

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 26 April 2016**

Case Number: T 0874/13 - 3.3.07

Application Number: 07764936.6

Publication Number: 2040683

IPC: A61K9/20, A61K31/585,
A61K31/567, A61K31/525,
A61P15/18

Language of the proceedings: EN

Title of invention:

PHARMACEUTICAL COMPOSITION CONTAINING A TETRAHYDROFOLIC ACID

Applicant:

Bayer Intellectual Property GmbH

Relevant legal provisions:

EPC Art. 115, 123(2), 84, 111(1)
RPBA Art. 13(1), 13(3)

Keyword:

Late-filed request - justification for late filing (yes)
Amendments - claim 1: added subject-matter (no)
Claim 1 - clarity (yes)
Appeal decision - remittal to the department of first instance
(yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0874/13 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 26 April 2016

Appellant: Bayer Intellectual Property GmbH
(Applicant) Alfred-Nobel-Strasse 10
40789 Monheim (DE)

Representative: Plougmann Vingtoft a/s
Rued Langgaards Vej 8
2300 Copenhagen S (DK)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 2 November 2012
refusing European patent application No.
07764936.6 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairwoman R. Hauss
Members: A. Usuelli
P. Schmitz

Summary of Facts and Submissions

I. The appeal of the applicant (appellant) lies from the decision of the examining division announced at the oral proceedings held on 11 October 2012 to refuse European patent application No.07764936.6.

II. The documents cited during the examination proceedings included the following:

D1: WO 03/070255 A1

III. The decision was based on a main request and three auxiliary requests filed on 11 September 2012.

Claim 1 of the main request read as follows:

"1. A solid pharmaceutical composition comprising a progestogen, an estrogen, a 5-methyl-(6S)-tetrahydrofolic acid or a pharmaceutically acceptable salt thereof, and at least one pharmaceutical acceptable excipient or carrier, wherein the *in vitro* dissolution of the progestogen is such that at least 70% is dissolved from the composition within 30 minutes, as determined by the USP XXIX Paddle Method II using water at 37°C as the dissolution media and 50 rpm as the stirring rate, and the composition does not contain vitamin B12".

Claim 1 of auxiliary requests 1 and 2 differed from claim 1 of the main request by the addition of a disclaimer at the end of the claim. Claim 1 of auxiliary request 3 differed from claim 1 of the main request in that it specified that the estrogen was micronised.

The four sets of claims also included an independent claim relating to a process for preparing a composition as defined in claim 1.

- IV. According to the decision under appeal, document D1 was the closest prior art for the assessment of the inventive step of the subject-matter of claim 1 of the main request. The composition of the invention differed from the composition of D1 mainly on account of the use of 5-methyl-(6S)-tetrahydrofolic acid as tetrahydrofolate component and in the absence of vitamin B12. The alleged benefit deriving from the use of 5-methyl-(6S)-tetrahydrofolic acid, namely the fact that unlike other tetrahydrofolate components this substance did not mask the indicators of vitamin B12 deficiency, was not credibly demonstrated. The technical problem was therefore to be seen in the provision of an alternative composition comprising a progestogen and an estrogen, wherein said composition allowed a folate supplementation.

Document D1 disclosed various substances, including 5-methyl-(6S)-tetrahydrofolic acid as suitable components for folate supplementation. The skilled person would have therefore replaced one of the folate components of the compositions of examples 1 and 2 of D1 by 5-methyl-(6S)-tetrahydrofolic acid.

The absence of vitamin B12 represented a disadvantageous modification of the composition of the closest prior art which did not involve any inventive activity.

Claim 1 of the main request was therefore not inventive.

The arguments set out for claim 1 of the main request also applied to claim 1 of the auxiliary requests. Hence, auxiliary requests 1 to 3 did not comply with Article 56 EPC either.

- V. The appellant lodged an appeal against that decision. With the statement setting out the grounds of appeal, sent on 11 March 2013, the appellant submitted a main request identical to the main request forming the basis of the decision under appeal.

With the same letter, the appellant submitted the following document:

D16: WHO/FAO: Vitamin and Mineral Requirements in Human Nutrition, 2nd edition 2004, page 291

- VI. Observations of a third party pursuant to Article 115 EPC were filed with letter dated 25 September 2014.

The following documents *inter alia* were annexed to the letter of the third party:

D20: Am. J. Clin. Nutr., 77, 658-662, (2003)

D21: The Journal of Nutrition, 132 (11), 3353-3355, (2002)

D22: Am. J. Clin. Nutr., 79, 473-478, (2004)

D23: The Journal of Nutrition, 134, 580-585, (2004)

- VII. The board issued a communication pursuant to Article 15(1) RPBA, dated 26 January 2016.

Concerning the assessment of inventive step, the board agreed with the examining division that document D1 was the closest prior art. However, in contrast with the conclusions of the examining division, the board

considered that, in the light of the arguments and evidence brought forward by the appellant with the statement setting out the grounds of appeal, it was credible that 5-methyl-(6S)-tetrahydrofolic acid did not suppress the indicators of vitamin B12 deficiency. The technical problem was therefore formulated as the provision of an alternative folate-supplemented oral contraceptive which is safe for use in subjects suffering from vitamin B12 deficiency.

The board nevertheless came to the conclusion that the subject-matter of claim 1 was obvious in view of the teaching of the closest prior art in combination with the teachings of documents D20 to D23.

VIII. With letter sent on 8 April 2016, the appellant submitted a new request and withdrew the set of claims submitted with the statement setting out the grounds of appeal.

The new request consisted of 15 claims relating to a process for the manufacture of a solid oral dosage form comprising a progestogen, an estrogen and a tetrahydrofolic acid.

IX. Oral proceedings were held before the board on 26 April 2016. At the beginning of the proceedings the appellant submitted a new main request replacing the request filed on 8 April 2016.

Claim 1 of the new main request read as follows:

"1. A process for the manufacture of a solid oral dosage form comprising a progestogen, an estrogen, a 5-methyl-(6S)-tetrahydrofolic acid or a pharmaceutically acceptable salt thereof, and at least

one pharmaceutical acceptable excipient or carrier, wherein the *in vitro* dissolution of the progestogen is such that at least 70% is dissolved from the solid oral dosage form within 30 minutes, as determined by the USP XXIX Paddle Method II using water at 37°C as the dissolution media and 50 rpm as the stirring rate, and the solid oral dosage form does not contain vitamin B12, wherein the process comprises the steps of:

- (i) subjecting a progestogen, an estrogen and at least one pharmaceutical acceptable excipient to a granulation process,
- (ii) mixing a 5-methyl-(6S)-tetrahydrofolic acid or a pharmaceutically acceptable salt thereof with the granules formed in step (i) at the end of, or near the end of, the granulation process, and
- (iii) optionally continuing the granulation process, and
- (iv) formulating the granules into solid oral dosage forms."

The set of claims of the new main request also contained fourteen claims depending on claim 1.

X. The appellant's arguments, insofar as they are relevant for the present decision, can be summarised as follows.

(a) Claim 1 of the main request differed from claim 1 of the request filed on 8 April 2016 only in the replacement in the preamble of the claim of the erroneous term "tetrahydrofolic acid" by "5-methyl-(6S)-tetrahydrofolic acid". It was clear from the wording of step (ii) that claim 1 related to the preparation of a composition containing 5-methyl-(6S)-tetrahydrofolic acid.

- (b) The arguments and evidence submitted by the third party had considerably changed the case. The withdrawal of the original request containing product claims and the submission of a request limited to process claims was a reaction of the appellant to the new situation arising from the submission of the third party. The main request was therefore to be admitted into the appeal proceedings.
- (c) Claim 1 was based on a combination of original claims 43 and 46. The limitations introduced in the claims concerning for instance the specific tetrahydrofolic acid, the dissolution profile of the progestogen and the absence of vitamin B12 had a basis in the description of the original application. Claim 1 of the main request complied therefore with the requirements of Article 123(2) EPC.
- (d) In step (ii) of claim 1, the addition of 5-methyl-(6S)-tetrahydrofolic acid "at the end of, or near the end of, the granulation process" was to be interpreted as meaning that the 5-methyl-(6S)-tetrahydrofolic acid was also part of the granules. Hence, the granules referred to in step (iv) of claim 1 included all the active ingredients.
- (e) Since the process claims were neither commented on nor decided upon by the examining division, the case was to be remitted to the department of first instance for further prosecution.

XI. The appellant requested that the decision under appeal be set aside and that the case be remitted to the

examining division for further prosecution on the basis of the set of claims as submitted during the oral proceedings.

Reasons for the Decision

1. Admission of the request submitted during the oral proceedings
 - 1.1 The appellant's sole request was filed during the oral proceedings before the board. The admission of this request is therefore at the board's discretion and depends upon the overall circumstances of the case (Article 13(1) RPBA). These will be considered in the paragraphs that follow.
 - 1.2 The requests which formed the basis of the decision under appeal contained product claims relating to pharmaceutical compositions comprising a progestogen, an estrogen and a 5-methyl-(6S)-tetrahydrofolic acid. Only these claims were discussed in the decision.

A central argument in the reasoning leading the examining division to the conclusion of lack of inventive step was the consideration that the alleged beneficial effect deriving from the use of 5-methyl-(6S)-tetrahydrofolic acid was not credibly demonstrated. In view of this, the technical problem was defined as the provision of an alternative composition allowing a folate supplementation. The solution to this problem proposed in claim 1 of all the requests was considered obvious, in view of the teaching of document D1 considered alone (see point IV above).

1.3 In the communication issued on 26 January 2016 the board, in contrast with the examining division, expressed the opinion that the technical effect deriving from the use of 5-methyl-(6S)-tetrahydrofolic acid was credible. Accordingly, the technical problem was formulated taking this effect into account. The board then came to the conclusion that the solution to this problem was obvious in view of the teaching of D1 in combination with the teachings of documents D20 to D23, which were filed by a third party in the context of observations pursuant to Article 115 EPC (see VII above).

1.4 Hence, upon receipt of the board's communication, the appellant was presented with a new objection on inventive step, different from the objection put forward by the examining division and largely based on evidence not available during the first instance proceedings.

The request filed on 8 April 2016, limited to process claims, therefore represents a legitimate reaction from the side of the appellant to the factual change in the case and to the opinion expressed by the board.

1.5 As explained by the appellant during the oral proceedings (see point X(a) above), claim 1 of the final request differs from claim 1 of the request of 8 April 2016 only in a minor amendment in the preamble of the claim introduced to remove an inconsistency concerning the definition of the tetrahydrofolic acid derivative.

1.6 Therefore, having regard to the circumstances of this case, the board in the exercise of its discretion

admits the main request into the appeal proceedings (Article 13(1)(3) RPBA).

2. Article 123(2) EPC

2.1 The subject-matter of claim 1 is based on the disclosure of original claims 43 and 46. The claim contains further limiting features which are disclosed in the following parts of the original application:

- (a) the use of 5-methyl-(6S)-tetrahydrofolic acid as tetrahydrofolic acid component is disclosed in claim 13 or on page 9 of the description, lines 26 to 28,
- (b) the feature defining the *in vitro* dissolution of the progestogen is disclosed in original claim 18 and in the paragraph bridging pages 5 and 6 of the description,
- (c) the indication that the solid dosage form does not contain vitamin B12 is based on claim 28 and on page 9, lines 33 to 36,
- (d) in step (ii) of the process, the indication that 5-methyl-(6S)-tetrahydrofolic acid is added "at the end of, or near the end of, the granulation process" is based on the disclosure of page 20, lines 25 and 26.

2.2 The features discussed in points (a) to (d) above reflect preferred embodiments of the invention, and their combination does not result in the addition of subject-matter extending beyond the content of the application as filed.

In view of the above, the board considers that claim 1 meets the requirements of Article 123(2) EPC.

3. Article 84 EPC

3.1 During the oral proceedings the appellant was asked to clarify whether 5-methyl-(6S)-tetrahydrofolic acid was a component of the granules. It was observed in this respect that, according to step (iv) of claim 1, only the granules are formulated into the final solid oral dosage forms. It therefore appeared doubtful whether 5-methyl-(6S)-tetrahydrofolic acid was included in the solid dosage forms as stated in the preamble of claim 1.

3.2 The appellant explained that in step (ii) of claim 1, the addition of 5-methyl-(6S)-tetrahydrofolic acid "at the end of, or near the end of, the granulation process" resulted in the incorporation of this substance into the granules.

The board accepts this explanation, which is in line with the teaching derivable from the description of the application. Indeed, in the paragraph bridging pages 19 and 20, it is explained that according to an embodiment of the invention, the tetrahydrofolic acid derivative could be added "after the granulation process has been completed", thereby forming an "outer component" of the granules. The addition of 5-methyl-(6S)-tetrahydrofolic acid after completion of the granulation process is, however, excluded from the wording of present claim 1. Hence, the possibility of having the tetrahydrofolic acid derivative outside of the granules is not comprised in claim 1.

3.3 Thus, the board has no objections under Article 84 EPC against claim 1.

4. Remittal

4.1 In the decision under appeal, the examining division examined only claims directed to a product *per se* and did not consider any issue concerning the patentability of the process claims (see point IV).

4.2 The sole request pending before the board is limited to process claims.

4.3 Thus, in order not to deprive the appellant of the opportunity to have the case examined by two instances, the request for remittal of the case is granted (Article 111(1) EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairwoman:



S. Fabiani

R. Hauss

Decision electronically authenticated