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**Datasheet for the decision
of 19 May 2025**

Case Number: R 0003/23

Appeal Number: T 1303/18 - 3.3.02

Application Number: 08853236.1

Publication Number: 2215072

IPC: CO7D333/20, A61K31/381,
A61P25/00

Language of the proceedings: EN

Title of the invention:
POLYMORPHIC FORM OF ROTIGOTINE

Patent Proprietor:
UCB Pharma GmbH

Opponents:
Interquim, S.A.
Hexal AG
Generics [UK] Limited
Luye Pharma AG
Wittkopp, Alexander
AMW GmbH

Headword:
Petition for review

Relevant legal provisions:
EPC Art. 112a(2)(c), 113(1)
EPC R. 106, 109(2)(a)
RPEBA Art. 13, 14(2)

Keyword:
Right to be heard - Infringed (no)
Opportunity to comment
Petition for review rejected as clearly unallowable

Decisions cited:

R 0003/09, R 0020/09, R 0016/12, R 0008/13, R0004/16,
R 0008/20, R 0025/22



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

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Case Number: R 0003/23

**D E C I S I O N
of the Enlarged Board of Appeal
of 19 May 2025**

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Decision under review: Decision T 1303/18 of the Technical
Board of Appeal 3.3.02 of the European
Patent Office of 21 November 2022

Composition of the Board:

Chairman: I. Beckedorf
Members: J. Geschwind
B. Willems

Summary of Facts and Submissions

- I. The petition for review is directed against the decision in case T 1303/18 of 21 November 2022 by which Technical Board of Appeal 3.3.02 (hereafter "the Board") dismissed the petitioner's appeal against the decision of the opposition division revoking the European patent for lack of novelty of the subject-matter of the main request and the auxiliary requests 1 and 2, and lack of inventive step of the subject-matter of auxiliary request 4.

The petition for review is based on Article 112a(2) (c) EPC, more specifically on a fundamental violation of the right to be heard according to Article 113 EPC. The petition for review is duly reasoned and was filed within the required time limit.

- II. The petitioner submits that the petition for review is filed regarding the way in which the Board has dealt with and finally decided on auxiliary request 2.

According to the petitioner, one of the main issues which were to be discussed concerned the validity of the claimed priority and the use of the term "substantially" in the wording of claim 1 of auxiliary request 2.

The petitioner argues that the opponents expressed their concerns about this aspect, for the first time, only in their submissions in response to the grounds of appeal.

However, in its preliminary opinion the Board did not address any objection at all concerning the term "substantially" used in claim 1 of auxiliary request 2.

The petitioner contends that, surprisingly, the only reason taken into account in the final decision of the Board with regard to the validity of the claimed priority was the use of the term "substantially".

Thus, the petitioner argues that it became aware of the importance of the use of the term "substantially" for the outcome of the case only after having read the fully reasoned decision of the Board.

III. More particularly, the Board decided (see point 8.3 of the decision): "The board finds the appellant's arguments unconvincing. As acknowledged by the appellant, D49 [US 60/990,721 P] does not disclose the term 'substantially' in relation to the X-ray powder diffraction spectrum, see especially page 11, lines 14 to 30, where the results shown in figure 1 of D49 are discussed. As pointed out by the respondents, this term allows undefined deviations from the spectrum shown in figure 1 of the patent which are not disclosed by D49. In particular, contrary to the appellant's view, there is no basis in D49 which allows the term 'substantially', referring in claim 1 to the whole X-ray diffraction spectrum, to be associated with the specific error margin of ± 0.1 disclosed in D49 (claim 1, page 3, lines 14 to 20, and page 6, lines 3 to 9) with regard to some specific X-ray diffraction peaks. As for claim 1 as granted, the polymorphic form of rotigotine defined in claim 1 of auxiliary request 2 is thus not directly and unambiguously derivable, using common general knowledge, from D49. In other words, claim 1 of auxiliary request 2 and D49 do not define the same compound".

IV. The Enlarged Board summoned the parties to oral proceedings and issued a communication under

Article 13 of the Rules of Procedure of the Enlarged Board of Appeal, on 28 October 2024.

- V. The petitioner made further submissions in a letter of 13 May 2025.
- VI. Oral proceedings before the Enlarged Board were held on 19 May 2025.
- VII. The petitioner requested that:
- the decision under review be set aside
 - the proceedings before the Technical Board of Appeal be-reopened,
 - the rapporteur of the Board who participated in the impugned decision be replaced, and
 - the fee for the petition for review be reimbursed.
- VIII. The Enlarged Board of Appeal announced the decision at the end of the oral proceedings.

Reasons for the decision

Admissibility of the petition

1. According to the admissibility requirement contained in Rule 106 EPC, the request for review is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.
2. The petitioner submits that an objection could not have been raised at the oral proceedings pursuant to Rule 106 EPC (see above, point 3), since it could only have become aware of the allegedly objectionable

reasoning of the Board regarding the impact of the use of the term "substantially" on the assessment of the validity of the claimed priority after having read the written decision of the Board.

3. Thus, the Enlarged Board of Appeal is of the opinion that the present petition for review is not clearly inadmissible.

Allowability of the petition

4. The petition is based on the sole argument that the violation of the right to be heard occurred in the course of the appeal proceedings regarding the reasoning of the Board in assessing the interpretation of the term "substantially" in claim 1 of the auxiliary request 2 and the resulting conclusion with regard to the validity of the claimed priority.

According to the petitioner, the specific reasoning adopted by the Board was not put to the parties, neither during the written proceedings, nor during the oral proceedings, thereby depriving the petitioner of any opportunity to comment on it or to amend its case, where eventually this reasoning was decisive for the assessment of the validity of the claimed priority.

5. The Enlarged Board of Appeal is of the opinion that the relevant issue relies on the assessment whether the parties, in particular the petitioner, had the opportunity to comment on the relevant issues and to which extent there could exist any surprising reason which was decisive for the Board's final decision. To this extent the Enlarged Board of Appeal would have to consider also the file history (see e.g. decisions: R 08/13, Reasons, point 9; R 25/22, Reasons, point 14).

5.1 The Enlarged Board of Appeal observes that the term "substantially" was objected to by opponents 1 and 2 in relation with the validity of the claimed priority in their replies to the petitioner's statement of grounds of appeal with their respective letters dated 18 December 2018 (see pp. 47 to 49). The petitioner responded to these specific objections with a letter dated 21 August 2020 (see pp. 21 and 22).

5.2 It is established case law that the preliminary opinion of a board does not have to be comprehensive (see e.g. decision R 03/09, Reasons, point 5.1).

Thus, the fact that at that stage of the appeal proceedings, the Board had discussed the issue of the validity of the claimed priority focusing only on the disclosure of an irradiation source and a spectrum measurement, without raising a further issue about the use of the term "substantially" in claim 1 of the auxiliary 2, appears in itself irrelevant to evidence a violation of the right to be heard.

5.3 It clearly appears from the minutes of the oral proceedings of 21 November 2022 (see the paragraph bridging pages 7 and 8) that the parties had sufficient opportunity to debate and to make submissions concerning the use of the term "substantially".

In particular, the petitioner submitted that: "The term 'substantially' did not change the compound claimed. This term was meant to take the fact into account that for technical reasons some deviations from figure I might occur. Moreover, this term reflected the error margins disclosed in the priority application".

It is further mentioned that the respondents submitted: "The term 'substantially' implied that deviations from the spectrum of figure 1 were possible. This

generalisation was not disclosed in the priority application."

The parties' respective argumentation about this issue was also summarised in the written decision of the Board under the section "Facts and submissions" (see, for the appellant (petitioner), p. 7, last paragraph and for the opponents, p. 11). More specifically the opponents' arguments are summarised by the Board as follows: "The term 'substantially' included in claim 1 of auxiliary requests 2 and 4 allowed intermediate deviations from the x-ray diffraction spectrum shown in figure 1 of the earliest priority applications D48/D49."

Since neither the minutes nor the part of the decision containing the summary of the parties' arguments were formally objected to, the Enlarged Board of Appeal sees no reason to question the correctness of their content, from which it appears that the parties were heard on the interpretation of the wording "substantially" in the specific context of the validity of the claimed priority.

6. It is established case law that a board of appeal has no obligation to give all aspects of reasoning in advance, e.g. by explaining in detail the result of the deliberation (see CLBA, Chapter V.B.4.3.5, 10th edition 2022 and the decisions cited; see also decision R 25/22, Reasons, points 10 and 11).

It is also settled case law that the minutes of oral proceedings before a board of appeal may contain only the essentials of the proceedings, without the need of explicitly stating each and every argument made by the parties or the reasoning underlying the decision (see e.g. decisions R 08/13, Reasons, point 16; R 04/16, Reasons, point 20; R 20/09, Reasons, point 3.3).

Therefore, the fact that the minutes of the oral proceedings do not mention the details of the Board's reasoning on the validity of the claimed priority is not relevant for the present case.

7. It appears indisputable that during the debates the argument was made that "some deviations" and "intermediate deviations" may occur which at least seem not to have been specified in the relevant priority document.

To this extend, the Board's conclusion that "the term allows undefined deviations" appears not to deviate from the arguments discussed with the parties and correctly reflects the subject of the debates. Eventually, the board did not add any further argument to the parties' case and followed the opponent's arguments on the use of the term "substantially", considering that the occurrence of possible deviations was decisive and detrimental to the acknowledgement of the claimed priority.

The Enlarged Board of Appeal considers that, in this context, there is no objective evidence that the petitioner was deprived of the opportunity to exhaustively comment on the issue at stake.

Furthermore, the Enlarged Board of Appeal observes that the petitioner's arguments about having been deprived of an opportunity to file further amendments would the Board have given a reasoning after deliberation is not convincing.

The Enlarged Board of Appeal has rather serious doubts that, in the specific and critical context of assessing the validity of the claimed priority, the petitioner, represented by experienced professional representatives, objectively could not have been aware

of the importance of a possible negative effect on the validity of the priority of the wording "substantially" and could have been surprised by the Board's conclusions drawn in the final decision about the use of this term. Even though there would have been any concern or misunderstanding regarding the outcome of the debates about the term "substantially", the petitioner would have had all the opportunity to ask the Board for clarification, which they did not do so.

For these reasons, the Enlarged Board of Appeal cannot acknowledge any violation of the petitioner's right to be heard.

8. It rather appears that the petitioner disagrees with the decision of the Board merely on the merits of the case, in particular on the conclusions regarding the use and the interpretation of the term "substantially" and their negative impact on the validity of the claimed priority.

The Enlarged Board of Appeal observes that this circumstance would lead to a review of the decision of the Board on its merits. This would extend beyond the scope of the examination of a petition for review by the Enlarged Board of Appeal according to Article 112 EPC (see decisions: R 16/12, Reasons, points 4.2 and 4.7; R 08/20, Reasons, point 3.4).

9. Consequently, the Enlarged Board of Appeal considers that the petition for review is clearly unallowable. This renders the petitioner's requests for setting aside the decision under review and for re-opening the appeal proceedings equally unsuccessful. The same applies to the petitioner's other requests which dependent on the aforementioned unsuccessful requests have no legal basis.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar:



N. Michaleczeck

Decision electronically authenticated

The Chairman:

I. Beckedorf