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**Datasheet for the decision
of 12 September 2024**

Case Number: T 1747/22 - 3.3.08

Application Number: 15752232.7

Publication Number: 3121274

IPC: C12N15/09, A61P35/00, C12Q1/68,
G01N33/15, G01N33/50

Language of the proceedings: EN

Title of invention:

METHOD FOR PREDICTING RESPONSIVENESS TO CANCER TREATMENT USING
p300-INHIBITING COMPOUND

Patent Proprietor:

National Cancer Center
Daiichi Sankyo Company, Limited

Opponent:

Cellcentric Limited

Headword:

Relevant legal provisions:

EPC Art. 83, 111(1)
RPBA 2020 Art. 11, 16

Keyword:

Sufficiency of disclosure - (yes)

Obiter dictum and remittal

Remittal to the department of first instance - (yes)

Apportionment of costs - (no)

Decisions cited:

G 0001/03, T 0802/97, T 0473/98, T 0197/10, T 2238/11,

T 2154/15, T 0101/17, T 0139/20, T 1006/21, T 1019/22

Catchword:



Beschwerdekammern

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Case Number: T 1747/22 - 3.3.08

D E C I S I O N
of Technical Board of Appeal 3.3.08
of 12 September 2024

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 17 May 2022
revoking European patent No. 3121274 pursuant to
Article 101(3) (b) EPC**

Composition of the Board:

Chairwoman T. Sommerfeld
Members: D. Pilat
 A. Bacchin

Summary of Facts and Submissions

- I. European patent No. 3 121 274 is based on European patent application No. 15 752 232.7 filed as an international application published as WO 2015/125956. The patent was opposed on the grounds of Article 100(a) EPC in conjunction with Article 56 EPC, and of Articles 100(b) and (c) EPC. The opposition division revoked the patent.
- II. The patent proprietors (appellants) lodged an appeal against the decision of the opposition division. With the statement of grounds of appeal, the appellants filed a main request and new auxiliary requests 1 to 32 and new evidence.
- III. The opponent (respondent) replied to the statement of grounds of appeal.
- IV. In a communication pursuant to Article 15(1) RPBA, the parties were informed of the board's preliminary opinion.
- V. Oral proceedings were held with both parties being represented.
- VI. The wording of claim 1 of the main request, the sole claim request dealt with in this decision, is set out in the reasons for the decision, below.
- VII. The parties' submissions, insofar as they are relevant to the decision, are discussed in the reasons for the decision, below.

VIII. At the end of the oral proceedings the parties' requests were as follows:

The appellants requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request submitted with the statement of grounds of appeal. Alternatively, they requested that the auxiliary requests 1 to 32 submitted with the statement of grounds of appeal be admitted and the patent be maintained based on one of these requests. They further requested that, should the board conclude that the patent met the requirements of sufficiency, the case be remitted to the opposition division for further prosecution.

The respondent requested that the appeal be dismissed. The respondent moreover requested that auxiliary requests 1 to 32 not be admitted into the appeal proceedings and that the case not be remitted to the opposition division. They further requested apportionment of costs.

Reasons for the Decision

Main request - claim 1

1. The main request is the same as auxiliary request 4 submitted on 4 March 2022 and decided upon in the appealed decision.

2. Claim 1 reads:

"1. A method for predicting responsiveness to the treatment of cancer with a compound inhibiting p300, comprising using a biological sample derived from a

cancer patient, detecting the presence or absence of an inactivating mutation in CBP contained in the biological sample, and determining the patient with the detected inactivating mutation in CBP as responsive to the treatment of cancer with the compound inhibiting p300, wherein the inactivating mutation is a homozygous CBP deletion, a CBP nonsense mutation, or one of the mutations Asn83Thr, Ser893Leu, Arg1446Cys, Trp1472Cys, Asn2175Ser, Glu1835Stop, Asn2111Ser, Leu551Ile, Gly1411Glu, or Ala2044Gly."

Claim construction - claim 1

3. Claim 1 is directed to a method for predicting responsiveness to the treatment of cancer with a compound inhibiting p300, comprising detecting the presence or absence of an inactivating mutation in CBP contained in a biological sample from a cancer patient, and determining that the patient with the detected inactivating mutation in CBP is responsive to the treatment of cancer with the compound inhibiting p300, wherein a limited set of inactivating mutations are to be detected.
4. The term "responsive" in claim 1 was interpreted by the opposition division to mean "high response rate to the treatment (par.0048), which is underpinned by concept of synthetic lethality (pars.0007-0011 and 0014)" (see decision under appeal, point 12.1.1, reference to paragraphs in the patent application as filed).
5. The board disagrees with the opposition division's interpretation of claim 1. Firstly, there is no general requirement for claims to be interpreted with the help of the description. The skilled person has only to ascertain whether the expressions used are to be

understood in their ordinary literal sense or whether they have a special meaning defined exclusively in the description (see decision T 197/10, headnote 1). Only if the claims are obscure will the skilled person seek to clarify them using other claims and/or the description and drawings in order to establish their correct interpretation. The board, in agreement with the respondent, considers that in claim 1 the term "responsive" in the phrase "responsive to the treatment of cancer" is clear and well-understood. The skilled person would understand this expression to mean that the growth of cancer cells is inhibited to some degree. There is no indication in claim 1 that the treatment involves the presence of synthetic lethality or that it means that the treatment's response is stronger (the subject is more responsive) compared to another reference subject. This interpretation is moreover supported by the description, since paragraph [0048] of the patent application specifies that "responsiveness to the treatment of cancer" is an index for deciding whether or not the compound inhibiting p300 can exert therapeutic effects on cancer and that the determination of the responsiveness may include also the evaluation of the degree of the responsiveness. There is no indication that the responsiveness has to occur via synthetic lethality in this paragraph. The concept of synthetic lethality is mentioned in paragraphs [0007] to [0011] and [0014]) of the application, where it is explained that the effect of the - paralogous - relationship between CBP and p300 in cancer cells is essential to the present invention, but, contrary to the conclusions of the opposition division (appealed decision, point 12.1.1), this has no bearing on the claim's interpretation, which is not restricted to any particular mechanism. Thus, even when the claim is interpreted in context and considering the

information provided in the description, the meaning of the term "responsive" remains consistent.

6. Consequently, if the wording of the claim is silent about a selected functional limitation feature mentioned only in the description, there is no reason why this limitation should be read into claim 1. Hence, the board sees no valid reason to interpret the claims, in particular claim 1, as limited to cancer treatment relying on synthetic lethality.
7. Claim 1 thus relates to a method for predicting responsiveness to the treatment of cancer with a compound inhibiting p300, and it is not limited to methods of treatment that are underpinned by synthetic lethality.

Sufficiency of disclosure - Article 83 EPC

8. Contrary to the respondent's position (reply to the statement of grounds of appeal, points 3.2 to 3.14), the board considers that, since the technical effect of predicting responsiveness to the treatment of cancer is recited in the claim, it must be taken into account under sufficiency of disclosure rather than under inventive step (see G 01/03, OJ 2004, 413, item 2.5.2 of the Reasons). This technical effect is not, though, restricted to treatment of cancer underpinned by synthetic lethality, as explained in points 5. to 7. above.
9. Given that the board does not concur with the opposition division's interpretation of claim 1, all the arguments regarding sufficiency of disclosure of claim 1 of the main request put forward by the respondent, whose arguments for insufficiency of

disclosure are based on the opposition division's interpretation of the term "responsive", must, for this reason alone, be considered moot. Absent any other objections under Article 83 EPC with respect to the main request in the respondent's reply, the board must consider the requirements of sufficiency of disclosure to be met.

Remittal (Article 111(1) EPC and Article 11 RPBA)

10. In accordance with Article 111(1) EPC, the board may either exercise any power within the competence of the department which was responsible for the appealed decision or remit the case to that department for further prosecution. The wording of this provision makes it clear that the decision to remit a case to the department whose decision was appealed lies with the discretion of the board.
11. In addition, Article 11 RPBA provides that a board shall not remit a case, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.
12. In deciding whether to remit a case, an important consideration is that the primary function of appeal proceedings is to provide a judicial review of the decision under appeal (see Case Law of the Boards of Appeal, 10th edition 2022, section V.A.1.1, second paragraph and the decisions referred to therein; see Article 12(2) RPBA).
13. In the present case, remittal was requested by the appellants, who essentially argued that the appealed decision was fundamentally deficient because of how the

opposition division interpreted claim 1. This amounted to special reasons for remitting in the sense of Article 11 RPBA. Furthermore, the question of inventive step had not been discussed at the oral proceedings before the opposition division, and the latter did not provide a decision on inventive step of the main request. Even the *obiter dictum* on inventive step did not go through all arguments and it especially did not deal with the question of non-obviousness. Thus, should the board not remit the case, it would have to decide for the first time on appeal on the question of inventive step. This would amount to an undue burden for the board. The question of lack of sufficiency was fundamentally different from the one of lack of inventive step.

14. The respondent objected to a remittal essentially because the request for remittal was late-filed and hence inadmissible pursuant to Article 13(2) RPBA and because no special reasons justifying remittal in the sense of Article 11 RPBA were present. The question of lack of inventive step of the main request, despite not formally decided by the opposition division, was based on the same factual situation and arguments as the objection of insufficiency. This was confirmed by the *obiter dictum* provided in the opposition division's decision, so that the board would have had no undue burden in deciding the matter.

15. As regards admittance of the request for remittal and the argument that the condition for remittal pursuant to Article 11 RPBA was not met, the board concurs with the findings in decision T 2154/15 (Reasons 2.3), cited by the appellants, that the discretionary powers attributed to the boards by Article 111(1) EPC for deciding remittal cannot be overruled by the RPBA, in

this case by Article 11 RPBA (as also confirmed by Article 23 RPBA). Article 11 RPBA cannot be interpreted as including an obligation for the board not to remit the case at hand.

- 15.1 Consequently, since the RPBA do not limit the powers of the boards as defined in Article 111(1) EPC, the discretionary decision under Article 111(1) EPC to remit a case can be taken *ex officio* by the Boards of Appeal at any time of the appeal proceedings and is therefore also not dependent on any request by a party. The board agrees in this context with decision T 1006/21 (Catchword 1 and Reasons 23 and 24) and with decision T 139/20 (Reasons 4.4), that a request for remittal made by a party is therefore not subject to the provisions of Articles 12 and 13 RPBA.
- 15.2 There is thus no reason to disregard the appellants' request for remittal.
16. The board furthermore notes that in their respective submissions on remittal, the parties gave significant weight to the presence of an *obiter dictum* on the matter of inventive step in the appealed decision.
- 16.1 The board finds that, as a matter of principle, parties cannot rely on *obiter dicta* as if they were fully reasoned decisions.
- 16.2 An *obiter dictum* is any general statement, either implicit or explicit, in a decision which does not constitute a *ratio decidendi* of said decision.
- 16.3 Accordingly, observations in an *obiter dictum* do not, by definition, form part of a decision (see T 802/97, Reasons 3; T 2238/11, Reasons 5 and T 1019/22, Reasons

33.2). While *obiter dicta* may be sometimes included in decisions of the examining and opposition divisions in order to avoid remittal (see decision T 473/98, Headnote I), it is not excluded that, depending on the circumstances, a remittal of the case is anyway deemed appropriate, despite the presence of an *obiter dictum*. Therefore *obiter dicta* cannot raise the expectation on the parties that there's indeed a decision on a certain issue.

16.4 Indeed, from a legal point of view *obiter dicta* have no significance for the decision of the specific case and have no binding force. They normally deal with issues that were not raised in the proceedings as a whole, or, as in the present case, with issues on which a decision did not actually have to be made.

17. With respect to the present case, the opposition division took a reasoned decision only on Article 100(c) EPC and on sufficiency of disclosure for the main request and auxiliary requests 1 to 7 underlying the appeal. Although the opposition division attached *obiter dicta* to the decision under appeal on Article 56 EPC of the main request and on Article 123(2) EPC of auxiliary requests 1 to 7, it was clearly stated that the issues were not discussed and were therefore not invoked as a ground for revocation (section IV. of the appealed decision).

18. In the *obiter dictum*, the opposition division stated that the same findings underpinning the lack of sufficiency of disclosure under Article 83 EPC with regard to independent claim 1 were relevant for the assessment of the inventive step under Article 56 EPC of the other independent claims, and that the assessment under Articles 83 or 56 EPC remained

factually the same, while formally it may differ (item 17.1 of the appealed decision, under section IV "Obiter Dicta").

19. The board is not convinced that the mere fact that the findings in the context of sufficiency are relevant for the assessment of inventive step is sufficient to avoid remittal for the following reasons.

On the one hand, sufficiency of disclosure is concerned with whether the patent application provides sufficient information for a skilled person in the art to carry out the invention, taking into account the prior art, common general knowledge and the disclosure of the patent. On the other hand, the assessment of inventive step is concerned with determining whether the claimed invention is obvious to a skilled person, given the state of the art at the time the invention was made. The latter involves an analysis of several essential aspects, such as considering the knowledge and abilities of the skilled person and using a problem-solution approach to identify an appropriate starting point relating to the subject-matter claimed from which technical differences are identified; then determining the technical effect underlying the technical differences and whether said technical effect is achieved across the entire scope of the claim; formulating the objective technical problem based on this effect and determining whether the claimed subject-matter constitutes a solution to it; finally determining whether the skilled person, starting from the closest prior art and faced with the objective technical problem, would arrive at the solution in an obvious manner.

20. Although the consideration of the effect of responsiveness to cancer's treatment may be relevant also for the analysis of inventive step, a full assessment of the problem solution approach is still required in view of the relevant prior art, on account of the common general knowledge and the documents cited in its support. Further discussions may also be necessary when considering the board's reversal of the appealed decision on sufficiency. However in the "*obiter dicta*" section, the opposition division remained silent on all the other aspects mentioned above required for a full assessment of inventive step and did not provide a full reasoning as to whether the requirements of Article 56 EPC are met, in particular it did not discuss obviousness and did not draw any conclusion on inventiveness of the main request.
21. Consequently, not remitting the case to the opposition division would imply that the board carries out for the first time an examination on inventive-step objection(s) in the absence of a fully reasoned decision of the opposition division, even if they were partially touched upon in an *obiter dictum* in the decision, instead of judicially reviewing the contested decision, which is the main purpose of appeal proceedings.
22. Since the substantive examination of Article 56 EPC of the main request has not been carried out, the case is remitted to the examining division for further prosecution (Article 111(1) EPC).

Apportionment of costs

23. The respondent requested a different apportionment of costs and submitted that, with the belated request for

remittal, the appellants had caused additional costs. The respondent had actually prepared themselves for the discussion of inventive step at the oral proceedings before the board.

24. The appellants *inter alia* submitted that the RPBA gave a discretion to the board to grant a request for remittal, which could be filed also at a late stage of the proceedings. Even if the request had been filed earlier, this would not have changed in terms of preparation for a possible discussion on inventive step.
25. Under the EPC each party to opposition proceedings must, as a rule, meet the costs it has incurred (Article 104 EPC). However, the opposition division or board of appeal may, for reasons of equity, order a different apportionment of the costs incurred during taking of evidence or in oral proceedings. At the appeal stage, Article 16(1) RPBA lists typical cases where costs arise as a result of: (a) amendments to a party's appeal case pursuant to Article 13 RPBA; (b) extension of a period; (c) acts or omissions prejudicing the timely and efficient conduct of oral proceedings; (d) failure to comply with a direction of the board; or (e) abuse of procedure.
26. As indicated above, a request for remittal made by a party is not subject to the provisions of Articles 12 and 13 RPBA, since a decision to remit the case may be taken *ex officio* by a board and is not dependent on any request by a party. Already for this reason, the board fails to see an abusive behaviour in the appellants requesting a remittal of the case, or otherwise a prejudice to the timely and efficient conduct of the

oral proceedings, which would give reason for ordering a different apportionment of costs.

27. Furthermore the board cannot follow the respondent's argument that higher costs have been incurred due to the filing of the request for remittal at the oral proceedings, because the respondent had actually prepared for the discussion of inventive step. Had the appellants filed the remittal request in advance of the oral proceedings, the respondent would have had to prepare for the discussion on inventive step anyway, because they could not predict with certainty how the board would exercise their discretion. Indeed remittal of the case is not an uncommon outcome in appeal oral proceedings, where the opposition division revoked the patent on the basis of a given ground for opposition, if the appealed decision is then overturned by the board.
28. In this context the present board concurs with the findings in decision T 101/17 (Reasons 5.4) that in order to establish any causal link between the respondent's expenses and the appellants' behaviour, the respondent would have to show that it was particularly the belated filing of the request for remittal that caused the expense rather than the filing of the request as such. Under such circumstances, preparation for the discussion on inventive step was thus part of the normal work of the respondent's representative, which had to be prepared, with the corresponding expenses incurred, even if the request for remittal were filed earlier.
29. The board thus concludes that the circumstances of the case do not justify a different apportionment of costs.

Order

For these reasons it is decided that:

1. The appealed decision is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The request for apportionment of costs is rejected.

The Registrar:

The Chairwoman:



C. Rodríguez Rodríguez

T. Sommerfeld

Decision electronically authenticated