not encompass the N,N-dimethylbutanamide residue. However, although there is a recognisable inconsistency between claim 1 and dependent claim 2 and although the skilled reader may have understood that the residue R₃ was intended to include such residues as N,N-dimethylbutanamide, this does not directly and unambiguously imply that the alkylcarbamoylalkyl residue in the generically defined group of compounds according to claim 1 had to be N,N-dimethylbutanamide. In other words, the generically defined group of compounds with R₁, R₂ and R₄ as defined in claim 1 and N,N-dimethylbutanamide at the position of R₃ is not the clear and unambiguous consequence of what is explicitly mentioned.
- 2.4.3 The appellant also relied on decision T 609/95 in support of its arguments. In this decision it is stated that "where a drafting error or inconsistency in an application would be evident to a skilled reader ..., it is reasonable to suppose that he would, in the light of the content of the application as filed, attempt to formulate a notional amendment which would enable him to make sense of what he reads, and to the extent that the amendment might be said to leap to the mind of the reader ..., it can be regarded as implicit in the application and would not contravene Article 123(2) EPC, if effected in practice" (see T 609/95, point 2.3 of the Reasons, penultimate paragraph).
- 2.4.4 The board is of the opinion that T 609/96 does not support the appellant's case. In this decision the board allowed an amendment to a statement in the description which was technically meaningless and

clearly wrong. In the present case, the term "alkylcarbamoylealkyl" is neither technically meaningless nor clearly wrong. Hence, the skilled reader would not need to attempt to formulate a notional amendment which would enable him to make sense of what he reads. Furthermore, the board is of the opinion that the present amendment, in view of the reasons explained in points 2.2 and 2.4.2 above, cannot be said to leap to the mind of the skilled reader.

2.5 For the reasons mentioned above, the board concludes that claim 1 of the main request has been amended in such a way that its subject-matter extends beyond the content of the application as originally filed, contrary to Article 123(2) EPC, with the consequence that the main request is not allowable.

2.6 Since claim 1 of the first auxiliary request is identical to claim 1 of the main request, the same observations and the same conclusion as in points 2.2 to 2.5 apply, with the consequence that the first auxiliary request must also be refused.

Second auxiliary request

3. Procedural matters

3.1 The board concedes that the objection of added matter raised in the board's communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA) against the presence of the N,N-dimethylbutanamide residue in the generally defined group of compounds has been overcome in claim 1 of the second auxiliary request. However, in the board's judgment, the amendment in said claim gives rise to a further objection of added matter, in particular in

view of the content of the parent application as originally filed. The fact that the appellant did not attend the oral proceedings does not prevent the board from deciding on the case and basing its decision on objections, regarding the allowability of amendments, which are - at least in part - new to the appellant. An appellant who submits amended claims shortly before the oral proceedings and subsequently does not attend these proceedings must expect a decision based on objections to such claims which might arise in his absence.

3.2 This approach is in line with established jurisprudence of the boards of appeal (see T 991/07, point 2 of the Reasons, T 1704/06, point 7 of the Reasons, T 823/04 point 1 of the Reasons) and Article 15(3) RPBA, which sets out that "The boards shall not be obliged to delay any step in the proceedings, including its decision, by reasons only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case". The explanatory note to this Article (see CA/133/02 dated 12 November 2002) states that "This provision does not contradict the principle of the right to be heard pursuant to Article 113(1) EPC since that Article only affords the opportunity to be heard and, by absenting itself from the oral proceedings, a party gives up that opportunity".

3.3 The appellant had been informed, in the board's communication accompanying the summons to oral proceedings, about the issues which the board would consider and decide on during the oral proceedings. In the preliminary opinion various objections under Articles 123(2) and 76(1) EPC were raised. In these circumstances, the appellant had to expect that

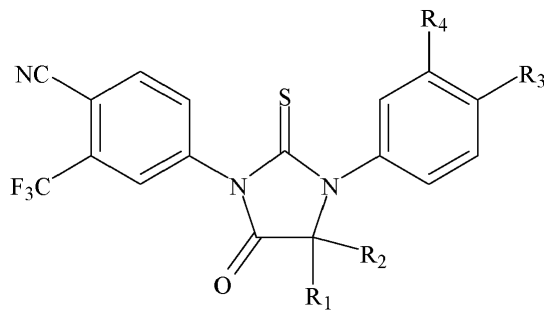
compliance of the amended claims with the requirements of these articles would be examined.

3.4 For the reasons mentioned above, the board was, despite the absence of the duly summoned appellant, in a position to take a final decision at the oral proceedings without violating the appellant's right to be heard.

4. Amendments (Article 76 EPC)

4.1 Pursuant to Article 76(1) EPC, a European divisional application may only be filed in respect to subject-matter which does not extend beyond the content of the earlier application, in the present case the parent application No. 07754380.9 (see point I above).

4.2 The parent application as originally filed discloses a group of compounds having the formula



- wherein R_1 and R_2 are independently methyl or, together with the carbon to which they are linked a cycloalkyl group of 4 to 5 carbon atoms,
- wherein R_3 is selected from the group consisting of carbamoyl, alkylcarbamoyl, carbamoylalkyl, alkylcarbamoylalkyl, cyano and cyanoalkyl, and
- wherein R_4 is hydrogen or fluorine (see claim 1 of the parent application as originally filed).

No specific sub-groups are mentioned anywhere in the parent application as originally filed.

- 4.3 In claim 1 of the second auxiliary request one specific meaning for the variables R_1/R_2 (i.e. cycloalkyl) and one specific meaning for the variable R_3 (i.e. cyanoalkyl) have been selected from the lists of meanings disclosed in the parent application. In the board's judgement, such a selection amounts to an inadmissible singling out of a specific sub-group which is encompassed, but not disclosed as such, by the parent application as originally filed (see T 801/02; point 2.2.1 of the Reasons; T 859/94, point 2.4.3 of the Reasons).

The board notes that the parent application as originally filed discloses one specific compound, which falls within the wording of claim 1 of the second auxiliary request (i.e. "NC57" with R_1/R_2 being cyclobutyl and R_3 being cyanopropyl). For the same reasons as set out in point 2.2 above, such a single compound with its specific combination of features does not provide an appropriate basis for the generically defined group of compounds of claim 1 of the second auxiliary request.

- 4.4 The appellant did not provide a basis for amended claim 1 in the parent application as originally filed.

- 4.5 In view of the above considerations, the board concludes that the subject-matter of claim 1 of the second auxiliary request is not clearly and unambiguously derivable from the parent application as originally filed, contrary to Article 76(1) EPC.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated