

Internal distribution code:

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

**Datasheet for the decision
of 21 May 2019**

Case Number: T 1024/15 - 3.3.01

Application Number: 05813062.6

Publication Number: 1829582

IPC: A61K36/67, A61P25/00

Language of the proceedings: EN

Title of invention:

AN EXTRACT OF PIPER LAETISPICUM C.DC., ITS METHOD FOR
PREPARATION AND ITS USES

Patent Proprietor:

Wang, Ezhou
Jiang, Yi

Opponent:

Wohldorff GmbH

Headword:

Piper laetispicum extract/WANG and JIANG

Relevant legal provisions:

EPC Art. 100(a), 54

Keyword:

Novelty - (yes)



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1024/15 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 21 May 2019

Appellant: Wohldorff GmbH
(Opponent) Diestelstr. 36
22397 Hamburg (DE)

Representative: Simandi, Claus
Badehausallee 55
27476 Cuxhaven (DE)

Respondents: Wang, Ezhou
(Patent Proprietors) 500 Cao Bao Road
Shanghai 200233 (CN)

Jiang, Yi
Room 503, No.3
716 Xie Tu Road
Shanghai 200023 (CN)

Representative: Schwahn, Hartmut
Gleiss Große Schrell und Partner mbB
Patentanwälte Rechtsanwälte
Leitzstraße 45
70469 Stuttgart (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 5 March 2015
rejecting the opposition filed against European
patent No. 1829582 pursuant to
Article 101(2) EPC**

Composition of the Board:

Chairwoman T. Sommerfeld
Members: M. Pregetter
 M. Blasi

Summary of Facts and Submissions

- I. European patent No. 1 829 582 is based on European patent application No. 05813062.6, filed as an international application published as WO2006/058487.
- II. The following documents, cited during the opposition and appeal proceedings, are referred to below:

(9) US 2004/0053994

(16) List und Hörhammer (Herausgeber), "Hagers Handbuch der pharmazeutischen Praxis, 7. Band, Springer Verlag, 1970, Seiten 25-34
- III. The appeal lies from the decision by the opposition division to reject the opposition. The opposition division acknowledged, *inter alia*, novelty of the claimed subject-matter in the light of the teaching of document (9).
- IV. The opponent (appellant) filed an appeal. In the statement setting out the grounds of appeal the appellant provided arguments with regard to the novelty of the subject-matter of claims 1, 4 and 9 and submitted document (16).
- V. The respondents (patent proprietors) requested that the appeal be dismissed.
- VI. In a communication pursuant to Article 15(1) RPBA, dated 18 March 2019, the board indicated that during the oral proceedings issues raised pursuant to Article 54 EPC had to be discussed in light of document (9).

VII. By letter dated 23 April 2019, the respondents provided arguments and filed two sets of claims as auxiliary requests 1 and 2.

VIII. The present decision is based on the patent as granted.

Claims 1, 4 and 9 read as follows:

"1. A method for preparing *Piper laetispicum* C.DC. extracts, including the following procedures: take *Piper laetispicum* C.DC. drug materials, wherein the *Piper laetispicum* C.DC. drug materials are selected from the root, rhizome, rattan, leaf and fruit or the entire plant of the *Piper laetispicum* C.DC, pretreat such materials by cutting or powdering, and then add organic solvents for impregnation at normal temperature or $\leq 70^{\circ}\text{C}$ to obtain extracts."

"4. *Piper laetispicum* C.DC. extracts prepared and obtained through the methods of one of the claims 1 to 3."

"9. *Piper laetispicum* C.DC. extracts of claim 4 for use in a method of treatment of monoamine transmitter metabolism related mental diseases."

IX. The oral proceedings before the board on 21 May 2019 took place in the absence of the appellant, who had informed the board by letter of 9 May 2019 that it would not attend.

X. The appellant's arguments, presented in writing and insofar as they are relevant to the present decision, may be summarised as follows:

The method as defined in claim 1 of the patent in suit

related to a method of maceration or digestion to obtain plant extracts. Document (9) disclosed in example 1 (paragraph [0050]) a method of taking Piper laetispicum C.DC. material, comminuting and grinding it, adding alcohol, i.e. an organic solvent, and heating it. Document (9) did not explicitly disclose that the heating lead to reflux or boiling of the alcohol. Thus, when reading document (9), the skilled person would not have understood being instructed to heat the alcohol to temperatures above the boiling point and consequently would not have done so. Furthermore, the wording used in document (9), i.e. "heating in a circulating device" was unclear. The skilled person would have understood that the term "circulating" referred to maceration under agitation ("Bewegungsmazeration") in, for example, a vortex extraction device ("Wirbelextraktion") (see document (16), page 27). In this context reference was made to decision T 412/91. All method steps of claim 1 as granted were already disclosed in document (9). Consequently, the disclosure of document (9) was novelty-destroying for the subject-matter of claim 1 of the patent as granted.

Claim 4 as granted was a product-by-process claim referring to the method of claim 1. Since the method of document (9) fell within the technical teaching of claim 1 as granted, the extracts obtained by these methods had to be identical.

Document (9) defined laetispicines as having a pharmacological action against depression and psychopathic disease (claims 15 and 16). These active agents were inherent to the extracts obtained in paragraph [0050]. These extracts were consequently suitable for the treatment of these diseases and

novelty-destroying for the subject-matter of claim 9 as granted.

XI. The respondents' arguments, insofar as they are relevant to the present decision, may be summarised as follows:

Claim 1 of the patent as granted defined, *inter alia*, a step of impregnation to obtain extracts. It was clear from this wording that the extraction method was based on this impregnation. Impregnation meaning the thorough soaking and permeation into the plant material for a time sufficient to lead to the extraction of the active ingredients. The skilled person would have understood from the wording of claim 1 that the extraction was not due to a non-claimed further method step. Document (9) described that the ground plant material was brought into contact with ethanol (paragraph [0050]). However, since document (9) disclosed neither that the material was first dried nor that grinding to a very small particle size was effected, the mere step of adding ethanol could not be considered to represent an impregnation. The extraction process of document (9) relied exclusively on a reflux method for the extraction. Heating in a circulating device would have been understood by the skilled person to refer to a reflux method. As the solvent was 95% ethanol, having a boiling point above 70°C, this necessarily meant that the temperature was raised to above 70°C. In a circulating device, the solvent went around in a circuit, contrary to a vortex device. Only by reading document (9) with hindsight, could its disclosure be construed to include a step of impregnation to obtain an extract. Consequently, the subject-matter of claim 1 was novel.

Claim 1 being novel, the subject-matter of claims 4 and 9 was novel as well.

XII. The final requests were as follows:

The appellant requested in writing that the decision under appeal be set aside and that the patent in suit be revoked.

The respondents requested that the appeal be dismissed, or alternatively, that the patent be maintained in amended form on the basis of one of the sets of claims of auxiliary requests 1 or 2, both filed on 23 April 2019.

Reasons for the Decision

1. The appeal is admissible.
2. The oral proceedings took place in the absence of the appellant, who had been duly summoned but who had chosen not to attend. According to Rule 115(2) EPC and Article 15(3) RPBA, the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence of a party at the oral proceedings. Accordingly, the board decided to continue the proceedings in the absence of the appellant and to treat the appellant as relying on its written case. Hence, the board was in a position to announce a decision at the conclusion of the oral proceedings, as foreseen by Article 15(6) RPBA.
3. In accordance with Article 12(2) RPBA, the statement of grounds of appeal (and the reply) shall contain a party's complete case. The appellant's statement of

grounds of appeal specified solely arguments concerning issues of novelty of granted claims 1, 4 and 9 in view of a single document, document (9).

With the communication pursuant to Article 15(1) RPBA, annexed to the summons to oral proceedings dated 21 September 2018, it was brought to the attention of the appellant that mere reference to the notice of opposition did not mean that the facts, arguments and evidence presented in this notice formed part of the appeal proceedings. The appellant did not comment or provide any further arguments.

The present decision is thus limited to an assessment of novelty of claims 1, 4 and 9 of the patent as granted in view of document (9) as set out in the appellant's statement of grounds for appeal.

4. *Novelty (Article 100(a) and Article 54 EPC)*

4.1 Claim 1 as granted defines the mandatory presence of two process steps, comminution ("cutting or powdering") and addition of organic solvent. This second step of the method defined in claim 1 of the patent as granted reads as follows "and then add organic solvents for impregnation". The term "impregnation" in the context of an extraction method has no meaning that goes beyond the general meaning of this term. The general meaning of the term "impregnation" can be paraphrased by the terms "thorough soaking and permeation".

4.2 In its statement setting out the grounds of appeal, the appellant cited document (9) as novelty-destroying and referred to the technical terms of maceration and digestion. However, document (9) does not disclose a method labelled "maceration" or "digestion" of Piper

laetispicum, contrary to the argument of the appellant. It merely discloses that Piper laetispicum C.DC was crushed and ground, that 95% industrial ethanol was added, and that heating was effected in a circulating device for 2 hours (paragraph [0050]).

It is clear from the wording of this passage in paragraph [0050] that a heating step takes place after the step of adding the ethanol. Document (9) does not disclose at which temperature the heating is stopped. In plant extraction processes, various methods are known. Maceration is usually carried out at room temperature. Consequently, it cannot be said that a method relying on a heating step, such as the method of document (9), constitutes maceration. Instead, the wording of paragraph [0050] of document (9) allows for the extraction methods of digestion (in its more specific form involving motion) and heating under reflux. Due to the solvent used, i.e. 95% ethanol, heating under reflux requires temperatures above 70°C. Digestion could be carried out at any temperature above room temperature. Since the disclosure of document (9) does not lend itself to an unambiguous conclusion on whether it relies on digestion or heating under reflux (or another method), it cannot be excluded that heating to temperatures above 70°C takes place. Such heating is thus encompassed by the disclosure of document (9). A broad disclosure of a method allowing for temperatures above 70°C cannot take away the novelty of a method with the specific restriction to temperatures $\leq 70^\circ\text{C}$.

It is irrelevant for the present decision whether the term "circulating device" points to a reflux method or maceration/digestion involving motion ("Bewegungsmazeration", "Wirbelextraktion"). All these methods are well established in the art in the context

of plant extraction processes and thus would have been well known to the skilled person who would have seriously contemplated the use of any of these methods. The situation is thus different from the situation underlying decision T 412/91.

The appellant has not provided any further arguments. In particular no arguments concerning the conditions under which impregnation takes place have been submitted.

Consequently, the appellant's arguments brought forward in appeal proceedings do not demonstrate that the subject-matter of claim 1 lacks novelty over document (9).

4.3 Claim 4 is worded as a so-called product-by-process claim. The patent in suit shows that the physiological effects of the extracts depend on the methods by which the extracts have been obtained (Cases of Implementation 7 to 12). Consequently, it cannot be assumed that the extracts obtained by different methods contain the same active ingredients in the same concentration. In the absence of any analysis of the extracts obtained by the process of document (9), there is no basis for assuming that the extracts of document (9) are novelty-destroying for the extracts of claim 4 of the patent as granted.

4.4 Claim 9 of the patent as granted is a purpose-limited product claim, the product being the extracts of claim 4. The limitation to a certain purpose in accordance with Article 54(5) EPC does not change the assessment made for the products as such. Consequently, the subject-matter of claim 9 of the patent in suit is

also novel over the disclosure of document (9).

4.5 Thus, the appellant's objections of lack of novelty under Article 100(a) and Article 54 EPC do not prejudice the maintenance of the patent as granted.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



T. Buschek

T. Sommerfeld

Decision electronically authenticated