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**Datasheet for the Ancillary decision
of 27 April 2022**

Case Number: T 0980/19 - 3.3.02

Application Number: 10006835.2

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Language of the proceedings: EN

Title of invention:
FORMULATION OF BORONIC ACID COMPOUNDS

Patent Proprietor:
THE UNITED STATES OF AMERICA, represented by
THE SECRETARY, DEPARTMENT OF HEALTH AND
HUMAN SERVICES

Opponents:

HGF Limited

Pfizer Inc.

Accord Healthcare Ltd

LEK Pharmaceuticals d.d.

Synthon B.V.

Fresenius Kabi Deutschland GmbH

Pentafarma Sociedade Técnico-Medicinal S.A.

Generics (U.K.) Limited

Teva Pharmaceuticals Inc.

Headword:

Relevant legal provisions:

EPC R. 124(1)

Keyword:

Minutes of oral proceedings - request to correct minutes

Decisions cited:

T 0212/97, T 0642/97

Catchword:



Beschwerdekammern

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Chambres de recours

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Case Number: T 0980/19 - 3.3.02

A N C I L L A R Y D E C I S I O N
of Technical Board of Appeal 3.3.02
of 27 April 2022

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
7 March 2019 concerning maintenance of the
European Patent No. 2251344 in amended form.

Composition of the Board:

Chairman M. O. Müller
Members: P. O'Sullivan
P. de Heij

Summary of Facts and Submissions

- I. Oral proceedings before the board were held on 18 and 19 October 2021. The minutes of oral proceedings were dispatched to the parties.
- II. With letter dated 11 November 2021, opponent 9 (hereinafter: the opponent) requested that the minutes of the oral proceedings be corrected due to a lack of compliance with Rule 124 EPC.
- III. With the letter dated 3 December 2021, the patent proprietor provided arguments against a correction of the minutes.
- IV. With a communication pursuant to Rule 100(2) EPC dated 1 February 2022, the board set out its preliminary view that the opponent's request for correction of the minutes was to be rejected. A time period of two months was set for reply to the communication. No replies were received.

Reasons for the Decision

1. As indicated in the board's communication dated 1 February 2022, the parts of the minutes for which correction is requested accurately reflect the course of the oral proceedings, as set out in the following.
2. Rule 124 EPC requires that the minutes contain the essentials of oral proceedings, and the relevant statements of the parties. There is no requirement that the minutes contain the complete arguments of a party

(see for example T 212/97, reasons 2.2 and T 642/97, reasons 9.3). In addition, it is not relevant whether particular statements should be qualified as not substantiated, speculation, allegation or whatever other qualification. What matters is the mere recording of the statement.

3. Hereinafter, the opponent's requests for correction will be addressed in turn.
4. First, the opponent requested that *"the precise time points of the hearing and its interruptions"* be included in the minutes.

The opponent did not put forward any reasons as to why, during the oral proceedings, the precise time points were essential. The board therefore fails to see why those time points represent essential elements of the oral proceedings according to Rule 124(1) EPC. This request is therefore refused.

5. Second, the opponent proposed the insertion of the following text after the second sentence of the third paragraph on page 7 of the minutes:

"The chairman answered that the objective technical problem had already been stated and would be the achievement of the two acknowledged effects. In response thereto, opponent 9 pointed out that this would not be a correct formulation of an objective technical problem according to the problem solution-approach. The chairman announced that the board would need to deliberate to discuss this question."

Oral proceedings were interrupted from 9:55 to 10:03 a.m."

The board does not see any reasons as to why the opponent's proposed text contains essential elements of the oral proceedings that need to be mentioned in the minutes. Moreover, the final sentence of the text proposed for correction ("*The chairman announced that the board would need to deliberate to discuss this question.*") is misleading in that it could be understood to mean that the chair specified that the board's deliberation would concern the formulation of the objective technical problem. However, the chair did not mention the specific purpose of the deliberation. Therefore, also the opponent's assertion in its request (last paragraph on page 4), that the "*board even needed a break to determine, which objective technical problem formed the basis of the decision on inventive step*", is without basis. This request is therefore refused.

6. Third, the opponent proposed the insertion of further text to follow paragraph 3 on page 7 of the minutes. This text reads as follows:

"Opponent 9 then stated that this statement implies that the board's indicated problem would be completely different from the problem discussed throughout the proceedings and as stated in the preliminary opinion of the board, namely - now - the provision of a solid form of bortezomib instead of the provision of a pharmaceutical formulation of bortezomib. This change in the objective technical problem constitutes a change in the matter of proceedings as the objective technical problem is a central aspect of the problem solution-approach. Opponent 9 argued that the opponents only became aware of this change during the oral hearing and only after explicitly asking the chairman to clarify the objective technical problem.

Consequently, as opponent 9 stated, the opponents did not have the opportunity to search for appropriate prior art and bring forward respective arguments regarding this new matter. Opponent 9 further stated this new objective technical problem would rather concern boron and boronic acid chemistry instead of prior art regarding the formulation of active pharmaceutical ingredients in the form of pharmaceutical formulations. A change in the objective technical problem could include a change in the skilled person, and finally a different prior art must likely be chosen as the closest prior art. To address this new objective technical problem, opponent 9 requested that the proceedings be continued in writing in order to discuss inventive step starting from a different objective technical problem and closest prior art than document D5."

The text proposed for insertion provides detailed arguments regarding what is already stated in the minutes as they stand, namely that the reason for the request to continue the proceedings in writing was *"that the board in its communication pursuant to Article 15(1) RPBA preliminarily had formulated a different problem on which the opponent had relied in its preparations"*. The board fails to see any reason to include more detailed arguments, the minutes being required to only contain the essentials of the oral proceedings.

More importantly, the text proposed for insertion does not reflect properly what was stated by opponent 9 during the oral proceedings: the opponent did not state that it needed an additional opportunity to *"search for appropriate prior art"* but stated only that it needed the opportunity to carry out the problem solution

approach starting from a different closest prior art document, such as D2 or D1.

Furthermore, the opponent did not ask for the appeal proceedings to be continued in writing in order to discuss inventive step from a different objective technical problem. The incorrectness of this proposed text follows from the proposed text itself in that it is contradictory. More specifically, it starts with "*To address **this new** objective technical problem*" and then continues by stating that proceedings should be continued in writing to start "*from a **different** objective technical problem*" (emphasis added by the board). Furthermore, the proposed text is not in agreement with what opponent 9 formulated during the oral proceedings in a written statement as its objection under Rule 106 EPC, namely that it was requested to continue the proceedings in writing "*in order to discuss inventive step based on a closest prior art different from D5*" (see annex to the minutes as they stand).

This request is therefore refused.

7. Fourth, the opponent submitted that the second sentence of the last paragraph on page 7 was incorrect.

This sentence reads as follows:

"The reason for this request was that the board in its communication pursuant to Article 15(1) RPBA preliminarily had formulated a different problem on which the opponent had relied in its preparations."

The opponent proposed a corrected version which reads:

"The reason for this request was that the board changed the objective technical problem and thereby, changed the matter of the proceedings unforeseeably in the oral hearing and the opponents did not have the opportunity to prepare for this new situation."

However, according to the board's detailed notes as well as its recollection of events in oral proceedings, the allegedly incorrect statement is accurate. The gist of both texts is in any case identical, being that the opponent indicated that during the oral proceedings a different objective technical problem was formulated for which they were not prepared in view of the board's preliminary opinion. The request to replace said sentence is therefore refused.

8. Fifth, the opponent contended that in the final paragraph on page 7 of the minutes, the following passage was "not appropriate":

"The chairman noted that the achievement of certain effects starting from solid bortezomib had for example already been addressed in the proprietor's submissions in reply to the board's communication."

However, according to the board's notes, this statement accurately reflects the chair's statement during the oral proceedings. This is not contested by the opponent. Therefore, independently of whether the opponent considers it inappropriate, a need to correct the minutes does not arise.

9. Sixth, in the same paragraph, the opponent criticised the following passage and requested omission thereof:

"Furthermore, the formulation of the objective technical problem had been discussed extensively with the parties on the preceding day of the oral proceedings. Opponent 9 could have made any submission starting from a different closest prior art document or taking into account a different objective technical problem at the latest at that point in time"

Again, according to the board's notes, this passage reflects what was stated by the chair during oral proceedings and again, the statement as such is not contested by the opponent. The opponent argues that, contrary to what was stated by the chair, it could not have known of the change of the objective technical problem already on day 1, and that on day 1 the problem had been formulated differently. However, the allegation that the statement that was actually made by the chair is incorrect is irrelevant for the purpose of formulating the minutes.

10. For the above reasons, the opponent's request for correction of the minutes is refused.
11. Aside from the specific requests for correction of the minutes, the opponent's letter dated 11 November 2021 contains several statements that do not properly reflect the course of the oral proceedings, and therefore merit comment by the board, as set out in the following.

11.1 In its letter, the opponent stated that it had only "*learned that the objective technical problem had changed after repeated requests on day 2 of the hearing*" (emphasis added by the opponent)

However, the opponent's allegation that it was only "*after repeated requests*" that it learned of the "new" objective technical problem is categorically incorrect. The opponent only enquired as to the board's formulation of the objective technical problem once, namely after the board's conclusion on inventive step for the main request had been announced on day 2.

It has also to be noted in this respect that, before giving the floor to the parties to address obviousness after defining the objective technical problem on day 1 of the oral proceedings, the chair noted that should any party wish to add anything with regard to the objective technical problem, it was free to do so (minutes, page 6, final paragraph). However, on day 1, none of the parties made any further enquiry regarding the objective technical problem. Hence, the opponent's statement that repeated requests were made is not only incorrect, but is misrepresentative of the course of the oral proceedings as a whole.

11.2 According to the opponent's letter, the board stated "*that the technical effects achieved by the claimed invention would be only effects (a) and (c) based on the effects (a)-(c) identified in the board's communication under Article 15(1) RPBA...*". However, according to the board's notes, the chair did not refer to the effects mentioned in said communication, but stated the outcome of the board's deliberation in full, as reflected in the minutes (page 7, second paragraph), namely

"The effects of solution stability and improved solid stability had been credibly demonstrated. However, improved dissolution behaviour had not been shown".

11.3 Finally, the opponent alleged that in contrast to the statement in the minutes (page 8, second full paragraph, second sentence), there was no deliberation before the chairman stated that the board did not change its rejection of the request to continue the proceedings in writing. However, as noted by the patent proprietor with the letter dated 3 December 2021, this is not correct. The board (sitting in the same room) deliberated briefly without adjourning the proceedings.

Order

For these reasons it is decided that:

The request of opponent 9 for correction of the minutes of oral proceedings held on 18 and 19 October 2021 is refused.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated