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**Datasheet for the decision  
of 10 December 2020**

**Case Number:** R 0008/20

**Appeal Number:** T 0041/17 - 3.3.02

**Application Number:** 05797740.7

**Publication Number:** 1797038

**IPC:** C07D213/81, A61K31/44,  
A61P35/00

**Language of the proceedings:** EN

**Title of invention:**

THERMODYNAMICALLY STABLE FORM OF BAY 43-9006 TOSYLATE

**Patent Proprietor:**

Bayer HealthCare LLC

**Opponents:**

Fresenius Kabi Deutschland GmbH  
Biofer S.p.A.

**Headword:**

Fundamental violation of the right to be heard

**Relevant legal provisions:**

EPC Art. 112a(2)(c), 113(1)  
EPC R. 106

**Keyword:**

Petition for review - clearly unallowable - fundamental violation of Article 113 EPC (no)

**Decisions cited:**

R 0003/18

**Catchword:**



**Große Beschwerdekammer**  
**Enlarged Board of Appeal**  
**Grande Chambre de recours**

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Case Number: R 0008/20

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 10 December 2020**

**Petitioner:**  
(Patent Proprietor)

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**Decision under review:**

**Decision of the Technical Board of Appeal 3.3.02  
of the European Patent Office of  
14 January 2020.**

**Composition of the Board:**

**Chairman**            I. Beckedorf  
**Members:**            W. Sekretaruk  
                             G. Eliasson

## **Summary of Facts and Submissions**

- I. The patent proprietor's petition for review is directed against the decision of Board of Appeal 3.3.02 (hereinafter: the Board) in case T 0041/17 revoking European patent No. 1797038. The petition for review is based on Article 112a(2)(c) EPC.
- II. In its decision at point 1.4.3 the Board dealt with the decision T 2114/13 by another board of appeal and concluded that the case at hand was not comparable to that case. In the cited case the closest prior art for assessing inventive step was of a different nature. During oral proceedings before the Board, the patent proprietor had summarized T 2114/13 and had compared it in detail with the case at hand. In its view in both cases the invention disclosed the same technical effect. In the cited case the board of appeal had acknowledged an inventive step based on exactly this effect. While admitting in its decision that the closest prior art in the case at hand was even more remote, the Board denied applicability of the cited case law due to a different effect of the claimed invention without providing any reasons in view of the slurry examples investigating "solvent mediated conversion" in the patent. Instead of dealing with the patent proprietor's arguments, the Board misinterpreted its explanations, as is proven by the minutes of the oral proceedings before the Board. This left the petitioner in a situation, where it was impossible to understand how the Board came to its conclusion. Consequently, it was not possible to comment. Even in the event the Enlarged Board of Appeal (hereinafter: the Enlarged Board) could not follow this argument, the petition was well-founded, because it could not be

established that the patent proprietor's submissions were indeed considered and fully taken into account. Had the Board correctly applied the case law of the boards of appeal in line with case T 2114/13 an inventive step of the claimed invention should have been acknowledged.

III. The petitioner's requests are

that the decision T 0041/17-3.3.02 be set aside;  
that the proceedings before the Board be re-opened;  
that the members of the Board who participated in the decision be replaced; and  
that the fee for the petition of review be reimbursed.

IV. In a communication dated 29 September 2020 the Enlarged Board expressed its preliminary view that the petition was likely to be rejected as being clearly unallowable.

V. In its reply of 23 October 2020, the petitioner addressed the Enlarged Board's preliminary opinion. It pointed out that the Board did not reason as to why decision T 2114/13 was not applicable to the case to be decided although the patent proprietor had pointed at examples in the patent which proved a stability against solvent mediated conversion. Therefore, the decision did not allow any conclusion that this issue had been substantively assessed and found relevant by the Board of Appeal.

VI. At the oral proceedings before the Enlarged Board on 10 December 2020 the petitioner further elaborated on the infringement of the Petitioner's right to be heard.

A party to EPO proceedings had a right to a real consideration of its arguments. What was completely missing was an explanation why the Board of Appeal came to a different result when deciding on basically the same facts and evidence as those of case T 2114/13.

### **Reasons for the Decision**

1. The petition meets the requirements with respect to the time limit and payment of the petition fee.
2. The petition complies with Rule 106 EPC. An objection in respect of the alleged procedural defects had not been possible before the Board as the alleged deficiencies only became apparent with the reasons of the decision.

#### 3. *The alleged violation*

The petitioner complains that its arguments concerning the comparability of the cited case T 2114/13 and the case at hand were not considered.

##### 3.1 *The law*

Article 113(1) EPC reads:

*The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.*

3.2 *The interpretation of an opportunity to present comments in the sense of Article 113(1) EPC*

An opportunity to present comments implies that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is reviewed, with respect to their relevance for the decision on the matter. On the other hand, the right to be heard does not go so far as to impose a legal obligation on a board to consider each and every argument of the parties in detail in a decision.

3.3 *The Board's uncontested facts and arguments*

The Enlarged Board refers to point XI. Inventive step of the impugned decision part "The respondent's arguments..." (page 6) referring to the respondent-proprietor's arguments

*The stability to mechanical stress of polymorph I was an unexpected effect in accordance with T 777/08 (headnote 1), T 517/14 (reasons 5.4) and and T 2114/13. The claimed subject-matter involved an inventive step.*

3.4 *The Board's reasons for the decision*

The Enlarged Board further refers to point 1.4 (page 11):

*This finding is in line with decisions T 777/08 (OJ EPO 2011, 633), T 517/14 and T 2114/13, cited by the respondent.*



and to point 1.4.3 (page 12):

*In decision T 2114/13 (reasons, 5), inventive step was acknowledged on the basis that the closest prior art disclosed a mixture of two polymorphic forms of febuxostat and that the technical problem was the provision of a pharmaceutical composition of febuxostat with improved polymorphic stability, in particular during formulation.*

*Also this decision concerns a case that is different from the present one. The effect in case T 2114/13, i.e. polymorphic stability against "solvent-mediated conversion" of a slurry in acetone and water (second paragraph of point 5.4 of the reasons) is different from the effect in the present case (stability under mechanical stress) and the closest prior art in case T 2114/13 was a document disclosing a polymorphic mixture while the closest prior art in the present case relates to a compound whose form is not specified.*

This proves that the petitioner's arguments indeed were taken into account. The argument that the Board did not find the patent proprietor's argument correct and deviated from the petitioner's view concerning the choice of the closest prior art and the effect of the claimed invention cannot be heard in review proceedings, because it is a question of the application of substantive law. The assessment of substantive law is excluded in review proceedings, see for example R 3/18, point 2.4.

*..., under Article 112a EPC, the Enlarged Board may be called upon by a party to appeal proceedings to remedy a fundamental procedural defect of those*

*proceedings (or in relation to a criminal act) pursuant to Article 112a(2) in conjunction with Rule 104 EPC. [...] The Enlarged Board has no competence under Art. 112a EPC to examine the merits of the decision and to go into the substance of a case..., not even indirectly... A review of the correct application of substantive law would amount to the Enlarged Board being a third instance which has been explicitly excluded... The Enlarged Board cannot act as a third instance or second-tier appellate tribunal in petition proceedings...*

4. In the light of the foregoing, the Enlarged Board cannot see a fundamental violation of the petitioner's right to be heard.

## **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

I. Beckedorf

Decision electronically authenticated