Internal distribution code:

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

Datasheet for the decision of 28 September 2021

Case Number: T 0001/18 - 3.3.02

Application Number: 12703670.5

Publication Number: 2670401

IPC: C07D401/14, C07D401/12, A61K31/00, A61K31/506, A61P35/00

Language of the proceedings: EN

Title of invention:
METHODS OF USING ALK INHIBITORS

Patent Proprietor:
Novartis AG

Opponents:
Teva Pharmaceutical Industries Ltd
Generics [UK] Limited
I P S Intellectual Property Services

Headword:
EML4-ALK INHIBITORS FOR TREATING NSCLC / NOVARTIS

Relevant legal provisions:
EPC Art. 56, 104(1)

Keyword:
Inventive step - (yes)
Different apportionment of costs - (no)

Decisions cited:
T 0013/19

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

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 0001/18 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 28 September 2021

Appellant 1: (Opponent 1)	Teva Pharmaceutical Industries Ltd 5 Basel Street P.O. Box 3190 49131 Petah Tiqva (IL)
Representative:	D Young & Co LLP 120 Holborn London EC1N 2DY (GB)
Appellant 2: (Opponent 2)	Generics [UK] Limited Albany Gate Darkes Lane Potters Bar Hertfordshire EN6 1AG (GB)
Representative:	Elkington and Fife LLP Prospect House 8 Pembroke Road Sevenoaks, Kent TN13 1XR (GB)
Appellant 3: (Opponent 3)	I P S Intellectual Property Services 11 Rue La Fayette 75009 Paris (FR)
Representative:	Casalonga Casalonga & Partners Bayerstraße 71/73 80335 München (DE)
Respondent: (Patent Proprietor)	Novartis AG Lichtstrasse 35 4056 Basel (CH)
Representative:	Aera A/S Niels Hemmingsens Gade 10, 5th Floor 1153 Copenhagen (DK)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 23 October 2017 rejecting the oppositions filed against European patent No. 2670401 pursuant to Article 101(2) EPC.**

Composition of the Board:

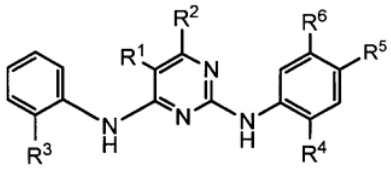
Chairman M. O. Müller
Members: M. Maremonti
M. Blasi

Summary of Facts and Submissions

I. The appeals by opponents 1 to 3 ("appellants 1 to 3") lie from the decision of the opposition division to reject the oppositions against European patent No. 2 670 401 ("the patent").

II. The patent contains 9 claims, independent claims 1 and 9 of which read as follows:

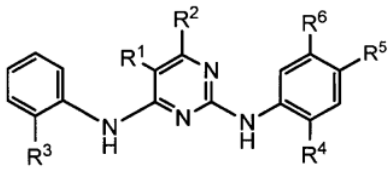
"*1. A compound of Formula (I)*



(I)

or a pharmaceutically acceptable salt thereof;
wherein [...];
for use in a method of treating an EML4-ALK$^+$ non-small cell lung cancer, and optionally resistant to crizotinib."

"*9. The use of a compound of Formula (I)*



(I)

or a pharmaceutically acceptable salt thereof;
wherein [...];
for the manufacture of a medicament for the treatment of EML4-ALK$^+$ non-small cell lung cancer, and optionally resistant to crizotinib."

Dependent claims 2 to 8 define specific embodiments of the subject-matter of claim 1.

III. The following documents were among those cited during the opposition proceedings:

D1: WO 2008/073687 A2

D2: Li et al., *Evaluation of EML4-ALK Fusion Proteins in Non-Small Cell Lung Cancer Using Small Molecule Inhibitors*, Neoplasia, 13(1), 2011, pages 1 to 11.

D3: Soda et al., *Identification of the transforming EML4-ALK fusion gene in non-small-cell lung cancer*, Nature, 448, 2007, pages 561 to 567.

D4: Kwak et al., *Anaplastic Lymphoma Kinase Inhibition in Non-Small-Cell Lung Cancer*, The New England J. of Medicine, 363(18), 2010, pages 1693 to 1703.

D7: Soda et al., *A mouse model for EML4-ALK- positive lung cancer*, PNAS, 105(50), 2008, pages 19893 to 19897.

D9: Sasaki et al., *The Neuroblastoma-Associated F1174L ALK Mutation causes Resistance to an ALK Kinase Inhibitor in ALK-Translocated cancers*, Cancer Res., 70(24), 2010, pages 10038 to 10043.

D10: Marsilje et al., J. of Medicinal Chemistry, 56, 2013, pages 5675 to 5690.

D14: Shaw et al., *Clinical Features and Outcome of patients with Non-Small-Cell Lung Cancer who harbor EML4-ALK,* J. of Clinical Oncology, 27(26), 2009, pages 4247 to 4253.

D15: Sasaki et al., *The biology and treatment of EML4-ALK Non-Small-Cell Lung Cancer*, European J. Cancer, 46, 2010, pages 1773 to 1780.

The opposition division came *inter alia* to the conclusion that the subject-matter of the claims as granted involved an inventive step in view of either D1 or D2 taken as the closest prior art.

IV. In their statements of grounds of appeal, the appellants maintained that the claimed subject-matter lacked an inventive step in view of either D1 or D2 taken as the closest prior art.

Appellant 2 corroborated its arguments by filing the following new item of evidence:

D29: Annex III - Activity Data filed by the respondent with the EPO on 9 June 2011 during the examination proceedings relating to document D1.

V. In its reply to the statements of grounds of appeal, the patentee ("respondent") rebutted the arguments of the appellants and argued, *inter alia*, that the claimed subject-matter involved an inventive step in view of either D1 or D2 taken as the closest prior art.

VI. The parties were summoned to oral proceedings in accordance with their requests.

VII. In preparation for the oral proceedings, the board issued a communication pursuant to Article 15(1) RPBA 2020.

VIII. In a subsequent letter, the respondent replied to the board's communication and submitted further arguments in favour of the inventive step of the claimed subject-matter.

IX. In a further communication the board informed the parties that, in view of the coronavirus pandemic, the oral proceedings would be held by videoconference.

X. By letters dated 6 September 2021, 24 August 2021 and 27 September 2021, respectively, appellants 1, 2 and 3 informed the board that they would not be attending the oral proceedings.

XI. Oral proceedings before the board were held on 28 September 2021 by videoconference in the absence of appellants 1 to 3.

XII. Final requests

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

The respondent requested that the appeals be dismissed (main request), implying maintenance of the patent as granted. Alternatively, it requested that the patent be maintained in amended form on the basis of the claims of one of auxiliary requests 1 to 8 as filed by letter dated 29 August 2016.

The respondent further requested a different apportionment of costs, i.e. that its preparation costs for the oral proceedings be borne by appellant 3.

XIII. The appellants' arguments, insofar as they are relevant to the present decision, are summarised as follows:

- Each of documents D1 and D2 might equally represent the closest prior art for the claimed subject-matter.
- D1 disclosed compounds falling under Formula (I) of claim 1 as granted, especially compound 66, as ALK and NPM-ALK inhibitors, to be used for treating various forms of cancer, in particular lung cancer.
- Starting from D1, the objective technical problem was to provide a further use of compound 66.

- It was known from all documents D2, D3, D4, D7, D14 and D15 that ALK inhibitors were used for treating EML4-ALK positive NSCLC. On the basis of this overwhelming teaching, the skilled person would have expected compound 66 of D1 to also show inhibition of EML4-ALK in EML4-ALK positive NSCLC. The claimed use was thus not inventive when starting from D1.

- Document D2 disclosed the use of an ALK inhibitor, compound TAE684, for treating EML4-ALK positive NSCLC.

- Starting from D2, the objective technical problem was to provide alternative inhibitors of EML4-ALK for the treatment of NSCLC.

- It was common general knowledge that ALK inhibitors were used for treating EML4-ALK positive NSCLC. D1 disclosed compound 66, falling under claim 1 at issue, as an ALK and NPM-ALK inhibitor. Compound 66 was structurally very similar to TAE684. Thus, the skilled person would have had a reasonable expectation of success when replacing TAE684 of D2 with compound 66 of D1. Therefore, the claimed use was not inventive when starting from D2 either.

XIV. The respondent's arguments, insofar as they are relevant to the present decision, are summarised as follows:

- Starting from compound 66 of D1 as the closest prior art, the objective technical problem was to provide a further use.

- No activity of compound 66 had been tested in D1. D1 only disclosed a very long list of compounds, without specifying which compound of this list was active against which target. The skilled person

would not have inferred from the disclosure in D1 that compound 66 had inhibitory activity against ALK or NPM-ALK.

- Therefore, the fact that other documents disclosed ALK inhibitors for treating EML4-ALK positive NSCLC would not have prompted the skilled person to use compound 66 of D1 for this purpose. Structural similarity was no guarantee of similar activity. Therefore, it had to be concluded that claim 1 involved an inventive step when starting from D1.

- Even if, starting from D2, the objective technical problem was the provision of alternative compounds for treating EML4-ALK positive NSCLC, the subject-matter of claim 1 would still be inventive.

- D2 compared the specific and selective EML4-ALK inhibitor TAE684 with the non-specific ALK inhibitor crizotinib and concluded that TAE684 was much more potent. In view of this disclosure, the skilled person would not have expected that other non-specific ALK inhibitors could replace TAE684, let alone compound 66 of D1. In particular, structural similarity was no guarantee of similar activity.

- Therefore, it had to be concluded that claim 1 involved an inventive step also when starting from D2.

Apportionment of costs

- Appellant 3's announcement of non-attendance at the oral proceedings only the evening before the hearing had generated additional costs for the respondent, since the oral proceedings could have been cancelled if this announcement had been made earlier.

- This behaviour justified a different apportionment of costs.

Reasons for the Decision

Appellants' non-attendance at the oral proceedings

Appellants 1 to 3 were duly summoned but did not attend the oral proceedings. In accordance with Rule 115(2) EPC and Article 15(3) RPBA 2020, the board decided to continue the proceedings in the appellants' absence and the appellants were treated as relying on their written case. Hence, the board was in a position to announce a decision at the conclusion of the oral proceedings in accordance with Article 15(6) RPBA 2020.

Main request - the patent as granted - claim 1

Ground for opposition under Article 100(a) EPC - inventive step under Article 56 EPC

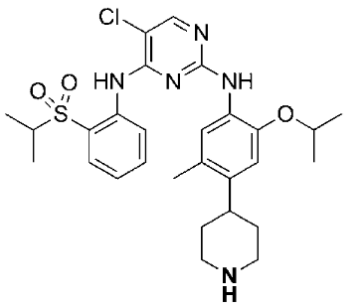
1. The invention as defined in claim 1 as granted (point II above) concerns the compounds of Formula (I) for use in treating non-small cell lung cancer (NSCLC) being positive, i.e. harbouring the fusion gene EML4-ALK, i.e. the gene resulting from the fusion of echinoderm microtubule-associated protein-like 4 (EML4) gene and anaplastic lymphoma kinase (ALK) gene. Exemplary compounds falling under the claimed Formula (I) are shown as compounds 1 to 6 on pages 3 and 4 of the patent.

The appellants submitted that both documents D1 and D2 might each represent the closest prior art for the claimed subject-matter.

2. Document D1

2.1 D1 discloses (paragraphs [0018] and [0019]) compounds of formulae (1), (2), (3A), (3B), (4A), (4B) and (5) (see pages 2 to 8) said to potentially inhibit kinases such as anaplastic lymphoma kinase (ALK), focal adhesion kinase (FAK) and Zeta-chain-associated protein kinase (ZAP-70) as well as insulin-like growth factor (IGF-1), found to be implicated in cancer diseases, including lung tumours. Additionally, D1 discloses (paragraphs [0040] to [0042]) that compounds of said formulae may inhibit the tyrosine kinase activity of the fusion protein of ALK and nucleophosmin (NPM-ALK), whereby NPM-ALK had been identified in neoplastic diseases.

In table 1 (page 60 to page 129), D1 discloses exemplary compounds 1 to 246 according to the disclosed formulae. Among these, compounds 66, 131 and 181 correspond to compounds 1, 5 and 6 as defined in the patent (table on page 3, claim 5). In particular, compound 66 has been indicated by the appellants as the closest prior art. Its structure is shown below:



The respondent did not agree that D1 and especially compound 66 disclosed therein could represent the closest prior art. In light of the considerations set out below, there was no need for the board to consider this issue further. Therefore, in the appellants' favour, the board assumes in the following that compound 66 can indeed be taken as the starting point

for the assessment of inventive step of the claimed subject-matter.

The distinguishing feature

2.2 Compound 66 falls under Formula (I) of claim 1 (compound 1 in the table on page 3 of the patent). Given the disclosure of D1 as set out above, the subject-matter of claim 1 as granted differs from the disclosure of D1 in that compound 66 is used for treating EML4-ALK positive NSCLC.

The objective technical problem

2.3 In view of the above-identified distinguishing feature, the objective technical problem, as submitted by the appellants, lies in the provision of a further therapeutic use of compound 66 of D1.

Obviousness of the claimed solution

2.4 The appellants argued that D1 taught that compounds falling under claim 1 as granted, especially compound 66, were active as ALK and NPM-ALK inhibitors for treating, *inter alia*, lung tumours. The appellants further regarded document D3 as a seminal paper, forming part of common general knowledge. D3 explained on page 562, right-hand column, that EML4-ALK was an oncogene with transforming activity dependent on its kinase activity. According to D3, on the basis of this finding, ALK inhibitors should have been able to suppress growth of cells expressing fusion proteins of ALK, *inter alia* NPM-ALK and EML4-ALK. The tests reported in D3 confirmed this assumption, showing that an ALK inhibitor, WHI-P154, inhibited the growth of cells expressing EML4-ALK. This teaching of D3 was confirmed in all documents D2, D4, D7, D14 and D15, which all disclosed the use of ALK inhibitors for treating EML4-ALK positive NSCLC. On the basis of this

overwhelming teaching, the skilled person would have expected compound 66, identified in D1 as an ALK and NPM-ALK inhibitor, to also show inhibition of EML4-ALK in EML4-ALK positive NSCLC. This reasonable expectation of success was further corroborated by the structural similarity between compound 66 of D1 and compound TAE684 used in D2 for treating EML4-ALK positive NSCLC. These two compounds belonged to the same family, as TAE684 had been used as a starting compound for the development of compound 66, as disclosed in document D10 on page 5675. The claimed subject-matter was thus obvious.

2.5 The board disagrees for the following reasons.

2.5.1 It is acknowledged that all documents D2, D3, D4, D7, D14 and D15 (D2: abstract, discussion on pages 8 to 10; D3: pages 564 and 565; D4: "*Discussion*" on pages 1700 to 1702; D7: abstract, pages 19894 and 19897; D14: "*Introduction*" on pages 4247 and 4248 as well as on pages 4251 to 4253; D15: abstract, "*Introduction*" on pages 1773 to 1774 and page 1778) disclose the use of ALK inhibitors for treating EML4-ALK positive NSCLC. However, D1, contrary to the appellants' view, does not disclose that compounds falling under claim 1 at issue, especially compound 66, are ALK or NPM-ALK inhibitors. As pointed out by the respondent during oral proceedings, D1 merely discloses (paragraphs [0040], [0042], [0047], [0049] and [0050]) that compounds covered by various formulae (1), (2), (3A), (3B), (4A), (4B) and (5) "***may inhibit***" (emphasis added by the board) various different targets, namely ALK, NPM-ALK, FAK, ZAP-70 and/or IGF-1, said to be implicated in neoplastic diseases. Moreover, a number of other potential medical uses of the disclosed compounds are mentioned in paragraph [0051]. Although tests for assessing the ability of the disclosed compounds to

inhibit ALK and NPM-ALK are mentioned in D1 (paragraphs [0043] to [0046] and [0143] to [0151]), no such tests were performed on the disclosed compounds, let alone on the specific compound 66. Therefore, no disclosure is present in D1 as regards which of the disclosed compounds is active against which target. Hence, the starting point of the appellants' argumentation, namely that D1 discloses compound 66 as an ALK and NPM-ALK inhibitor, is not correct.

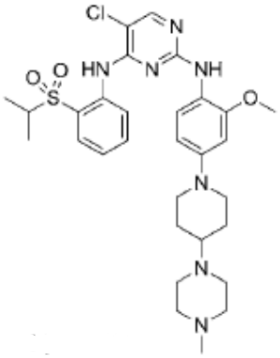
2.5.2 Starting again from the assumption that D1 taught that compound 66 was active against ALK and NPM-ALK, appellant 2 argued that, contrary to the finding in the opposition division's decision, it would have been credible that compound 66 did indeed provide this effect of acting against ALK and NPM-ALK. Appellant 2 argued that it would have been obvious to the skilled person to perform the tests indicated in D1. The skilled person had to be able to perform obvious tests to confirm the teaching of a prior-art document, just as an applicant or patentee could file the results of tests carried out after the filing date to confirm the teaching of the application as filed. In doing such tests, the skilled person would have verified that compound 66 exhibited activity against ALK. The post-published document D29 in the name of the respondent did indeed confirm the ALK inhibitory activity of compound 66.

2.5.3 However, the board notes that, for the same reasons as given above, the starting point chosen by appellant 2 for its line of argument is not correct. D1 does not disclose that compound 66 is active against ALK or NPM-ALK. Therefore, the question as to whether this activity is credible does not arise. For this reason alone, the appellant 2's argument must fail. Furthermore, when assessing the content of a prior-art

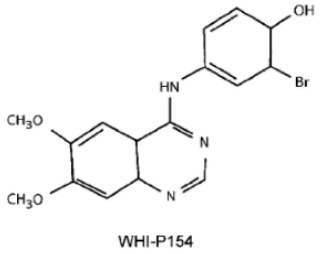
document, only the actual disclosure is to be considered, i.e. what the skilled person would derive, explicitly or implicitly, but directly and unambiguously, using common general knowledge, from the document as a whole. Supplementing an actual disclosure, such as that of D1, with additional information, such as that of document D29 that had been made available to the public only after the filing date of the patent in suit, is not permitted, no matter how obvious such additional information may turn out to be. Since the ALK inhibitory activity tests reported in D29 are not part of the disclosure of D1, either implicitly or explicitly, they cannot be considered when assessing inventive step starting from the disclosure of D1.

2.5.4 Thus, D1 does not disclose that compound 66 shows ALK or NPM-ALK inhibitory activity. Therefore, even accepting in the appellants' favour that documents D2, D3, D4, D7, D14 and D15 disclose that ALK inhibitors can be used to treat EML4-ALK positive NSCLC, the skilled person would not have been prompted by any one of these documents to apply the teaching contained therein to compound 66 of D1, i.e. to use this compound for treating EML4-ALK positive NSCLC.

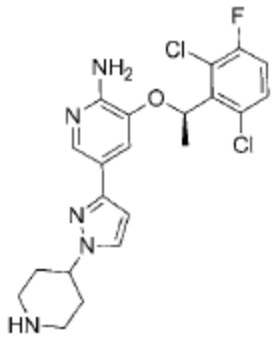
2.5.5 Also, the alleged structural similarity between compound 66 (point 2.1 above) and TAE684, the ALK inhibitor used in D2 (*loc. cit.*) for treating EML4-ALK positive NSCLC, would not have prompted the skilled person to use compound 66 for the same purpose either. The structure of TAE684 is shown below:



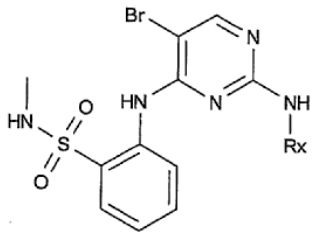
Even if some similarities are indeed present, the structures of the two compounds differ in many aspects, as evident from the figures shown above. Moreover, as pointed out by the respondent, no evidence has been presented that a similar structure would also result in a similar inhibitory activity. In fact, the evidence on file shows that the structures of the compounds disclosed in D2 (TAE684), D3 (WHI-P154), D4 (Crizotinib), D7 (compound 3-39 according to WO 2005/016894), D14 (Crizotinib) and D15 (Crizotinib) as ALK and EML4-ALK inhibitors are widely different, as shown by the figures below:



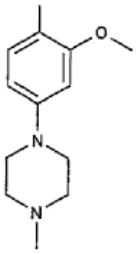
WHI-P154



1 (crizotinib)



ALK inhibitor according to D7,



wherein R_x is

Therefore, no link can be established between the structure of a compound and its ALK inhibitory activity.

As regards D10, invoked by the appellants to allege that TAE684 had been used to develop compound 66, it is noted that D10 is a document published after the filing date of the patent in suit. Therefore, the development disclosed therein does not represent prior art available to the skilled person.

2.6 For the reasons set out above, the board concludes that the subject-matter of claim 1 involves an inventive step when starting from D1 as the closest prior art (Article 56 EPC).

3. Document D2

3.1 D2 discloses (*loc. cit.*) the use of the ALK inhibiting compound TAE684 for treating EML4-ALK positive NSCLC. D2 thus discloses the same therapeutic application as defined in claim 1 as granted. The parties were in agreement that D2 could be taken as a starting point for assessing inventive step.

The distinguishing feature

3.2 It was common ground that the subject-matter of claim 1 as granted differs from the disclosure of D2 in that compounds of Formula (I), rather than compound TAE684 of D2, are used for treating EML4-ALK positive NSCLC.

The objective technical problem

3.3 However, the views of the parties diverged as far as the objective technical problem deriving from this distinguishing feature is concerned.

The appellants argued that no technical effect derived from the above-mentioned distinguishing feature and, thus, that the objective technical problem lay in the provision of alternative inhibitors of EML4-ALK for the treatment of EML4-ALK positive NSCLC. In light of the conclusions below, there was no need for the board in the present case to establish whether or not a particular technical effect is associated with the distinguishing feature. The board therefore assumes in the following that the formulation of the objective technical problem is as suggested by the appellants.

Obviousness of the claimed solution

3.4 The appellants argued that D1 disclosed compounds falling under claim 1 as granted, especially compound 66, that were said to be ALK and NPM-ALK inhibitors. It was known in the prior art, from e.g. D3 and D4, that ALK inhibitors also inhibited ALK fusion proteins, especially EML4-ALK. It was also known, from e.g. D7, D14 and D15, that ALK inhibitors might be used for treating EML4-ALK positive NSCLC. Based on this common general knowledge, the skilled person seeking a solution to the technical problem posed would have had a reasonable expectation of success when using compound 66 for treating EML4-ALK positive NSCLC. This applied

also in view of the similarity between the structures of TAE684 used in D2 and compound 66 of D1. Indeed, these two compounds belonged to the same family since TAE684 had been used as a starting compound for the development of compound 66, as disclosed in document D10 on page 5675. The subject-matter of claim 1 was thus obvious in view of D2 in combination with D1.

3.5 The board disagrees for the following reasons.

3.5.1 As already mentioned under point 2.5 above, D1 does not report any activity of the disclosed compounds, let alone of compound 66, and let alone an inhibitory activity of this specific compound against ALK or NPM-ALK. As also set out above, there is no evidence that structural similarity would have resulted in a similar inhibitory activity. Furthermore, document D10, being post-published, is not prior art available to the skilled person. Thus, the skilled person would not have turned to D1 when aiming to solve the technical problem posed, but would have instead considered any one of documents D3, D4, D7, D14 and D15, all disclosing compounds used for treating EML4-ALK positive NSCLC. However, in doing this, the skilled person would not have arrived at the claimed subject-matter, as none of these compounds falls under claim 1 at issue.

3.5.2 Even assuming that the skilled person had considered D1, the skilled person would have found in paragraph [0047] the indication that FAK, rather than ALK inhibitors, may be useful in treating NSCLC. This indication would, likewise, not have pointed to any specific compound, let alone compound 66, as FAK inhibitory activity was not tested in D1 for any of the disclosed compounds.

3.6 Therefore, the board concludes that, even with the assumption in the appellants' favour that no technical

effect would be associated with the feature distinguishing claim 1 from D2, the subject-matter of claim 1 involves an inventive step when starting from D2 as the closest prior art (Article 56 EPC).

3.7 The respondent, in defending inventive step over D2, relied on D10 to show the presence of a technical effect of the feature distinguishing claim 1 from D2. The appellants did not agree that the post-published document D10 should be taken into account to prove this effect.

However, since the board reached the above conclusion in favour of an inventive step of the subject-matter of claim 1 even assuming that no technical effect of the feature distinguishing claim 1 from D2 was present, it did not need to decide whether document D10 could be taken into account.

Conclusion

4. For the reasons set out above, the subject-matter of claim 1 as granted involves an inventive step within the meaning of Article 56 EPC. The same applies to the subject-matter of claims 2 to 8, dependent on claim 1, and to the subject-matter of claim 9, defining the same medical use as claim 1 in the Swiss-type format. The subject-matter of claims 2 to 9 also involves an inventive step (Article 56 EPC).

It follows that the ground for opposition under Article 100(a) EPC in combination with Article 56 EPC does not prejudice the maintenance of the patent as granted.

Therefore, the main request of the respondent is allowable.

Request for a different apportionment of costs

5. During oral proceedings, the respondent requested that the costs incurred by it for preparing the oral proceedings be borne by appellant 3. It was submitted that, while appellants 1 and 2 had announced their non-attendance at the oral proceedings well in advance, the remaining appellant 3 indicated its non-attendance only the evening before the hearing. Therefore, the board had not been given any opportunity to form an opinion on the case at an earlier point in time and to possibly cancel the oral proceedings.

Moreover, appellant 3 had spoken in French at the oral proceedings before the opposition division and all letters filed during the appeal proceedings were also written in French. The fact that appellant 3 had informed the board of its intention to speak English at the oral proceedings was an indication that it had probably already considered, at that point in time, not attending the oral proceedings, but wanted to avoid translation costs in the event of deciding not to attend at the very last minute.

A different apportionment of costs was thus justified.

6. The board disagrees for the following reasons:

6.1 Under Article 104(1) EPC and Article 16(1) RPBA 2020, each party to the appeal proceedings bears the costs that it has incurred, unless the board, for reasons of equity, orders a different apportionment of costs. Reasons of equity may arise if the procedural behaviour of a party generates disadvantages to other parties to the proceedings, in particular in situations set out in Article 16(1) RPBA 2020.

6.2 In the present case, the appellant 3's announcement of non-attendance at the oral proceedings was filed at an

extremely late stage, namely roughly twelve hours before the start of the oral proceedings, without any justification for this late filing. It is no more than the usual degree of courtesy owed to a board of appeal as a court of final appellate jurisdiction and to the other parties for a party's intention not to attend the oral proceedings to be communicated as early as possible (see also decision T 13/19, reasons, point 1.3).

6.3 However, no causal link can be established between appellant 3's procedural behaviour and any additional costs incurred by the respondent, namely additional preparation costs as argued by the respondent. It can be noted that the board's communication under Article 15(1) RPBA did not contain a preliminary opinion of the board concerning the appeals, in particular concerning inventive step, in favour of the respondent. Instead, the board (points 5.3.3 and 5.5 of said communication) expressed the opinion that the issue of inventive step had to be discussed at the oral proceedings. Therefore, it cannot be deduced from the board's communication that no oral proceedings would have been necessary, had all appellants announced their non-attendance at such oral proceedings well in advance and even assuming that their announcements of non-attendance had been considered as withdrawals of their requests for oral proceedings. In fact, a possible cancellation of the oral proceedings in the event of appellant 3 having announced its non-attendance at an earlier point in time would have entirely depended on the board's dealing with the case and the timing of its deliberations. Additionally, the respondent itself (reply to the appeals, page 2, point 1) had requested oral proceedings in the event of the main request not being granted. Thus, this request was not conditional on the presence of the appellants at oral proceedings

and remained pending until the final decision on the main request was taken by the board in the oral proceedings. Thus, independently of the behaviour of appellant 3, the respondent would have had to prepare for a discussion of its case at the oral proceedings anyway. The board therefore does not consider it equitable to order a different apportionment of costs in the circumstances of the present case.

6.4 As regards the French language being used by appellant 3 in its letters, on the one hand, and the announcement of its intention to plead in English on the other, the board notes that the parties are free to use any one of the official languages - see Rule 3(1) and Rule 4(1) EPC. The reasons as to why a different language, here English as the language of the proceedings, is intended to be used at the oral proceedings can be manifold. For instance, the person who plans to attend the oral proceedings may either prefer to plead in the language of the proceedings, or may at least accept this, considering that interpretation would likely have to be arranged by the EPO otherwise, resulting in additional human and financial resources on the part of the EPO and additional complexity for the hearing. A further reason may be that the attendee is aware that a particular hearing format might not be available where interpretation is required. Therefore, the board is far from seeing any misuse of the procedure by appellant 3 in its announcement that it would use the language of the proceedings at the hearing. It can also be noted in this context that the persons whose attendance was initially announced were not the persons attending the oral proceedings in opposition on behalf of appellant 3, as can be derived from the minutes of the opposition division. The respondent's argument that the change in the language to be used by appellant 3

implied that it intended, already well in advance, to be absent from the oral proceedings is nothing but speculation that, without proper substantiation, has to be disregarded.

6.5 For the reasons set out above, the board rejected the respondent's request for a different apportionment of costs.

Order

For these reasons it is decided that:

1. The appeals are dismissed.

2. The request for a different apportionment of costs is rejected.

The Registrar: The Chairman:

N. Maslin M. O. Müller

Decision electronically authenticated