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Datasheet for the decision of 14 August 2020

Case Number: T 2571/18 - 3.3.01

Application Number: 12160586.9

Publication Number: 2478907

IPC: A61P35/00, A61K31/58, A61K45/06

Language of the proceedings: EN

Title of invention:
Methods and compositions for treating cancer

Applicant:
Janssen Oncology, Inc.

Headword:
Abiraterone and prednisone combination against prostate cancer/JANSSEN

Relevant legal provisions:
EPC Art. 87(1), 83

Keyword:
Priority - basis in priority document (yes)
Sufficiency of disclosure - (yes)

Decisions cited:
G 0002/98, T 0609/02, T 1599/06, T 1616/09

Catchword:

Europäisches Patentamt
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Beschwerdekammern

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Case Number: T 2571/18 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 14 August 2020

Appellant: (Applicant)	Janssen Oncology, Inc. 10990 Wilshire Blvd. Suite 1200 Los Angeles CA 90024 (US)
Representative:	Carpmaels & Ransford LLP One Southampton Row London WC1B 5HA (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 25 May 2018 refusing European patent application No. 12160586.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman	A. Lindner
Members:	G. Seufert
	R. Romandini

Summary of Facts and Submissions

I. The applicant (appellant) lodged an appeal against the decision of the examining division refusing European patent application 12 160 586.9.

II. The present decision refers to the following documents:

D1 A. O'Donnell *et al.*, British Journal of Cancer, vol. 90, 2004, pages 2317 to 2325

D14 J. S. Lam *et al.*, The Journal of Urology, vol. 175, January 2006, pages 27 to 34

D15 "Prostate Cancer, Principles and Practice", Editors R. S. Kirby *et al.*, London (GB): Taylor & Francis Group, January 2006, pages 915 to 928

D16 M. Fakih *et al.*, Urology, vol. 60, no. 4, 2002, pages 553 to 561

D17 I. Herr, J. Pfitzenmaier, The Lancet Oncology, vol. 7, May 2006, pages 425 to 430

D18 R. P. Rutz, The Lancet, vol. 360, 2002, pages 1969 to 1970

D20 European Medicines Agency, Assessment Report for Zytiga (abiraterone), Procedure No. EMEA/H/C/ 002321, 2011, pages 1 to 78

D25 Summary of Product Characteristics for Zytiga, 2018, pages 1 to 77

D26 P. Emgard *et al.*, Acta Oto-Largyngologica, 2005, vol. 125, pages 346 to 352

S2 R. J. Auchus, Endocrinology and Metabolism Clinics of North America, vol. 30, no. 1, 2001, pages 101 to 119

III. The decision under appeal is based on the set of claims submitted by letter dated 14 December 2017.

The examining division refused the patent application on the ground of non-compliance with Article 83 EPC by a decision according to the state of the file based on the communications dated 13 March 2018 and 4 August 2017.

The examining division considered that the application did not disclose the suitability of the co-administration of prednisone for the treatment of prostate and breast cancer, either in the form of data or by explaining the mechanism of action. In particular, the examining division observed that the application did not contain any information as to how the compounds intended for co-administration, including prednisone, might contribute to solving the problem as defined in paragraph [0007] of the application. Nor did the application contain any evidence as to whether the co-administration of additional anticancer agents or steroids might be beneficial in the treatment of refractory cancer as alleged in paragraph [0008] of the application. Common general knowledge (D1, D14 to D18) was not helpful either, as there was no consensus as to whether prednisone had detrimental or beneficial effects on the treatment of prostate or breast cancer.

According to the examining division, the priority for the claimed subject-matter was valid.

IV. With the statement of grounds of appeal, the appellant resubmitted the set of claims on which the decision under appeal was based as its main request and filed auxiliary requests 1 to 7. It also filed additional documents, *inter alia* D20 and D25.

V. In a communication pursuant to Article 15(1) RPBA, the board expressed doubts as to the validity of the

priority for the claimed subject-matter and indicated issues that needed to be discussed regarding sufficiency of disclosure.

VI. By letter dated 3 February 2020, third-party observations pursuant to Article 115 EPC were filed by Dr Martin Bachelin from Hoffmann Eitle, to which the appellant replied by letter dated 11 March 2020.

VII. The board acceded to the appellant's request for a change of date of the oral proceedings due to the COVID-19 outbreak and issued a new summons to oral proceedings, scheduling them to take place on 14 August 2020.

VIII. In a communication dated 15 May 2020, the board provided further comments and observations to facilitate the discussion at the oral proceedings. It also introduced document S2 into the appeal proceedings. In addition, the appellant was informed of the possibility of the oral proceedings being conducted as a videoconference.

IX. By letter dated 14 July 2020, the appellant filed new sets of claims according to auxiliary requests 8 to 15, which were identical to the sets of claims according to the main request and auxiliary requests 1 to 7 except that claims 4 and 5 had been deleted in each of the new claims sets. The appellant also informed the board that it agreed to the oral proceedings being held by videoconference.

X. At the oral proceedings, which took place as scheduled on 14 August 2020 as a videoconference, the appellant withdrew its main request and all auxiliary requests

except auxiliary requests 9, 11, 13 and 15. It also filed document D26.

XI. Auxiliary request 9 consists of three independent claims reading as follows:

"1. Abiraterone acetate for use in a method of treating prostate cancer in a human, said method comprising administering to said human a therapeutically effective amount of abiraterone acetate and a therapeutically effective amount of prednisone."

"2. Prednisone for use in a method of treating prostate cancer in a human, said method comprising administering to said human a therapeutically effective amount of said prednisone and a therapeutically effective amount of abiraterone acetate."

"3. A pharmaceutical composition for use in a method of treating prostate cancer in a human, wherein the pharmaceutical composition comprises a therapeutically effective amount of abiraterone acetate and a therapeutically effective amount of prednisone."

XII. The appellant's arguments as far as they concern the decisive issue of the present decision can be summarised as follows:

- Priority

The invention currently claimed was entitled to its priority date. The subject-matter of the claims of auxiliary request 9 was directly and unambiguously derivable from the disclosure of the priority application. The "same invention" standard was met.

The priority application related to a combination therapy of 17α-hydroxylase/$C_{17,20}$-lyase (CYP-17) inhibitors with at least one additional anticancer agent for the treatment of cancer (see for example paragraphs [0001], [0008] or [0029]). The focus on abiraterone acetate to be used as preferred CYP-17 inhibitor was apparent from the very first paragraph of the priority application, and its preference in the combination therapy was reinforced by paragraphs [0018] and [0037]. The treatment of prostate cancer was also directly and unambiguously disclosed. This specific cancer type was highlighted throughout the priority application (see for example paragraphs [0002] to [0007] and in particular paragraph [0038]). Paragraph [0038] directly linked abiraterone acetate to the treatment of prostate cancer. The priority application also clearly referred to the combination of abiraterone acetate with any additional anticancer agents recited in the priority application (see paragraphs [0028] and [0067]). The additional anticancer agents referred to in paragraphs [0042] to [0051] represented a single list of compounds to be combined with abiraterone acetate. The assignment of the individual anticancer agents to different classes was irrelevant and should not be understood as a restriction (see last sentence of paragraph [0042] of the priority application). Prednisone was explicitly mentioned in the list of suitable anticancer agents (see paragraph [0050]). Even if the skilled person had realised that prednisone did not belong to the class of antibiotic compounds referred to in paragraph [0050], they would not have simply discarded it. The skilled person knew from the cross-referenced document D1 (see paragraph [0038] of the priority application) that glucocorticoids, to which prednisone belongs, were potential combination partners for abiraterone acetate in the treatment of

prostate cancer. Furthermore, prednisone was an anticancer agent. To discard it would have been at odds with common general knowledge as illustrated in document D16. Specifying prednisone was an allowable mono-dimensional restriction of the additional anticancer agent.

- Sufficiency of disclosure

The requirement of Article 83 EPC was met. The application disclosed the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. There was no doubt that the claimed combination therapy worked in the treatment of prostate cancer. This was confirmed by documents D20 and D25.

The examining division had erred in its legal and factual analysis. It had incorrectly referred to the problem to be solved, i.e. the provision of a more effective way of treating prostate and breast cancer, in the context of sufficiency. Nothing in the claims required a more effective treatment. The problem to be solved, and the contribution of the additional anticancer agents to the solution of that problem, were points for consideration in the assessment of inventive step.

The suitability of abiraterone acetate in the treatment of prostate cancer had not been contested by the examining division. In line with decision T 1616/09, the same conclusion applied to the combination of abiraterone acetate with prednisone. The documents cited by the examining division did not provide sufficient reasons, based on verifiable facts, to

believe that prednisone would interfere with the activity of abiraterone acetate.

According to document D16, glucocorticoids had been widely used in the treatment of prostate cancer at the priority date and their growth inhibitory effect was well documented (see D16, page 553, left-hand column, second and third paragraphs). D16 also disclosed that glucocorticoids had been extensively used in the treatment of androgen-independent prostate cancer (AIPC) (see page 555, left-hand column, first paragraph under the heading "Clinical Utility of Glucocorticoids in AIPC").

Document D17 acknowledged the use of glucocorticoids in the treatment of various cancers, including prostate cancer (see first sentence of abstract and introduction), but also discussed potential disadvantages, such as the induction of treatment resistance, the induction of progression of metastasis and the suppression of the immune system, which might exacerbate the metastatic process (see page 426, right-hand column, lines 27 to 32; page 427, paragraph bridging the left- and right-hand columns; page 428, left-hand column, second complete paragraph). As regards treatment resistance, none of the references supporting this assertion in D17 mentioned hormone therapy. On the contrary, various references explicitly mentioned non-hormonal treatments, such as cytotoxic therapy or chemotherapy. As regards the induction of metastasis and the immunosuppressive activity, D17 referred to rather old publications, despite the existence of which glucocorticoids had become widely used in the treatment of prostate cancer.

Document D18 also indicated that glucocorticoids might induce treatment resistance to a broad range of cytotoxic agents used in the treatment of cancer (see page 1969, right-hand column, second paragraph), but crucially hormone therapy was not mentioned in this context. Inhibition of apoptosis by corticosteroids was mentioned (see D18, page 1969, first sentence of the last paragraph), but again not in the context of hormone therapy.

XIII. The appellant requested that the decision be set aside and a patent be granted on the basis of one of the sets of claims according to auxiliary requests 9, 11, 13 and 15 filed by letter dated 14 July 2020.

XIV. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. Admission of document D26 into the proceedings

2.1 Document D26 was filed at the oral proceedings before the board in support of the appellant's argument that prednisone is an antibiotic.

2.2 The board notes that the question as to whether or not prednisone belongs to the list of antibiotic agents of paragraph [0050] of the priority document had already been raised by the board in its communication dated 17 January 2020. Therefore, the appellant could and should have submitted evidence to address this issue at

a much earlier stage of the proceedings. Moreover, the board did not regard document D26 as evidence that prednisone - a known anti-rheumatic, anti-inflammatory and immunosuppressive agent - was also commonly known as an antibiotic agent.

2.3 Hence, in exercising its discretion under Article 114(2) EPC and Article 13 RPBA 2007, applicable under the provision of Article 25(3) RPBA 2020, the board decided not to admit document D26 into the proceedings.

Auxiliary request 9 filed on 24 July 2020 (main request)

3. Admission

Auxiliary request 9 was filed to address the board's concerns regarding the simultaneous presence of purpose-limited product claims and Swiss-type claims in a single claim set. Since this issue had been raised for the first time in the board's communication dated 15 May 2020 and has been resolved by the deletion of the Swiss-type claims, the board sees no reason not to admit auxiliary request 9 into the appeal proceedings.

4. Validity of priority

4.1 Document D13 constitutes prior art for the assessment of novelty and inventive step, if and to the extent that the priority is not valid for the subject-matter of auxiliary request 9. Therefore it needs to be established whether the priority date is valid as regards the claimed subject-matter.

4.2 According to Article 87(1) EPC, a right of priority can only be enjoyed for the same invention. In opinion

G 2/98, in which the Enlarged Board of Appeal considered the requirement of the same invention, it is stated that priority 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 (see G 2/98, headnote).

4.3 Claims 1 and 2 of auxiliary request 9 are directed to abiraterone acetate and prednisone to be used in a method of treating prostate cancer, said method comprising the administration of therapeutically effective amounts of abiraterone acetate and prednisone. Claim 3 is directed to a pharmaceutical composition to be used in such a method comprising abiraterone acetate and prednisone (see point XI above).

4.4 The invention disclosed in the priority document (US 60/921,506) relates to a combination therapy for the treatment of cancer comprising the administration of a 17α-hydroxylase/$C_{17,20}$-lyase inhibitor and at least one additional anticancer agent (see paragraphs [0001], [0008] and [0029]; claim 1). In the very first paragraph, abiraterone acetate is identified as the preferred 17α-hydroxylase/$C_{17,20}$-lyase inhibitor. This is further confirmed in paragraphs [0018] and [0037] and claim 4 of the priority application. 17α-hydroxylase/$C_{17,20}$-lyase is a key enzyme in the biosynthesis of androgens, including testosterone, which are known to promote the growth of prostate cancer (see paragraphs [0002] to [0007] and [0012] of the priority application). Moreover, paragraph [0038], which refers to document D1 - a document considered to be part of common general knowledge - explicitly links

abiraterone acetate to the treatment of prostate cancer.

4.5 The board therefore concurs with the appellant that a combination therapy with abiraterone acetate and an additional anticancer agent in the treatment of prostate cancer is clearly and unambiguously derivable from the priority application. The skilled person is also taught that any anticancer agents cited in the priority application can be used (see paragraphs [0029] and [0067]).

4.6 Additional anticancer agents, which are categorised according to their mechanism of action, e.g. hormone ablation agents, antibiotic agents, and antiandrogens, are mentioned in paragraph [0042] of the priority application. In the subsequent paragraphs [0043] to [0051] individual compounds are disclosed for each of these categories. The board accepts the appellant's view that, regardless of their different mechanisms of action, the individual compounds form a single list of additional anticancer agents.

4.7 Prednisone is mentioned in paragraph [0050] of the priority application in the context of suitable antibiotic agents. The skilled person, based on their common general knowledge, would however immediately realise that prednisone does not belong to this list. The antibiotics referred to in paragraph [0050] are compounds which in view of their strong cytotoxicity are useful as chemotherapeutic agents in the treatment of cancer. Prednisone on the other hand is a corticosteroid with glucocorticoid activity which is commonly known as an anti-rheumatic, anti-phlogistic and immunosuppressive agent. Hence it needs to be examined whether the skilled person, having realised

this discrepancy, would have considered the reference to prednisone in paragraph [0050] a mistake and consequently would have discarded it from the list of suitable compounds for co-administration, or whether they would have considered the reference to prednisone in the context of paragraph [0050] a simple misclassification.

4.8 In the cross-referenced document D1 (see paragraph [0038] of the priority application), the skilled person is taught the potential use of glucocorticoids in combination with abiraterone acetate in the treatment of prostate cancer. This is consistent with the common practice of glucocorticoid repletion when patients are treated with adrenal androgen inhibitors (see point 5.4 below). In addition, based on their common general knowledge, the skilled person would be aware that glucocorticoids have shown prostate cancer cell growth-inhibitory properties (see for example D14, pages 30/31, section "corticosteroids"; D16: page 553, left-hand column, fifth line from the bottom to right-hand column, line 2; page 555, left-hand column, first complete paragraph; page 559, left-hand column, lines 1 to 6 of first complete paragraph; point 5.5 below). In the board's view, the skilled person would therefore not discard prednisone from the list of additional anticancer agents, regardless of its apparently incorrect classification as a (cytotoxic) antibiotic.

4.9 It follows from the above that in the present case the selection of prednisone is not considered to result in new subject-matter since the selection is made from a single list of additional anticancer agents to be co-administered.

4.10 Hence the board concludes that the claimed subject-matter of auxiliary request 9 is clearly and unambiguously derivable from the priority application. The priority date is therefore validly claimed for said subject-matter.

5. Sufficiency of disclosure (Article 83 EPC)

5.1 Claims 1 and 2 are medical use claims drafted in the form of purpose-related compound claims pursuant to Article 54(5) EPC. As set out in point 4.3 above, they are directed to abiraterone acetate or prednisone to be used in a method of treating prostate cancer, said method comprising the administration of therapeutically effective amounts of abiraterone acetate and prednisone. In the board's understanding of claims 1 and 2, the claimed effect, i.e. the treatment of prostate cancer, is attained by the combined administration of abiraterone acetate and prednisone.

5.2 According to the case law of the boards of appeal, for a therapeutic use to be accepted as sufficiently disclosed, the application as filed must provide some information rendering it technically plausible for the skilled person that the claimed therapeutic effect is attained, or the therapeutic effect must be derivable from the prior art or common general knowledge (see e.g. T 1599/06, point 6 of the Reasons; T 609/02, point 9 of the Reasons).

5.3 The examining division did not dispute the suitability of abiraterone acetate in the treatment of prostate cancer. Neither does the board. Abiraterone acetate acts as an inhibitor of 17α-hydroxylase/$C_{17,20}$-lyase, which is a key enzyme in the biosynthesis of androgens (see textbook D15, Figure 93.2; D1, Figure 1; or S2,

Figure 1). Abiraterone acetate has been shown to reduce the level of testosterone produced by the testes and adrenal glands in castrate and non-castrate men with advanced prostate cancer (see D15, pages 919 to 920, section "abiraterone acetate" in combination with D1, in particular pages 2320 to 2321, section "Results"). Androgens, including testosterone, promote the growth of prostate cancer, and androgen deprivation therapy has been the mainstay in the systemic management of prostate cancer (see D15, page 916, left-hand column, last paragraph). The data in D1 also support a potential role of abiraterone acetate in the treatment of refractory cancer (see D1, page 2324, right-hand column, last paragraph).

5.4 As regards prednisone, the board notes that it is a well-known compound belonging to the class of corticosteroids with mainly glucocorticoid activity. Glucocorticoids are known in the art to act as anti-rheumatic, anti-inflammatory and immunosuppressive agents. They have been widely used in palliative treatment of prostate cancer, *inter alia* to treat pain from osseous metastasis, nausea and vomiting, discomfort from inflammatory reaction, etc. (see D17: page 425, left-hand column, lines 1 to 14; page 426, section "Historical overview"). They are also known as standard supportive therapy for patients treated with agents that inhibit adrenal function, e.g. for glucocorticoid repletion and to alleviate potential side effects which might occur when gluco- and mineralocorticoid pathways in the adrenal glands are affected (see for example D14, page 30, right-hand column, last paragraph to page 31, left-hand column, line 17; D15, page 920, left-hand column, lines 14 to 16; D16, page 553, right-hand column, first complete paragraph; D17, page 425, right-hand column, lines 5 to

18). The board notes that neither the palliative nor the supportive use of prednisone in the treatment of prostate cancer is excluded by the wording of the claims of auxiliary request 9.

5.5 Furthermore, glucocorticoids are also known for their antiproliferative effects and anticancer activity in the treatment of prostate cancer patients, in particular of patients with androgen-independent prostate cancer (AIPC, equivalent to refractory or recurring cancer in the application at issue, see paragraphs [0027] to [0030]) in whom the cancer has become resistant to castration (see D16: page 553, left-hand column, fifth line from the bottom to right-hand column, line 2; pages 555 to 559, section "Clinical Utility of Glucocorticoids in AIPC"; page 559, left-hand column, first complete paragraph under the heading "Comment"), even if the benefits may be limited and the mechanism of the inhibitory effect of glucocorticoids on prostate cancer cell growth is not yet fully understood (see D16: page 553, right-hand column, lines 2 to 4; page 559, left-hand column, first complete paragraph). In table 1, document D16 reports a PSA (prostate-specific androgen) decline for various glucocorticoids, including prednisone. PSA is a marker for response in the treatment of prostate cancer and is associated with an increase in overall survival rate (see D16, page 555, right-hand column, first complete paragraph). It is the same parameter on which the appellant's expert relied to argue efficacy of a combination of abiraterone acetate and a glucocorticoid. A modest anticancer effect of glucocorticoids is also disclosed in document D14 (see page 30, right-hand column, fifth line from the bottom to page 31, left-hand column, line 17; page 28, table 1).

5.6 In view of the above, the board judges that it was technically plausible at the relevant date for the claimed therapeutic effect, i.e. the treatment of prostate cancer, to be attained by the combined administration of abiraterone acetate and prednisone.

5.7 This conclusion is not altered by certain reservations about the use of glucocorticoids in the treatment of cancer, as described in documents D17 and D18. It is undisputed that prednisone, like any medication, may also exhibit adverse effects. In this context, documents D17 and D18 refer to glucocorticoid-induced tumour resistance, potential contribution to progression of metastasis and suppression of the immune system. The board notes that glucocorticoid-induced resistance in cells of solid tumours has been essentially observed for combinations with either cytotoxic anticancer agents (i.e. in chemotherapy) or radiotherapy (see D17, page 426, right-hand column, lines 27 to 50 and the table on page 427; D18, page 1969, right-hand column, first complete paragraph). Apparently, glucocorticoids block the lethal signal delivered by cytotoxic drugs. Hormone therapy or effects of glucocorticoids in hormone therapy are not mentioned in this context. Document D17 also suggests that glucocorticoids might suppress the immune system and might contribute to progression of metastasis of prostate cancer (see page 428, left-hand column, line 3 to right-hand column, line 17). However, no verifiable data relating to prostate cancer is provided in this context.

5.8 In the board's view, documents D17 and D18 alert the clinician to the potential risks which may be associated with the use of glucocorticoids, which is

important information in deciding on an appropriate treatment by balancing potential risks and known benefits, but does not render technically implausible the claim of the patent application that the combined administration of abiraterone acetate and prednisone could be used in the treatment of prostate cancer. In the board's view, D17 or D18 does not constitute evidence that prednisone would interfere with abiraterone acetate to the extent that the effectiveness of abiraterone acetate in lowering the level of androgens, and accordingly its suitability in the treatment of prostate cancer, would be completely eliminated.

5.9 In the decision under appeal, the examining division argued that there was no information on how the compounds to be co-administered with abiraterone acetate contribute to the problem to be solved as stated in paragraph [0007] of the patent application, i.e. the provision of a more effective way to treat cancer, in particular prostate cancer.

The board concurs with the appellant that the question of whether the combined administration of abiraterone acetate and prednisone leads to increased efficacy is not relevant in the context of sufficiency of disclosure: indeed, an improvement is not required by the claims (see also T 1616/09, point 6.2.3 of the Reasons). Whether the co-administration of prednisone leads to any beneficial effects beyond those that could and would have been expected are issues that may be relevant in the discussion of inventive step, but not that of sufficiency of disclosure.

5.10 The board agrees with the examining division that the application does not contain any information that

prednisone has a direct effect on a metabolic mechanism specifically involved in prostate cancer. However, in the board's judgement, the inhibitory effect of glucocorticoids on prostate cancer cell growth was already known in the art, as set out in point 5.5 above, and did not need to be demonstrated. Moreover, the co-administration of glucocorticoids in combination with adrenal androgen inhibitors was common practice. Hence, based on their common general knowledge, the skilled person had no serious reason to doubt the suitability of the co-administration of prednisone in a method of treating prostate cancer. As explained in point 5.9 above, whether any unexpected beneficial effects are obtained is a matter that will have to be discussed in the context of inventive step.

5.11 The examining division also pointed to the statement in document D1 that further studies were needed to ascertain whether concomitant therapy with glucocorticoids was necessary (see D1, page 2323, right-hand column, last paragraph). However, this statement is not a contraindication for the co-administration of glucocorticoids in the treatment of prostate cancer. It merely informs the skilled person that it is not yet certain whether the co-administration of glucocorticoids, which is standard practice in treatment with adrenal androgen inhibitors, is indeed necessary. The fact that in D1 the patients were not allowed to take steroids represents good scientific practice in the board's opinion. The purpose of D1 is to examine the efficacy of abiraterone acetate; steroids on the other hand may also have an antitumour effect on prostate cancer by the suppression of adrenal androgens due to negative feedback on the pituitary gland (see D16, page 553, right-hand column, first complete paragraph).

5.12 For the reasons given above, the board concludes that the subject-matter of auxiliary request 9 is sufficiently disclosed. The requirement of Article 83 EPC is therefore met.

6. Remittal

6.1 The board notes that the examining division in its communication dated 13 March 2018, on which the decision under appeal is based, assessed solely priority and sufficiency of disclosure. No other requirements for patentability of the subject-matter currently claimed were discussed and decided on.

6.2 Having regard to the primary object of the appeal proceedings, which is to review the decision under appeal in a judicial manner (Article 12(2) RPBA 2020) and not to conduct a complete examination of the application, the board considers the fact that the examining division has not yet taken an appealable decision upon all requirements for patentability to be a special reason within the meaning of Article 11 RPBA 2020 justifying remittal.

6.3 In exercising its discretion under Article 111(1) EPC, the board therefore remits the case to the examining division for further prosecution.

Auxiliary requests 11, 13 and 15

7. Since auxiliary request 9 (main request) is found to comply with Article 83 EPC and is remitted to the examining division for the reasons set out above, there is no need for the board to decide on the lower-ranking auxiliary requests 11, 13 and 15.

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 based on the main request filed as auxiliary request 9 by letter dated 24 July 2020.

The Registrar: The Chairman:

M. Schalow A. Lindner

Decision electronically authenticated