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**Datasheet for the decision
of 18 March 2022**

Case Number: T 1213/18 - 3.3.04

Application Number: 10771018.8

Publication Number: 2582385

IPC: A61K38/19, C07K7/64, C07K14/525

Language of the proceedings: EN

Title of invention:
Treatment of vascular complications of diabetes

Applicant:
APEPTICO Forschung und Entwicklung GmbH

Headword:
Diabetes/APEPTICO

Relevant legal provisions:
EPC Art. 111(1)
RPBA 2020 Art. 12(2)

Keyword:
Appeal decision - remittal to the department of first instance
(yes)

Decisions cited:
G 0004/19



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Case Number: T 1213/18 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 18 March 2022

Appellant: APEPTICO Forschung und Entwicklung GmbH
(Applicant) Mariahilferstraße 136
1150 Wien (AT)

Representative: SONN Patentanwälte OG
Riemergasse 14
1010 Wien (AT)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 4 December 2017
refusing European patent application No.
10771018.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chair G. Alt
Members: A. Schmitt
L. Bühler

Summary of Facts and Submissions

- I. The appeal of the applicant (appellant) lies from the decision of the examining division to refuse European patent application No. 10 771 018.8 ("application"), which is a divisional application from European patent application No. 10 166 637.8, filed on 21 June 2010 ("earlier application"). The title of the application is "*Treatment of vascular complications of diabetes*".
- II. The examining division refused the application on the grounds that "*the prevention of double patenting*" was "*a generally recognised principle of procedural law applicable under Article 125 EPC*" and "*at least independent claims 1 and 2 of the Main request of European patent application EP10166637, which has already proceeded to grant, [were] identical to the claims of the present application*" (see page 5, point 2.2 of the decision).
- III. With the statement of grounds of appeal, the appellant maintained the set of claims of the main request on which the decision under appeal was based, and further indicated that "*auxiliary requests 1-3 filed on 25 October 2016 were upheld*" (see the statement of grounds of appeal, page 1, point 1.).
- IV. The board issued a communication pursuant to Rule 100(2) EPC, in which it provided its preliminary opinion that, in view of decision G 4/19 of 22 June 2021 of the Enlarged Board of Appeal, the appeal was likely to be dismissed. Furthermore, if the board decided that the claims of one of the auxiliary requests 1 to 3 needed to be considered, it would remit

the case to the examining division for further prosecution (Article 111(1) EPC).

- V. By letter dated 20 December 2021, the appellant withdrew the main request and maintained auxiliary requests 1, 2 and 3 (see section III.) as main request, auxiliary request 1 and auxiliary request 2 respectively.

Claims 1, 2, 3 and 7 of the main request, which had been submitted on 25 October 2016 as auxiliary request 1, read as follows.

"1.: Peptide, consisting of 7-17 amino acids and including the hexamer $TX_1EX_2X_3E$, wherein X_1 , X_2 and X_3 can be any natural or non natural amino acid, wherein the peptide does not exhibit TNF-receptor-binding activity and is cyclic, for use in the treatment or prevention of vascular complications in diabetes patients;
wherein the route of administration is parenteral administration, preferably through inhalation or intravenous administration or as an intraperitoneal bolus dosage.

2.: Peptide, consisting of 7-17 amino acids and including the hexamer TPEGAE, wherein the peptide does not exhibit TNF-receptor-binding activity and is cyclic, for use in the treatment or prevention of vascular complications in diabetes patients;
wherein the route of administration is parenteral administration, preferably through inhalation or intravenous administration or as an intraperitoneal bolus dosage.

3.: Cyclic peptide, consisting of a sequence of consecutive amino acids selected from the group consisting of

- QRETPEGAEAKPWY
- PKDTPEGAEELKPWY
- CGQRETPEGAEAKPWYC and
- CGPKDTPEGAEELKPWYC

and fragments of at least seven amino acids containing the hexamer TPEGAE for use in the treatment or prevention of vascular complications in diabetes patients;

wherein the route of administration is parenteral administration, preferably through inhalation or intravenous administration or as an intraperitoneal bolus dosage.

7.: Pharmaceutical composition comprising a peptide according to any one of claims 1 to 6 and a pharmaceutical carrier for use in the treatment or prevention of vascular complications in diabetes patients;

wherein the route of administration is parenteral administration, preferably through inhalation or intravenous administration or as an intraperitoneal bolus dosage."

VI. The appellant requested that the decision under appeal be set aside and that a patent be granted based on one of the following sets of claims (and the respective amended pages of the description submitted on 25 October 2016):

- claims of the main request, submitted on 25 October 2016 as auxiliary request 1, or

- claims of auxiliary request 1, submitted on

25 October 2016 as auxiliary request 2, or

- claims of auxiliary request 2, submitted on
1 April 2016 as auxiliary request 3.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is admissible.

Main request

Double patenting

2. The examining division refused the application because it claimed the same subject-matter as European patent No. 2 397 151, which had been granted to the applicant on the earlier application (see section II.).
3. Independent claims 1, 2, 3 and 7 of the main request (see section V.) comprise the feature that the route of administration is parenteral administration. This feature is not present in the claims of European patent No. 2 397 151 as granted. The subject-matter of the claims of the main request is therefore not identical to the subject-matter of the claims as granted on the earlier application.
4. Consequently, the prohibition of double patenting endorsed in the Enlarged Board of Appeal's decision G 4/19 of 22 June 2021 is not pertinent to the claims of the main request.

Remittal (Article 111(1) EPC)

5. According to Article 111(1) EPC, the board of appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.
6. It is the primary function of appeal proceedings to give a judicial decision upon the correctness of the decision under appeal (see Case Law of the Boards of Appeal, 9th edition 2019, section V.A.1.1, second paragraph and decisions referred to there).
7. The sole reason for refusing the application was the prohibition of double patenting (see section II.). This reason is not pertinent to the claims of the main request (see points 2. to 4. above). The examining division has not taken any decision on whether the claims of the main request comply with any other requirements of the EPC.
8. The board therefore decided, in line with its primary object to review the decision under appeal in a judicial manner (see point 6. above; see Article 12(2) RPBA 2020), to remit the case to the examining division for further prosecution (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.

The Registrar:

The Chair:



A. Chavinier-Tomsic

G. Alt

Decision electronically authenticated