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**Datasheet for the decision
of 5 March 2009**

Case Number: T 2034/08 - 3.3.02

Application Number: 99960608.0

Publication Number: 1140201

IPC: A61K 47/48

Language of the proceedings: EN

Title of invention:

Compounds for intracellular delivery of therapeutic moieties
to nerve cells

Applicant:

Asilomar Pharmaceuticals, Inc.

Opponent:

-

Headword:

Nerve cells delivery compounds/ASILOMAR PHARMACEUTICALS, INC.

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

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Keyword:

"Added subject-matter: back to the original wording"

Decisions cited:

-

Catchword:

-



Case Number: T 2034/08 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 5 March 2009

Appellant: Asilomar Pharmaceuticals, Inc.
2995 Woodside Road 400
Woodside
CA 94062-2446 (US)

Representative: Perry, Robert Edward
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7 Eldon Street
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 April 2008
refusing European application No. 99960608.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: J. Riolo
P. Mühlens

Summary of Facts and Submissions

- I. European patent application No. 99 960 608.0 was refused by a decision of the Examining Division dated 11 April 2008 under Article 97(2) EPC in conjunction with Article 123(2) EPC and Rule 139 EPC.
- II. The decision was based on claim 1 of the request received on 24 December 2007 by letter of 20 December 2007.

Independent claim 1 of this request, which contains 16 claims, reads as follows:

"1. A compound for delivering a non-cytotoxic therapeutic moiety selectively to the cell body of a nerve cell, the compound having the general formula:

B-L-TM

where:

B is a nerve growth factor (NGF), or fragment thereof which selectively binds a neurotrophin receptor;

TM is a non-cytotoxic therapeutic moiety selected from the group consisting of analgesics, adrenergic agents, anti-trauma agents, anti-viral agents, hormones and steroids; and

L is a linker, coupling B to TM, of formula R1-NH-CO-R2, wherein R1 and R2 are independently selected from the group consisting of alkyl, aryl, heteroaryl, cycloalkyl, cycloalkene and heterocycloalkene."

III. The reasons for the decision can be summarised as follows:

The Examining Division considered that the appellant's request under Rule 139 EPC to change formula B-R1-(CO)-NH-R2-TM to TM-R1-(CO)-NH-R2-B could not be granted because it was not immediately evident from the content of the application that nothing else was meant to be disclosed by it.

It also held that, as a consequence, the feature [B]-R1-NH-(CO)-R2 -[TM], introduced in claim 1, had no basis in the application as originally filed, and therefore contravened the requirements of Article 123(2) EPC.

No other objections were raised in the decision by the Examining Division.

IV. The appellant (applicant) lodged an appeal against the said decision.

V. The appellant filed a new request with its grounds of appeal dated 14 August 2008. It did not contest the unfavourable conclusions of the Examining Division with respect to the request received on 24 December 2007 by letter of 20 December 2007, which was dealt with in the Examining Division's decision.

Independent claim 1 of this request, which contains 10 claims, reads as follows:

1. A compound for delivering a non-cytotoxic therapeutic moiety to the cell body of a nerve cell, the compound having the general formula: B-L-TM wherein B is a nerve growth factor (NGF) or fragment thereof which selectively binds a neurotrophin receptor, TM is a non-cytotoxic therapeutic moiety which is a steroid, and L is a linker coupling B to TM.
- VI. In a phone conversation with the appellant's representative on 16 February 2009, the Board informed the appellant of its intention to remit. The appellant agreed that, under these circumstances, oral proceedings were not necessary.
- VII. The appellant requested in writing that the decision under appeal be set aside and that the patent be granted on the basis of the set of claims in the request filed with its grounds of appeal dated 14 August 2008.

Reasons for the Decision

1. The appeal is admissible
2. The Board observes that the appellant did not maintain its request for correction under Rule 139 EPC, and nor did it either contest the unfavourable conclusions of the Examining Division in that respect.

In addition, the Board notes that the feature -R1-NH-(CO)-R2-, and its corresponding definitions for R1 and R2, defining the linker L in claim 1 of the set of

claims dealt with by the Examining Division, has been deleted, so that the wording defining this linker is now identical to the wording in claim 1 as originally filed. Accordingly, the requirements of Article 123(2) EPC are fulfilled as regards this feature.

Under these circumstances, the decision of the Examining Division, which was confined to the objections under Rule 139 EPC and Article 123(2) EPC with respect to the definition of the linker in claim 1, no longer holds good and the case is therefore remitted to the department of first instance for a complete examination of the new request.

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