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**Datasheet for the decision
of 11 July 2025**

Case Number: T 0217/23 - 3.3.04

Application Number: 16822406.1

Publication Number: 3389691

IPC: A61K38/12, C07K7/50, C07K7/64,
C07K14/005, A61K51/08,
A61K47/50, A61K51/04, A61P31/20

Language of the proceedings: EN

Title of invention:

Cyclic NTCP-targeting peptides and their uses as entry
inhibitors

Patent Proprietor:

Ruprecht-Karls-Universität Heidelberg

Opponent:

Margaret Dixon Limited

Headword:

Cyclic peptides/RUPRECHT-KARLS-UNIV

Relevant legal provisions:

EPC Art. 123(2)
RPBA 2020 Art. 12(4), 12(6)

Keyword:

Main request - Amendments - allowable (no)

Auxiliary requests - Amendment to the case - should have been submitted in the proceedings leading to the decision under appeal (yes)

Decisions cited:

G 0002/10, T 0326/87, T 0430/89, T 0669/90, T 0951/91,
T 0201/92, T 0502/98, T 0582/08, T 0141/20



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0

Case Number: T 0217/23 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 11 July 2025

Appellant: Margaret Dixon Limited
(Opponent) 1st Floor, Aurora Building
Counterslip Bristol BS1 6BX (GB)

Representative: Mewburn Ellis LLP
Aurora Building
Counterslip
Bristol BS1 6BX (GB)

Respondent: Ruprecht-Karls-Universität Heidelberg
(Patent Proprietor) Grabengasse 1
69117 Heidelberg (DE)

Representative: Engelhard, Markus
Boehmert & Boehmert
Anwaltspartnerschaft mbB
Pettenkoferstrasse 22
80336 München (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
15 November 2022 concerning maintenance of the
European Patent No. 3389691 in amended form.

Composition of the Board:

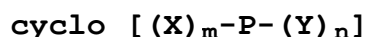
Chairwoman M. Pregetter
Members: D. Luis Alves
L. Bühler

Summary of Facts and Submissions

- I. European patent No. 3 389 691, entitled "*Cyclic NTCP-targeting peptides and their uses as entry inhibitors*", was granted on European patent application No. 16 822 406.1, filed as an international application published as WO 2017/102906 (in the following, the application as filed).
- II. The patent was opposed under Article 100(a) EPC, on the grounds of lack of inventive step (Article 56 EPC), and on the grounds of insufficiency of disclosure (Article 100(b) EPC) and added subject-matter (Article 100(c) EPC).
- III. The opposition division decided that, account being taken of the amendments in the form of auxiliary request 2, the patent and the invention to which it related met the requirements of the EPC (Article 101(3) (a) EPC).
- IV. The opponent (appellant) filed an appeal against that decision. The patent proprietor is respondent to this appeal.
- V. In its statement setting out the grounds of appeal, the appellant contested the reasoning of the opposition division on, *inter alia*, added subject-matter (Article 123(2) EPC). It also filed several documents. Before the time limit for filing the statement setting out the grounds of appeal, the appellant filed further arguments and documents with the letter dated 27 March 2023.

- VI. With the reply to the statement of grounds of appeal, the respondent filed sets of claims of a main request and two auxiliary requests. The main request is identical to the request held allowable by the opposition division. Auxiliary requests 1 and 2 are newly filed in appeal.
- VII. The board appointed oral proceedings and in a communication pursuant to Article 15(1) RPBA, informed the parties of its preliminary opinion that, *inter alia*, the main request did not meet the requirements of Article 123(2) EPC and that auxiliary requests 1 and 2 were not to be admitted into the appeal proceedings.
- VIII. By letter dated 15 April 2025, the appellant withdrew the request for oral proceedings and informed that it would not be attending.
- IX. The respondent, with the letter dated 5 June 2025, filed further arguments and sets of claims of corrected auxiliary request 1 and auxiliary requests 1a and 2a. It informed the board that it would not attend the oral proceedings.
- X. The board cancelled the oral proceedings.
- XI. Claims 1 and 10 of the **main request** read as follows.

"1. A cyclic peptide of the general formula 1a



(Ia)

wherein

P is the amino acid sequence NPLGFXaaP (SEQ. ID NO: 1),
with Xaa being F or L,
X is an amino acid sequence having a length of m amino
acids,
wherein m is at least 1;
Y is an amino [sic] sequence having a length of n amino
acids,
wherein n is at least 1;
and wherein m + n is 2 to 42;

and carrying at least one hydrophobic modification at
amino acid side chain(s) of X,
wherein said cyclic peptide is not cyclized within the
amino acid sequence of P of SEQ ID NO. 1 and not via
amino acid side chains of P,

wherein the hydrophobic modification is an acylation or
addition of hydrophobic moieties,

or a pharmaceutically acceptable salt thereof.

10. The cyclic peptide of any of claims 1 to 8 or the
pharmaceutical composition of claim 9 for use as *in*
vitro HBV and/or HDV entry inhibitors."

Claim 1 of **auxiliary request 1**, as well as of **corrected**
auxiliary request 1 and **auxiliary request 1a**, reads as
claim 1 of the main request except for the definitions
of P and of the hydrophobic modification, which read as
follows (the differences relative to the main request
are indicated with underlining, for additions, and
strike-through, for deletions):

"**P** is the amino acid sequence NPLGFXaaP (SEQ. ID NO:
1), with Xaa being F ~~or L~~"

"wherein the hydrophobic modification is an acylation with C8 to C22 fatty acids ~~or addition of hydrophobic moieties~~"

Auxiliary request 1 and corrected auxiliary request 1 contain a claim identical in wording to claim 10 of the main request.

Claim 1 of **auxiliary requests 2 and 2a** reads as claim 1 of auxiliary request 1 except for the additional definition of the peptide, inserted after the definition of P, X and Y of formula Ia, as follows (inserted text is indicated by underlining):

"1. A cyclic peptide ... [as claim 1 of auxiliary request 1] ... wherein

P is [as claim 1 of auxiliary request 1]

X is [as claim 1 of auxiliary request 1]

Y is [as claim 1 of auxiliary request 1]

consisting of an amino acid sequence selected from the group of SEQ ID Nos. 7, 9, 10, 13, 15, 16, 24 and 25
...."

Auxiliary request 2 contains a claim identical in wording to claim 10 of the main request.

XII. The appellant's arguments relevant to this decision may be summarised as follows.

Main request

Amendments (Article 123(2) EPC) - Claim 10

The requirements of Article 123(2) EPC were not met. The application as filed did not include the term "*in vitro*". Claim 10 was directed to a product, and

therefore this term was not used to disclaim unpatentable subject-matter. The assay disclosed in the example in the application as filed could not serve as a basis for the generalisation in claim 10.

Auxiliary requests 1, 1a, 2, 2a and corrected auxiliary request 1

No arguments were provided in respect of these requests.

XIII. The respondent's arguments relevant to this decision may be summarised as follows.

Main request

Amendments (Article 123(2) EPC) - Claim 10

Peptides for use as *in vitro* HBV and/or HDV entry inhibitors were directly and unambiguously derivable from the application as filed for a skilled person.

Claim 11 as filed did not explicitly define the use to be an *in vivo* use and therefore at least implicitly related to both *in vitro* and *in vivo* uses.

Subject-matter implicitly disclosed to the skilled person was part of the content of the application as filed.

Claim 11 as filed provided a disclosure of only two specific embodiments: *in vitro* and *in vivo* uses.

The *in vitro* use was furthermore implied for the skilled person from point 4 on page 39 ("example 4") and Figure 8, of the application as filed.

Auxiliary requests 1 and 2

Admittance into the appeal proceedings

The auxiliary requests should be admitted into the appeal proceedings, in line with decision T 141/20.

In opposition proceedings, a myriad of auxiliary requests could have been filed to address the multiple objections of the opponent. However, this would have been against procedural economy.

The preliminary opinion of the opposition division was highly positive. Thus, there was no reason to file any further auxiliary requests during the opposition proceedings.

Auxiliary requests 1a, 2a and corrected auxiliary request 1

Admittance into the appeal proceedings

Compared to auxiliary request 1, the corrected auxiliary request 1 merely contained corrections of two obvious errors and therefore did not amount to an amendment of the respondent's case. It should be admitted into the appeal proceedings.

Auxiliary requests 1a and 2a corresponded to auxiliary requests 1 and 2, respectively, where one claim objected to for added-matter and one claim objected to for lack of sufficient disclosure had been deleted. These requests should be admitted into the proceedings as they promoted procedural economy.

- XIV. The appellant requested in writing that the decision under appeal be set aside and that the patent be revoked.

The respondent requested in writing that the appeal be dismissed and that the patent be maintained in amended form on the basis of the claims of the main request (held allowable by the opposition division) or of corrected auxiliary request 1, auxiliary request 1, auxiliary request 1a, auxiliary request 2 or auxiliary request 2a. Furthermore, it was requested that the documents filed by the appellant in appeal proceedings not be admitted.

Reasons for the Decision

1. The appellant withdrew the request for oral proceedings, and the respondent informed the board that it would not be attending. Therefore, the board cancelled the oral proceedings and decided the case on the basis of the written submissions of the parties.

Main request

Amendments (Article 123(2) EPC) - Claim 10

2. Claim 10 of the main request reads as follows (underlining added by the board):

"10. The cyclic peptide of any of claims 1 to 8 or the pharmaceutical composition of claim 9 for use as in vitro HBV and/or HDV entry inhibitors."

The underlined wording "*in vitro*" is at issue here as it was not present in the corresponding claim (claim 11) as filed.

3. It is established case law of the boards that any amendment to the parts of a European patent application or a European patent relating to the disclosure (the description, claims and drawings) can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of the application as filed (decision G 2/10, Reasons 4.3).
4. As the basis for the wording "*in vitro*", the respondent indicated the following passages of the application as filed: claim 11, point 4 on page 39 ("example 4") and Figure 8.
5. Claim 11 of the application as filed is drafted in the form of a purpose-limited product claim, pursuant to Article 54(5) EPC, and is directed to a cyclic peptide for use in the inhibition of HBV or HDV infection, prevention of primary infections with HBV or HDV, and as an inhibitor of HBV and/or HDV entry. However, given that the application was filed as an international application under the PCT, it may be argued that the claim was not intended to be drafted in the form pursuant to Article 54(5) EPC. Indeed, the respondent argued that the claim does not refer to *in vivo* uses and thus implicitly relates to both *in vitro* and *in vivo* uses. According to the respondent, claim 11 was not a broad generic disclosure but instead disclosed only two alternative embodiments: *in vivo* and *in vitro*.

6. The board does not find this argument convincing as the absence of a feature (*in vivo*, in the current case) does not amount to the direct and unambiguous disclosure of an alternative feature (*in vitro*, in the current case).
7. The board also does not agree with the respondent that an *in vitro* use is necessarily implied by the patent application as a whole. In its line of argument, the respondent relied on claim 11 in combination with page 39 and Figure 8. Page 39 and Figure 8 concern the same *in vitro* inhibition assay described in point 4 of the example. Even if the example describes an assay for the inhibitory activity of the peptides, it cannot from this assay, carried out under specific conditions, be inferred that the invention concerns *in vitro* assays as generally defined in claim 10 of the main request. Moreover, in the board's view, an *in vitro* use is not implied by the application as filed when read as a whole since it relates solely to peptides for medical uses, in particular concerning HBV infection, liver diseases and cardiovascular diseases.
8. In conclusion, the subject-matter of claim 10 extends beyond the content of the application as filed, contrary to the requirements of Article 123(2) EPC.

Auxiliary requests 1 and 2

Admittance into the appeal proceedings

9. Auxiliary requests 1 and 2 were filed for the first time in appeal proceedings. Compared to claim 1 of the main request, in these requests the peptide defined in claim 1 is more limited both in terms of the sequence of the core peptide P and the nature of the hydrophobic moiety. In auxiliary request 2, the peptide is

additionally limited in terms of the overall peptide sequence. Further, in both requests independent claim 14, directed to peptides for use in treating cardiovascular diseases, has been deleted.

10. Under the provisions of Article 12(4) RPBA, these requests are an amendment to the respondent's case since they were not admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendments may be admitted only at the discretion of the board. The provisions of Article 12(6) RPBA, which apply to amendments to a party's case, provide that the board shall not admit requests which should have been submitted in the proceedings leading to the decision under appeal unless the circumstances of the appeal case justify their admittance.
11. In the case at hand, the notice of opposition included objections under the grounds for opposition in Article 100(a) EPC, for lack of inventive step, and in Article 100(b) and (c) EPC. The opponent made the argument that a technical effect could not be extrapolated from the compounds exemplified in the patent to all compounds claimed, in respect, for example, of the hydrophobic moiety and the specific peptide sequence. Therefore, that technical effect could not be taken into account in the assessment of inventive step (see points 4.6, 4.10, 4.16, 4.17, 4.23 and 6.25 of the notice of opposition). The opponent reasoned why the claims directed to the peptides for medical use, including claim 14, did not meet the requirements of sufficiency of disclosure (see point 7.22 of the notice of opposition). During opposition proceedings, the patent proprietor reacted to the opponent's objections by argument and by filing

a main request and two auxiliary requests. These requests all addressed the opponent's objection that claim 1 as granted contravened the requirements of Article 123(2) EPC because the requirement for the cyclisation not to involve the core peptide P was contradictory with the embodiment where the peptides X and Y could both be absent (i.e. m and n could be zero simultaneously). In summary, with regard to all other objections raised in the notice of opposition, the patent proprietor chose to not file any fallback positions during the opposition proceedings and to rely solely on arguments. Thus, in response to the objections of lack of inventive step of the peptides defined in claim 1 and lack of sufficient disclosure of the medical uses defined in claims 11 to 16 as granted, the patent proprietor did not file any fallback positions. These were filed for the first time in appeal proceedings with limitations to the peptide in claim 1 and deletion of claim 14. The respondent has not contested that the objections had been raised with the notice of opposition and that auxiliary requests addressing them were filed for the first time in appeal proceedings.

12. Instead, the respondent submitted that the requests address objections of the opponent of lack of sufficient disclosure of claims 1 and 14 (see reply to the statement of grounds of appeal, page 16, penultimate paragraph and page 18, fourth paragraph). As to why these requests were filed only in appeal proceedings, the respondent submitted the following arguments. Addressing the multiple objections raised during the opposition proceedings would have required a myriad of auxiliary requests. This would have been against procedural economy. On the other hand, in view of the highly positive preliminary opinion of the

opposition division, there was no reason why they should have been filed during opposition proceedings. Thus, in line with decision T 141/20, the auxiliary requests should be admitted into the appeal proceedings.

13. Thus, at issue is whether a patent proprietor may wait for the preliminary opinion of the opposition division to react to the objections raised in the notice of opposition and whether, where the preliminary opinion is positive, no auxiliary claim requests with fallback positions need to be filed, unless the opposition division changes its opinion at oral proceedings.
14. In inter partes proceedings, each party has to be given equal opportunity to present its case and a fair chance to respond to new matter raised by the other party or parties, or by the opposition division. The opposition division and the parties have to observe the principle of good faith (T 669/90, OJ EPO 1992, 739, points 2.3 and 2.4; T 201/92, point 3.5). To expedite the proceedings and implement the principle of fairness towards the other party or parties, each party must submit all facts, evidence, arguments and requests for amendments relevant for its case as early and completely as possible, and not in a piecemeal manner (T 326/87, OJ EPO 1992, 522, points 2.1.1 and 2.1.2; T 430/89, point 5.3; T 951/91, OJ EPO 1995, 202, points 5.2 and 5.3). This case law developed mainly in the context of Article 114(2) EPC pertaining to facts and evidence. Nevertheless, in view of the principles set out above, the rationale of this case law also applies to a patent proprietor's observations and amendments (Rule 79(1) EPC), which should not only include all facts and evidence relied on to defend the patent (T 502/98, point 1.5) but also requests for amendment

of the patent considered necessary to address the main objections raised by the opponent in case these should be found to prejudice the maintenance of the patent (see e.g. T 582/08, point 8.5).

15. Patent proprietors do not have a privileged position in opposition proceedings allowing them to address objections raised by opponents by way of requests for amendment only when presented with the preliminary or final opinion of the opposition division in the summons or during oral proceedings. This would be unfair to the opponents as they would be confronted at a very late stage with a change in the object of the proceedings that they could not reasonably have foreseen and for which they could not prepare. To expect a patent proprietor to address in its observations to a notice of opposition the objections raised by the opponents also by filing suitable fallback positions does not place an undue burden on the patent proprietor. A proper response to an opposition does not require permutations of sets of amended claims that address each objection individually or in any combination as this would leave it to the opposition division to identify any patentable subject-matter from such a plethora of claim sets and unduly burden the proceedings. Presented with an opponent's complete case at the outset of the opposition proceedings, a patent proprietor, knowing its commercial interests, should be able to define a reasonable number of fallback positions that address the main issues in its observations to the opposition. Although the persuasiveness of objections by opponents cannot be predicted with absolute certainty, the duty to file requests for amendment cannot solely depend on the opinion by the opposition division as this would imply a shift of the patent proprietor's responsibility for

making its case to the opposition division and would compromise the opposition division's duty to equal treatment of the parties. Of course, there are complex cases in which numerous objections are raised which cannot be fully addressed by a reasonable number of requests for amendments and which might even require the patent proprietor to adopt non-convergent strategies of defence to safeguard its commercial interests in a patent. Nevertheless, also in these cases, the main lines of defence should emerge from the patent proprietor's observations to an opposition which also must include any request for amendment to give the opponent a proper opportunity to reply to new matter and to avoid ping-pong submissions immediately before or during oral proceedings before the opposition division.

16. Requiring the submission of all facts, evidence, arguments and requests for amendments relevant for the patent proprietor's case as early and completely as possible does not preclude further submissions, including the filing of additional requests for amendment in the course of opposition proceedings if there are good reasons, for example, responding to new evidence, addressing new objections or dealing with unforeseen challenges relating to gaps in the chain of evidence or argument which emerge during the course of the proceedings.
17. For these reasons, T 141/20 (point 5.4.1) is not followed.
18. The board considers that in the current case there are no circumstances justifying the admittance of auxiliary requests 1 and 2 into the appeal proceedings, and

decided to not admit them into the appeal proceedings (Article 12(6) RPBA).

*Auxiliary requests 1a, 2a and corrected auxiliary request 1
Admittance into the appeal proceedings*

19. These claim requests were filed after notification of a communication under Article 15(1) RPBA and are therefore an amendment to the respondent's case. Such amendments are governed by Article 13(2) RPBA 2020 and are, in principle, not to be taken into account unless there are exceptional circumstances, justified by cogent reasons.
20. The respondent submitted that the requests were in the interest of procedural economy. However, the board notes that the respondent did not withdraw auxiliary requests 1 and 2, which remained higher-ranking requests relative to auxiliary request 1a and 2a, respectively.
21. Moreover, in auxiliary requests 1a and 2a, claim 10 as granted has been deleted. This amendment addresses an objection raised in the statement of grounds of appeal, but no justification was put forward for why it had not been filed in reply to the statement of grounds of appeal.
22. Furthermore, the reasons set out above for not admitting auxiliary requests 1 and 2 apply equally to these claim requests since they include the limitations to claim 1 and deletion of claim 14 discussed above (see point 11.).

23. In light of the foregoing, the board decided to not admit the requests into the appeal proceedings.

Admittance of the documents filed by the appellant in appeal proceedings

24. The board did not decide on this issue as the contents of these documents were not of relevance for the decision.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairwoman:



A. Wille

M. Pregetter

Decision electronically authenticated