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**Datasheet for the decision
of 16 November 2012**

Case Number: T 1760/11 - 3.3.01
Application Number: 00108480.5
Publication Number: 1020461
IPC: C07D401/12, A61K31/44, A61P1/04
Language of the proceedings: EN

Title of invention:

Magnesium salt of the (-)-enantiomer of omeprazole and its use

Patent Proprietor:

AstraZeneca AB

Opponents:

Hexal AG
Teva Pharmaceutical Industries Ltd.
Mepha AG
STADA Arzneimittel AG
Pinewood Laboratories Limited
ETHYPHARM
Actavis Group hf.
Lupin Limited
Zentiva a.s.
Generics [UK] Limited
Ratiopharm GmbH
1A Pharma GmbH
Hexal Pharma GmbH
Hörnchen, Ulrich, Dr.

Headword:

(-)-Omeprazole Mg/ASTRAZENECA

Relevant legal provisions:

EPC Art. 24

Relevant legal provisions (EPC 1973):

Keyword:

Partiality of chairman (no)

Decisions cited:

G 0002/08, G 0001/05

Catchword:

-



Case Number: T 1760/11 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 16 November 2012

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 29 July 2011 revoking European patent No. 1020461 pursuant to Article 101(2), (3)(b) EPC.**

Composition of the Board:

Chairman: J.-B. Ousset
Members: L. Bühler
L. Seymour

Summary of Facts and Submissions

- I. The procedure under Article 24(3), (4) EPC leading to the present decision resulted from an objection of suspected partiality raised in the course of the oral proceedings held from 13 to 16 November 2012 in the appeal T 1760/11.
- II. Towards the end of the third day of oral proceedings, on 15 November 2012, after the parties had been informed that the board had come to the conclusion that the subject-matter of auxiliary request 1 met the requirements of the EPC, respondents 1 to 4, 6, 7, and 9 to 13 requested the referral of the following two questions to the Enlarged Board of Appeal:
- "1. In case where there is more than one feasible starting point, is it admissible, contrary to T 21/08, to find an inventive step by applying the problem solution approach starting from only one of these starting points without considering the others?
 2. In particular, is it admissible in a case relating to a patent granted on a divisional application, to ignore the starting point identified by the Appeal Board in the technically closely related parent case (here: T 401/04)?"

As an auxiliary request, the same respondents requested to be given the opportunity to address inventive step of the subject-matter of auxiliary request 1 starting from document (1) as the closest prior art.

III. After both requests had been rejected, respondents 1 to 4, 6, 7, and 10 to 13 raised an objection under Rule 106 EPC in conjunction with Article 112a(2)(c) EPC, which was formulated in writing as follows:

"We hereby raise an objection under R. 106 EPC since we were denied the opportunity to address inventive step starting from D1 as closest prior art during oral proceedings. This constitutes a violation of the right to be heard."

IV. Owing to the fact that the chairman of the board had denied their request for an adjournment of oral proceedings until the next day in order to formulate said objection under Rule 106 EPC, respondents 1 and 12 objected to the chairman of the board under Article 24(3) EPC because of suspected partiality.

V. On the following day, on 16 November 2012, after this objection was found to be admissible by the board in its original composition, the chairman objected to (hereinafter referred to as former chairman) was replaced by his alternate for the purpose of deciding on allowability (Article 24(4) EPC). Oral proceedings were resumed by the board in its new composition. In accordance with Article 3(2) of the Rules of Procedure of the Boards of Appeal (see Supplement to OJ EPO 1/2012, 38 to 49) an invitation was issued to the former chairman in order to give him the opportunity to present his comments as to whether there were any reasons for his exclusion. The parties were informed thereof.

VI. The reply of the former chairman reads as follows:

"Since [the representative of respondents 1 and 12] had explained orally that he intended to raise an objection under R. 106 EPC on the ground that he had not had the opportunity to present in case regarding inventive step of the first auxiliary request starting from document (1) as closest state of the art, I thought that fifteen minutes were sufficient to write down his objection.

We were at the end of the third day of oral proceedings and we were still discussing the first auxiliary request. I had therefore to see that the parties have sufficient time to present possibly their case on the second, third and fourth auxiliary requests so that their right to be heard in that respect be not violated."

VII. The parties were given the opportunity to present their arguments after having received and read the reply.

VIII. The arguments of respondents 1 and 12 can be summarised as follows:

Their request to be given the opportunity to address inventive step of the subject-matter of auxiliary request 1 starting from document (1) was rejected shortly before 20:00 hrs. Respondents 1 and 12 then informed the board that they wished to raise an objection under Rule 106 EPC. In view of the fact, that interpretation was no longer available after 20:00 hrs, the former chairman initially indicated that he intended to adjourn oral proceedings in order to discuss the objection under Rule 106 EPC on the next

day. However, the former chairman changed his mind when respondents 4 and 6, upon request, agreed to continue oral proceedings without interpretation. The former chairman then stated that he considered 15 minutes to be sufficient to put the objection under Rule 106 EPC in writing. Despite the fact that respondents 1 and 12 objected that 15 minutes were inappropriate, and asked for adjournment of oral proceedings until the next day in order to prepare the objection under Rule 106 EPC, the former chairman insisted that the respondents put their objection in writing within 15 minutes, and indicated that he intended to bring oral proceedings to a close at 21:00 hrs.

The allocated time of 15 minutes could not be considered to be an appropriate time for the preparation of an objection pursuant to Rule 106 EPC. Contrary to the allegation of the appellant, respondents 1 and 12 had not envisaged such an objection at lunchtime, but only announced their intention to submit a point of law to be referred to the Enlarged Board of Appeal. There had thus been no time to prepare the objection before the board's refusal of the respondents' request to address inventive step of the subject-matter of auxiliary request 1 starting from document (1).

The refusal to allow the respondents 1 and 12 appropriate time to carefully formulate a procedurally important objection and to coordinate with the other respondents conveyed the former chairman's predetermination to reject the objection under Rule 106 EPC without proper consideration of the arguments of the respondents and to bring oral proceedings to a

close before 21:00 hrs. Had the former chairman had an open mind, he would have acted differently.

The written reply of the former chairman did not remove the suspicion of partiality. No reasons were given why 15 minutes were regarded as appropriate time and why the oral proceedings could reasonably be expected to come to a close at 21:00 hrs. The reply was also contradictory, since no reason had been given as to why the fact that further auxiliary requests might need to be discussed on the following day necessarily implied that the request for adjournment to properly prepare and present the objection under Rule 106 EPC should be rejected. Moreover, procedural efficiency could not be regarded as valid justification to deny a party's right to be heard on an objection under Rule 106 EPC.

IX. Respondent 2 added with regard to the reply of the former chairman that the first auxiliary request had been found to be allowable and that there was no need to consider further auxiliary requests. Respondent 6 submitted in addition that the former chairman had exerted pressure to continue the oral proceedings without interpretation.

X. The appellant's arguments may be summarised as follows:

Referring to the decision of the Enlarged Board of appeal G 2/08 of 15 June 2009, the appellant noted that the respondents had not submitted evidence of actual partiality of the former chairman. Therefore, it was to be determined if the circumstances of the case would allow a reasonably objective and informed person to conclude that the respondents 1 and 12 might have good

reason to suspect the partiality of the former chairman.

In conducting oral proceedings a chairperson had the competence to set a party a time limit for formulating a new request or for other procedural acts. It was thus not extraordinary that a limited time was given to formulate the objection under Rule 106 EPC. It was also normal for a chairman to strive to bring the proceedings efficiently to a close. These circumstances could thus not give rise to a suspicion of partiality. Moreover, no evidence had been given that would support the allegation that the former chairman had exerted pressure on respondents 4 and 6 to agree to continue without interpreters after 20:00 hrs. The respondents had not been denied the opportunity to prepare the objection under Rule 106 EPC. They had had enough time to prepare, since they already had indicated at lunchtime that they might raise an objection under Rule 106 EPC if they were not allowed to address inventive step of the subject-matter of auxiliary request 1 starting from document (1). The former chairman had also been prepared to give the respondents the opportunity to present their arguments in support of the objection under Rule 106 EPC. There was no evidence that the former chairman had not been willing to give consideration to the respondents' arguments. The envisaged time of one hour for discussion of this issue was not unreasonable.

- XI. Respondents 1 and 12 requested that the chairman be excluded from the proceedings in the appeal T 1760/11 for reasons of suspected partiality.

- XII. The appellant requested that the objection of suspected partiality be rejected.

Reasons for the Decision

1. According to the jurisprudence of the Enlarged Board of Appeal, the suspicion of partiality must be justified on an objective basis (G 2/08 of 15 June 2009, point 4.2 of the Reasons). It is necessary that a reasonable, objective and informed person considering the circumstances of the case would conclude that the party might have good reason to doubt the impartiality of the member objected to (G 1/05, OJ EPO 2008 271, points 20 to 24 of the Reasons).
2. The question to be decided here is therefore whether a reasonable, objective and informed person would conclude that respondents 1 and 12 had good reason to suspect the former chairman of being predetermined to reject the objection under Rule 106 EPC without proper consideration of the arguments of the respondents due to the former chairman's refusal to accord more time to the preparation of an objection under Rule 106 EPC and his announced intention to bring oral proceedings to a close at 21:00 hrs. Applying the criteria set out above (point 1), the board cannot identify in the former chairman's conduct of the proceedings any good reason to suspect partiality.
3. At oral proceedings, the time available for a party's presentations is inevitably limited. In conducting oral proceedings a chairperson has thus the competence to set a party a time limit for its submissions. The fact

that the time allocated to a party for its submissions is limited is not in itself a violation of proper procedure, as long as the party is thereby afforded a reasonable opportunity to present its case and, in *inter partes* proceedings, not placed at a substantial disadvantage vis-à-vis the adversarial party. This applies equally to the preparation of a new request or to other procedural acts.

4. In the present case, it was shortly before 20:00 hrs when respondents 1 and 12 informed the board that they wished to raise an objection under Rule 106 EPC in view of the refusal of the two requests of respondents 1 to 4, 6, 7, and 9 to 13, namely, the request for referral of two questions to the Enlarged Board of Appeal and the request to be given the opportunity to address inventive step of the subject-matter of auxiliary request 1 starting from a different prior art document (see point II above). Since interpretation was no longer available after 20:00 hrs, the former chairman had to consider how to proceed. The former chairman decided to pursue the debate after respondents 4 and 6 had agreed to continue oral proceedings without interpretation.
5. Respondent 6 asserted that the former chairman pressured for a continuation of oral proceedings without interpretation. However, respondent 6 did not substantiate its allegation and there is no evidence supporting the perceived pressure. Respondent 4 did not argue that pressure had been applied. In the board's opinion, the former chairman did not have the means to exert pressure on any of the parties to agree to continue without interpreters. Indeed, a professional

representative can be expected to be aware of the implications of waiving its right to interpretation, and to carefully consider its reply to a question of a chairperson in this respect. The board can therefore not identify in the former chairman's endeavours to continue oral proceedings a reason that could reasonably give rise to a suspicion of partiality. The purely subjective perception of pressure by the representative of respondent 6 does not constitute an objective basis on which a suspicion of partiality can be justified.

6. Respondents 1 and 12 relied instead on the facts that the chairman turned down their request for postponement, instructed them to put their request in writing within 15 minutes and indicated that he envisaged bringing oral proceedings to a close at 21:00 hrs.

- 6.1.1 The board agrees with the appellant that the factual circumstances following the announcement of an objection under Rule 106 EPC cannot be considered in isolation. The objection under Rule 106 EPC is consequential to the board's finding on the preceding requests of respondents 1 to 4, 6, 7, and 9 to 13, namely, the request for referral of two questions to the Enlarged Board of Appeal and the request to be given the opportunity to address inventive step of the subject-matter of auxiliary request 1 starting from a different prior art document (see point II above). The events relied upon by respondents 1 and 12 have thus to be evaluated in the context of the discussions on these requests.

- 6.1.2 The discussion on the request for referral to the Enlarged Board of Appeal started at about 19:05 hrs and took approximately 10 minutes. The chairman then adjourned oral proceedings in order for the board to deliberate on the issues raised and to carefully consider the arguments and the case law invoked by respondents 1 to 4, 6, 7, and 9 to 13. Oral proceedings were resumed at about 19:40 hrs. The former chairman informed the parties that the request for referral to the Enlarged Board of Appeal was rejected. This announcement was followed by the discussion on the request of respondents 1 to 4, 6, 7, and 9 to 13 to be given the opportunity to address inventive step of the subject-matter of auxiliary request 1 starting from document (1) as the closest prior art. The debate took less than 10 minutes. After deliberation by the board, the former chairman informed the parties at about 19:55 hrs that this request was rejected.
- 6.1.3 An objective observer would have been aware that the discussion on the request for referral to the Enlarged Board of Appeal and the request to be given the opportunity to address inventive step of the subject-matter of auxiliary request 1 starting from a different prior art document had implications with respect to a possible objection under Rule 106 EPC. Indeed, respondents 1 and 12 indicated before the start of the discussion of these requests that they intended to file an objection under Rule 106 EPC if these requests were not allowed. Moreover, in support of their requests, respondents 1 to 4, 6, 7, and 9 to 13, in substance, invoked the right to be heard as legal basis. In view of the link between the objection under Rule 106 EPC and the preceding requests, an objective person would

not have expected the debate on the objection to require more time than the discussion on the preceding requests, since the main arguments had been presented by the parties and carefully considered by the board in the context of these requests. Since the discussions and deliberations on these requests had taken less than one hour, an objective observer would have thought it reasonable to envisage the end of debate at 21:00 hrs. In this context, an objective observer would not have regarded the allocated time of 15 minutes for preparation of the objection under Rule 106 EPC as extraordinary or inadequate, particularly since about the same time had been accorded for the preparation of the questions for referral to the Enlarged Board of Appeal. Moreover, respondents 1 and 12 would have had time to prepare their objection under Rule 106 EPC in advance, namely, during the deliberations by the board on the preceding requests. Therefore, from an objective point of view, neither the time accorded for the preparation of the objection under Rule 106 EPC nor the envisaged end of debate at 21:00 hrs are valid reasons to suspect the former chairman of being predetermined to reject the objection under Rule 106 EPC without proper consideration of the arguments of the respondents. On the contrary, the procedural arrangements of the former chairman are in keeping with his duty to conduct oral proceedings and duly take into account the interrelated discussions on the requests of respondents 1 to 4, 6, 7, and 9 to 13.

7. It is regrettable that, in the heat of the argument, the forceful manner in which the former chairman rejected the request for postponement and directed respondents 1 and 12 to put their objection under

Rule 106 EPC in writing might have prompted respondents 1 and 12 to believe that the former chairman was prejudiced. However, the circumstances of events are not sufficient to justify the suspicion of partiality. From the point of view of a reasonably objective and informed person, the behaviour of the former chairman would not have been considered a good reason to suspect his partiality, since the former chairman legitimately disagreed with respondents 1 and 12 about the appropriateness of an adjournment of oral proceedings until the following day, and, being mindful of his responsibility to conduct oral proceedings, endeavoured to avoid any undue delay of the oral proceedings.

8. Since the board could not identify any reason justifying a suspicion of partiality, the request under Article 24(3) EPC of 15 November 2012 had to be rejected.

Order

For these reasons it is decided that:

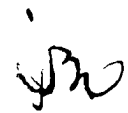
The request under Article 24(3) EPC of 15 November 2012 is rejected.

The Registrar:


M. Schalow



The Chairman:


J.-B. Ousset