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Datasheet for the decision of 30 April 2026

Case Number: T 0964/24 - 3.3.02

Application Number: 16703009.7

Publication Number: 3247711

IPC: C07D405/14, A61K31/4439, A61P31/10

Language of the proceedings: EN

Title of invention:
NOVEL SALTS AND POLYMORPHS OF SCY-078

Patent Proprietor:
Scynexis, Inc.

Opponent:
Synthon BV

Relevant legal provisions:
EPC Art. 123(2), 84, 83, 54, 56

Keyword:
Amendments
Claims - essential features
Sufficiency of disclosure
Novelty
Inventive step

Decisions cited:
T 0777/08, T 0636/10, T 1684/16, T 2635/16

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Case Number: T 0964/24 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 30 April 2026

Appellant: (Opponent)	Synthon BV Microweg 25 6503 GN Nijmegen (NL)
Representative:	Algemeen Octrooi- en Merkenbureau B.V. P.O. Box 645 5600 AP Eindhoven (NL)
Respondent: (Patent Proprietor)	Scynexis, Inc. Post Office Box 12878 Research Triangle Park, NC 27709-2878 (US)
Representative:	Finnegan Europe LLP 1 London Bridge London SE1 9BG (GB)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted/electronically transmitted on 24 May 2024 rejecting the opposition filed against European patent No. 3247711 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman	M. O. Müller
Members:	A. Lenzen
	R. Romandini

Summary of Facts and Submissions

I. The opponent (appellant) lodged an appeal against the opposition division's decision (decision under appeal) to reject the opposition against European patent No. 3 247 711 (patent).

II. Reference is made in the present decision to the following documents filed with the opposition division:

D1 WO 2010/019203 A1
D6 US 8,188,085 B2
D7 EP 2 326 172 B1
D12 Saal, C., et al., Eur. J. Pharm. Sci. 49 (2013), 614-623
D14 Lepak, A. J., et al., Antimicrob. Agents Chemother. 59, 1265-1272

III. With the statement of grounds of appeal, the appellant filed four new documents (D22 to D25).

IV. With the reply to the statement of grounds of appeal, the patent proprietor (respondent) filed, *inter alia*, the sets of claims of auxiliary requests 1 to 4.

V. In preparation for the oral proceedings, which had been arranged at the parties' request, the board issued a communication under Article 15(1) RPBA. In that communication, it summarised the parties' previous substantive submissions and expressed its preliminary opinion on several issues.

VI. By letters dated 2 March 2026 (appellant) and 31 March 2026 (respondent), the parties filed further substantive submissions.

VII. Oral proceedings before the board were held on the premises of the European Patent Office on 30 April 2026 in the presence of both parties. The appellant stated that it was no longer relying on the documents filed with the statement of grounds of appeal (D22 to D25) and that, therefore, a decision on their admittance was not required. At the end of the oral proceedings, the chair announced the order of the present decision.

VIII. The parties' final requests at the end of the oral proceedings, in so far as they are relevant to this decision, were as follows:

- The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety.
- The respondent requested that the appeal be dismissed (main request), implying that the decision under appeal be upheld and that the patent be maintained as granted. In the alternative, it requested that the patent be maintained in amended form based on one of the sets of claims of auxiliary requests 1 to 4, filed with the reply to the statement of grounds of appeal.

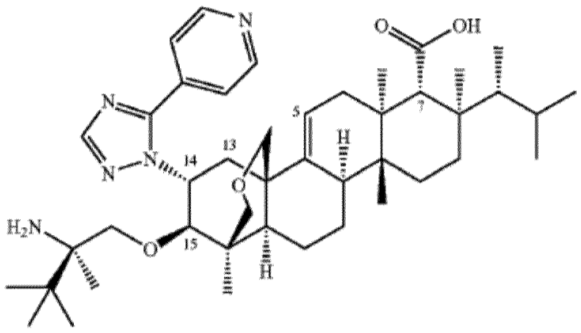
IX. Summaries of the parties' submissions relevant to the present decision and key aspects of the decision under appeal are set out in the Reasons for the Decision below.

Reasons for the Decision

Main request (patent as granted)

1. Claim 1 of the main request reads:

"*A citrate salt of compound 1:*



"

In line with the parties, compound 1 of claim 1 will be referred to below as "SCY-078". Thus claim 1 of the main request relates to a citrate salt of SCY-078, or an SCY-078 citrate for short.

2. Novelty (Article 54 EPC)

2.1 The appellant argued that the subject-matter of claim 1 of the main request lacked novelty over D6 (claim 49; column 21, line 54 to column 22, line 21).

2.2 Claim 49 of D6 reads as follows (the systematic name recited in the claim has been replaced by SCY-078, since it was common ground between the parties that the systematic name refers to that compound):

"*The compound according to claim 1, wherein the compound is [SCY-078] or a pharmaceutically acceptable salt thereof.*"

Furthermore, as regards the formation of pharmaceutically acceptable salts, D6 discloses the following passage (column 21, line 54 to column 22, line 21; emphasis added by the board using underlining and bold type):

> "*All compounds of the present invention may be administered in the form of "pharmaceutically acceptable salts" or hydrates as appropriate. ... For example, when the compounds of the present invention contain a basic amine group, they may be conveniently isolated as trifluoroacetic acid salts ... Other desired amine salts may ... be prepared in a conventional manner by reacting the free base with a suitable organic or inorganic acid. Representative pharmaceutically acceptable quaternary ammonium salts include the following: hydrochloride, sulfate, phosphate, carbonate, acetate, tartrate,* ***citrate****, malate, succinate, lactate, stearate, fumarate, hippurate, maleate, gluconate, ascorbate, adipate, gluceptate, glutamate, glucoronate, propionate, benzoate, mesylate, tosylate, oleate, lactobionate, laurylsulfate, besylate, caprylate, isetionate, gentisate, malonate, napsylate, edisylate, pamoate, xinafoate, napadisylate, hydrobromide, nitrate, oxalate, cinnamate, mandelate, undecylenate, and camsylate. Many of the compounds of the invention carry an acidic carboxylic acid moiety, in which case suitable pharmaceutically acceptable salts thereof may include alkali metal salts, e.g., sodium or potassium salts; alkaline earth metal salts, e.g., calcium or magnesium salts; and salts formed with suitable organic ligands, e.g., quaternary ammonium salts.*"

2.3 The parties agreed that citrate must be selected as the pharmaceutically acceptable salt from the passage quoted above (see emphasis in bold) in order to arrive at the subject-matter of claim 1 of the main request. However, they disagreed as to whether any further selections were required and whether such additional selections, if any, could establish novelty over D6.

2.4 As set out above, claim 49 of D6 relates both to SCY-078 in its free-base form and to a pharmaceutically acceptable salt thereof. Furthermore, the passage quoted above discloses citrate as a pharmaceutically acceptable salt. The board acknowledges that this disclosure is not made specifically in the context of SCY-078, but rather in relation to all the compounds of the invention of D6. However, since SCY-078 is one of those compounds, the skilled person would already derive directly and unambiguously from this disclosure that citrate also applies to SCY-078. Any remaining doubt is dispelled by the passages preceding the disclosure of citrate. In particular, D6 states that "*[a]ll compounds of the present invention may be administered in the form of "pharmaceutically acceptable salts" or hydrates as appropriate*" (column 21, lines 54 to 56) and that "*[r]epresentative pharmaceutically acceptable quaternary ammonium salts include the following*" (column 22, lines 5 to 7). These passages make it clear that the subsequently disclosed citrate salt applies to all the compounds disclosed in D6, including SCY-078.

Thus, even if one were to accept the respondent's rather formal approach that, in addition to selecting citrate from the passage quoted above, a

pharmaceutically acceptable salt of SCY-078 must be selected from claim 49 instead of the free base of SCY-078, D6 provides a clear technical link between these selections. Accordingly, D6 directly and unambiguously discloses SCY-078 citrate as defined in claim 1 of the main request.

2.5 In the respondent's view, the passage quoted above disclosed two alternative possibilities for salt formation. The compounds could be converted into salts either at a basic amine group or at an acidic carboxylic acid moiety (see underlining in the quotation above). Since SCY-078 contained both functional groups, a further selection of the former alternative over the latter was required.

The board agrees with the respondent that the options for forming a pharmaceutically acceptable salt disclosed in the passage quoted above fall into two categories, depending on the functional group involved in salt formation. However, the board agrees with the appellant that this categorisation does not give rise to an additional selection beyond the choice of a particular salt-forming option. This is because the categorisation merely reflects the underlying mechanism of salt formation and does not imply any further limitation going beyond that inherent in the selection of a specific option (for a similar case, see T 636/10, point 5 of the Reasons). In other words, the selection of a particular option from the passage quoted above already determines the functional group involved in salt formation, namely either a basic amine group or an acidic carboxylic acid moiety. More specifically, the selection of "*citrate*" as the counterion inevitably implies salt formation at a basic amine group rather

than at an acidic carboxylic acid moiety, so no further selection is required beyond the choice of "*citrate*".

2.6 The appellant also relied on T 2635/16. According to the appellant, even though the factual circumstances underlying that decision were comparable with those of the present case, a selection was nevertheless acknowledged (point 4.5 of the Reasons). However, the board in T 2635/16 adopted a rather formal approach and the specific factual situation discussed above in section 2.4 as relevant in the present case did not exist and was not relied upon by the board in T 2635/16.

2.7 It follows that the subject-matter of claim 1 of the main request lacks novelty over D6. The main request is not allowable.

Auxiliary requests 1 to 3

3. Novelty (Article 54 EPC)

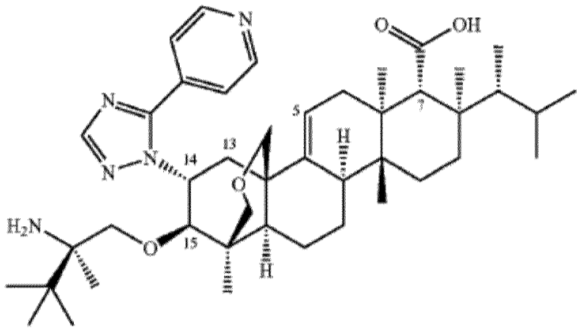
Claims 1 of auxiliary requests 1 to 3 are identical to claim 1 of the main request. For the reasons set out above, the subject-matter of claims 1 of auxiliary requests 1 to 3 also lack novelty over D6. Consequently, none of auxiliary requests 1 to 3 is allowable.

Auxiliary request 4

4. As far as relevant to this decision, the wording of claims 1 and 4 is reproduced below.

4.1 Claim 1

"*A citrate salt of compound 1:*



wherein the citrate salt of compound 1 comprises

Type A citrate crystal form, wherein the Type A citrate crystal form has an XRPD pattern comprising one or more peaks at d-spacings of 11.86, 7.70, 7.09, 6.71, 5.90, and 5.29 Å and/or an XRPD pattern comprising one or more peaks at degrees 2 theta of 7.45, 11.49, 12.49, 13.19, 15.02, and 16.75; or

Type B citrate crystal form, ...; or

Type E citrate crystal form, ...; or

Type F citrate crystal form, ...; or

Type M citrate crystal form, ...; or

Type N citrate crystal form, ...; or

Type O citrate crystal form, ...; or

Type Q citrate crystal form, ...; or

Type R citrate crystal form, ...; or

Type S citrate crystal form, ..."

Thus, in comparison with claim 1 of the main request, claim 1 of auxiliary request 4 relates to one of a total of 10 crystalline forms, referred to as Types A, B, E, F, M, N, O, Q, R and S.

4.2 Claim 4

"*The citrate salt of claim 2 or claim 3,*
...
wherein the Type A citrate crystal form has a kinetic solubility of at least one of the following:
4 mg/mL at 4 hours in dextrose buffer at pH 5.5,
8 mg/mL at 24 hours in dextrose buffer at pH 5.5,
5 mg/mL at 4 hours in phosphate buffer at pH 6.0,
8 mg/mL at 24 hours in phosphate buffer at pH 6.0,
21 mg/mL at 1 hour in SGF media,
4 mg/mL at 24 hours in FeSSIF media,
10 mg/mL at 1 hour in FaSSIF media, or
21 mg/mL at 4 hours in FaSSIF media;
..."

Claims 2 and 3, to which claim 4 refers, eventually refer back to claim 1 quoted above under point 4.1.

Thus claim 4 of auxiliary request 4 specifies the kinetic solubilities of the Type A citrate crystal form in various buffers and media.

5. Clarity (Article 84 EPC)

5.1 The appellant argued that some of the claims of auxiliary request 4, such as claim 1 reproduced above, defined peaks solely in terms of d-spacings and/or

diffraction angles, without specifying relative intensities. According to the appellant, the omission of relative intensities meant that these claims lacked essential information and were therefore unclear.

5.2 The board observes that the set of claims of auxiliary request 4 differs from that of the main request, i.e. the claims as granted, only in that claim 1 of auxiliary request 4 combines granted claims 1 and 2. Even assuming, in the appellant's favour, that the clarity objection is to be considered at all in view of G 3/14, the board does not find it convincing. As noted during the oral proceedings and as not disputed by the appellant, it is conventional practice to define solid forms solely by peak positions, i.e. without reference to relative intensities.

6. Amendments (Article 123(2) EPC)

6.1 The appellant raised objections under Article 100(c) EPC against the subject-matter of claim 2 as granted. Since, as noted above, claim 1 of auxiliary request 4 is the combination of claims 1 and 2 as granted, those objections likewise apply to claim 1 of auxiliary request 4 under Article 123(2) EPC.

6.2 The board shares the opposition division's and the respondent's view that the subject-matter of claim 1 of auxiliary request 4 is based on claims 21 and 22 as filed, which define the citrate salt of SCY-078 as comprising at least one of Types A, B, E, F, M, N, O, Q, R and S, i.e. the same types as those recited in claim 1 of auxiliary request 4. Further basis is found in paragraphs [0176] to [0185] of the application as filed, with paragraph [0176] providing support in terms

of d-spacings and angles for the definition of the Type A citrate crystal form, paragraph [0177] for the Type B citrate crystal form, and so on.

6.3 In its arguments concerning the definition of the citrate crystal types recited in claim 1 of auxiliary request 4 in terms of their d-spacings and angles, the appellant, in paragraphs [0176] to [0185], focused on paragraph [0176] relating to the Type A citrate crystal form. It submitted that the corresponding arguments applied *mutatis mutandis* to paragraphs [0177] to [0185] and to the corresponding Type B, E, F, M, N, O, Q, R and S citrate crystal forms.

In line with the appellant's submissions, paragraph [0176] is therefore analysed below with respect to the Type A citrate crystal form, and it is assumed that the conclusions drawn in this context apply equally to the remaining paragraphs and citrate crystal forms.

6.4 With respect to the Type A citrate crystal form, the last two sentences of paragraph [0176] of the application as filed recite exactly those six d-spacings and angles which have been included in claim 1 of auxiliary request 4:

> "*For example, the SCY-078 citrate Type A has an XRPD pattern comprising one or more peaks at d-spacings of 11.86, 7.70, 7.09, 6.71, 5.90, and 5.29* Å. *In another example, the SCY-078 citrate Type A has an XRPD pattern comprising one or more peaks at degrees 2 theta of 7.45, 11.49, 12.49, 13.19, 15.02, and 16.75.*"

The six d-spacings and the six angles are recited in two separate sentences, thereby providing a basis for their combination with an "or" in claim 1 of auxiliary request 4. This was never contested by the appellant either.

Furthermore, it is immediately apparent to the skilled person

(i) that these six d-spacings and the six angles relate to the same peaks of the XRPD pattern numerically described in the preceding table I of the same paragraph (see second, fifth to eighth and eleventh entries of table I), i.e. that the six d-spacings and the six angles are simply two alternative ways of expressing the same technical information, and

(ii) that these six d-spacings and the corresponding angles represent the essential part of this XRPD pattern because they belong to those six peaks which have the highest relative intensity.

Therefore the last two sentences of paragraph [0176] of the application as filed, when read together with the preceding table I, also provide a basis for combining the six d-spacings and the six angles in claim 1 of auxiliary request 4 by means of an "and" (see (i) above). This combination may be carried out without including the further data from table I, such as the relative intensities of the corresponding six peaks (see (ii) above).

6.5 The disclosure in paragraph [0176] is independent and self-contained. Therefore the fact that the application

as filed discloses two additional XRPD patterns for the Type A citrate crystal form (example 8, table 10 in paragraph [0243]; example 21, table 15 in paragraph [0276]), contrary to the appellant's argument, has no bearing on the assessment above.

Notwithstanding the above, the board fully concurs with the opposition division and the respondent that the differences between the XRPD patterns disclosed in paragraphs [0176], [0243] and [0276] of the application as filed are so minor that they fall within experimental error. Accordingly, the skilled person would necessarily regard them as representing the same crystal form, particularly since all three are identified as the Type A citrate crystal form.

6.6 The appellant's further arguments did not convince the board either.

6.6.1 Specifically, the appellant argued that claim 1 of auxiliary request 4 defined the Type A citrate crystal form in such broad terms that it encompassed other citrate crystal forms disclosed in the application as filed. In particular, the wording "***one*** *or more peaks*" (emphasis added) in claim 1 meant that the Type A citrate crystal form was already anticipated whenever a single peak corresponded to one of the specified d-spacings or angles. For example, the appellant submitted that the Type A citrate crystal form shared a d-spacing of 5.29 Å with the Type O citrate crystal form disclosed in paragraph [0182] of the application as filed, and therefore encompassed that form. In addition, by applying an assumed 20% error margin to the d-spacing values in claim 1 of auxiliary request 4, as also applied by the opposition division, at least some of the recited values would

overlap with those characterising the Type B, E, M and S citrate crystal forms, such that these forms would likewise fall within the scope of the Type A citrate crystal form. Since the application as filed distinguished between the various SCY-078 citrate crystal forms, the appellant concluded that claim 1 of auxiliary request 4 extended beyond the content of the application as filed.

Furthermore, the appellant argued for the first time during the oral proceedings that the d-spacings and angles characterising the Type A citrate crystal form were linked by an "*and/or*". With this wording, one of the recited d-spacings could be attributed to the Type A citrate crystal form and one of the angles to the Type O citrate crystal form. Consequently, the subject-matter of claim 1 also encompassed mixtures of Type A and Type O citrate crystal forms. However, such mixtures were not disclosed in the application as filed.

6.6.2 However, the issues raised by the appellant - namely whether the definition of the Type A citrate crystal form in claim 1 of auxiliary request 4 encompasses other forms or mixtures with the Type O citrate crystal form - arise in the same way in paragraph [0176] of the application as filed, on which claim 1 is based (see above). In other words, the concerns identified by the appellant in relation to claim 1 of auxiliary request 4 are already inherent in the corresponding disclosure of the application as filed. These issues therefore do not point to added subject-matter but rather concern the proper interpretation of both the claim and the application as filed.

7. Sufficiency of disclosure (Article 83 EPC)

7.1 The appellant's arguments were directed against the invention as defined in claim 4 of auxiliary request 4, which, as set out above, specifies the kinetic solubilities of the Type A citrate crystal form in various buffers and media.

7.2 The appellant argued that the application as filed disclosed substantial variability in the kinetic solubilities measured for both the Type A citrate crystal form and the amorphous SCY-078 citrate in water. Since no explanation for this variability was provided, the skilled person would lack sufficient guidance to obtain a Type A citrate crystal form exhibiting the kinetic solubilities specified in claim 4 across the various buffers and media.

Furthermore, claim 1 of auxiliary request 4 defined the Type A citrate crystal form so broadly that it encompassed the Type B, E, M, O and S citrate crystal forms, as well as mixtures thereof, including mixtures of the Type A and Type O citrate crystal forms. Even if the variability in kinetic solubility in water were disregarded, it could not be assumed that the solubilities specified in claim 4 for the Type A citrate crystal form would apply equally to the other forms or to such mixtures.

7.3 The board is not convinced by these arguments, for the following reasons.

As was not disputed by the appellant, the application as filed discloses how to prepare the Type A citrate crystal form and how to measure its kinetic solubility (see examples 6, 21 and 26 as well as example 4,

respectively). The values recited in claim 4 of auxiliary request 4 correspond to those determined experimentally in the application as filed (example 24, table 18).

Even if the appellant's argument regarding variability of the measurements in water were accepted, this would not demonstrate that the same variability necessarily occurred in the buffers and media recited in claim 4 of auxiliary request 4. Nor has the appellant provided evidence to that effect.

Furthermore, even assuming, in the appellant's favour, that the Type A citrate crystal form also encompasses other citrate crystal forms and their mixtures, the board finds that the disclosed kinetic solubilities for the Type A citrate crystal form also apply to such other forms and mixtures, since these are also citrate crystal forms, just like the Type A citrate crystal form. In any event, no counter-evidence has been provided by the appellant.

In summary, the board therefore sees no reason to conclude that the invention defined in claim 4 of auxiliary request 4 is insufficiently disclosed in the application as filed.

8. Novelty (Article 54 EPC)

In view of the findings on the main request, the subject-matter of claim 1 of auxiliary request 4 differs from D6 in that it is limited to specific crystal forms that are not disclosed in D6. Moreover, the appellant did not raise any separate novelty objection against the claimed subject-matter of

auxiliary request 4. The board therefore concludes that the subject-matter of auxiliary request 4 is novel.

9. Inventive step (Article 56 EPC)

D6 as closest prior art

9.1 At the oral proceedings, the appellant considered, *inter alia*, D6 as possible closest prior art.

Upon request for clarification by the board, it stated that it regarded the pharmaceutically acceptable salt of SCY-078 disclosed in claim 49 as the starting point for assessing inventive step. However, it did not start from the citrate of SCY-078 as disclosed in D6 (see assessment of main request above).

To the benefit of the appellant, it is assumed in the following that this is correct.

9.2 Distinguishing feature

The subject-matter of claim 1 of auxiliary request 4 is directed to ten specific crystal forms of SCY-078 citrate. By contrast, claim 49 of D6 discloses a pharmaceutically acceptable salt of SCY-078 only in generic terms. Accordingly, the subject-matter of claim 1 of auxiliary request 4 differs from D6 at least in that it relates to a specific salt class, namely citrate salts.

9.3 Technical effect and objective technical problem

9.3.1 In order to demonstrate a technical effect associated with the selection of citrate salts in claim 1 of auxiliary request 4 from the broader class of

pharmaceutically acceptable salts as disclosed in claim 49 of D6, the respondent relied on the experimental data of the application as filed (tables 18 and 41).

9.3.2 Specifically, table 18 of the application as filed shows that the Type A citrate crystal form exhibits superior kinetic solubility in fasted state simulated intestinal fluid (FaSSIF) and in fed state simulated intestinal fluid (FeSSIF) compared with other salts of SCY-078 (hippurate, fumarate, mesylate, phosphate). Furthermore, table 41 of the application as filed shows that the kinetic solubilities of trifluoroacetic and hydrochloric acid salts of SCY-078 are indeed very low in an alternative FaSSIF medium. Therefore these experimental data show that the Type A citrate crystal form exhibits a higher kinetic solubility in FaSSIF and FeSSIF media than other SCY-078 salts.

In view of the well-known use of FaSSIF and FeSSIF to predict (oral) drug bioavailability, the board agrees with the respondent and the opposition division (see decision under appeal, page 12, point 16.17) that the higher kinetic solubility of the Type A citrate crystal form in these media results in improved bioavailability of this form. Thus the technical effect shown by the experimental data in the application as filed, although somewhat abstract, translates into an effect which is biologically meaningful. Contrary to the appellant's argument, the link between the two is clearly derivable from the application as filed as required by G 2/21 in the light of the common general knowledge regarding FaSSIF and FeSSIF media.

9.3.3 While it is true that, as argued by the appellant, the properties of one crystalline form cannot automatically

be extrapolated to other crystalline forms, the board considers it credible, also in view of the absence of any counter-evidence from the appellant, that the higher bioavailability observed for the Type A citrate crystal form is likewise exhibited by the other forms recited in claim 1 of auxiliary request 4, all of which are citrate forms. The same conclusion applies to mixtures of these forms, in so far as they are encompassed by claim 1 as argued by the appellant.

9.3.4 The appellant also took issue with the method disclosed in the application as filed for determining kinetic solubilities.

The application as filed (example 4) discloses that, for measuring the kinetic solubility of a solid substance in a liquid medium, a defined amount of the substance is combined with a specified volume of the medium, and the resulting suspension is stirred for predetermined time periods. After each time period, an aliquot of the suspension is withdrawn, centrifuged, and filtered to separate the solid matter from the solution. The clear supernatant is then examined to determine the amount of dissolved substance.

The appellant argued that this method deviated from standard procedures for determining kinetic solubility in the prior art and that serious doubts should therefore be raised regarding the data in the application as filed.

However, in the absence of supporting evidence, the board does not consider this allegation convincing. Moreover, even if correct, the mere fact that the method of the application as filed differs from those of the prior art does not, in itself, disqualify it.

Rather, the board agrees with the respondent that the method of the application as filed appears well suited for measuring kinetic solubilities. The board finds the data obtained in the application as filed to be credible on this basis. In any event, no counter-evidence has been provided by the appellant.

9.3.5 Consequently, in line with the respondent's submission, the objective technical problem is to provide an SCY-078 salt having improved bioavailability.

9.4 Obviousness

As set out by the respondent, none of the documents in the proceedings teaches the use of citrate in order to increase bioavailability of a drug relative to other salt-forming options. Contrary to the appellant's argument, the statement in D12 (page 618, left-hand column, first sentence) that "*[a] considerable number of Citrates approved for oral as well as for intraveneous treatment exists*" cannot be interpreted in that sense either.

Moreover, the appellant's argument that the skilled person, when searching for a salt of SCY-078 exhibiting increased bioavailability, would have identified citrates as the solution through routine salt screening is not persuasive. This is because the mere hope of finding a solution to the objective technical problem by means of routine screening is not equivalent to a reasonable expectation of success in actually arriving at such a solution (T 1684/16, point 4.3.4 of the Reasons).

It follows that the subject-matter of claim 1 of auxiliary request 4 involves an inventive step when

starting from the pharmaceutically acceptable salt disclosed in claim 49 of D6.

9.5 In its statement of grounds of appeal, the appellant also considered the free base of SCY-078 disclosed in claim 49 of D6 as a suitable starting point for assessing inventive step. However, it did not repeat this objection during the oral proceedings. In any event, this objection is not persuasive either, for the following reasons.

If the free base of SCY-078 exhibits only low kinetic solubility (statement of grounds of appeal, point 148) - as was generally acknowledged by the appellant with reference to tables 6 and 7 of the application as filed - the board sees no reason why the improvement of bioavailability should not still form part of the objective technical problem when starting from the free base of SCY-078.

For the reasons given above, the solution to this objective technical problem would not have been obvious. Furthermore, even if the skilled person had carried out a routine salt screening with the expectation that an SCY-078 salt would show higher kinetic solubility than the free base, as argued by the appellant, the claimed citrate salt(s) still does(do) not constitute a mere arbitrary selection from equally suitable candidates (T 777/08, point 5.2 of the Reasons). Rather, the citrate salt(s) of claim 1 is(are) characterised by a higher kinetic solubility compared with other salts (see results discussed above).

The subject-matter of claim 1 of auxiliary request 4 therefore also involves an inventive step when starting

from the free base of SCY-078 disclosed in claim 49 of D6.

9.6 Although the appellant argued in writing that the subject-matter of all the claims of auxiliary request 4 lacked an inventive step, it did not put forward any arguments specifically directed to the other independent claims 5, 6, 8 and 9 of auxiliary request 4. Rather, as each of these independent claims refers back to claim 1, it must be concluded that the subject-matter of these additional independent claims also involves an inventive step.

D1, D7 and D14 as closest prior art

9.7 As further possible closest prior art, the appellant also considered D1, D7 and D14. However, at the oral proceedings it admitted that its arguments with regard to these documents were identical to those advanced starting from D6. In view of the board's assessment of the appellant's objections starting from D6 above, the board concludes that the objections starting from D1, D7 or D14 are likewise not convincing.

Conclusion in inventive step

9.8 It follows that the claimed subject-matter of auxiliary request 4 involves an inventive step and that auxiliary request 4 is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division with the order to maintain the patent in amended form with the following claims and a description and figures possibly to be adapted thereto:

   Claims Nos. 1 to 10 of auxiliary request 4 filed with the reply to the statement of grounds of appeal.

The Registrar: The Chairman:

K. Boelicke M. O. Müller

Decision electronically authenticated