

## **Trial decision**

Correction No. 2015-390096

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The case of Trial for correction of Japanese Patent No. 5784911 has resulted in the following trial decision:

#### Conclusion

The correction of the description and the scope of claims of Japanese Patent No. 5784911 shall be approved as the corrected description and scope of claims attached to the written demand for trial of the case.

#### Reason

##### No. 1 History of the procedures

The application relating to Japanese Patent No. 5784911 was filed on February 27, 2009 as an international filing date (priority claim under the Paris Convention: March 7, 2008, European Patent Office), the establishment of the patent right relating to the inventions according to claims 1 to 18 was registered on July 31, 2015, and then the trial for correction of the case was demanded on August 31, 2015.

##### No. 2 Objective of the demand and details of the correction

The object of the demand for trial of the case is to request to correct the description and the scope of claims of Japanese Patent No. 5784911, to the corrected description and scope of claims attached to the written demand for trial of the case, and details of the correction are the following corrections A to D.

#### 1 Correction A

In the description of claim 6 of the scope of claims,

"The bombesin analog peptide antagonist conjugate according to claim 1 wherein the spacer B linked to the N-terminal of C has general Formula II:

II B<sub>1</sub>-B<sub>2</sub>

(wherein

B<sub>1</sub> is a covalent bond or a natural amino acid or an unnatural amino acid or a linear diamine or a cyclic diamine,

B<sub>2</sub> is a covalent bond or a natural amino acid or an unnatural amino acid or a linear carboxylic acid or a cyclic carboxylic acid,

with the proviso that both B<sub>1</sub> and B<sub>2</sub> cannot be covalent bonds at the same time and that, when B<sub>1</sub> is a diamine, B<sub>2</sub> is a carboxylic acid)."

is corrected to

"Bombesin analog peptide antagonist conjugate having general formula (I):

(I): A-B-C

(wherein

A is a metal chelator which is 1, 4, 7, 10-tetraazacyclotridecane-1, 4, 7, 10-tetraacetic acid, and A contains radionuclide metal selected from the group consisting of

a) <sup>68</sup>Ga, and

b) <sup>111</sup>In,

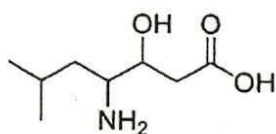
B is a spacer linked to the N-terminal of C, and B is 4-amino-1-carboxymethyl-piperidine, and

C is a bombesin analog peptide antagonist of the following sequence:

D-Phe-Gln-Trp-Ala-Val-Gly-His-Sta-Leu-NH<sub>2</sub>

wherein Sta is statine represented by the following chemical formula:

[Chemical 2]



".

## 2 Correction B

In the description of claim 7 of the scope of claims,  
"any one of claims 1-6"  
is corrected to  
"any one of claims 1-5."

## 3 Correction C

In the description of claim 7 which is dependent on claim 6 relating to the correction A, "bombesin analog peptide antagonist conjugate"  
is corrected to  
"A bombesin analog peptide antagonist conjugate having the following formula:  
[Chemical 3]



" so as to newly add as claim 19.

## 4 Correction D

The description of claim 18 which is dependent on claim 7 which is dependent on claim 6 relating to the correction A of "kit for the preparation of radiotherapeutical agent or of a radiopharmaceutical imaging agent" is newly added as claim 20 which is dependent on claim 19 relating to the correction C.

## No. 3 Judgment by the body

### 1 Regarding the correction A

#### (1) Purpose of correction

The correction A is to correct claim 6 before correction which is dependent on claim 1 so as not to be dependent on claim 1 so as to be an independent claim, and to correct "x" to "1," "n" to "1," "metal chelator" to "1, 4, 7, 10-tetraazacyclotridecane-1, 4,

7, 10-tetraacetic acid," "radionuclide metal" to "a)  $^{68}\text{Ga}$  or b)  $^{111}\text{In}$ ," "B<sub>1</sub>-B<sub>2</sub>" to "4-amino-1-carboxymethyl-piperidine," and "sequence C-1" to "D-Phe-Gln-Trp-Ala-Val-Gly-His-Sta-Leu-NH<sub>2</sub>."

Therefore, the correction A is for the purpose of "restriction of the scope of claims" as prescribed in item (i) of the proviso to Article 126(1) of the Patent Act, and falls under "to change the description of claims dependent on other claims into claims which are not dependent on other claims " as prescribed in item (iv) of the proviso to Article 126(1) of the Patent Act.

(2) Correction that is within the matters described in the description, scope of claims or drawings attached to the application

As in paragraphs [0210] and [0211] of the description attached to the application,  $^{111}\text{In}$ -Compound 2 and  $^{68}\text{Ga}$ -Compound 2 are disclosed, and compounds according to claim 6 after correction correspond to these compounds, the correction A is a correction that is within the matters described in the description, scope of claims or drawings attached to the application, and falls under Article 126(5) of the Patent Act.

(3) Correction that substantially does not enlarge or alter the scope of claims

As described in (1) above, the correction A is to restrict the matters specifying the invention from a generic concept to a more specific concept described in Examples, does not enlarge or alter the scope of claims, and falls under Article 126(6) of the Patent Act.

(4) Invention that is independently patentable

As no reason for refusal that the invention cannot be patented independently at the time of the application is found for the inventions specified by the matters described in the scope of claims after correction, the correction A falls under Article 126(7) of the Patent Act.

## 2 Regarding the correction B

(1) Purpose of correction

As the correction B is to correct "any one of claims 1-6" in claim 7 before correction to "any one of claims 1-5" so as to reduce choices of claims on which claim 7 is dependent, and claim 1 on which claim 7 is dependent is restricted by the correction A, the correction B is for the purpose of "restriction of the scope of claims" as prescribed in item (i) of the proviso to Article 126(1) of the Patent Act.

(2) Correction that is within the matters described in the description, scope of claims, or drawings attached to the application

As the correction B is to reduce choices of claims on which claim 7 is dependent, and as described in 1(2) above, the correction A relating to claim 1 on which claim 7 is dependent is within the matters described in the description, scope of claims, or drawings attached to the application, the correction B falls under Article 126(5) of the Patent Act.

(3) Correction that substantially does not enlarge or alter the scope of claims

The correction B is to reduce choices of claims on which claim 7 is dependent, and as described in 1(3) above, the correction A relating to claim 1 on which claim 7 is dependent does not enlarge or alter the scope of claims, the correction B falls under Article 126(6) of the Patent Act.

(4) Invention that is independently patentable

As no reason for refusal that the invention cannot be patented independently at the time of the application is found for the inventions specified by the matters described in the scope of claims after correction, the correction B falls under Article 126(7) of the Patent Act.

### 3 Regarding the correction C

(1) Purpose of correction

As the correction C is to correct "bombesin analog peptide antagonist conjugate" described in claim 7 which is dependent on claim 6 relating to the correction A so as not to be dependent on claim 6 and to be an independent claim, the correction C is for the purpose of "restriction of the scope of claims" as prescribed in item (i) of the proviso to Article 126(1) of the Patent Act, and falls under "to change the description of claims dependent on other claims into claims which is not dependent on other claims" as prescribed in item (iv) of the proviso to Article 126(1) of the Patent Act.

(2) Correction that is within the matters described in the description, scope of claims, or drawings attached to the application

As the compound 2 is disclosed in paragraphs [0136] and [0197] of the description attached to the application, and compounds according to claim 19 after correction correspond to the compound 2, the correction C is a correction that is within

the matters described in the description, scope of claims, or drawings attached to the application, and falls under Article 126(5) of the Patent Act.

(3) Correction that substantially does not enlarge or alter the scope of claims

As described in (1) above, the correction C is to restrict the matters specifying the invention from a generic concept to a more specific concept described in the embodiment, does not enlarge or alter the scope of claims, and falls under Article 126(6) of the Patent Act.

(4) Invention that is independently patentable

As no reason for refusal that the invention cannot be patented independently at the time of the application is found for the inventions specified by the matters described in the scope of claims after correction, the correction C falls under Article 126(7) of the Patent Act.

#### 4 Regarding the correction D

(1) Purpose of correction

As the correction D is to newly add claim 20 dependent on claim 19 relating to the correction C, with respect to a "kit for the preparation of radiotherapeutical agent or of a radiopharmaceutical imaging agent" described in claim 18 which is dependent on claim 7 that is dependent on claim 6 relating to the correction A, similar to the correction A and the correction C, the correction D falls under "restriction of the scope of claims" as prescribed in item (i) of the proviso to Article 126(1) of the Patent Act.

(2) Correction that is within the matters described in the description, scope of claims, or drawings attached to the application

The correction D, as apparent from (1) above, is a correction that is within the matters described in the description, scope of claims, or drawings attached to the application, and falls under Article 126(5) of the Patent Act.

(3) Correction that substantially does not enlarge or alter the scope of claims

The correction D, as apparent from (1) above, does not substantially enlarge or alter the scope of claims, and falls under Article 126(6) of the Patent Act.

(4) Invention that is independently patentable

As no reason for refusal that the invention cannot be patented independently at

the time of the application is found for the inventions specified by the matters described in the scope of claims after correction, the correction D falls under Article 126(7) of the Patent Act.

#### No. 4 Closing

Therefore, the demand for trial for correction of the case is intended for the matters listed in items (i) and (iv) of the proviso to Article 126(1) of the Patent Act, and falls under the provisions of Articles 126(5) to (7) of the Patent Act.

Therefore, the trial decision shall be made as described in the conclusion.

October 21, 2015

Chief administrative judge: TAMURA, Akiteru

Administrative judge: NAGAI, Keiko

Administrative judge: KOBORI, Asako