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**Datasheet for the decision
of 25 October 2021**

Case Number: T 2742/19 - 3.3.07

Application Number: 12793107.9

Publication Number: 2714070

IPC: A61K38/26, C07K14/605,
A61P3/10, A61P7/12

Language of the proceedings: EN

Title of invention:

LONG-ACTING GLP-1/GLUCAGON RECEPTOR AGONISTS

Applicant:

Prolor Biotech Inc.

Headword:

LONG-ACTING GLP-1/GLUCAGON RECEPTOR AGONISTS/Prolor Biotech
Inc.

Relevant legal provisions:

EPC Art. 123(2), 84

Keyword:

Main request - Amendments (Yes)
Remittal to the examining division

Decisions cited:

Catchword:



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Case Number: T 2742/19 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 25 October 2021

Appellant: Prolor Biotech Inc.
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Representative: Pearl Cohen Zedek Latzer Baratz UK LLP
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 3 May 2019
refusing European patent application No.
12793107.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

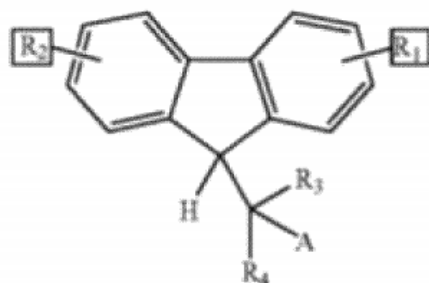
Chairman A. Uselli
Members: D. Boulois
Y. Podbielski

Summary of Facts and Submissions

- I. The appeal lies from the decision of the examining division to refuse European patent application n° 12 793 107.9. The decision was based on 3 sets of claims filed with letter of 22 June 2017 as the main request and with letter of 6 February 2019 as auxiliary requests 1 and 2.

Claim 1 of the main request read as follows:

"1. A compound of the formula (X)_n-Y, wherein Y is dual GLP-1/Glucagon receptor agonist consisting of an oxyntomodulin peptide, wherein X is a radical of formula (i)



(i)

wherein R₁ is a radical containing a polymer polyethylene glycol (PEG) moiety;

R₂ is selected from the group consisting of hydrogen and -SO₃H;

R₃ and R₄ are each hydrogen;

A is a covalent bond when the radical is linked to a carboxyl, phosphate or mercapto group of the drug Y, or A is (OCO) when the radical is linked to an amino or

hydroxyl group of the drug Y; and n is an integer of at least one."

Claim 1 of auxiliary request 1 was amended as shown in bold:

"...R₁ is a radical containing **a protein** or polymer **carrier moiety or a** polyethylene glycol (PEG) moiety; R₂ is selected from the group consisting of hydrogen, **alkyl, alkoxy, alkoxyalkyl, aryl, alkaryl, aralkyl, halogen, nitro, -SO₃H, -SO₂NHR, amino, ammonium, carboxyl, PO₃H₂, and OPO₃H₂;**

R₃ and R₄ are each hydrogen;

A is a covalent bond when the radical is linked to **an amino or hydroxyl** group of the drug Y, or A is (OCO) when the radical is linked to an amino or hydroxyl group of the drug Y; and n is an integer of at least one."

Claim 1 of auxiliary request 2 was identical to claim 1 of auxiliary request 1.

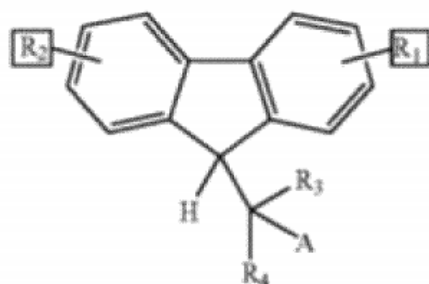
- II. According to the decision under appeal, the subject-matter of claims 1, 3-6, 10, 11 and 23-26 of the main request did not find adequate basis in the application as originally filed and was therefore contrary to Article 123(2) EPC. Claim 1 of auxiliary requests 1 and 2 was also contrary to Article 123(2) EPC.

- III. The patent applicant (hereinafter the appellant) filed an appeal against said decision. With the statement setting out the grounds of appeal dated 12 September 2019, the appellant filed a new main request, and new auxiliary requests 1, 2 and 3.

- IV. A communication expressing the Board's preliminary opinion was sent to the appellant on 15 April 2021. In this it was stated in particular that none of the requests on file met the requirements of Articles 123(2), 84 and 53(c) EPC.
- V. With a letter dated 18 October 2021, the appellant filed a main request' and auxiliary requests 1'-3'.
- VI. The oral proceedings before the Board took place on 25 October 2021 by videoconference. During the oral proceedings, the appellant filed a new main request comprising 19 claims and withdrew all other requests.

Claim 1 of the new main request read as follows:

"1. A compound of the formula (X)_n-Y, wherein Y is dual GLP-1/Glucagon receptor agonist consisting of an oxyntomodulin (OXM) peptide, wherein Y is a moiety of OXM bearing a free amino or hydroxyl group, and wherein X is a radical of formula (i)



wherein

R₁ is a polyethylene glycol (PEG) moiety;

R₂ is either hydrogen or is -SO₃H at position 2 of the fluorene ring;

R₃ and R₄ are each hydrogen;

A is -OCO-, wherein the radical of formula (i) is linked to an amino or hydroxyl group of the drug Y; and n is an integer of at least one."

VII. Requests

The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution on the basis of the new main request filed during the oral proceedings on 25 October 2021.

Reasons for the Decision

1. Admittance of Main request

—

The main request filed during the oral proceedings addresses the objections raised for the first time by the Board in its communication of 15 April 2021 as well as the comments made by the Board at the beginning of the oral proceedings in relation to the requests filed on 18 October 2021. In the exercise of its discretion the Board considers it appropriate in the present case to admit the main request into the appeal proceedings.

2. Main request-Amendments

2.1 Claim 1

The subject-matter of claim 1 finds a basis in paragraphs [[075], 0076] and [078]of the patent application as originally filed (WO2012/167251. hereinafter "the application").

2.2 Claims 2-3

The subject-matter of claims 2 and 3 finds a direct basis in paragraph [0070] of the application.

2.3 Claim 4

The subject-matter of dependent claim 4 is disclosed in original claim 5.

2.4 Claims 5-6

A basis for these claims can be found in paragraph [188].

2.5 Claims 7-10

A basis for these claims can be found in paragraphs [081], [014], [015] and [069].

2.6 Claims 11-12

The basis for these claims is in original claims 3 and 6.

2.7 Claims 13-15

Claim 13 finds basis in paragraph [062]. The basis for claims 14 and 15 can be found in paragraphs [059], [060], [62], [063], [064],[084] and [123].

2.8 Claim 16

The original application relates generally to a pharmaceutical composition or a medicament.

2.9 Claim 17

A basis for this claim can be found in original claim 27.

2.10 Claims 18 and 19

The subject-matter of claim 18 reflects one of the preferred compounds disclosed in the application for instance in paragraph [224]. As to claim 19, the application as filed makes a constant reference to oxyntomodulin.

3. The Board does not see any deficiency in relation to the clarity of the claims. Thus, the subject-matter of the main request is considered to comply with the requirements of Article 84 EPC.

4. Remittal to the examining division

The only grounds for the refusal set out in the decision under appeal, namely objections under Article 123(2) EPC, are no longer justified.

The examining division has not yet examined the patentability requirements, such as novelty and inventive step, and no reasons in this regard are included in the decision under appeal.

Article 11 RPBA 2020 provides that 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.

In the present case, the Board holds that such special reasons are apparent because the examining division has

not taken an appealable decision on essential outstanding issues. As recalled in Article 12(2) RPBA 2020, the primary object of the appeal proceedings is to review the decision under appeal in a judicial manner. This principle would not be respected if the Board were to conduct a complete examination of the application.

Under these circumstances, the Board considers it appropriate to allow the appellant's request for remittal of the case to the examining division (Article 111(1) EPC).

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:



B. Atienza Vivancos

A. Usuelli

Decision electronically authenticated