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**Datasheet for the decision
of 16 October 2025**

Case Number: T 1360/24 - 3.3.04

Application Number: 16192229.9

Publication Number: 3175863

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A61P19/08, A61P21/00

Language of the proceedings: EN

Title of invention:
Variants of C-type natriuretic peptide

Patent Proprietor:
BioMarin Pharmaceutical Inc.

Opponents:
Ascendis Pharma Growth Disorders A/S
Ascendis Pharma A/S

Headword:
CNP variants/Ascendis

Relevant legal provisions:
EPC Art. 76(1)

Keyword:

Divisional application - added subject-matter (yes)

Decisions cited:

G 0001/94, G 0002/24



Beschwerdekammern

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Case Number: T 1360/24 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 16 October 2025

Appellant: BioMarin Pharmaceutical Inc.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
23 September 2024 concerning maintenance of the
European Patent No. 3175863 in amended form.**

Composition of the Board:

Chairwoman M. Pregetter
Members: A. Chakravarty
R. Romandini

Summary of Facts and Submissions

- I. In an interlocutory decision, the opposition division decided that European patent No. 3 175 863 amended according to auxiliary request 1, met the requirements of the EPC.
- II. The patent was filed as application EP 16 192 229, which was a divisional application of earlier application EP 10 778 389, itself filed as an international application under the PCT, which was published as WO 2010/135541 (the earlier or parent application).
- III. Both patent proprietor (appellant I) and the opponent (appellant II) filed appeals against this decision and replied to the respective appeal. They further submitted responses to the replies.
- IV. A notice of intervention of an assumed infringer under Article 105 EPC was filed by letter dated 10 April 2025. The intervener provided evidence showing that infringement proceedings had been initiated by the patent proprietor and served on the intervener on 17 February 2025. The intervention was filed within three-months following notification of the infringement action, as stipulated by Rule 89 EPC. The opposition fee was duly paid.
- V. The board issued a communication stating that it considered that the intervention was admissible and that, in line with G 1/94, the intervener assumes the status of an opponent with full party rights. In the meantime, decision G 2/24 has been issued, which confirms this approach. The intervener is a party as of

right in the proceedings and is referred to as opponent 2 in this decision. The two appellants will be referred to by their roles in the opposition procedure (patent proprietor and opponent 1).

VI. In the decision under appeal, the opposition division considered a main request, filed on 23 January 2023 and an auxiliary request 1 (filed as auxiliary request 7 on 10 May 2024). It construed claim 1 of the main request to the effect that the claimed subject-matter encompassed not only the specific sequences CNP-35 and CNP-38 but also longer or modified variants such as CNP-53 and CNP-126 (see points 24.2.2. and 26.1). As a consequence of this, the subject-matter of claims 1 and 2 lacked novelty over the disclosure in prior art documents D16, D16a, D17, D18, D19, and D20 which disclosed sequences or variants that were considered to fall within the scope of the claims, either explicitly or implicitly.

Auxiliary request 1 was held to be allowable. The opposition division considered and dismissed objections against it under Article 123(2) EPC and Article 76(1) EPC, Article 84 EPC, Article 54 EPC, Article 56 EPC and Article 83 EPC.

VII. The patent proprietor filed a statement of grounds of appeal together with a set of claims of a main request. The claims of the main request were the same as those of main request'''' filed before the opposition division on 10 May 2024.

VIII. Claims 1 to 6 of the main request read:

"1. A variant of C-type natriuretic peptide (CNP) selected from the group consisting of:

LQEHPNARKYKGANKKGLSKGCFGLKLDLDRIGSMSGLGC (CNP-38)
(SEQ ID NO: 160); and
HPNARKYKGANKKGLSKGCFGLKLDLDRIGSMSGLGC (CNP-35)
(SEQ ID NO: 162)".

2. The variant CNP of claim 1, wherein the variant CNP is LQEHPNARKYKGANKKGLSKGCFGLKLDLDRIGSMSGLGC (CNP-38) (SEQ ID NO: 160).

3. The variant CNP of claim 1 or 2, further comprising a hydrophilic polymer.

4. The variant CNP of claim 3, wherein the hydrophilic polymer is polyethylene glycol (PEG).

5. The variant CNP of claim 3 or claim 4, wherein the hydrophilic polymer is conjugated to the CNP variant at a location selected from the group consisting of (1) only at the N-terminus; (2) only at the C-terminus; (3) only at an internal site; (4) at both the N-terminus and the C-terminus; (5) at the N-terminus and an internal site; and (6) at the C-terminus and an internal site.

6. The variant CNP of any one of claims 3-5, further comprising a hydrolysable linkage conjugating the hydrophilic polymer to the CNP variant".

IX. Oral proceedings before the board were held as scheduled. During the oral proceedings, the patent proprietor submitted a new auxiliary request 1 and withdrew all claim requests except the main request and this new auxiliary request 1. New auxiliary request 1 consists of claims 1 to 5 and differs from the main request in that all dependent product claims have been deleted. The Chairwoman announced that new auxiliary

request 1 was not admitted. At the end of the oral proceedings the Chairwoman announced the decision of the board.

- X. The opponents' relevant submissions are summarised as follows:

Basis in the earlier application (Article 76(1) EPC)

Claims 3 and 6

The claims 3 and 6 of the main request introduced subject-matter which was not directly and unambiguously disclosed in the earlier application as filed, contrary to Article 76(1) EPC. Claim 3 related to CNP-35 and CNP-38 further comprising a hydrophilic polymer. Claim 6 defined that said polymer was conjugated to the CNP via a hydrolysable linkage. Claim 3 referred explicitly (also) to claim 2.

The claimed subject-matter could only be derived by making multiple selections from separate lists. Firstly, CNP-35 or CNP-38 had to be chosen from a long list of truncated CNP-53 variants disclosed on pages 70 to 72 of the application. Secondly, a hydrophilic polymer had to be selected from another list of ten alternatives on page 72, which included moieties such as bone-targeting peptides, carbohydrates, hydrophobic acids and hydrophilic polymers. For claim 6, a third selection was required for the feature "hydrolysable linkage", which was not disclosed as a preferred or mandatory feature.

The application did not provide any explicit or implicit disclosure of these features in combination. Moreover, neither CNP-35 nor CNP-38 was exemplified nor

tested. The passages cited by the proprietor (pages 12 to 13 and 79 to 80) as basis in fact related to specific embodiments and could not be combined freely with other teachings.

Furthermore, the relevant features were disclosed in distinct portions of the application, which described different general approaches (e.g. CNP-22 mutations versus truncated CNP-53 variants). Combining these disclosures led to subject-matter that was not directly and unambiguously disclosed in the earlier application.

For claim 6, the hydrolysable linkage was only disclosed as an alternative to a "stable linkage" on pages 12 and 79 to 80 and the examples in the application showed stable conjugates rather than hydrolysable ones.

Finally, there was no pointer to the claimed combinations in the earlier application was filed.

Admittance of auxiliary request 1 (Article 13(2) RPBA)

This set of claims, filed at the oral proceedings before board, should not be admitted because there were no exceptional circumstances in the appeal that justified this. The circumstances invoked by the patent proprietor as exceptional had no bearing on the added matter objection. In fact, the now successful objection of added matter against the main request had already been set out in opponent 1's notice of opposition and had been repeated in the reply to the patent proprietor's statement of grounds of appeal. There was no reason why this claim request could not have been filed earlier.

XI. The patent proprietor's relevant submissions are summarised as follows:

Basis in the earlier application (Article 76(1) EPC)

Claims 3 and 6

The objection of added subject-matter raised by opponent 1 was unfounded and the opposition division had correctly concluded that the claims complied with Article 76(1) EPC. The earlier application provided a coherent and structured disclosure of CNP variants and their modifications, including PEGylation, and the claimed subject-matter could be derived directly and unambiguously from this disclosure.

CNP-38 was disclosed at page 71, lines 27 to 28, and in claim 1 of the earlier application. The paragraph bridging pages 79 to 80 of the application was a generic teaching relating to the use of hydrophilic polymers, and was not limited to any particular CNP variant. This passage began with the statement "The disclosure contemplates...", confirming its generic nature, so that it could be combined with the claimed CNP variants.

Similar reasoning also applied to the general basis at page 12, lines 5 to 7 of the application, which stated that "the disclosure encompasses" CNP variants conjugated to a hydrophilic polymer at the N-terminus, C-terminus and at an internal site. Opponent 1 was also incorrect in asserting that "hydrophilic polymer" had to be selected from 10 alternatives at page 72, not least because basis for "hydrophilic polymer" was provided elsewhere.

PEG was singled out as an example of a hydrophilic polymer at page 12, lines 5 to 7, and again at page 79, line 32, with language indicating general applicability across CNP variants. The hydrolysable linkage was disclosed at page 12, line 31 and page 80, line 1, as one of two individualised options for conjugating PEG to the CNP variant.

These features were not selected from unrelated lists but were part of an interrelated teaching that consistently presented PEGylation as a preferred modification for CNP variants. The feature in claim 6 of conjugation via a hydrolysable linkage did not introduce new technical information either, because most exemplified linkages in the application were hydrolysable and the application provided a clear pointer to this feature.

In conclusion, claims 3 and 6 satisfied the requirements of Article 76(1) EPC and the the opponents' arguments should be dismissed.

Admittance of auxiliary request 1 (Article 13(2) RPBA)

This set of claims was filed at the oral proceedings before board. It overcame the added matter objections raised against the main request. Its admittance was justified by exceptional circumstances in the sense of Article 13(2) RPBA. There were a number of such circumstances, namely: the intervention, the fact that the proceedings were massively accelerated, the new novelty objection raised in the intervention, the new added matter objection made by the Board in its communication under Article 15(1) RPBA, and the new claim construction adopted by the Board, which departed from that of the opposition division.

Requests

- XII. The patent proprietor requests that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the main request filed with the statement of grounds of appeal (identical to the set of claims filed before the opposition division as main request'''' on 10 May 2024. Alternatively, the patent should be maintained in amended form on the basis of auxiliary request 1 submitted during the oral proceedings before the board.
- XIII. The opponents request that the decision under appeal be set aside and that the patent be revoked in its entirety.

Reasons for the Decision

Admittance of the main request

1. The board admitted the main request into the appeal proceedings. In view of the final decision in the case, the opponents are not disadvantaged by this and no reasoning for this needs to be given.

The patent in suit

2. The patent in suit was granted on application EP 16 192 229, originally filed on 4 October 2016, with description pages 1 to 198, and drawing sheets 1/57 to 57/57. No claims were filed until 25 January 2017. The description of this application is identical to that of the parent application as published WO 2010/135541, except for the inclusion in the former of numbered paragraphs on pages 182 to 198 which correspond to the claims of the parent application.

3. In the following only the requirements of Article 76(1) are dealt with.

Claims 2 to 6

Claim construction

4. The subject-matter of claim 2 is a peptide defined by its amino acid sequence:

LQEHPNARKYKGANKKGLSKGCFGLKLD RIGSMSGLGC (SEQ ID NO: 160)
(C-type natriuretic peptide 38 or CNP-38).

5. The claimed subject-matter is CNP-38 only and does not include longer peptides containing this sequence. CNP stands for C-type natriuretic peptide. The opposition division considered that the use of the term "variant" in the claim meant that the claimed subject-matter included longer peptides comprising the amino acid sequence presented in the claim. The board is however of the view that the skilled person would understand that the claimed peptide is itself a variant of "wild-type" human CNP-22. (see description paragraph [0022]).
6. Claim 3 is directed to a "variant CNP of claim 1 or 2, further comprising a hydrophilic polymer". It is an independent claim because its subject-matter is not encompassed by claim 1. The way the CNP-38 "comprises a hydrophilic polymer" is not defined and therefore includes any technically sensible means, such as covalent attachment or simple mixing with the CNP. For embodiments where the hydrophilic polymer is covalently attached, the location of covalent attachment to the hydrophilic polymer is not defined. It can be any location in the CNP peptide (compare with claim 5, which limits the attachment points). The hydrophilic

polymer is also not defined and can be any polymer that is factually hydrophilic.

7. Claim 4 specifies that the hydrophilic polymer is polyethylene glycol (PEG). The skilled person knew PEG as a class of polymers having a range of molecular weights, which may be linear or branched (c.f. paragraph [0038] and [0039] of the patent).
8. Claim 5 is dependent on claims 3 or 4 and specifies that the hydrophilic polymer is conjugated to the CNP-38 peptide and also specifies the location in the CNP-38 for the conjugation. No particular means of conjugation is defined.
9. Claim 6 is dependent on any of claims 3 to 5 and specifies that the hydrophilic polymer is conjugated to the CNP peptide via a hydrolysable linkage. The linkage is not structurally defined and may have any structure that meets the functional requirement.

Basis in the earlier application (Article 76(1) EPC)

Claim 6

10. The board will focus on whether embodiments where the CNP peptide is CNP-38 comprising a hydrophilic polymer, such as PEG and wherein said polymer is conjugated to the CNP-38 via a hydrolysable linkage (the subject-matter of claim 6, via its dependency on claims 3 and 2) are directly and unambiguously disclosed in the earlier application.
11. There is no dispute that the earlier application does not contain a *verbatim* disclosure of the claim language. Instead, the patent proprietor submits that

the claimed subject-matter is directly and unambiguously disclosed in the earlier application as a whole.

12. The board is not persuaded by the patent proprietor's submissions. In fact, the claimed subject-matter can only be derived from the earlier application by making undisclosed selections from various lists:
13. A first selection is that of CNP-38 from a long list of CNP variants (see pages 70 to 72 and claim 1).
14. A second selection is the choice of hydrolysable polymer from a list of potential conjugation partners (see pages 72 to 73:
*"In yet another embodiment, the truncated CNP peptides having wild-type sequences or amino acid addition(s), deletion(s) and/or substitution(s), can be conjugated at the N-terminus, C-terminus and/or internal site(s) to any of the moieties described herein, including but not limited to bone- or cartilage-targeting moieties (e.g., bisphosphonates, bone- or cartilage-targeting peptide sequences (e.g., poly Asp, polyGlu), peptide sequences derived from bone-targeting domains of bone proteins (e.g., osteopontin, osteocalcin, sialoprotein)), peptide sequences derived from the functional domains of bone morphogenetic proteins (e.g., BMP2, BMP3, BMP5, BMP7, BMP8a), peptide sequences derived from natriuretic polypeptides (e.g., NPPC, ANP, BNP), peptide sequences derived from polypeptides of non-natriuretic origin (e.g., serum albumin, IgG, histidine-rich glycoproteins, fibronectin, fibrinogen, zinc finger-containing polypeptides, FGF-2, osteocrin), moieties that reduce renal clearance (e.g., negatively charged PEG moieties), **hydrophilic polymers (e.g., PEG),***

carbohydrates (e.g., carbohydrates recognized by receptors on the surface of cells at bone growth plates), hydrophobic acids (e.g., C₅-C₁₂ carboxylic acids, natural fatty acids), phospholipids, and combinations thereof. In an embodiment, the truncated CNP peptides having wild-type sequences or amino acid addition(s), deletion(s) and/or substitution(s), and optionally conjugated to one or more moieties at the N-terminus, C-terminus and/or internal 5 site(s), have a total mass characterized by the ranges described generally herein, e.g., from about 2.6 kDa or 2.8 kDa to about 6 or 7 kDa"- emphasis added by the board).

15. A third selection is that of hydrolysable linkage from "*hydrolysable or stable linkage*" as disclosed on page 12, line 31 and page 79, line 33 to page 80, line 1).
16. It is established case law that a basis for a combination of features from more than a single list, can generally only be acknowledged when the disclosure of the (earlier) application provides a pointer towards each of the selections (see Case Law of the Boards of Appeal of the European Patent Office, 11th edition 2025, II.E.1.6).
17. As can be seen from the above cited passages, the earlier application contains separate disclosures of each of the features of the conjugated CNP-38 of claim 6, but discloses neither the claimed conjugated CNP-38 directly nor does it contain a pointer to the claimed combination of features.

Claim 3

18. The finding of lack of basis also applies to the subject-matter of this claim. The earlier application

does not directly and unambiguously disclose CNP-38 comprising a hydrophilic polymer because it contains no pointer to this combination of features.

19. The board is not persuaded by the patent proprietor's argument that the disclosure on pages 11 and 12 giving details of CNP variants conjugated to a hydrophilic or water-soluble polymer such as PEG represent a generalisable teaching that itself directly and unambiguously discloses CNP-38 further comprising a hydrophilic polymer. Instead, these passages disclose more specific conjugates, limited to polymers in certain size ranges (page 11) or limited to polymers with specified points of attachment to the CNP peptide (page 12).

Auxiliary request 1

Admittance (Article 13(2) RPBA)

20. This claim request was submitted during the oral proceedings before the board. The board decided not to admit it.
21. Under Article 13(2) RPBA any amendment to a party's appeal case made after notification of a communication under Article 15(1), shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons by the party concerned.
22. In relation the exceptional circumstances that were said to justify the admittance of the request under Article 13(2) RPBA, the patent proprietor referred to the intervention of the assumed infringer, the fact that the proceedings were accelerated, the new novelty

objection raised in the intervention, the new added matter objection made by the Board in its communication under Article 15(1) RPBA, and the new claim construction adopted by the Board, which departed from that of the opposition division.

23. According to the case law of the boards of appeal "exceptional circumstances" within the meaning of Article 13(2) RPBA refer to new or unforeseen developments in the appeal proceedings, such as, for example, new objections raised by the board in its communication under Article 15(1) RPBA 2020 (see Case Law, 11th edition, 2025, V.A.4.5.4 a), second paragraph and the decisions cited there).
24. In the case at hand, the board cannot recognise any new or unforeseen developments in the appeal proceedings which might justify the admittance of the new request.
25. None of the reasons put forward by the patent proprietor as new or unforeseen developments in the appeal proceedings have any bearing on the consideration relating to Article 76(1) EPC. The objections of added subject-matter in relation to the earlier application, which the request aims to overcome, were first raised in the notice of opposition of opponent 1 (see section 3 of the notice of opposition). They were also reiterated in its reply to the patent proprietor's statement of grounds of appeal. Therefore, there is no basis for asserting that the objections that led the board to find the main request not allowable, represent new or unforeseen developments in the appeal proceedings.

Conclusions

26. The main request is not allowable and no other claim request is admitted.

Order

For these reasons it is decided that:

The decision under appeal is set aside.

The patent is revoked.

The Registrar:

The Chairwoman:



I. Aperribay

M. Pregetter

Decision electronically authenticated