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**Datasheet for the decision
of 4 March 2019**

Case Number: T 0885/15 - 3.3.04
Application Number: 07710624.3
Publication Number: 1994155
IPC: A61P19/08, C07K14/705,
A61K31/7088, A61K38/17,
A61K39/395, A61K48/00
Language of the proceedings: EN

Title of invention:

Polynucleotide and polypeptide sequences involved in the
process of bone remodeling

Patent Proprietor:

Daiichi Sankyo Company, Limited

Opponent:

Strawman Limited (withdrawn)

Headword:

Bone remodeling/DAIICHI SANKYO COMPANY

Relevant legal provisions:

EPC Art. 111(1), 123(3)

Keyword:

Amendments - broadening of claim (no)

Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:

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Case Number: T 0885/15 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 4 March 2019

Appellant: Daiichi Sankyo Company, Limited
(Patent Proprietor) 3-5-1, Nihonbashi Honcho
Chuo-ku
Tokyo 103-8426 (JP)

Representative: Arends, William Gerrit
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 February 2015 concerning maintenance of the
European Patent No. 1994155 in amended form.

Composition of the Board:

Chairwoman G. Alt
Members: B. Claes
P. de Heij

Summary of Facts and Submissions

- I. Both the patent proprietor and the opponent lodged appeals against the interlocutory decision of the opposition division that European patent No. 1 994 155, having the title "*Polynucleotide and polypeptide sequences involved in the process of bone remodeling*", could be maintained in amended form.
- II. The patent as granted comprised 16 claims, of which claim 7 read:
- "7. A compound capable of interfering with the activity or expression of a polypeptide selected from SEQ ID NO.:48 or a polypeptide encoded by SEQ ID NO.:1 for use in modulating osteoclast differentiation *in vivo*, preventing bone disease or treating a bone disease, wherein said compound is selected from the group consisting of antibodies or antigen-binding fragments thereof **binding specifically to a polypeptide** selected from SEQ ID NO.: 48 or to a fragment thereof, and an siRNAs or shRNAs inhibiting specifically activity or expression of a polypeptide encoded by SEQ ID NO.: 1." (emphasis added by the board)
- III. The patent was opposed to the extent of claims 7 to 12 on grounds of opposition in Article 100(a), (b) and (c) EPC.
- IV. In the decision under appeal the opposition division held that claim 7 of the main request, filed with a letter dated 22 December 2014, concerned amendments which would extend the protection conferred by the patent, therefore not meeting the requirements of Article 123(3) EPC, and that the patent as amended

according to the auxiliary request and the invention to which it related met the requirements of the EPC.

Claim 7 of the main request, comprising amended claims 7 to 12, read:

"7. A compound capable of interfering with the activity or expression of a polypeptide selected from SEQ ID NO.:48 or a polypeptide encoded by SEQ ID NO.:1 for use in preventing bone disease or treating a bone disease *in an individual in need thereof*, wherein said compound is selected from the group consisting of an isolated or purified antibody or antigen-binding fragment thereof **capable of specifically binding to a polypeptide** consisting of SEQ ID NO.: 48, and an siRNA or shRNA inhibiting specifically expression of a polypeptide encoded by SEQ ID NO.: 1." (emphasis added by the board)

- V. With its statement of grounds of appeal the patent proprietor (hereinafter "appellant") re-submitted the main request dealt with in the decision under appeal and argued that amended claim 7 did not infringe the requirements of Article 123(3) EPC.
- VI. The opponent requested in its statement of ground of appeal that the patent be revoked to the extent of claims 7 to 12 as granted.
- VII. After each party had replied to the statement of grounds of appeal of the other party, the opponent withdrew its opposition and appeal.
- VIII. The board summoned oral proceedings and issued a communication pursuant to Article 15(1) RPBA in which it informed of its preliminary appreciation of certain

issues concerning the appeal. The board understood the appellant to request that the patent be maintained as granted, yet with amended claims 7 to 12 as in the main request. It was further of the preliminary opinion that claim 7 of the main request did not extend the protection conferred by the patent.

IX. With a letter dated 14 January 2019 the appellant requested oral proceedings "*unless the board decides to set aside the decision of the Opposition Division (with respect to Article 123(3) EPC) under appeal and remit the case to the Opposition Division for further prosecution.*"

X. The oral proceedings were subsequently cancelled.

XI. The arguments of the appellant, relevant for the present decision, can be summarised as follows:

Claim 7 of the main request did not extend the scope of protection of the patent as granted (Article 123(3) EPC).

Neither the preamble of claim 7 as granted nor the description of the invention suggested that "*capable of specifically binding*" should be interpreted as implying additional properties compared to "*binding specifically*".

The skilled person would not consider that antibodies "*binding specifically*" to an antigen possessed fewer properties than antibodies "*capable of specifically binding*" to the antigen.

The assertion that the term "*capable of specifically binding*" implied "additional properties" compared to "*binding specifically*" was not substantiated.

Reasons for the Decision

1. The appeal is admissible.
2. The opponent has withdrawn its opposition and appeal. Hence, the opponent ceased to be a party to the present appeal proceedings.

Main request - claim 7 - Article 123(3) EPC

3. The opposition division gave the following reason for holding that the main request did not meet the requirements of Article 123(3) EPC: "*Amending the feature "binding specifically" to "capable of specifically binding" is considered to extend the protection conferred by the patent. The term "capable of specifically binding" implies that the antibody has properties in addition to the property of binding specifically and can therefore be interpreted more broadly than the term "binding specifically". This is also the case when account is taken of the fact that the **notion of specificity**, which does not exclude that an antibody may cross-react with other polypeptides than that against which it has been raised, **is inherent to the nature of antibodies**; because the additional properties may include properties other than cross-reacting. With respect to the preamble, which defines the compound as capable of interfering with the activity of the polypeptide, the antibodies capable of specifically binding the polypeptide represent a broader selection thereof than the antibodies binding*

specifically to the polypeptide." (emphasis added by the board)

4. Thus, the opposition division accordingly held that the antibodies defined in amended claim 7 (see section IV) were not excluded to have particular additional properties which the antibodies defined in granted claim 7 (see section II) were excluded to possess. Whereas the opposition division did not identify such properties, it clarified that it did not refer to the property of cross-reacting to other polypeptides than that against which the antibody had been raised.
5. The board has, however, not seen any evidence in the case that the definition of the antibodies in claim 7 as granted is excluding the antibodies to possess any additional properties. In fact, the board considers that, indeed, any construction of granted claim 7 to the effect that it *excludes* these antibodies to have (additional) general properties, such as e.g. Fc-receptor binding, would be counter to the reading of the claim by the skilled person.
6. In view of the above considerations the board cannot concur with the opposition division that claim 7 of the main request infringes Article 123(3) EPC. The board therefore holds that the sole reason for the opposition division to decide that the main request was not allowable to be unwarranted.

Remittal (Article 111(1) EPC)

7. Pursuant to Article 111(1) EPC, following the examination as to the allowability of the appeal, the board will decide on the appeal, and in that respect it may either exercise any power within the competence of

the department which was responsible for the decision or remit the case for further prosecution.

8. In view of the appellant's request (see Section IX) and also considering that the opposition division in the decision under appeal has not dealt with the main request in relation to any of the invoked grounds of opposition (see section III), the board considers it appropriate to make use of its discretion under Article 111(1) EPC and to order the remittal of the case to the examining division for further prosecution on the basis of the main request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution on the basis of the main request.

The Registrar:

The Chair:



S. Lichtenvort

G. Alt

Decision electronically authenticated