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Datasheet for the interlocutory decision of 3 February 2022

Case Number: T 0419/16 - 3.3.04

Application Number: 05713577.4

Publication Number: 1725261

IPC: A61K39/395, A61K38/20, A61K38/17, A61P11/06, A61P19/02, A61P25/02, A61P31/00, A61P35/00, A61P37/00, C07K16/24, C07K16/28, C07K14/715

Language of the proceedings: EN

Title of invention:
Use of agonists and antagonists of interleukin-33 (IL-33)

Patent Proprietor:
Merck Sharp & Dohme Corp.

Opponents:
Regeneron Pharmaceuticals, Inc.
Strawman Limited
Gray, Tony
Takeda California, Inc.
Sanofi

Headword:
IL-33 antagonist antibodies/MSD

Relevant legal provisions:
EPC Art. 54, 83, 87(1), 123(2)

Keyword:
Amendments - main request - added subject-matter (yes) - auxiliary request 1 - added subject-matter (no)
Sufficiency of disclosure - auxiliary request 1 (yes)
Priority - auxiliary request 1 - same invention (yes)
Stay of proceedings (yes) - questions on entitlement to priority pending before the Enlarged Board

Decisions cited:
G 0005/83, G 0002/10, T 0128/82, T 0036/83, T 0426/00, T 1513/17, T 2719/19

Catchword:
-

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Case Number: T 0419/16 - 3.3.04

I N T E R L O C U T O R Y D E C I S I O N
of Technical Board of Appeal 3.3.04
of 3 February 2022

Appellant: (Opponent 1)	REGENERON PHARMACEUTICALS, INC. 777 Old Saw Mill River Road Tarrytown, NY 10591-6707 (US)
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Appellant: (Opponent 2)	STRAWMAN LIMITED Orchard Lea Horns Lane Combe Witney, Oxfordshire OX29 8NH (GB)
Representative:	Mewburn Ellis LLP City Tower 40 Basinghall Street London EC2V 5DE (GB)
Appellant: (Opponent 4)	Takeda California, Inc. 10410 Science Center Drive San Diego, CA 92121 (US)
Representative:	Huenges, Martin Maiwald Patentanwalts- und Rechtsanwaltsgesellschaft mbH Elisenhof Elisenstraße 3 80335 München (DE)
Appellant: (Opponent 5)	SANOFI 174, Avenue de France 75013 Paris (FR)

Representative:	Zwicker, Jörk ZSP Patentanwälte PartG mbB Hansastraße 32 80686 München (DE)
Respondent: (Patent Proprietor)	Merck Sharp & Dohme Corp. 126 East Lincoln Avenue Rahway, NJ 07065-0907 (US)
Representative:	Horgan, James Michael Frederic Merck & Co., Inc. European Patent Department Hertford Road Hoddesdon EN11 9BU (GB)
Party as of right: (Opponent 3)	Gray, Tony 81 Middlemead Hook Hampshire RG27 9TE (GB)
Representative:	Avidity IP Broers Building Hauser Forum 21 JJ Thomson Avenue Cambridge CB3 0FA (GB)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 5 January 2016 concerning maintenance of the European Patent No. 1725261 in amended form**

Composition of the Board:

Chairman	B. Claes
Members:	A. Chakravarty
	L. Bühler
	O. Lechner
	M. Blasi

Summary of Facts and Submissions

I. European patent No. 1 725 261, entitled "*Use of agonists and antagonists of interleukin-33 (IL-33)*" was opposed by five opponents based on the grounds for opposition in Article 100(a) EPC in conjunction with Articles 54 and 56 EPC and under Article 100(b) and (c) EPC. The patent was granted in respect of application EP 05 713 577.4, which had been filed as an international application, published as WO 2005/079844 (the application as filed).

II. Opponents 1, 2, 4 and 5 filed appeals against the interlocutory decision of the opposition division that, account being taken of the amendments in the form of auxiliary request 2, the patent and the invention to which it related met the requirements of the EPC. The patent proprietor is the respondent to the appeals and opponent 3 is a party as of right to the proceedings.

III. By communication of 25 May 2016, receipt of which was acknowledged, the registry of the board informed appellant-opponent 2 that it appeared from the file that the statement of grounds of appeal had not been filed, and that it was therefore to be expected that the appeal would be rejected as inadmissible, pursuant to Article 108, third sentence, EPC in conjunction with Rule 101(1) EPC.

IV. With letter of 26 May 2017 opponent 2 requested reimbursement of the appeal fee for the reason that a statement setting out the grounds of appeal had not been filed. The board informed opponent 2 by communication dated 1 June 2017 of its preliminary opinion on the request and received no further

submission from that party on the issue of admissibility of the appeal or reimbursement of the appeal fee.

V. In view of the board's decision that the appeal of opponent 2 is inadmissible (see point 2. of the Reasons, below), that party remains party as of right. Opponents 1, 4 and 5 are the appellants and are referred to in this decision as appellant-opponent 1, 4 and 5, respectively or collectively as appellants.

VI. The claims of auxiliary request 2, held allowable by the opposition division, read:

"1. An antagonist of IL-33 for use as a medicament, wherein the antagonist comprises a binding composition from an antibody that specifically binds to IL-33.

2. The antagonist of Claim 1, wherein the binding composition from the antibody comprises:
a) a monoclonal antibody;
b) a humanized antibody; or
c) an Fab, Fv, or $F(ab')_2$ fragment.

3. The antagonist of Claim 1 or 2 for use in the treatment of a disorder or condition selected from the group consisting of:
a) asthma;
b) allergy; or
c) multiple sclerosis.

4. Use of an antagonist of IL-33 in the preparation of a medicament for the treatment of a disorder or condition selected from the group consisting of:
a) asthma;
b) allergy; or

c) multiple sclerosis,
wherein the antagonist comprises a binding composition from an antibody that specifically binds to IL-33.

5. Use according to Claim 4, wherein the binding composition from an antibody comprises:
a) a monoclonal antibody;
b) a humanized antibody; or
c) an Fab, Fv, or $F(ab')_2$ fragment".

VII. The patent proprietor (respondent) replied to the appeals and maintained the set of claims of auxiliary request 2, held allowable by the opposition division, as the main claim request. They also filed sets of claims of auxiliary requests 1 and 2. The set of claims of auxiliary request 1 corresponds to the main request with claims 3 to 5 deleted.

VIII. The following document is referred to in this decision.

D1: WO 2004/056868

IX. Oral proceedings were held by videoconference. Only the respondent attended these proceedings, all other parties having informed the board in writing that they would not attend. At the end of the oral proceedings, the Chair announced the decision of the board.

X. The arguments of the appellants are summarised as follows.

Main request - Amendments (Article 123(2) EPC)
Claim 1

The application as filed did not disclose the subject-matter of a first medical use claim since it lacked a

disclosure of a broad generic medical application but only contained a general statement that "immune disorders or conditions" were amenable to treatment with the described therapeutic agents.

In decision G 2/08, the Enlarged Board of Appeal (EBA) addressed the question of whether Article 54(5) EPC prevented a known medicament from being patented for use in a different treatment by therapy of the same illness. It did not hold that first medical use claims did not have to comply with the other provisions of the EPC, including those of Article 123(2) EPC. The case law of boards of appeal, for instance decisions T 128/82 and T 36/83, supported the view that under Article 123(2) EPC a first medical use claim needed a disclosure in the application as filed of broad pharmaceutical activity to serve as a basis. In the case at hand, the application as filed did not contain a direct and unambiguous disclosure of the claimed antibody for a broad pharmaceutical activity.

In the absence of a literal basis for a first medical use claim in the application as filed, adding claims in this claim category resulted in added subject-matter, even if it might have been possible to draft such a claim at the time of filing.

Claims 3 to 5

The application as filed disclosed that either an agonist or antagonist of IL-33 or an agonist or antagonist of IL-33R may be used for treatment of asthma or allergy (claim 2b as filed, as dependent on claim 1). The specific selection of an IL-33 antagonist (as opposed to an IL-33 agonist, or an IL-33R agonist or antagonist) for the specified treatments and the

further selection of a binding composition from an IL-33 antibody as the antagonist was not disclosed in the application as filed.

Paragraph [0096] related to antibodies neutralising IL-33 but this neutralising property was not specified in the claims. Furthermore, because antibodies neutralising IL-33 could exert their effect either by targeting IL-33 or IL-33R (see paragraph [0096]), a disclosure of the use of IL-33 neutralising antibodies was not equivalent to the disclosure of the use of an antibody which specifically binds to IL-33.

Paragraph [0096] described a use in airway inflammation and in particular mouse models and did not directly and unambiguously disclose a medical use in any/all allergy or asthma indications.

Auxiliary request 1 - claim 1 and 2

Priority (Article 87(1) and 89 EPC)

The effective date of the claimed subject-matter was the filing date.

Same invention

The application from which priority was claimed (the previous application) did not disclose the invention of claim 1. As was the case with the application as filed and as had been explained in relation to added subject-matter (Article 123(2) EPC), the previous application only disclosed treatment of specific conditions, i.e. immune disorders, or even more specific indications. It did not disclose a first medical use, which was therefore subject-matter not entitled to the priority.

In the present case, the previous application explicitly disclosed that blocking the anti-IL-33R would exacerbate arthritis. In the decision under appeal, granted claim 4(b) - in which the medical use was specified as the treatment of rheumatoid arthritis - was held as not entitled to priority because of a lack of sufficiency of disclosure in the previous application for this specified medical use. This lack of sufficiency of disclosure applied equally to claims 1 and 2 because they included the invention that was not sufficiently disclosed in the previous application.

In view of this, a first medical use was not the same invention as disclosed in the previous application.

Entitlement to the priority right

Appellant-opponent 5 also argued that there had been no valid transfer of the right to claim priority from US 60/545730, prior to the filing of the international application PCT/US2005/004743 (see section I)). However, these arguments need not be reproduced here since the board did not decide on this issue.

Novelty (Article 54 EPC)

Document D1 generally related to therapeutic uses of certain polypeptides. Document D1 disclosed antagonist antibodies for carrying out those therapies. In detail, document D1 disclosed an inhibition of NF-HEV (another name for IL-33) by providing therapeutic compositions comprising anti-NF-HEV-antibodies in (e.g. paragraphs [0226} to 0233] and [0431] to [0435]). Paragraph [0333] disclosed pharmaceutical compositions comprising anti-NF-HEV antibodies. Document Dl further disclosed the

use of these compositions for the treatment of inflammatory disorders such as rheumatoid arthritis and Crohn's disease (e.g. paragraphs [0321], [0322]). Thus, the disclosure in document D1 anticipated the subject-matter of claims 1 and 2.

XI. The arguments of the respondent are summarised as follows.

Main request - Amendments (Article 123(2) EPC)
Claim 1

Article 54(4) EPC permitted a claim to the first medical use of a compound or composition when no medical use was known in the art. This applied to the claimed IL-33 antagonists which had not previously been disclosed as having any therapeutic utility. The application as filed disclosed the medical utility of agonists and antagonists of IL-33 and this was a basis for a first medical use claim even if the literal wording of such a claim was absent from the application as filed.

Moreover, paragraph [0027] of the application as filed disclosed an effective amount of an "*antagonist of the IL-33 of the present invention*" in "*an amount sufficient to ameliorate a symptom or sign of a disorder or physiological condition*". This statement was equivalent to a first medical use. There was a similar disclosure at paragraph [0030].

Claims 3 to 5

Claims 3 to 5 had a direct and unambiguous basis in the application as filed. The subject-matter of claims 3 and 4 was based on claims 1, 2 and 10, and paragraphs

[0009] and [0010] of the application as filed. Further basis could be found throughout the application as filed, in particular in paragraph [0099]. This stated that the invention provided agonists and antagonists of IL-33 for the modulation of inflammatory and autoimmune disorders such as asthma and allergies. Thus, paragraph [0099] in combination with paragraph [00l0] provided a basis for an antagonist of IL-33 comprising a binding composition from an antibody that specifically binds to IL-33 for use in treating asthma or allergy.

The disclosure of paragraph [0096] also provided support for the requirement of an antagonist of IL-33 for treating allergy and asthma, since it disclosed "*allergen-induced airway-hyper-reactivity in mouse models of asthma*".

The phrase "antibodies neutralizing IL-33" in that same paragraph could only refer to antagonistic antibodies since agonistic antibodies would not neutralise IL-33. Furthermore the application as filed made a clear distinction between antibodies that bind to IL-33R and antibodies that bind to IL-33 (see e.g. paragraphs [0051] and [0054] and the description of the drawings on page 6). In view of this, a skilled person would have understood that the statement "antibodies neutralizing IL-33" in paragraph [0096] referred to antibodies that bind to IL-33 and not IL-33R. Paragraph [0099] was a basis for limiting to IL-33 rather than IL-33R.

Auxiliary request 1 - claim 1 and 2

Priority (Article 87(1) and 89 EPC)

Same invention

The invention lay in the identification of the previously unknown endogenous ligand for a known receptor (IL-33R or T1/ST2). It was known at the priority date of the claimed invention that disease conditions were associated with this receptor. Since the previous application disclosed the identification of the endogenous ligand and proposed the use of antibody antagonists to it, uses to treat the disease conditions already linked to the (known) receptor were both plausible and sufficiently disclosed in the previous application. Moreover, the previous application disclosed the use of antagonists of IL-100 (another name for IL-33) for treating asthma, allergies and multiple sclerosis (see page 4, second paragraph). The claimed invention was thus the same one as disclosed in the previous application.

Entitlement to the priority right

The respondent also provided arguments to the effect that there had been a valid transfer of priority. However, as is the case with the corresponding arguments of appellant-opponent 5, these arguments are not relevant to the board's current decision and are therefore not reproduced here.

Novelty (Article 54 EPC)

Document D1 formed part of the state of the art under Article 54(2) EPC for subject-matter with no valid priority. However, the subject-matter of claims 1 and 2 was entitled to priority and in any case, document D1 did not disclose the use of an IL-33 antagonist

antibody in the treatment of allergy, asthma or multiple sclerosis.

XII. Neither of the parties as of right (opponents 2 and 3) made any submissions on the merits of the appeals.

XIII. The requests of the parties were as follows.

Appellant-opponents 1, 4 and 5 requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

Appellant-opponent 4 also requested that the documents designated D83 and D84 be admitted into the proceedings.

Appellant-opponent 5 further requested that documents D83 and D84 filed on 7 January 2015 not be admitted into the proceedings, and that documents D88 to D92 filed on 6 September 2017 be admitted into the proceedings.

Opponent 2 (party as of right) requested that the decision under appeal be set aside and that the patent be revoked in its entirety.

Opponent 3 did not file any requests in the appeal proceedings.

The respondent requested that the appeals be dismissed (main request), or, alternatively, that the patent be maintained based on the set of claims of auxiliary requests 1 or 2, both filed with the reply to the statements of grounds of appeal. The respondent further requested that the board decide that the EPO has no jurisdiction to decide on priority ownership. They also

requested not to admit the documents denominated D88 to D92, filed on 6 September 2017, into the appeal proceedings.

Reasons for the Decision

1. The appeals of appellant-opponents 1, 4 and 5 comply with Articles 106 to 108 and Rule 99 EPC and are admissible.

Admissibility of the appeal of opponent 2 and reimbursement of the appeal fee

2. Opponent 2's notice of appeal contains nothing that can be regarded as a statement of grounds of appeal pursuant to Article 108 EPC and Rule 99(2) EPC.

3. As no statement setting out the grounds of appeal has been filed, opponent 2's appeal is to be rejected as inadmissible pursuant to Article 108 EPC, third sentence, in conjunction with Rule 101(1) EPC. Opponent 2 is nevertheless a party as of right in the appeal proceedings (Article 107 EPC).

4. Opponent 2's request for reimbursement of the appeal fee is to be rejected.

5. A reimbursement in full can only be ordered if the requirements of Rule 103(1) EPC are fulfilled. In the present case, opponent 2's appeal is neither allowable - as this presupposes the admissibility of the appeal - (Rule 103(1)(a) EPC) and was not withdrawn before expiry of the period for filing the statement of grounds of appeal (Rule 103(1)(b) EPC).

6. A reimbursement of the appeal fee at 50% cannot be ordered either because this would have required a withdrawal of the appeal before expiry of the two-month time-limit set by the communication dated 25 May 2016 (Rule 103(3)(b) EPC). Neither of these requirements have been met in the present case. There is therefore no legal basis for the reimbursement of the appeal fee.

Main request

Amendments (Article 123(2) EPC)

Claims 1 and 2

7. The appellants argued that the subject-matter of claim 1 (see section V) had no basis in the application as filed. In their view, the application as filed disclosed the claimed antagonist of IL-33 only for a specific medical use, but not for a first medical use.

8. The board recalls that Article 54(4) EPC provides for claims directed to a first medical use of a *per se* already known substance or composition and that such a claim confers broad (albeit purpose-limited) protection for substances or compositions, covering any use in a medical method, even if only one specific use is disclosed in the application (see Case Law of the Boards of Appeal of the European Patent Office, 2019, I.C.7.1.1 and decision T 128/82, OJ EPO 1984, 164). It is the board's view that it follows from this case law that the disclosure in an application of a substance or composition for a specific medical use is a basis for a claim directed to a first medical use.

9. Contrary to the appellants' submissions, the findings in decisions T 36/83 (OJ EPO 1986, 295) and T 128/82 do

not support the view that a basis for a first medical use claim (in the sense of Article 123(2) EPC) can only be an identical or equivalent broad disclosure in the application as filed. In both decisions, it was held that a broad disclosure of a pharmacologically active substance for use as a medicament provided a basis for a corresponding broad (first medical use) claim. These decisions however did not consider other possible bases for such a claim nor rule out that the disclosure of a specific medical use can constitute a basis for a claim to a first medical use.

10. Claim 1 therefore meets the requirements of Article 123(2) EPC.

11. No separate objection was submitted to claim 2 (see section V).

Claims 3 to 5

12. The subject-matter of claims 3 to 5 (see section V) includes the use of an IL-33 antagonist antibody for treating allergy and asthma. The respondent referred to claims 1, 2 and 10, as well as paragraphs [0009], [0010], [0096] and [0099] of the application as filed as a basis for this subject-matter.

13. The board does not agree. It is established case law that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the description, claims and drawings of the application as filed (see decision G 2/10, OJ EPO 2012, 376, Reasons 4.2). It is further established case law that the content of an application must not be considered to

be a reservoir from which features pertaining to separate embodiments of the application could be combined in order to artificially create a particular embodiment (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition, 2019, II.E.1.6.1). This concept applies when considering features originally disclosed in separate lists of alternatives, except when there is a pointer to a particular combination (*ibid*).

14. Claims 1, 2 and 10 of the application as filed read:

"1. A method of modulating an immune disorder or condition, comprising administering an effective amount of an agonist or antagonist of IL-33 of [sic] IL-33 Receptor complex (IL-33R).

2. The method of Claim 1, wherein the disorder or condition comprises: a) innate response; b) asthma or allergy; c) multiple sclerosis; d) an inflammatory bowel disorder; e) arthritis; f) infection; g) a cancer or tumor.

10. The method of Claim [sic] 1, wherein the antagonist comprises a binding composition from an antibody that specifically binds: a) IL-33; b) an IL-33R complex; or c) a complex of IL-33 and IL-33R".

15. Claim 1 of the application as filed thus relates to functionally defined agonists and antagonists of both IL-33 and IL-33R for use in modulating an immune disorder, while claim 2 provides a list of disorders to be treated. From these two claims, the subject-matter of claim 3 can only be derived by making selections from the list of disorders, from the list of targets (IL-33 or IL-33R), from the type of activity (agonist

or antagonist) and from all possible chemical entities that could carry out this function. There is no pointer to or preference for the claimed selection. Thus, claims 1 and 2 of the application as filed do not provide a basis for the claimed subject-matter.

16. Claim 10 of the application as filed limits the chemical entity used to "a binding composition from an antibody" and provides a list of three targets. The claimed subject-matter can only be derived from claims 1, 2 and 10 of the application as filed by making a selection from the list of diseases in claim 2 and combining it with a selection from the list of targets in claim 10. In the absence of a relevant pointer, this selection cannot be regarded as directly and unambiguously derivable from the application as filed.

17. As is the case with claims 1, 2 and 10, the claimed subject-matter is only disclosed in paragraphs [0009] and [0010] of the application as filed via a selection of at least the same lists referred to in points 15. and for which the application does not disclose a preference.

18. Paragraphs [0096] and [0099] of the application as filed do not directly and unambiguously disclose the claimed subject-matter either. Firstly, in paragraph [0096], the therapeutic activity is presented as a mere possibility - "*may be beneficial*". Secondly, the target of the therapeutic antibodies is not disclosed as being IL-33, since "*neutralizing IL-33*" refers to antibodies capable of abrogating the biological function of IL-33, but does not define a therapeutic target. Furthermore, paragraph [0096] cannot provide a basis for the treatment of allergies in general, since it only

discloses treatment of "*allergen-induced airway-hyper-reactivity in mouse models of asthma*".

19. Paragraph [0099] discloses "*The present invention provides agonists and antagonists of IL-33 for the modulation of inflammatory and autoimmune disorders and conditions, e.g., psoriasis, asthma, allergies, and inflammatory bowel disease, e.g., gastric inflammation, ulcerative colitis, Crohn's disease, celiac disease, and irritable bowel syndrome*". This disclosure either on its own or in combination with paragraph [0010] does not provide a basis for the claimed subject-matter because, as with the other passages cited, it is necessary to make a selection to which there is no pointer, to arrive at the claimed subject-matter. A selection of antagonists has to be made from a disclosure of agonists and antagonists, of antibodies from all possible chemical agents, of IL-33 as the target of the antibodies and finally of allergy and asthma from the list of diseases provided.

20. In view of the above considerations, the subject-matter of claims 3 to 5 of the main request extends beyond the content of the application as filed, contrary to Article 123(2) EPC and the main request is not allowable.

Auxiliary request 1

Amendments (Article 123(2) EPC)

21. This claim request consists only of claims 1 and 2 of the main request which have been found to meet the requirements of Article 123(2) EPC, see points 7. to 11. above.

Disclosure of the invention (Article 83 EPC)

22. The appellants have not submitted arguments to the effect that the patent did not sufficiently disclose the claimed invention. The board therefore sees no reason to overturn the decision of the opposition division in this respect.

Novelty (Article 54 EPC)

23. Document D1, published after the priority date but before the filing date of the patent, relates to a polypeptide named NF-HEV. It is common ground that this polypeptide is IL-33. In the absence of a valid priority, the disclosure in document D1 anticipates the subject-matter of claim 1.

Priority (Article 87(1) and 89 EPC)

24. Since document D1 is relevant to novelty, it is necessary to decide on whether or not the claimed subject-matter can validly claim priority from US provisional patent application 60/545,730.

25. The appellants pursued several lines of argument to demonstrate that the claimed invention differed from that disclosed in the priority application.

Same invention

26. The first was that in view of the opposition division's finding that subject-matter relating to an anti-IL-33 antibody for use in treating arthritis (claim 4(d) as granted) had no basis in the priority application since this rather disclosed that anti-IL-33 receptor antibodies exacerbated arthritis. Thus, the subject-

matter of independent claim 1 must also lack a basis in the previous application, at least partially.

27. This objection fails because they are based on a misunderstanding of the first medical use claim format established by Article 54(4) EPC. As set out in decision T 128/82, Article 54(5) EPC 1973 (now Article 54(4) EPC) provides a special concept of novelty for any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52(4) EPC 1973 (now Article 53(c) EPC), provided that its use for any method referred to in that paragraph is not comprised in the state of the art (see decision T 128/82, Reasons 9; confirmed by decision G 5/83, OJ EPO 1985, 65, Reasons 21). The decision further clarifies that "[*i*]*f an inventor is granted absolute protection in respect of a new chemical compound for use in therapy, the principle of equal treatment would require that an inventor who for the first time makes a known compound available for therapy should be correspondingly rewarded ... with a purpose-limited substance claim under Article 54(5) EPC* [1973 (now Article 54(4) EPC)] *to cover the whole field of therapy*" (*Id.*, Reasons 10).

28. A logical consequence of the availability of purpose-limited substance protection for a first medical use is that the disclosure of a single therapeutic use of a compound is both sufficient to meet the requirements of Article 83 EPC and to serve as a basis for such a claim in the sense of Articles 87(1) EPC and Article 123(2) EPC, respectively.

29. In view of the above considerations, claims 1 and 2 relate to the same invention as disclosed in the previous application in the sense of Article 87(1) EPC.

Entitlement to the priority right

30. A further line of argument of the appellants was that no valid transfer of the right to claim priority from US provisional patent application 60/545,730 had taken place prior to the filing of PCT application WO 2005/079844.

Stay of proceedings

31. According to the established case law of the boards of appeal, proceedings before a board may be stayed in a case where the decision is dependent on the answer to questions that have been referred to the Enlarged Board of Appeal (see for instance, decision T 426/00 of 27 June 2003, Reasons 4).

32. By recent consolidated decisions T 1513/17 and T 2719/19, the issue of entitlement to priority was referred to the Enlarged Board of Appeal. The cases are pending before the Enlarged Board as G 1/22 and G 2/22. The questions referred to the Enlarged Board in those cases also need to be answered in the present case before a decision on novelty and inventive step can be taken. The questions include whether the EPC confers jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1) EPC and whether a so-called "PCT joint applicants approach" might be valid. The questions referred to the Enlarged Board therefore cover the scenario in the present case and it is not necessary for the board to refer additional questions to the Enlarged Board. In view of this, the board decided to stay the proceedings until a decision is issued by the Enlarged Board in cases G 1/22 and G 2/22.

Order

For these reasons it is decided that:

1. Opponent 2's appeal is rejected as inadmissible and the request for reimbursement of the appeal fee is rejected.

2. The appeal proceedings are stayed until a decision is issued by the Enlarged Board of Appeal in cases G 1/22 and G 2/22. They will be continued in writing thereafter.

The Registrar: The Chair:

A. Chavinier Tomsic B. Claes

Decision electronically authenticated