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**Datasheet for the decision
of 30 July 2024**

Case Number: T 1907/22 - 3.3.04

Application Number: 13808014.8

Publication Number: 2938337

IPC: A61K31/11, A61K47/44,
C07C47/46, A61P25/28,
A61P25/16, A61P25/14

Language of the proceedings: EN

Title of invention:

4-HYDROXY-2-METHYL-5-(PROPAN-2-YLIDENE)CYCLOHEX-3-
ENECARBALDEHYDE FOR THE PREVENTION AND TREATMENT OF A
COGNITIVE, NEURODEGENERATIVE OR NEURONAL DISEASE

Applicant:

Cesa Alliance S.A.

Relevant legal provisions:

EPC Art. 83

Keyword:

Sufficiency of disclosure - undue burden (yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

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European Patent Office
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Case Number: T 1907/22 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 30 July 2024

Appellant: Cesa Alliance S.A.
(Applicant) 184, route d'Arlon
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Representative: Dennemeyer & Associates S.A.
Postfach 70 04 25
81304 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 April 2022
refusing European patent application No.
13808014.8 pursuant to Article 97(2) EPC**

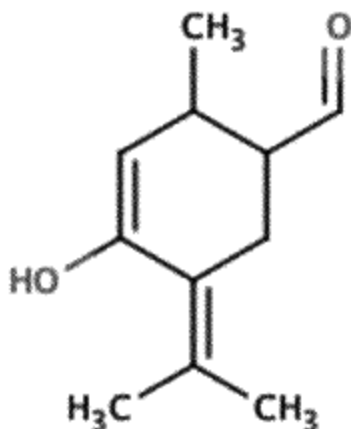
Composition of the Board:

Chair M. Pregetter
Members: S. Albrecht
L. Bühler

Summary of Facts and Submissions

- I. The appeal of the applicant ("appellant") lies from the decision of the examining division to refuse European patent application No. 13 808 014.8 ("application"), published as WO 2014/102090.
- II. The decision of the examining division was based on a main request and a single auxiliary request. The set of claims of the main request was filed on 29 May 2019. Claim 1 of this request reads as follows.

"1. Compound having the Formula (1):



Formula (1).

presenting 1-30% of the isomer CIS and 70-99% of the isomer TRANS."

- III. In the appealed decision, the examining division concluded, *inter alia*, that the subject-matter of independent claims 2 and 3 of the main request was not sufficiently disclosed in the application as filed (Article 83 EPC).

- IV. With its notice of appeal, the appellant requested, *inter alia*, to hold oral proceedings by means of a videoconference, should the decision under appeal not be set aside.
- V. With the statement setting out the grounds of appeal, the appellant resubmitted the set of claims of the main request underlying the decision under appeal.
- VI. The appellant was summoned to oral proceedings to be held on 30 July 2024 at the premises of the boards of appeal.
- VII. In a communication under Article 15(1) RPBA issued on 17 June 2024 ("communication"), the Board expressed its preliminary opinion that the invention defined in claims 1 to 13 of the main request lacked sufficiency of disclosure (Article 83 EPC).
- VIII. Oral proceedings took place before the Board in person on 30 July 2024 in the presence of the appellant. At the end of the oral proceedings, the Chair announced the Board's decision.
- IX. The appellant's written and oral submissions, where relevant to this decision, can be summarised as follows.

The claimed invention was directed to a molecule having the chemical structure of Formula (1), not to a method for making it. The application as filed clearly outlined all the steps required for successfully synthesising this molecule, named "A7" in this application. Accordingly, a skilled person reading the disclosure in the application as filed could readily

prepare A7 without any burden using standard reactions in the art, as confirmed by several specialists in the art, including Mr Isaacman. As an example for such standard reactions, Friedel-Crafts acylation with reactants containing parts of the desired molecule might be cited.

- X. The appellant's final requests, where relevant to this decision, were as follows.

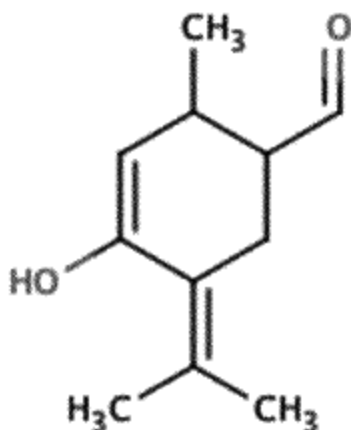
The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the set of claims of the main request underlying the decision under appeal and resubmitted with the statement of grounds of appeal.

Reasons for the Decision

1. The appeal is admissible.

The invention defined in claim 1

2. Claim 1 is a product claim whose subject-matter is directed to a compound having the following formula (Formula (1)):



3. Claim 1 further requires that this compound presents 1 to 30% of the isomer "CIS" and 70 to 99% of the isomer "TRANS".
4. According to the application as filed (see page 4), the term "CIS" indicates that the aldehyde group and the hydroxyl group of the 6-membered carbonic ring lie on the same side of the ring plane ("isomer CIS"). By contrast, in the isomer named "TRANS" ("isomer TRANS"), these two ring substituents are oriented on opposite sides relative to the ring plane.
5. Claim 1 is thus directed to a mixture of the aforementioned two isomers CIS and TRANS in specified percentages ("CIS/TRANS mixture").

*Sufficiency of disclosure of the invention defined in claim 1
(Article 83 EPC)*

6. To meet the requirements of Article 83 EPC, an invention has to be disclosed in a manner sufficiently clear and complete for it to be carried out by the skilled person, without undue burden, on the basis of the information provided in the application as filed read by the skilled person with their common general knowledge in mind.
7. In the case at issue, the invention defined in claim 1 is directed to a mixture of two specific isomers of a compound of Formula (1) (see points 2. to 4. above). Contrary to the appellant's position, depicting the formula of the desired compound in the application as filed and stating that it should be present as a specific mixture of its isomers is not sufficient to acknowledge sufficiency of disclosure. Rather, the application as filed must put the skilled person in a

position that enables them to carry out the claimed invention, i.e. to prepare the claimed CIS/TRANS mixture of the compound, without undue experimentation.

8. In the Board's judgement, the application as filed fails to do so, the reasons being as follows.
 - 8.1 Manufacturing methods are described on pages 8 to 10 of the application as filed. Specifically, page 8 discloses a scheme for the synthesis of a compound of Formula (1), referred to as "RVT:A7" and "A7". Page 9 provides details on the reactants for this synthesis. Page 10, lines 1 to 8, in turn, describes an example of the synthesis mentioned on page 8.
 - 8.2 It is undisputed that the resulting product of the synthesis reported in this example is a mixture of several compounds including PBS and glycerol. This mixture is not further specified in the application as filed. In particular, as noted in the Board's communication (see point 2.4), the application as filed does not contain any information on whether this mixture comprises the claimed isomers CIS and TRANS and, if so, how to isolate these isomers from this mixture of components.
 - 8.3 At the oral proceedings, the appellant argued that the final product of this synthesis did not include PBS and glycerol. Only the oil phase containing the molecule (i.e. A7) was used to produce the final product, i.e. the capsules. PBS and glycerol were used only to stop the reaction.
 - 8.4 However, as explicitly observed by the Board at the oral proceedings, claim 1 is directed to a mixture of

cis- and trans-configurations whereas in the formula of A7 (i.e. Formula (1) of claim 1) no stereochemistry is depicted. After having been made aware of this fact, the appellant conceded that the application as filed did not contain any statement on how to obtain the claimed CIS/TRANS mixture by means of the methods of synthesis described in pages 8 to 10.

- 8.5 It follows from the above that the application as filed lacks the necessary guidance on how to prepare the claimed CIS/TRANS mixture.
- 8.6 What is more, there is no evidence on file to show that this guidance may be found in the common general knowledge. Without such guidance, the skilled person has to resort to random trial-and-error experimentation to put the claimed invention into practice without any guarantee of success. Such trial-and-error experimentation places an undue burden on the skilled person, contrary to the requirements of Article 83 EPC.
9. In its written and oral submissions, the appellant argued that the actual making of A7 was standard in the art (see point IX. above).
10. However, the invention defined in claim 1 is not directed to A7 as such but to a mixture of two specific isomers of this compound (see point 8.4. above). When asked at the oral proceedings whether making use of Friedel-Crafts Acylation would have been straightforward considering that claim 1 required the compounds of the mixture to have a certain substitution pattern on the ring and a certain stereochemistry, the appellant did not present any substantive argument. It merely observed that the scientists consulted by it had

confirmed that they were able to prepare the claimed molecule.

11. Given these circumstances, the Board sees no reason to change its preliminary opinion and therefore concludes that the invention defined in claim 1 is not sufficiently disclosed (Article 83 EPC).

Appellant's request to hold oral proceedings by means of a videoconference

12. For the sake of completeness it is noted that the Board, in exercising its discretion under Article 15a(1) RPBA, rejected the appellant's request to hold oral proceedings by means of a videoconference and provided reasons in support of its decision (see point 1.2 of the Board's communication).
13. In reply to this communication, the appellant did not further comment on this point, neither in its subsequent written submissions nor at the oral proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chair:



K. Boelicke

M. Pregetter

Decision electronically authenticated