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Datasheet for the decision of 22 October 2018

Case Number: R 0010/17

Appeal Number: T 0609/12 – 3.3.01

Application Number: 03738280.1

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Language of the proceedings: EN

Title of invention:
Combination of azelastine and fluticasone

Patent Proprietor:
Cipla Limited

Headword:
-

Relevant legal provisions:
EPC Art. 112a(2)(c), 113(1)

Keyword:
"Admissibility of petition - (yes)"
"Right to be heard fundamentally violated – (no)"
"Petition for review – clearly unallowable"

Decisions cited:

R 0001/08, R 0012/09, R 0015/12, R 0002/13, R 0014/13, R 0016/13, R 0003/15

Catchword:
-

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Case Number: R 0010/17

D E C I S I O N
of the Enlarged Board of Appeal
of 22 October 2018

Petitioner: (Patent Proprietor)	Cipla Limited Cipla House Peninsula Business Park Ganpatrao Kadam Marg Lower Parel Mumbai - 400013 (IN)
Representative:	Cooke, Richard Spencer Elkington and Five LLP Thavies Inn House 3-4 Holborn Circus London EC1N 2HA (UK)
Other party: (Opponent)	Glaxo Group Limited Glaxo Wellcome House Berkeley Avenue Greenford Middlesex UB6 0NN (UK)
Representative:	Goddard, Carolyn Janice GlaxoSmithKline Global Patents (CN925.1) 980 Great West Road Brentford, Middlesex TW8 9GS (UK)
Decision under review:	**Decision T 0609/12 of the Technical Board of Appeal 3.3.01 of the European Patent Office of 31 May 2017.**

Composition of the Board:

Chairman: C. Josefsson
Members: F. Blumer
A. Ritzka

Summary of Facts and Submissions

I. The petition for review concerns decision T 609/12 of 31 May 2017 of Board of Appeal 3.3.01, revoking European patent no. 1 519 731 which was granted on 15 April 2009 to Cipla Limited (petitioner in the present review proceedings).

II. Claim 1 of the granted patent covers a pharmaceutical formulation basically comprising a combination of two active compounds:

- Azestaline (an antihistamine) or certain derivatives thereof ("AZE"), and
- Fluticasone (a corticosteroid) or certain derivatives thereof ("FLU").

The pharmaceutical formulation is useful for preventing or minimising allergic reactions. In addition to the active compounds, the formulation usually contains excipients (auxiliary materials) such as water, preservatives, stabilizers, thickeners etc. It can be prepared, for example, in the form of a nasal spray.

III. Opposition was filed by Glaxo Group Limited. The opposition was based, *inter alia*, on the ground for opposition under Article 100(a) in connection with Article 56 EPC (lack of inventive step).

IV. With its response to the summons for oral proceedings before the Opposition Division, the petitioner filed documents D21 to D25 to support its arguments that the claimed invention was based on an inventive step. A declaration of Ms Geena Malhotra (D21), accompanied by Exhibits A and B (D22 and D23, both containing experimental data) should demonstrate that the

combination of AZE and FLU led to a higher stability in comparison to a combination of AZE and another corticosteriod than Fluticasone (a combination disclosed in document D1). A declaration of Mr Joachim Maus with Exhibits A and B (D24 and D25) should demonstrate that a combination therapy with AZE and FLU had a better therapeutic effect for the treatment of seasonal allergic rhinitis than a monotherapy with AZE or a monotherapy with FLU.

V. Late-filed documents D21 to D25 were admitted into the proceedings by the Opposition Division since they were considered to be *prima facie* relevant for inventive step. In its interlocutory decision the Opposition Division found that the subject-matter of claim 1 of the then pending first auxiliary request (which was narrower than granted claim 1 in a few aspects not relevant to these review proceedings) met the requirements of the EPC. In its reasons concerning inventive step, the Opposition Division started from D1 as closest prior art and found that the synergistic effect of the combination therapy with AZE and FLU could not be considered in support of inventive step since the evidence on file (including D24 and D25) could not be considered an appropriate comparison in view of the closest prior art D1. On the other hand, the Opposition Division accepted that improved stability when stored at elevated temperatures and high humidity (as compared to the formulations of D1) was shown by the test results of D22 and D23. The unexpected effect of improved stability provided the basis for inventive step in the opposition division’s view.

VI. An appeal was filed by the opponent. In the grounds of appeal and the petitioner's response thereto, various aspects of the test results presented in documents D21 to D25 were discussed.

VII. In its communication of 10 March 2017 accompanying the summons for oral proceedings, the Board of Appeal gave its preliminary observations. In view of the expected discussion on inventive step at the oral proceedings, the Board of Appeal wrote: *"The parties should come prepared for the discussion of inventive step starting from document (1) and taking into consideration the teaching of document (11) and the evidence presented in documents (21) to (25)."* (pt. 11 of the communication of 10 March 2017). In their reply letters to the summons to oral proceedings, the parties did not address documents D21 to D25.

VIII. At the oral proceedings before the Board of Appeal (which were held in the absence of the opponent/appellant), it was discussed, *inter alia*, *"which technical effects or improvements could be attributed to the distinguishing feature of the claimed invention"* (minutes, page 3). The claimed invention differed from the closest prior art (example III of document D1) insofar as the corticosteroid used in the claimed combination formulation was FLU, not triamcinolone acetonide as in D1 (column 3 of the table in D22). The discussion during oral proceedings on the alleged improvement of the stability was, in particular, based on the experimental data of document D22. This discussion and the conclusion of the Board of Appeal is reflected in point 4.2 of the decision under review:

"In document (22), the formulation according to the invention (column 1) differs from that of example III of document (22) (column 3) not only in the corticosteroid but also in the nature and amount of the excipients, in particular the nature and amount of the thickening agent (Avicel RC 591 at 1.5% vs HPMC at 1.0%) and the amount of surfactant (Polysorbate 80 at 0.025% vs 0.05%). Thus, the higher stability of the formulation in column 1 cannot be exclusively ascribed to the different corticosteroid. This was countered by the respondent at the oral proceedings before the board with the argument that the excipients in the examples of document (22) were equivalent and that they were present in such low concentrations that they could not be expected to cause any difference in the stability of the formulations. This argument, however, did not convince the board because ionic and non-ionic thickeners cannot be regarded as being equivalent and because their concentrations, albeit low, correspond to their customary values. In addition, the fact that the amounts of thickener and surfactant differed from one formulation to the other in a relationship of 50 to 100% could not be neglected either."

IX. The decision under review was sent to the parties on 12 September 2017. The petition for review was filed on 22 November 2017 together with an authorisation for Mr R. Gillard and Mr R. Cooke, both of Elkington & Five LLP. In a subsequent letter of 21 December 2017, the petitioner referred to decision R 3/15 of 28 November 2017.

X. The petitioner’s arguments can be summarised as follows:

(a) The petitioner did not have an opportunity to respond to certain concerns the Board had with respect to the comparative tests in D22.

(b) In particular, the petitioner had not had the chance to present their position rebutting the Board’s particular grounds or concerns relating to the nature of the different thickening agents (ionic vs. non-ionic) and the concentrations of the thickening agent and the surfactant.

(c) These particular concerns appeared in the written decision only.

XI. The petitioner requested that the decision of the Board of Appeal be set aside and the proceedings before the Board of Appeal be reopened. The petitioner further requested oral proceedings in the event that the Enlarged Board was to reach a decision other than in accordance with their requests.

XII. The Enlarged Board issued summons to oral proceedings together with a communication pursuant to Articles 13 and 14(2) RPEBA on 3 August 2018. In a reply letter of 25 September 2018, the petitioner addressed, in particular, the decisions discussed in the Enlarged Board’s communication and other pertinent case law.

Reasons for the Decision

1. The petitioner’s objections

1.1 The petition is based on Article 112a(2)(c) EPC (fundamental violation of Article 113 EPC).

1.2 In particular, the petitioner sees its right to be heard violated because in the context of the experimental results of D22, which were introduced to demonstrate an improved stability of the claimed pharmaceutical formulations, the Board of Appeal addressed certain specific issues only in the written decision, namely:

(a) that the ionic and non-ionic thickening agents used in the different formulations could not be regarded as being equivalent, and

(b) that the concentrations of thickeners and surfactants used in the different formulations corresponded to their customary values and differed from one formulation to the other in a relationship of 50 to 100%.

Since these issues were not raised during oral proceedings or earlier in the appeal proceedings, the petitioner did not have a chance to respond to these concerns.

2. Admissibility of the petition

2.1 The decision under review of 31 May 2017 of Board of Appeal 3.3.01 was notified on 12 September 2017. The petition was filed on 22 November 2017, i.e. within the time limit specified in Article 112a(4), and the corresponding fee was paid on the same day. The formal requirements of Rule 107(1) and (2) EPC have been complied with, and the petitioner is adversely affected by the decision under review.

2.2 The petitioner does not rely on procedural violations occurring before and during oral proceedings before the Board of Appeal, which violations could and should have

been objected to under Rule 106 EPC during oral proceedings. Instead, the petitioner's objections focus on the written decision of the Board of Appeal which contained concerns that were not raised during the appeal proceedings and could not be addressed by the petitioner during the oral proceedings. Since the petitioner could not be aware of these concerns of the Board, no objection under Rule 106 EPC could be made (R 2/13 of 10 June 2013, Reasons, point 1; R 14/13 of 25 February 2015, Reasons, point 2).

2.3 The petition is therefore in compliance with Rules 106 and 107 EPC and admissible.

3. Allowability of the petition

3.1 Discussion of the comparative tests during appeal proceedings

3.1.1 The petitioner's objections relate to the discussion of comparative tests filed as D22 during opposition proceedings in order to demonstrate improvements achieved by the claimed pharmaceutical formulations over the closest prior art (D1). Documents D21 to D25 were admitted as late-filed documents and discussed during opposition proceedings. D22 and D23 provided, in the opposition division's view, a basis for recognizing an improved stability of the formulation when stored at elevated temperatures and high humidity and, consequently, an inventive step (see above Facts and Submissions, point V).

3.1.2 In the appeal proceedings, the opponent took the position that the comparative tests did not show an improved stability of the claimed combination of active

substances. In the grounds of appeal (Section 6.4, “The Stability Data”) the various documents provided in this context (including D22) were extensively discussed. The opponent took the position (Section 6.4, first paragraph) that the improved stability acknowledged by the opposition division on the basis of D22 was not due to the specific choice of active substances but rather “due to the specific formulations tested” (comprising the active substances and the excipients such as thickeners and surfactants). Also in the context of Article 83 EPC, the opponent emphasized the significant impact of the excipients on the properties of the formulation, such as stability (grounds of appeal, page 5, last paragraph).

3.1.3 In its response to the grounds of appeal (letter dated 14 February 2013), the petitioner supported the opposition division’s position on improved stability, referring, in particular, to D22 (see, e.g., Sections 7.4.3 and 7.6.2). In the communication sent with the summons to oral proceedings, the Board of Appeal wrote that the parties should come prepared for discussing inventive step starting from D1 and taking into consideration, inter alia, the evidence presented in documents D21 to D25 (see above Facts and Submissions, point VII). No reference was made to specific issues like the stability and the influence of the excipients thereon in the communication.

3.1.4 During oral proceedings before the Board of Appeal, it was discussed whether the technical effects or improvements (in particular, the stability) documented in D22 could be attributed to the distinguishing feature of the claimed invention (i.e., the combination

of active substances) or whether the stability improvements had to be ascribed to the differences in the excipients, namely the nature and amount of the thickener and the amount of surfactant (point 4.2 of the decision under review). During oral proceedings before the Enlarged Board, the petitioner confirmed that during the oral proceedings before the Board of Appeal concerns were raised about the nature and amount of excipients in the tested formulations.

3.2 Alleged violation of the petitioner’s right to be heard

3.2.1 The reason why the Board of Appeal did not acknowledge an improvement of the stability of the claimed formulations over the prior art on the basis of the experiments documented in D22 was the fact that the formulations tested differed not only with respect to the claimed features (active substances) but also in respect of the excipients (such as thickeners and surfactants). As the Board of Appeal found that the alleged improvement of the stability was not demonstrated, the claimed subject-matter was considered not to be inventive.

3.2.2 Said reason was presented to the petitioner during oral proceedings before the Board of Appeal (above point 3.1.4). It was based on the objections made by the opponent (who was not present at these oral proceedings) in the grounds of appeal already (above point 3.1.2).

3.2.3 During oral proceedings before the Enlarged Board, the petitioner argued that in its communication the Board of Appeal did not indicate that it wanted to go into

more detail of the excipients and that even during the oral proceedings, the “prevailing view” was that the excipients were not material to the case. However, the relevance of the excipients for the stability was raised in the grounds of appeal already (above point 3.1.2). The reaction of the petitioner during oral proceedings before the Board of Appeal shows that the petitioner fully understood the objection: Its arguments concerning the equivalence of the different thickeners and the small amounts of the excipients were made to explain why the nature and the amount of the excipients could not be expected to cause any difference in the stability of the formulation (point 4.2 of the decision under review).

3.2.4 Even if the issues concerning the excipients may not have been in the focus of the parties during the written phase of the appeal proceedings, they were made clear at the latest during the oral proceedings. The petitioner reacted during oral proceedings by presenting its counterarguments, and the petitioner has not argued that it did not have sufficient opportunities to react.

3.2.5 In its decision, the Board of Appeal had to evaluate the arguments about the excipients presented by the petitioner during oral proceedings. In the written decision, the Board of Appeal explained why the arguments of the petitioner were not convincing, i.e., that the experimental results of D22 did not show an improved stability because the tested formulations differed not only in the active substances but also in the nature and amount of the excipients. The reasons given by the Board of Appeal concerning the nature of

the thickeners (that ionic and non-ionic thickeners could not be equivalent, see above point 1.2(a)) was a mere illustration of the fact that the two thickeners differed at least in one important chemical property and could therefore not be easily interchanged without risking an effect on the properties of the formulations. No arguments were given by the petitioner during the appeal proceedings as to why the thickeners should be equivalent. The Board's reasons concerning the allegedly small amounts of thickeners and surfactants (that the concentrations were customary and differed from one formulation to the other in a relationship of 50 to 100%) just reiterated data given in D22.

3.2.6 Article 113(1) EPC requires that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned had an opportunity to present their comments. A board of appeal is not required to provide the parties in advance with all foreseeable reasons which may appear in the decision (cf. R 1/08 of 15 July 2008, Reasons, point 3.1; R 12/09 of 15 January 2010, Reasons, point 11). The right to be heard is respected if the party had an opportunity to comment on the relevant aspects of the case and the pertinent passages of the prior art. The board, after hearing the parties, may then draw its own conclusions which may then appear in the written reasons (R 15/12 of 11 March 2013, Reasons, point 5(a)); R 16/13 of 8 December 2014, Reasons, point 3.3).

3.2.7 The reasons given by the Board of Appeal only in the written decision exclusively addressed a ground which was presented to the petitioner (the flaws of the experimental results in D22) and the responses given by

the petitioner during oral proceedings before the Board of Appeal. The Enlarged Board therefore cannot see a fundamental violation of Article 113 EPC as required under Article 112a(2)(c) EPC. The Board's reasons in the written decision are closely related to the issues discussed at oral proceedings and could not come as a surprise to the petitioner.

3.2.8 The petitioner relied on decisions R 16/13 and R 3/15 in which the petitions were allowed, arguing that these cases were very similar to the present case. As far as R 3/15 is concerned, the Enlarged Board cannot see any relevant similarity. In this case, the Board of Appeal apparently came to a specific interpretation of the relevant patent claim only in the written decision. This interpretation had been brought forward by neither of the parties, neither during opposition nor on appeal, and had apparently not been mentioned by the Board of Appeal. The Enlarged Board of Appeal found that the petitioner had not had the opportunity to take position with regard to this new interpretation (R 3/15 of 28 November 2017, Reasons, point 4.5.8).

3.2.9 The case underlying decision R 16/13, on the other hand, is similar to the present case at least in that it concerned an objection related to comparative tests on which the petitioner allegedly was not sufficiently heard. In the context of comparative tests filed as D11A, the Board of Appeal raised concerns in the written decision only that the parameters of a product compared with the prior art were not completely given in D11A. These concerns, which led to the conclusion that the alleged improvement of the stability (and consequently, an inventive step) could not be

recognised, were never addressed throughout the appeal proceedings (R 16/13 of 8 December 2014, Reasons, point 2.2). In contrast, in the present case the Board of Appeal's specific concerns about the experimental data of D22 were raised, in particular, in the grounds of appeal, and they were discussed during oral proceedings.

3.2.10 The petitioner further argued that in the present case the Board of Appeal addressed the petitioner's (patentee's) arguments on a specific, technical level while the patentee only had the opportunity to comment on the general. In other cases where the Enlarged Board did not allow a petition, the board of appeal addressed the patentee's comments at the same level of generality as presented by the patentee (see, in particular, the letter dated 25 September 2018). For the Enlarged Board, the level of generality of the ground on which a petitioner allegedly had no opportunity to comment is not decisive. In view of Article 113(1) EPC, every ground which has a potential effect on the decision has to be presented and discussed with the parties concerned. The ground at dispute, namely the non-pertinence of comparative tests due to differences in the nature and the amounts of the excipients, was presented and discussed during the oral proceedings before the Board of Appeal. The principle that a board of appeal is not required to provide the parties in advance with all foreseeable reasons which may appear in the decision (above point 3.2.6) also applies for reasons of any level of generality.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as being clearly unallowable.

The Registrar: The Chairman:

N. Michaleczek C. Josefsson