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**Datasheet for the decision  
of 12 October 2022**

**Case Number:** T 1706/17 - 3.3.02

**Application Number:** 12746091.3

**Publication Number:** 2766364

**IPC:** C07D475/04, A61K31/519,  
A61P35/00, C07K5/02

**Language of the proceedings:** EN

**Title of invention:**  
FOLATE CONJUGATES OF ALBUMIN-BINDING ENTITIES

**Applicant:**  
Merck & Cie

**Headword:**

**Relevant legal provisions:**  
EPC Art. 123(2)  
RPBA 2020 Art. 11, 12(1), 12(2)

**Keyword:**  
Amendments  
Remittal

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
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Case Number: T 1706/17 - 3.3.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.02**  
**of 12 October 2022**

**Appellant:** Merck & Cie  
(Applicant) Im Laternenacker 5  
8200 Schaffhausen (CH)

**Representative:** Rentsch Partner AG  
Kirchenweg 8  
Postfach  
8034 Zürich (CH)

**Decision under appeal:** **Decision of the Examining Division of the  
European Patent Office posted on 24 February  
2017 refusing European patent application No.  
12746091.3 pursuant to Article 97(2) EPC.**

**Composition of the Board:**

**Chairman** M. O. Müller  
**Members:** P. O'Sullivan  
L. Bühler

## **Summary of Facts and Submissions**

- I. The appeal of the patent proprietor (hereinafter appellant) lies from the decision of the examining division to refuse European patent application 12746091.3.
- II. According to the contested decision, the application was refused for lack of compliance with Article 123(2) EPC on the basis of sets of claims of a main request and an auxiliary request.
- III. The appellant appealed this decision. With the statement of grounds of appeal the appellant submitted new sets of claims of a main request and auxiliary requests 1, 2 and 3.
- IV. With a communication pursuant to Article 15(1) RPBA, the board provided the preliminary view that the respective claim 1 of the main request and auxiliary requests 1 and 2 contravened Article 123(2) EPC, while the set of claims of auxiliary request 3 met the requirements of Article 123(2) EPC.

The board also stated that in view of its preliminary view, a remittal of the case to the examining division on the basis of the set of claims of auxiliary request 3 could be envisaged if the appellant were to expressly withdraw the sets of claims of the main request and auxiliary requests 1 and 2.

- V. With the letter dated 19 August 2022, and in response to an enquiry from the board, subsequent clarification with the letter dated 31 August 2022, the appellant withdrew the sets of claims of the main request and

auxiliary requests 1 and 2 submitted with the statement of grounds of appeal, and requested that the case be remitted to the examining division for further prosecution on the basis of the set of claims of auxiliary request 3. The appellant also stated that it withdrew its request for oral proceedings provided that the board confirmed its preliminary view and remitted the case to the examining division.

VI. Oral proceedings scheduled to take place on 22 September 2022 were cancelled.

VII. Requests

The appellant requests that the contested decision be set aside, and that the case be remitted to the examining division for further prosecution on the basis of the set of claims of auxiliary request 3 submitted with the statement of grounds of appeal.

VIII. The appellant's submissions, insofar as relevant to the present decision, may be summarised as follows:

The set of claims of auxiliary request 3 complied with the requirements of Article 123(2) EPC.

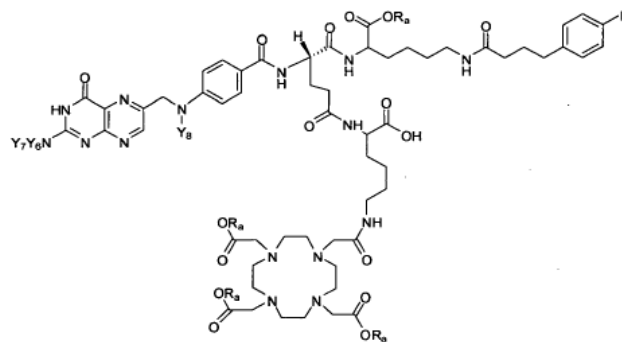
## **Reasons for the Decision**

Auxiliary request 3 - Article 123(2) EPC

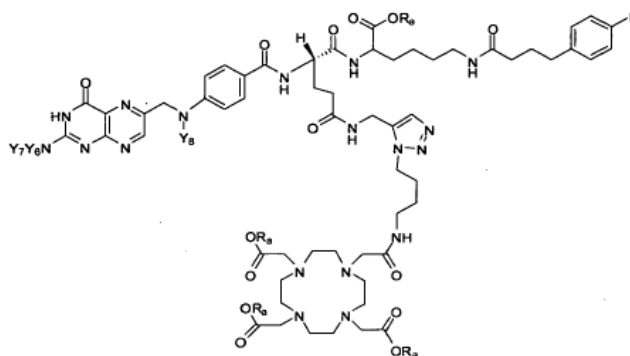
1. The present application concerns *inter alia* compounds described as "*trifunctional folate-conjugates comprising a folate, an albumin binder and a radionuclide-based diagnostic or therapeutic moiety*" (application, page 1, lines 10-12).

Claim 1 of auxiliary request 3 reads as follows:

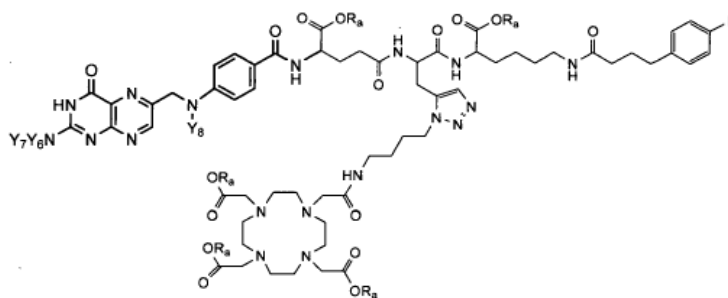
"A compound having the following formula



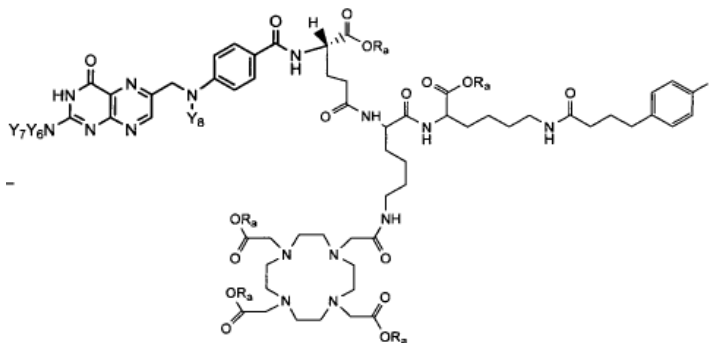
or



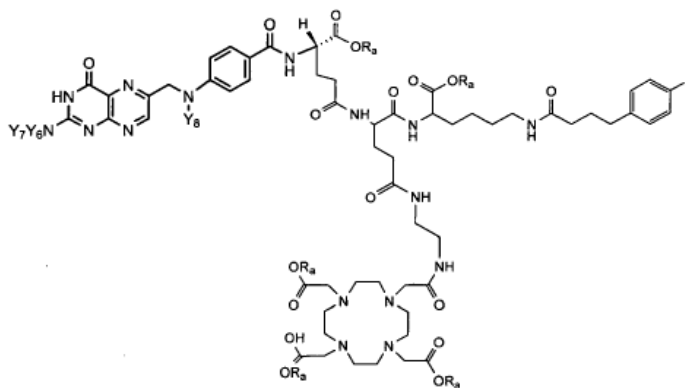
or



or



or



wherein

*Y6, Y7 are independently of each other selected from H, halo, C(1-12)alkyl, C(2-12)alkenyl, C(2-12)alkynyl, -OR', -COR', -COOR', and -NHR', wherein R' is H or C(1-8)alkyl,*

*Y8 is selected from H, nitroso, C(1-12)alkyl, -OR', -COR', and halosubstituted -COR',*

*wherein R' is H or C(1-12)alkyl,*

*Ra is H or C(1-8)alkyl."*

2. Article 123(2) EPC

2.1 Claim 1 is directed to compounds defined by the above five structural formulae. The first two structural formulae depicted above are identical to those

disclosed in the application as filed on page 53 (sole structure) and on page 54 (first structure).

- 2.2 The third structure depicted above is identical to the first structure depicted on page 56 of the application as filed, with the exception that in the latter structure, a single bond connecting an amido nitrogen atom to an  $\alpha$ -carbon of an adjacent carboxylate group is absent (left hand side of the structure). The omission of this single bond in the application as filed, corrected in present claim 1, is an obvious typographical error, the correction of which is equally obvious. Hence, the corrected structure in claim 1 meets the requirements of Article 123(2) EPC.
- 2.3 The remaining two structures depicted in claim 1 are identical to those depicted on page 56 of the application as filed (second and third structures respectively).
- 2.4 Furthermore, the definitions of the variable moieties for all 5 structures depicted in claim 1 are disclosed for the first two structures of claim 1 on page 54, lines 3-8 of the application as filed, and for the remaining three structures on page 57, lines 1-6 of the application as filed. Since these definitions are both identical to each other and to the definitions provided for the variables in present claim 1, above, the structures defined in claim 1 find basis in the application as filed.
- 2.5 Consequently, claim 1 fulfills the requirements of Article 123(2) EPC.



2.6 The set of claims of auxiliary request 3 also comprises further claims 2-10. These claims, reformulated where necessary as purpose limited product claims pursuant to Articles 54(4) and (5) EPC, find basis in claims 26-34 of the application as filed, respectively.

It follows that the set of claims of auxiliary request 3 meets the requirements of Article 123(2) EPC.

3. Remittal - Article 11 RPBA 2020

3.1 The appellant requested that the contested decision be set aside, and that the case be remitted to the examining division for further prosecution. This implies a request that the board acknowledges compliance with Article 123(2) EPC, and remits the case accordingly.

3.2 According to Article 11 RPBA 2020, the board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so.

3.3 The board notes that the further requirements of the EPC, different from Article 123(2) EPC, were not addressed in the contested decision.

3.4 Article 12(2) RPBA 2020 stipulates that the primary object of appeal proceedings is to review the decision under appeal in a judicial manner. Hence, it is not the task of the board to restart examination of the further requirements of the EPC from the beginning. Therefore, the present situation constitutes sufficient "special reasons" within the meaning of Article 11 RPBA 2020 to justify remittal of the case to the examining division.

Consequently, in line with the appellant's request, the board decided to remit the case to the examining division for further prosecution.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated