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**Datasheet for the decision  
of 8 April 2011**

**Case Number:** T 0177/08 - 3.3.02

**Application Number:** 00963551.7

**Publication Number:** 1216234

**IPC:** C07D 239/91

**Language of the proceedings:** EN

**Title of invention:**

Mediators of hedgehog signaling pathways, compositions and uses related thereto

**Patentee:**

Curis, Inc.

**Opponent:**

SMITHKLINE BEECHAM CORPORATION  
Cytokinetics, Inc.

**Headword:**

Mediators of hedgehog signaling pathways/CURIS INC.

**Relevant legal provisions:**

EPC Art. 123(3), 111  
EPC R. 43, 139

**Relevant legal provisions (EPC 1973):**

-

**Keyword:**

"Main request, auxiliary request 1 - Article 123(3): no"  
"Auxiliary request 2 - Article 123(3): yes"  
"Remittal - yes: undecided issues"

**Decisions cited:**

T 0190/99, T 0681/00, T 1321/04, T 0307/05

**Catchword:**

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Case Number: T 0177/08 - 3.3.02

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.02  
of 8 April 2011

**Appellant:** Curis, Inc.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 16 November 2007  
revoking European patent No. 1216234 pursuant  
to Article 102(1) EPC.

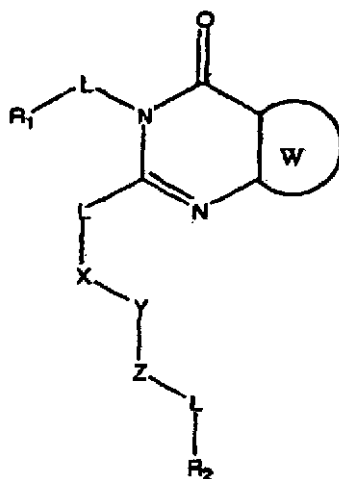
**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** A. Lindner  
L. Bühler

## Summary of Facts and Submissions

I. European patent No. 1 216 234 based on application No. 00 963 551.7 was granted on the basis of 32 claims. The independent claims read as follows:

"1. Use of a compound for the preparation of a pharmaceutical composition for inhibiting hyperproliferation of a cell, wherein the compound is an organic molecule represented by the general formula (II):



**Formula II**

wherein, as valence and stability permit,  $R_1$  and  $R_2$ , independently for each occurrence, represent H,  $C_1$ - $C_{10}$  alkyl, aryl (substituted or unsubstituted), aralkyl (substituted or unsubstituted), heteroaryl (substituted or unsubstituted), or heteroaralkyl (substituted or unsubstituted);  $L$ , independently for each occurrence, is absent or represents -alkenyl-, -alkynyl-,  $-(CH_2)_nO(CH_2)_p$ ,  $-(CH_2)_nNR_2(CH_2)_p$ -,  $-(CH_2)_nS(CH_2)_p$ -,  $-(CH_2)_n$ alkenyl $(CH_2)_p$ -,

$-(\text{CH}_2)\text{alkynyl}(\text{CH}_2)_p-$ ,  $-\text{O}(\text{CH}_2)_n-$ ,  $-\text{NR}_2(\text{CH}_2)_n-$ , or  $-\text{S}(\text{CH}_2)_n-$ ;

**X** is selected from  $-\text{N}(\text{R}_8)-$ ,  $-\text{O}-$ ,  $-\text{S}-$ ,  $-\text{Se}-$ ,  $-\text{N}=\text{N}-$ ,  $-\text{ON}=\text{CH}-$ ,  $-(\text{R}_8)\text{N}-\text{N}(\text{R}_8)-$ ,  $-\text{ON}(\text{R}_8)-$ , a heterocycle, or a direct bond between L and Y;

**Y** is selected from  $-\text{C}(=\text{O})-$ ,  $-\text{C}(=\text{S})-$ ,  $-\text{S}(\text{O}_2)-$ ,  $-\text{S}(\text{O})-$ ,  $-\text{C}(=\text{NCN})-$ ,  $-\text{P}(=\text{O})(\text{OR}_2)-$ , a heteroaromatic group, or a direct bond between X and Z;

**Z** is selected from  $-\text{N}(\text{R}_8)-$ ,  $-\text{O}-$ ,  $-\text{S}-$ ,  $-\text{Se}-$ ,  $-\text{N}=\text{N}-$ ,  $-\text{ON}=\text{CH}-$ ,  $-\text{R}_8\text{N}-\text{NR}_8-$ ,  $-\text{ONR}_8-$ , a heterocycle, or a direct bond between Y and L;

**R<sub>8</sub>**, independently for each occurrence, represents H, C<sub>1</sub>-C<sub>10</sub> alkyl, aryl (substituted or unsubstituted), aralkyl (substituted or unsubstituted), heteroaryl (substituted or unsubstituted), or heteroaralkyl (substituted or unsubstituted), or two R<sub>8</sub> taken together form a 4-to 8-membered ring, together with the atoms to which they are attached, which ring may include one or more carbonyls;

**W** represents a substituted or unsubstituted benzo or pyrido ring fused to the pyrimidone ring;

**p** represents, independently for each occurrence, an integer from 0 to 10; and **n**, individually for each occurrence, represents an integer from 0 to 10, wherein the term "heteroaryl" or "heteroaralkyl" refers to an aryl group having up to 4 heteroatoms and wherein the term "substituted" refers to a substituent selected from halogen, azide, alkyl, aralkyl, alkenyl, alkynyl, cycloalkyl, hydroxyl, alkoxy, amino, nitro, sulfhydryl, imino, amido, phosphate, phosphonate, phosphinate, carbonyl, carboxyl, silyl, ether, alkylthio, sulfonyl, sulfonamido, ketone, aldehyde, ester, heterocyclyl, aromatic or heteroaromatic moieties,  $-\text{CF}_3$ , or  $-\text{CN}$ .

21. The use as in any preceding claim, wherein L adjacent to R<sub>1</sub> is absent, and L adjacent to X is a substituted or unsubstituted methylene.
27. Use of a compound for the preparation of a pharmaceutical composition for treating cancer, wherein the compound is an organic molecule represented by the general formula (II) as defined in any preceding claim.
31. Use of a compound for the preparation of a pharmaceutical composition for inhibiting unwanted hair growth, wherein the compound is an organic molecule represented by the general formula (II) as defined in any preceding claim."
- II. Two oppositions were filed against the patent. The patent was opposed under Article 100(a) EPC for lack of novelty and inventive step, under Article 100(b) EPC for insufficiency of disclosure and under Article 100(c) EPC for amendments that contained subject-matter extending beyond the content of the application as originally filed.
- III. The present appeal lies from a decision of the opposition division, pronounced on 11 October 2007, to revoke the patent pursuant to Article 102(1) EPC.
- IV. In substance, the opposition division arrived at the conclusion that the main request filed at the oral proceedings did not meet the requirements of Article 123(3) EPC. As regards the definition "L adjacent to X is a substituted or unsubstituted methylene", a basis therefor could be found in claim 21 as granted. The skilled person, reading the claims,

would immediately recognise that claim 21, although referring to any preceding claim, was *de facto* an independent claim, which, as a consequence, did not meet the requirements of Rule 29 EPC 1973. Instead of interpreting said definition as non-existent as proposed by opponent 02, the opposition division concluded that the reformulation of claim 21 into an independent claim constituted a correction of an obvious error. As a consequence, the above definition was encompassed by the subject-matter of the claims as granted and its introduction into claim 1 of the main request was not objectionable under Article 123(3) EPC.

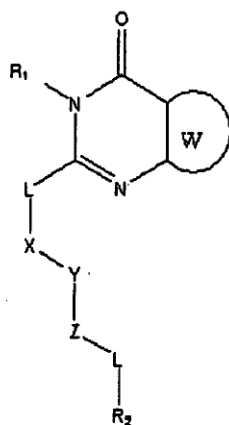
As regards the introduction of the list of possible substituents for any alkyl group, the opposition division concluded that claim 1 as granted had to be interpreted as it literally stood. In the claims the terms "substituted" or "unsubstituted" were never used in connection with "alkyl" as such, but only in combination with a specific alkyl group in claim 21 as granted. Moreover, the IUPAC definition for alkyl groups was  $C_nH_{2n+1}$ . As a consequence, the introduction into claim 1 of the list of substituents from paragraph [86] of the patent as granted, with a view to further defining the alkyl group, extended the protection conferred.

- V. The appellant (patentee) lodged an appeal against that decision.
  
- VI. With the statement of the grounds of appeal dated 25 March 2008, the appellant filed a main request and three auxiliary requests. The sole independent claims of the main request and of auxiliary request 1, which

are identical to the corresponding requests of the decision under appeal, read as follows:

(i) Main request

"1. Use of a compound for the preparation of a pharmaceutical composition for inhibiting hyperproliferation of a cell, wherein the compound is an organic molecule represented by the general formula (II):



Formula II

wherein, as valence and stability permit,  
**R<sub>1</sub>** represents H, C<sub>1</sub>-C<sub>10</sub> alkyl, aryl (substituted or unsubstituted), aralkyl (substituted or unsubstituted), heteroaryl (substituted or unsubstituted), or heteroaralkyl (substituted or unsubstituted);  
**R<sub>2</sub>** represents a substituted or unsubstituted aryl or heteroaryl group;  
**L** adjacent to X is -CH(R<sub>10</sub>)-, wherein R<sub>10</sub> is alkyl, alkenyl, cycloalkyl or aralkyl, and  
**L** adjacent to R<sub>2</sub> is absent or represents -alkenyl-, alkynyl-, -(CH<sub>2</sub>)<sub>n</sub>O(CH<sub>2</sub>)<sub>p</sub>-, -(CH<sub>2</sub>)<sub>n</sub>NR<sub>2</sub>(CH<sub>2</sub>)<sub>p</sub>-, -(CH<sub>2</sub>)<sub>n</sub>S(CH<sub>2</sub>)<sub>p</sub>-, -(CH<sub>2</sub>)<sub>n</sub>alkenyl(CH<sub>2</sub>)<sub>p</sub>-, -(CH<sub>2</sub>)<sub>n</sub>alkynyl(CH<sub>2</sub>)<sub>p</sub>-, -O(CH<sub>2</sub>)<sub>n</sub>-, -NR<sub>2</sub>(CH<sub>2</sub>)<sub>n</sub>-, or -S(CH<sub>2</sub>)<sub>n</sub>-;

**X** is  $-N(R_{12})-$ , wherein  $R_{12}$  is a substituted or unsubstituted  $C_1-C_{10}$  alkyl;

**Y** is selected from  $-C(=O)-$ ,  $-C(=S)-$ ,  $-S(O_2)-$ ,  $-S(O)-$ ,  $-C(=NCN)-$ ,  $-P(=O)(OR_2)-$ , or a heteroaromatic group;

**Z** is selected from  $-N(R_8)-$ ,  $-O-$ ,  $-S-$ ,  $-Se-$ ,  $-N=N-$ ,  $-ON=CH-$ ,  $-R_8N-NR_8-$ ,  $-ONR_8-$ , a heterocycle, or a direct bond between Y and L;

**R<sub>8</sub>**, independently for each occurrence, represents H,  $C_1-C_{10}$  alkyl, aryl (substituted or unsubstituted), aralkyl (substituted or unsubstituted), heteroaryl (substituted or unsubstituted), or heteroaralkyl (substituted or unsubstituted), or two  $R_8$  taken together form a 4-to 8-membered ring, together with the atoms to which they are attached, which ring may include one or more carbonyls;

**W** represents a substituted or unsubstituted benzo or pyrido ring fused to the pyrimidone ring;

**p** represents, independently for each occurrence, an integer from 0 to 10; and

**n**, individually for each occurrence, represents an integer from 0 to 10,

wherein the term "heteroaryl" or "heteroaralkyl" refers to an aryl group having up to 4 heteroatoms, wherein any substituted aromatic ring can be substituted at one or more ring positions with a substituent selected from halogen, azide, alkyl, aralkyl, alkenyl, alkynyl, cycloalkyl, hydroxyl, alkoxy, amino, nitro, sulfhydryl, imino, amido, phosphate, phosphonate, phosphinate, carbonyl, carboxyl, silyl, ether, alkylthio, sulfonyl, sulfonamido, ketone, aldehyde, ester, heterocyclyl, aromatic or heteroaromatic moieties,  $-CF_3$ , or  $-CN$  and wherein any alkyl group can be substituted on one or more carbons of the hydrocarbon backbone with a



substituent selected from halogen, azide, aralkyl, hydroxyl, alkoxy, amino, nitro, silyl, imino, amido, phosphate, phosphonate, phosphinate, alkylthio, sulfonyl, sulfonamido, heterocyclyl, aromatic or heteroaromatic moieties, or -CN, for the treatment of squamous cell carcinoma (e.g. lung squamous carcinoma), carcinosarcoma, adenocystic carcinoma, epidemoid carcinoma, nasopharyngeal carcinoma, renal cell carcinoma, papilloma, epidemoidoma, tumors related to Gorlin's syndrome (e.g., medulloblastoma, meningioma, etc.), tumors evidenced in pct knock-out mice (e.g., hemangioma, rhabdomyosarcoma, etc.), tumors resulting from gli-I amplification (e.g., glioblastoma, sarcoma, etc.), tumors connected with ptc homolog TRC8 (e.g., renal carcinoma, thyroid carcinoma, etc.), Ext-I-related tumors (e.g., bone cancer, etc.), *Shh*-induced tumors (e.g., lung cancer, chondrosarcomas, etc.), breast cancer, urogenital cancer (e.g., kidney, bladder, ureter, prostate, etc.), adrenal cancer, primary CNS malignant neuroectodermal tumors (e.g. malignant medulloblastoma), malignant gliomas, meningiomas, neuroectodermal tumors, ependymomas, pineoblastoma, or keratoacanthoma."

*(ii) Auxiliary request 1*

Claim 1 is identical to claim 1 of the main request except for the following additional feature at the end of the claim: "wherein the cell has a *hedgehog*-gain of function phenotype".

VII. In its reply to the statement of the grounds of appeal dated 12 August 2008, respondent 02 (opponent 02)

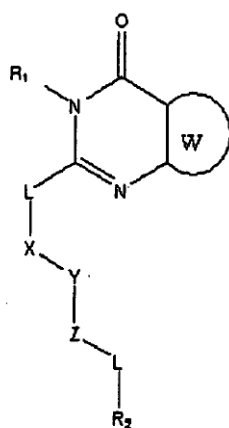
raised objections under Articles 84 and 123(2) and (3) EPC.

VIII. In the communication of 23 February 2011, issued pursuant to Article 5(3) RPBA, the board informed the parties that in its provisional opinion none of the requests on file appeared to meet the requirements of Article 123(3) EPC.

IX. With a letter of 8 March 2001, the appellant filed new auxiliary requests 2 and 3. The sole independent claims read as follows:

*(i) Auxiliary request 2*

"1. Use of a compound for the preparation of a pharmaceutical composition for inhibiting hyperproliferation of a cell, wherein the compound is an organic molecule represented by the general formula (II):



Formula II

wherein, as valence and stability permit, R<sub>1</sub> represents H, C<sub>1</sub>-C<sub>10</sub> alkyl, aryl (substituted or unsubstituted), aralkyl (substituted or unsubstituted),

heteroaryl (substituted or unsubstituted), or heteroaralkyl (substituted or unsubstituted);  $R_2$  represents a substituted or unsubstituted aryl or heteroaryl group;

$L$  adjacent to  $X$  is  $-CH(R_{10})-$ , wherein  $R_{10}$  is alkyl, alkenyl, cycloalkyl or aralkyl, and  $L$  adjacent to  $R_2$  is absent or represents  $-alkenyl-$ ,  $alkynyl-$ ,  $-(CH_2)_nO(CH_2)_p-$ ,  $-(CH_2)_nNR_2(CH_2)_p-$ ,  $-(CH_2)_nS(CH_2)_p-$ ,  $-(CH_2)_nalkenyl(CH_2)_p-$ ,  $-(CH_2)_nalkynyl(CH_2)_p-$ ,  $-O(CH_2)_n-$ ,  $-NR_2(CH_2)_n-$ , or  $-S(CH_2)_n-$ ;

$X$  is  $-N(R_{12})-$ , wherein  $R_{12}$  is  $C_1-C_{10}$  alkyl;

$Y$  is selected from  $-C(=O)-$ ,  $-C(=S)-$ ,  $-S(O_2)-$ ,  $-S(O)-$ ,  $-C(=NCN)-$ ,  $-P(=O)(OR_2)-$ , or a heteroaromatic group;

$Z$  is selected from  $-N(R_8)-$ ,  $-O-$ ,  $-S-$ ,  $-Se-$ ,  $-N=N-$ ,  $-ON=CH-$ ,  $-R_8N-NR_8-$ ,  $-ONR_8-$ , a heterocycle, or a direct bond between  $Y$  and  $L$ ;

$R_8$ , independently for each occurrence, represents  $H$ ,  $C_1-C_{10}$  alkyl, aryl (substituted or unsubstituted), aralkyl (substituted or unsubstituted), heteroaryl (substituted or unsubstituted), or heteroaralkyl (substituted or unsubstituted), or two  $R_8$  taken together form a 4- to 8-membered ring, together with the atoms to which they are attached, which ring may include one or more carbonyls;

$W$  represents a substituted or unsubstituted benzo or pyrido ring fused to the pyrimidone ring;

$p$  represents, independently for each occurrence, an integer from 0 to 10; and

$n$ , individually for each occurrence, represents an integer from 0 to 10,

wherein the term "heteroaryl" or "heteroaralkyl" refers to an aryl group having up to 4 heteroatoms, wherein any substituted aromatic ring can be substituted at one or more ring positions with a

substituent selected from halogen, azide, alkyl, aralkyl, alkenyl, alkynyl, cycloalkyl, hydroxyl, alkoxy, amino, nitro, sulfhydryl, imino, amido, phosphate, phosphonate, phosphinate, carbonyl, carboxyl, silyl, ether, alkylthio, sulfonyl, sulfonamido, ketone, aldehyde, ester, heterocyclyl, aromatic or heteroaromatic moieties, -CF<sub>3</sub>, or -CN for the treatment of squamous cell carcinoma (e.g. lung squamous carcinoma), carcinosarcoma, adenocystic carcinoma, epidemoid carcinoma, nasopharyngeal carcinoma, renal cell carcinoma, papilloma, epidemoidoma, tumors related to Gorlin's syndrome (e.g., medulloblastoma, meningioma, etc.), tumors evidenced in pct knock-out mice (e.g., hemangioma, rhabdomyosarcoma, etc.), tumors resulting from gli-I amplification (e.g., glioblastoma, sarcoma, etc.), tumors connected with ptc homolog TRC8 (e.g., renal carcinoma, thyroid carcinoma, etc.), Ext-I-related tumors (e.g., bone cancer, etc.), *Shh*-induced tumors (e.g., lung cancer, chondrosarcomas, etc.), breast cancer, urogenital cancer (e.g., kidney, bladder, ureter, prostate, etc.), adrenal cancer, primary CNS malignant neuroectodermal tumors (e.g. malignant medulloblastoma), malignant gliomas, meningiomas, neuroectodermal tumors, ependymomas, pineoblastoma, or keratoacanthoma."

*(ii) Auxiliary request 3*

Claim 1 is identical to claim 1 of auxiliary request 2 except for the following additional feature at the end of the claim: "wherein the cell has a *hedgehog*-gain of function phenotype".

X. Oral proceedings were held before the board on 8 April 2011.

XI. In connection with the requirements of Article 123(3) EPC, the appellant's arguments can be summarised as follows:

The subject-matter of the claims as granted encompassed substituted alkyl groups in the light of the disclosure in paragraph [0086] of the contested patent which stated that the term "alkyl" as used throughout the specification, examples and claims embraced both unsubstituted and substituted alkyls. Moreover, paragraph [0086] pertained to both "alkyl" and "lower alkyl", the latter being defined as having from 1-10 carbon atoms. According to the established case law of the boards of appeal, the patent document could serve as its own dictionary, which meant that definitions provided therein took precedence over definitions commonly used in the technical field under consideration, even in cases where the meaning resulting from such a definition deviated from the meaning commonly held in the art. Decision T 1321/04 (unpublished) was cited in this context. A further indication that "alkyl" included "substituted alkyl" could be seen in the fact that in cases where substitution was to be excluded, the alkyl rests were defined by their chemical formula  $(CH_2)_n$ . The fact that claim 1 as granted specifically mentioned that the aryl rest could be either substituted or unsubstituted did not allow the conclusion that substitution was not foreseen for the alkyl rest, where this indication was missing. This difference was the consequence of different definitions given in paragraphs [0086] and

[0092] of the contested patent. According to paragraph [0086], the term "alkyl" encompassed *per se* substituted and unsubstituted alkyl rests, while paragraph [0092] only said that the aromatic rings of the aryl groups could be substituted, which did not indicate that the term "aryl" taken alone would include substituted species. As a consequence, the option of a substituent being present had to be included in claim 1 in connection with "aryl".

Regarding the feature "L adjacent to X is  $-\text{CH}(\text{R}_{10})$ ", it was held that claim 21 as granted, which was not the result of an obvious error, specifically mentioned substituted methylene groups.

XII. In connection with the requirements of Article 123(3) EPC, the arguments of respondent 02 can be summarised as follows:

Regarding the main request and auxiliary request 1, it was reasoned that the subject-matter of the claims as granted did not include substituted alkyl groups. As claims had to be read literally, paragraph [0086] of the contested patent could not be used to interpret the content of the claims. In view of the fact that formula II as defined in claim 1 of the main request and auxiliary request 1 included substituted alkyl groups, the requirements of Article 123(3) EPC were not met.

The inclusion of the definition "L adjacent to X is  $-\text{CH}(\text{R}_{10})$ " into claim 1 extended the protection conferred, as compounds wherein L is a substituted methylene group were not included in formula II as defined in claim 1 as granted. L could comprise a

substituted methylene group according to claim 21 as granted. Claim 21, however, was erroneous as it did not contain all the features of the preceding claims to which it referred. Claim 21 as granted did not meet the requirements of Rule 43 EPC and should either be deleted or ignored. Reference was made to decision T 0307/05 (unpublished), which in connection with the requirements of Article 123(2) and (3) EPC stated that the slightest doubt that the unamended patent could be construed differently to the patent as amended would preclude the allowability of the amendment. Decision T 681/00 (unpublished) was also cited in this context. Alternatively, it was reasoned that claim 21 as granted contained an obvious error. The feature "L adjacent to X is a substituted or unsubstituted methylene" had not been included in the claims as originally filed but had been added in the course of substantive examination. However, the corresponding passage in the original description had not been correctly cited.

XIII. Respondent 01 (opponent 01) did not make any submissions.

XIV. The appellant requested that the decision under appeal be set aside and a patent be maintained according to the main request submitted during the oral proceedings before the opposition division, or, in the alternative, to auxiliary request 1, filed with the statement of the grounds of appeal, or, in the alternative, to auxiliary requests 2 or 3 filed with letter dated 8 March 2011.

The respondents requested that the appeal be dismissed.

## Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of auxiliary requests 2 and 3

These requests were filed at a late stage of the appeal proceedings, i.e. one month before the oral proceedings before the board. The admissibility of these requests is therefore at the board's discretion and depends upon the overall circumstances of the case under consideration (see Article 13 RPBA). As the amendments were a reaction by the appellant to objections raised by the board in its communication of 23 February 2011, the board decided to admit auxiliary requests 2 and 3 into the proceedings (Article 13 RPBA). This was not contested by the respondents.

3. Main request - Article 123(3) EPC
  - 3.1 The Markush formula according to claim 1 as granted can contain  $C_1$ - $C_{10}$  alkyl rests at three locations, namely at positions  $R_1$ ,  $R_2$  and  $R_8$ . The claims do not contain any information as to whether or not these alkyl rests may be substituted. As was correctly pointed out in the decision under appeal, alkyl according to IUPAC is equivalent to  $C_nH_{2n+1}$ , which precludes substitution. On the other hand, paragraph [0086] of the description reads: "Moreover, the term "alkyl" (or "lower alkyl") as used throughout the specification, examples, and claims is intended to include both "unsubstituted alkyls" and "substituted alkyls", the latter of which refers to alkyl moieties having substituents replacing



a hydrogen on one or more carbons of the hydrocarbon backbone."

3.2 According to Article 69 EPC, the extent of the protection conferred by a European patent shall be determined by the claims. Nevertheless, the description and the drawings shall be used to interpret the claims. It therefore has to be decided whether said interpretation of the claims by the content of the description is limited to cases where the claims are in need of interpretation, e.g. because of functional or unclear features, or whether it also applies to the present case, where a well-known and generally accepted meaning of a term is overthrown and replaced by a new definition given in the description.

3.3 The appellant cited decisions T 1321/04 and T 0190/99 in this context. T 1321/04 indicates that terms are not considered in isolation but in the context of the content of the document as a whole. Terms must be construed as they would be by the skilled person according to the whole content of the application, taking into account what is achieved by the invention (see point 2.3 of the reasons for the decision). However, decision T 1321/04 concerned the question of how the term "predetermined value of nitrogen oxide concentration" should be interpreted in view of the assessment of novelty. To understand the meaning of this term, the whole content of the document was taken into consideration. The case was not concerned with the issue of determining the scope of protection.

In the present case, the situation is quite different: here, the meaning of the feature in question is

generally accepted, perfectly understandable *per se*, and unambiguously defined by IUPAC, whom the skilled person acknowledges as the competent authority in this context. The skilled person therefore has no need to consult the description for a definition of "alkyl". The board is of the opinion that the second sentence of Article 69 EPC does not apply to cases where an unambiguous and generally accepted definition of a term figuring in the claims should be superseded by a different definition found in the description. If it is intended that a term which is in no need of any interpretation is given a new meaning, then the definition for this new meaning must be put into the claims. Third parties cannot be expected to check every single term of the claims for a potentially different meaning that might be hidden somewhere in the description. As a consequence, irrespective of the definition in paragraph [0086] of the contested patent, the term "alkyl" in the claims as granted has the meaning of  $C_nH_{2n+1}$ .

- 3.4 Nor does decision T 0190/99 have any bearing on the present case. In T 0190/99, it was found that the skilled person when considering a claim should rule out interpretations which are illogical or which do not make technical sense. He should arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent pursuant to Article 69 EPC. The patent must be construed by a mind willing to understand, not by a mind desirous of misunderstanding (see point 2.4). In T 0190/99, the board held that the skilled person reading the feature "said plurality of tensioning warp threads (19) extending parallel with and between said

upper and lower binding warp threads (17, 18)" would not unreservedly assume that the term "parallel" had to be understood in the strict geometrical sense of the word (i.e. two equidistant straight lines) (see point 2.2.4). It was part of the most basic knowledge of the skilled person that in a woven fabric warp threads appeared to be parallel when the fabric was seen in plan, but running approximately sinusoidally when seen in cross-section. Warp threads were therefore not parallel in the strict sense of the word (see point 2.2.3). As a consequence, the board arrived at the conclusion that in view of the overall disclosure the replacement of "parallel" by an amended and less restricted definition was not objectionable under Article 123(3) EPC.

In contrast to decision T 0190/99, where a term used in its usual meaning did not make technical sense, formula II according to claim 1 of the contested patent does not include any subject-matter which is illogical or does not make technical sense if the term "alkyl" is used in its usual and well-known meaning. Reference is again made to the last two sentences of point 3.3 above.

3.5 As a consequence, the board concludes that the subject-matter of the main request extends the protection conferred and does not meet the requirements of Article 123(3) EPC.

4. Auxiliary request 1

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that the cells to be treated have a

*hedgehog*-gain function phenotype. The compounds defined by formula II are, however, identical. As a consequence, the reasoning of point 3 above applies *mutatis mutandis* to claim 1 of auxiliary request 1. The requirements of Article 123(3) EPC are therefore not met.

5. Auxiliary request 2 - Article 123(3) EPC

5.1 The subject-matter of auxiliary request 2 does not include substituted alkyl groups. As a consequence, the objections raised above in point 3 do not apply to auxiliary request 2.

5.2 Formula II according to claim 1 of auxiliary request 2 comprises compounds in which L adjacent to X is -CH(R<sub>10</sub>)-. Claim 1 as granted does not include this option. However, claim 21 as granted, which refers to any preceding claim and thus also to claim 1 as granted, comprises compounds wherein X adjacent to L includes unsubstituted methylene groups if L adjacent to R<sub>1</sub> is absent. The latter condition is also fulfilled by the subject-matter of auxiliary request 2, where L adjacent to R<sub>1</sub> was deleted from formula II. Claim 21 as granted, in combination with the preceding claims to which it refers, therefore encompasses the subject-matter of auxiliary request 2. As a consequence, it has to be evaluated whether claim 21 as granted can be taken into consideration or, as was alleged by respondent 02, whether it is erroneous and therefore to be disregarded. In this context, respondent 02 made reference to Rules 43 and 139 EPC.

### 5.2.1 Rule 43 EPC

Rule 43(4) EPC stipulates that any claim which includes all the features of any other claim is a dependent claim and shall contain, if possible at the beginning, a reference to the other claim and then state the additional features.

Claim 21 as granted contains a reference to the preceding claims and has the same category as the claims to which it refers. However, the compounds defined by formula II according to claim 21 as granted are different from those according to claims 1 to 20 as granted as far as the substituent L adjacent to R<sub>1</sub> is concerned: substituted methylene groups (claim 21 as granted) are not included in the list of substituents for L as defined in claim 1 as granted. Despite its reference to the preceding claims, claim 21 as granted is therefore an independent claim, as it does not include all the features of the claims to which it refers. As a consequence, the requirements of Rule 43(4) EPC are not met.

Despite this deficiency, the skilled person has no doubts as far as the content of claim 21 as granted is concerned. He will conclude that the definitions for those substituents not mentioned there (i.e. all substituents except R<sub>1</sub> and L adjacent to X) can be found in the preceding claims and in particular in claim 1. Doing so, he will realise that claim 21 is indeed an independent claim which, however, is clearly and unambiguously defined and therefore does not give rise to any doubts regarding its content. As a consequence,

the skilled person would not disregard claim 21 as granted.

#### 5.2.2 Rule 139 EPC

Making reference to Rule 139 EPC, respondent 02 alleged that claim 21 had been erroneously introduced in the course of substantive examination. Features which were the consequence of an obvious error had not been intended to be part of the claims and could therefore not be used in support of Article 123(3) EPC.

This argument cannot succeed, as the appellant contested that the introduction of claim 21 was the result of an obvious error. The fact that respondent 02 has doubts regarding the basis for claim 21 as granted in the application as originally filed is an issue that does not concern Article 123(3) EPC but should be discussed in connection with the requirements of Article 123(2) EPC. The board therefore concludes that claim 21 is not the result of an obvious error.

5.3 As a consequence, the use of compounds according to formula II as defined in auxiliary request 2, in which L adjacent to X is  $-\text{CH}(\text{R}_{10})-$ , is encompassed by the claims as granted, so the requirements of Article 123(3) EPC are met.

6. In view of this finding, an evaluation of auxiliary request 3 is not necessary.

7. Remittal to the department of first instance

7.1 Although the EPC does not guarantee the parties an absolute right to have all the issues in the case considered by two instances, it is well recognised that any party may be given the opportunity of two readings of the important elements of the case. The essential function of an appeal is to consider whether the decision issued by the first-instance department is correct. Hence, a case is normally referred back if essential questions regarding the patentability of the claimed subject-matter have not yet been examined and decided by the department of first instance.

In particular, remittal is considered by the boards in cases where a first-instance department issues a decision against a party based upon certain issues only which are decisive for the case, and leaves other essential issues outstanding. If, following appeal proceedings, the appeal on the particular issues is allowed, the case is normally remitted to the first-instance department for consideration of the undecided issues (Article 111 EPC).

7.2 The observations made above apply fully to the present case, where the opposition division issued a decision which does not take into consideration the grounds of opposition invoked by the opponents but is solely based on Article 123(3) EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

N. Maslin

U. Oswald