PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43*bis*.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*
PCT/US2018/065605	14.12.2018	21.12.2017

International Patent Classification (IPC) or both national classification and IPC
INV. A61K38/26 C07K14/605 A61P3/00

Applicant
ELI LILLY AND COMPANY

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notifed the International Bureau under Rule 66.1*bis*(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

Name and mailing address of the ISA:	Date of completion of this opinion	Authorized Officer
European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Fax: +49 89 2399 - 4465	see form PCT/ISA/210	Orlando, Michele Telephone No. +49 89 2399-0

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of:

   ☒ the international application in the language in which it was filed.

   ☐ a translation of the international application into , which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1 (b)).

2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43*bis*.1(a))

3. ☒ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of a sequence listing:

   a. ☒ forming part of the international application as filed:

      ☒ in the form of an Annex C/ST.25 text file.

      ☐ on paper or in the form of an image file.

   b. ☐ furnished together with the international application under PCT Rule 13*ter*.1(a) for the purposes of international search only in the form of an Annex C/ST.25 text file.

   c. ☐ furnished subsequent to the international filing date for the purposes of international search only:

      ☐ in the form of an Annex C/ST.25 text file (Rule 13*ter*.1(a)).

      ☐ on paper or in the form of an image file (Rule 13*ter*.1(b) and Administrative Instructions, Section 713).

4. ☐ In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that forming part of the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

5. Additional comments:

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	1-28
	No:	Claims	
Inventive step (IS)	Yes:	Claims	
	No:	Claims	1-28
Industrial applicability (IA)	Yes:	Claims	1-28
	No:	Claims	

2. Citations and explanations

see separate sheet

Re Item V.

Claims 22, 23, 26 and 27 relate to subject-matter considered by this Authority to be covered by the provisions of Rule 39.1(iv) PCT. The patentability can be dependent upon the formulation of the claims. The EPO, for example, does not recognize as patentable claims to the use of a compound in medical treatment, but may allow claims to product, in particular substances or compositions for use in a first or further medical treatment.

Reference is made to the following document:

D1: WO 2015/067716 A1 (ZEALAND PHARMA AS [DK]; JUST RASMUS [DK]; RIBER DITTE [DK]; SHELTON AN) 14 May 2015 (2015-05-14)cited in the application

Inventive step - Art. 33(3) PCT

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1-28 does not involve an inventive step in the sense of Article 33(3) PCT.

The problem underlying the present invention is the treatment of diabetes mellitus, dyslipidemia, fatty liver disease, metabolic syndrome, non-alcoholic steatohepatitis and obesity.

The proposed solution is an incretin analog according to claim 1, with activity at each of the GIP, GLP-1 and glucagon receptors.

1. Document D1 discloses compounds which have agonist activity at the glucagon, GIP and GLP-1 receptors, and to their use in the treatment of metabolic disorders, wherein the metabolic disorder is diabetes or a diabetes related disorder, or obesity or an obesity related disorder, and wherein the diabetes related disorder is insulin resistance, glucose intolerance, increased fasting glucose, pre-diabetes, type 1 diabetes, type 2 diabetes, gestational diabetes hypertension, dyslipidemia, bone related disorder or a combination thereof.

The incretin analogs according to the present application exhibit high structural similarity with the triple agonist incretin analogs disclosed in D1.

These technical differences however do not seem to result in any technical effect.

It is noted that the application does not provide a direct comparison in terms of biologic activity, receptor affinity or similar, between the compounds according to D1 and the presently claimed solutions.

On page 2 lines 7 and 8, it is acknowledged that D1 discloses analogs with triple agonist activity. In the next paragraph (page 2 lines 14-18) the Applicant alleges that a need would still exist for "*treatments, especially T2DM, that are capable of providing effective glucose control, with weight loss benefits and a favorable side effect profile. There also is a need for therapeutic agents available for use with sufficiently extended duration of action to allow for dosing as infrequently as once a day, thrice-weekly, twice-weekly or once a week.*".

This statement is however not supported by any experimental data showing either that the triple agonist compounds of D1 would still present these limitations or that the claimed solutions would exhibit a better profile over the compounds of D1.

In the absence of a clear technical effect associated to the structural differences, the remaining technical problem has to be formulated as how to find an alternative triple agonist starting from the compounds disclosed by D1.

D1 provides the skilled man with all information needed to screen and identify further triple agonists. It is just a matter of routine experimentation, replacing amino acid residues and testing the activity (e.g. in vitro); this exercise however does not seem to be associated with any inventive merit, therefore the subject-matter of claims 1 and 22-28 does not fulfil the requirements of Article 33(3) PCT.

2. Dependent claims 2-21 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, could be regarded as an inventive contribution over the state of the art. The features claimed in these dependent claims represent matters of common practice to a skilled person; as such, they represent mere known alternative embodiments to the compositions / therapy in question. In the absence of any indication as to a (further) technical effect being obtained by these features, the claims concerned lack an inventive step (Article 33(3) PCT).

3. The solutions proposed in claims 1-28 are not inventive (Article 33(3) PCT).

Possible steps after receipt of the international search report (ISR) and written opinion of the International Searching Authority (WO/ISA)

General information

For all international applications, the competent International Searching Authority **(ISA)** will establish an international search report **(ISR)** accompanied by a written opinion of the International Searching Authority **(WO/ISA)**. The **WO/ISA** may be responded to by

- filing informal comments with the **International Bureau of WIPO (IB)** (where no demand for international preliminary examination **(demand)** is filed)
- filing amendments under Art. 19 PCT (this can be done whether or not a **demand** is filed)
- filing amendments under Art. 34 PCT and/or formal observations in response to objections raised in the **WO/ISA** (where a **demand** *is* actually filed)

This document explains these possibilities.

Filing informal comments

After receipt of the **ISR and WO/ISA**, the applicant may file informal comments on the **WO/ISA, directly with the IB** (see International Search and Preliminary Examination Guidelines 2.15). These will be communicated to the designated/elected Offices, together with the International Preliminary Report on Patentability **(IPRP)** at 30 months from the priority date.

Amending claims under Art. 19 PCT

The applicant may file **amended claims** under Art. 19 PCT, **directly with the IB** by the later of the following dates:

- 2 months from the date of mailing of the **ISR** and the **WO/ISA**
- 16 months from the priority date

However, any such amendment received by the **IB** after the expiration of the applicable time limit shall be **considered to have been received on time** by the **IB**, if it reaches it **before** the technical preparations for international publication have been completed (the 15th day prior to the date of publication, see PCT Applicant's Guide, International Phase, 9.013).

For further information, please see Rule 46 PCT as well as form PCT/ISA/220.

Please also note that, when filing amended claims under Art. 19 PCT, such amendments shall be **accompanied by a letter** identifying the amendments made and also the basis for the amendments in the application as originally filed (Rule 46.5(b) PCT). Where a **demand** is filed, failure to comply with this requirement may result in the amendments being ignored in the International Preliminary Examination Report **(IPER)**, see Rule 70.2(c-*bis*) PCT.

Filing a demand for international preliminary examination

In principle, the **WO/ISA** will be considered to be the written opinion of the International Preliminary Examining Authority (**IPEA**). Where the **WO/ISA** issued by the **EPO** as **ISA** gives a positive opinion on the international application and the invention to which it relates, filing a **demand** with the **EPO** as **IPEA** would normally be unnecessary, since a positive IPRP would anyway be established by the IB based on the WO/ISA (see also further below).

If the applicant wishes to file a **demand** (for example, to allow him to argue his case in international preliminary examination with regard to objections raised in a negative **WO/ISA** before the **IPEA** issues an **IPER**), this must be done before expiration of **3 months after the date of mailing of the ISR and WO/ISA** or **22 months after priority date,** whichever expires later (Rule 54*bis* PCT). Amendments under Art. 34 PCT can be filed with the IPEA, normally at the same time as filing the demand (Rule 66.1(b) PCT) or within the time limit set for reply to any written opinion issued during international preliminary examination by the **IPEA**.

If a **demand** is filed at the **EPO** as **IPEA** and no comments/amendments have been received by the time the **EPO** starts drawing up the **IPER** (Rule 66.4*bis* PCT), the **WO/ISA** will be transformed by the **IPEA** into an **IPER** (also called the **IPRP (Chapter II)** which would merely reflect the content of the **WO/ISA** (OJ 10/2011, 532). The **demand** can still be withdrawn (Art. 37 PCT).

Please also note that, when filing amendments under Art. 34 PCT, such amendments shall be accompanied by a letter which identifies the amendments made and also the basis for the amendments in the application as originally filed (Rule 66.8(a) PCT). Failure to comply with this requirement may result in the amendments being ignored in the **IPER (IPRP (Chapter II))**, see Rule 70.2(c-*bis*) PCT.

Filing a request for supplementary international search

The applicant may, with the **IB**, file a request for **supplementary international search** under Rule 45*bis*.1 PCT. The present **ISR** and **WO/ISA** may also be taken into account in the execution of that supplementary international search, provided that these are available to the Authority charged with this task before it starts the supplementary search (Rule 45*bis*.5 PCT).

This kind of request **cannot be filed specifying the ISA** who did the **international search.**

More information on this topic can be found in the **PCT Applicant's Guide**, Chapter 8 (http://www.wipo.int/pct/en/guide/ip08.html).

End of the international phase

Where no **demand** is filed, at the end of the international phase, the **IB** will transform the **WO/ISA** into the IPRP (PCT Chapter I) (Rule 44*bis* PCT), which will then be transmitted together with possible informal comments to the designated Offices. Where a demand is filed, the **WO/ISA** is not transformed into an **IPRP (Chapter I)** by the **IB**, but rather the **IPEA** will establish an **IPER**, (the IPER is the same as the IPRP (PCT Chapter II), see Rule 70.15 PCT).

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