

**Internal distribution code:**

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

**D E C I S I O N**  
**of 19 June 2002**

**Case Number:** T 1095/98 - 3.3.2

**Application Number:** 92104479.8

**Publication Number:** 0505872

**IPC:** A61K 9/20

**Language of the proceedings:** EN

**Title of invention:**

Swallowable tablet with a high content of edible organic acid salts

**Applicant:**

Bayer Corporation

**Opponent:**

-

**Headword:**

"Swallowable tablet"/BAYER

**Relevant legal provisions:**

EPC Art. 54, 56, 84, 123(2)

**Keyword:**

"Main request: inventive step (no). First auxiliary request: lack of clarity. Second auxiliary request: amended claim 1 not supported by the application as filed. Third auxiliary request: inventive step (no)."

**Decisions cited:**

-

**Catchword:**

-





**Case Number:** T 1095/98 - 3.3.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.2**  
**of 19 June 2002**

**Appellant:** Bayer Corporation  
100 Bayer Road  
Pittsburg, PA 15205-9741 (US)

**Representative:** Petrovicki, Wolfgang, Dr.  
Bayer AG  
Konzernbereich RP  
Patente und Lizenzen  
D-51368 Leverkusen (DE)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 21 July 1998  
refusing European patent application  
No. 92 104 479.8 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** U. Oswald  
**Members:** G. F. E. Rampold  
S. U. Hoffmann

## Summary of facts and submissions

I. The applicant's appeal is against the examining division's decision, posted on 21 July 1998, refusing European patent application No. 92 104 479.8, filed on 16 March 1992 and published on 30 September 1992 as EP-A-0 505 872. The decision was based on an amended set of 5 claims, filed on 25 July 1997 with the appellant's (applicant's) letter dated 23 July 1997. Claim 1 was worded as follows:

"A swallow tablet comprising an effective amount of a therapeutic drug, an alkali metal or alkaline earth metal salt of an edible organic acid selected from the group consisting of citric, malic, fumaric, tartaric and succinic acid or mixtures thereof, and optionally a carbonate or bicarbonate, characterized by the inclusion of the salt in an amount between 0.250 and 1.0 g per tablet with the proviso that such tablet will disintegrate in vivo and is not an effervescent tablet intended to be dissolved in water prior to ingestion."

Dependent claims 2 to 5 related to elaborations of the tablet according to claim 1.

II. The following patent documents were cited as state of the art in the decision of the examining division and are referred to in this decision:

(1) EP-A-0 396 972

(2) EP-A-0 484 106

(3) WO-A-92 11 003

(4) EP-A-0 474 040

Citations (2) to (4) are comprised in the state of the art under Article 54(3) and (4) EPC.

III. In its decision the examining division raised objections under Article 123(2) EPC as to the admissibility of both disclaimers introduced by way of amendment at the end of claim 1. As regards the first disclaimer, it referred to the passage in the description at page 3, lines 26 to 27, reading "the tablet will disintegrate in vivo within about fifteen minutes". The examining division concluded that this disclosure offered by the appellant to support the first disclaimer was inadequate since it related to a specific disintegration time which was not recited in the first disclaimer. As regards the second disclaimer, which was introduced to establish novelty over the state of the art according to (3), the examining division considered that the disclaimer was broader than necessary to exclude the novelty-destroying subject-matter disclosed in the cited state of the art and that it was therefore not acceptable.

Further, the examining division held that, in spite of the disclaimers, a tablet comprising all the technical features of the tablet claimed in claim 1 of the applicant's request was already disclosed in citation (3). In this context, it emphasised that the characterisation of the claimed tablet in claim 1 as a "swallow tablet" was irrelevant to the assessment of novelty in the present case. Even if one were to accept that the particular intended mode of application of the "swallow tablet" according to the application [direct oral ingestion of the tablet without prior dissolution

in water] and that of the "effervescent tablet" disclosed in citation (3) [dissolution of the tablet in water prior to ingestion] were indeed different, the technical features of both tablets would, in the view of the examining division, not differ and the claimed tablet in the application would therefore lack novelty.

Finally, the examining division stated in its decision that in the circumstances of the case it saw no reason to discuss any aspect of inventive step. Nevertheless, it asserted in its decision that it could not recognise an inventive step in comparison with the prior art according to citation (1), since both the appellant's application and the cited document related to the same problem of providing swallow or effervescent tablets comprising a salt of an edible organic acid and an effective amount of a therapeutic drug.

- IV. The appellant lodged an appeal against this decision and submitted together with the statement setting out the grounds of appeal two amended sets of claims forming its current main request and third auxiliary request. During oral proceedings, held on 19 June 2002, the appellant presented two additional sets of claims forming its current first and second auxiliary requests.

The **main request** consists of 7 claims, claim 1 reading as follows:

"A swallowable tablet comprising: (a) an effective amount of a therapeutic drug; (b) an alkali metal or alkaline earth metal salt of an edible organic acid; and (c) optionally a carbonate or bicarbonate, characterized by the inclusion of the salt of the

edible organic acid in an amount between 0.250 and 1.0 g per tablet, *with the proviso that the tablet does not effervesce in the presence of water.*"

Dependent claims 2 to 7 relate to elaborations of the tablet according to claim 1.

The **first auxiliary request** corresponds to the above main request, the proviso at the end of claim 1 differing as follows:

*"with the proviso that said salt is not an aliphatic carboxylic acid component of an effervescent couple"*

The **second auxiliary request** consists of 6 claims, claim 1 reading as follows:

"A swallowable tablet comprising: (a) an effective amount of a therapeutic drug; (b) trisodium citrate or an alkaline earth metal salt of malic, fumaric tartaric or succinic acid or mixtures thereof; and (c) optionally a carbonate or bicarbonate, characterized by the inclusion of trisodium citrate in an amount between 0.250 and 1.0 g per tablet.

Dependent claims 2 to 6 relate to elaborations of the tablet according to claim 1.

The **third auxiliary request** corresponds to the above-mentioned second auxiliary request, claim 1 differing by the limitation of component (b) to trisodium citrate only.

V. The appellant's arguments presented in writing and during the hearing can be summarised as follows:

The claims in all current requests did not contain subject-matter which extended beyond the content of the application as filed. All claims complied therefore with the requirements of Article 123(2) EPC.

As regards novelty of the claimed subject-matter in the application, the appellant submitted that the tablet of claim 1 of all current requests comprised an effective amount of a therapeutic drug, an amount between 0.250 and 1.0 g of an alkali metal or alkaline earth metal salt of an edible organic acid per tablet, and optionally a carbonate or bicarbonate. Furthermore, the claimed tablet did not effervesce in the presence of water.

Citation (1) admittedly disclosed tablets comprising qualitatively the same ingredients. However, tablets disclosed in (1) contained the salt of the edible organic acid in an amount which was significantly lower than the amount specified in claim 1 for the tablets according to the invention. This conferred novelty on claim 1 of all current requests.

Citation (2) related to controlled, long-acting release pharmaceutical formulations comprising a biologically active substance, a water-soluble alginate, and a magnesium or sodium antacid. Since the tablets disclosed in (2) did not contain an edible organic acid, this prior art did not anticipate the claimed subject-matter in the appellant's actual requests.

The effervescent pharmaceutical compositions disclosed in citation (3) comprised as the therapeutic drug a substance which acted as a 5HT<sub>1</sub>-like receptor agonist and an effervescent couple consisting essentially of an



acid or an acid salt of an edible organic acid, for example, citric acid or monosodium citrate and a base component, for example, an alkali metal or alkaline earth metal carbonate or bicarbonate, such as sodium bicarbonate. In contrast to this prior art, claim 1 of all current requests required that the claimed swallowable tablet did not effervesce in the presence of water. A skilled person would thus immediately realise that the tablets according to claim 1 must contain a salt of an edible organic acid which is not capable of reacting in water with the base under generation of carbon dioxide and which is accordingly different from the salt present in tablets disclosed in (3).

Citation (4) was likewise concerned with effervescent tablets comprising a therapeutic drug and an effervescent couple consisting of an acid salt of tartaric or citric acid and a carbonate or bicarbonate. This meant that the tablets disclosed in (4) were distinguished from the claimed tablets in claim 1 of all requests by the content of an effervescent couple as is the case in the prior art of (3).

As regards inventive step the appellant regarded comparable effervescent tablets referred to in the introductory part of the application as representing the closest prior art and identified the problem to be solved by the claimed invention as that of providing a swallowable tablet the efficiency and onset of action of which were at least as good as those of a comparable effervescent tablet. In the appellant's opinion, the state of the art did not suggest to a person skilled in the art solving this problem by increasing the proportion of the edible organic acid in

the swallowable tablet to an amount in the range of from 0.250 to 1 grams.

- VI. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the main request submitted with the statement of the grounds of appeal or, in the alternative, on the basis of the first or second auxiliary request, both filed during oral proceedings, or on the basis of the third auxiliary request filed as an auxiliary request together with the statement of the grounds of appeal or, if the board considers none of these requests allowable, to continue the proceedings in writing.

### **Reasons for the Decision**

1. The appeal is admissible.
2. Claim 1 in the appellant's current main request and in any of its first, second and third auxiliary requests has been amended so as to replace, *inter alia*, the designation of the subject-matter of the alleged invention, reading in the original version of claim 1 "A solid oral dosage form", with "A swallowable tablet". References to a "swallowable tablet" or "swallow tablet" may be found throughout the originally filed specification, *inter alia*, at page 1, line 6; page 2, line 2; and in claims 5 to 9. The proposed amendment is therefore acceptable as being adequately supported by the originally filed documents and complying in this formal respect with the requirements of Articles 84 and 123(2) EPC.

*Main request*

3. In accordance with the main request, claim 1 as originally filed has further been amended by including at the end of the claim *"the proviso that the tablet does not effervesce in the presence of water."* Correctly interpreted, this proviso has the effect that the subject-matter for which protection is sought is defined in amended claim 1 by **an additional characterising technical feature** which as such is nowhere disclosed, at least not explicitly, in the application as filed. Claim 1 as amended must correctly be construed as being directed to "a swallowable tablet **which does not effervesce in the presence of water** comprising (a) an effective amount of a therapeutic drug; (b) an alkali metal or alkaline earth metal salt of an edible organic acid; and (c) optionally a carbonate or bicarbonate, characterized by the inclusion of the salt of the edible organic acid in an amount between 0.250 g and 1.0 g per tablet".

3.1 The appellant argued during oral proceedings before the board that the added technical feature in claim 1 (*"tablet which does not effervesce in the presence of water"*) is implicitly contained in the original application documents and that claim 1 as amended would not therefore contravene Article 123(2) EPC. Even if the board accepts the appellant's assertions that the added feature is, for the skilled reader, implicit in what is explicitly disclosed in the application as filed and that claim 1 as amended is therefore adequately supported by the originally filed documents, this does not help the appellant for the simple reason that the claimed subject-matter is not patentable for the reasons set forth below.

3.2 Citation (1) discloses a method of preparing a

granulate of a medically effective ingredient and its further processing into tablets comprising the steps of

- mixing (a) an effective amount of a finely divided solid therapeutic drug with (b) an aqueous granulating solution of a sodium or potassium or mixed sodium potassium salt of an edible organic acid chosen from citric, malic, tartaric or fumaric acid, which granulating solution may optionally also contain (c) sodium or potassium bicarbonate;
- granulating the mixture and
- drying the granulated mixture; followed by
- mixing the granulate with an edible organic acid to form an effervescent powder and
- compressing the mixture into conventional effervescent tablets; **or**
- mixing the dried granulate with other tableting excipients and
- compressing the mixture **into swallowable tablets.**

3.2.1 Example 12 of (1) discloses a capsule-shaped, **swallowable tablet which does not effervesce in the presence of water** comprising, apart from minor amounts of certain conventionally used, pharmaceutically acceptable tableting excipients and carriers, the following major ingredients (mg/tablet):

328.8 mg **(a) Acetaminophen U.S.P.** (an effective amount of a therapeutic drug)

70.4 mg **(b) Trisodium Citrate** (an alkali metal salt of an edible organic acid)

383.6 mg **(c) Precipitated Calcium Carbonate** U.S.P. (a carbonate)

---

792.8 mg

The tablet of Example 12 contains materials in a total amount of 886 mg.

3.2.2 As is apparent from the board's observations in points 3.2 and 3.2.1 above, the claimed swallowable tablet in the application and that disclosed in Example 12 of (1) comprise exactly the same sort of individual components (a), (b) and (c). As the appellant itself admitted at the oral proceedings before the board and, moreover, clearly indicated by using the two-part form for claim 1 (see "*characterized by the inclusion of the salt of the edible organic acid in an amount between 0.250 and 1.0 g per tablet*"), the **only difference** between the claimed tablet in the application and that disclosed in (1) lies in the amount of component (b), i.e. the salt of the edible organic acid, contained in one single tablet. Since, moreover, both the cited state of the art and the present application relate to a drug delivery system in the form of swallowable tablets, there cannot, in the board's opinion, remain any reasonable doubt that the swallowable tablets in (1) come closer with regard to their composition **and** application to the subject-matter of claim 1 than effervescent delivery systems (tablets) cited as the only relevant state of the art in the application under appeal (see page 1, line 11 to page 3, line 4) and referred to by the appellant during oral proceedings before the board as being the closest prior art.

3.2.3 Although the examining division stated in the impugned decision that the present application and the prior art according to (1) apparently relate to the same problem of providing swallowable or effervescent tablets comprising an effective amount of a drug and certain salts of an edible organic acid and that no inventive step associated with the claimed subject-matter in the application was therefore recognisable, the appellant made no attempt to refute the examining division's objections, as might have been expected, by the submission of comparative evidence demonstrating any potentially unexpected advantage or beneficial effect resulting from the use of an increased proportion of the salt of an edible organic acid (trisodium citrate) in the claimed tablet in comparison with the swallowable tablets disclosed in citation (1). Instead, the appellant essentially argued that the presence of the edible organic acid salts had no purpose at all in the completed swallowable tablets disclosed in (1) and that such tablets neither provided the fast delivery of an effervescent system nor the enhanced onset of action for a variety of therapeutic agents seen with the swallowable tablets according to the claimed invention.

3.2.4 According to the established case law of the boards of appeal, such alleged but entirely unsupported advantages cannot be taken into consideration in respect of the determination of the problem underlying the application and hence the assessment of inventive step, where comparison is made with highly pertinent prior art. This is the case here since the alleged advantages over the prior art of (1) lack the required adequate support (see Case Law of the Boards of Appeal, 4th edition, 2001, I.D.4.4, page 108). Therefore, given the swallowable tablets disclosed in (1) as representing the closest

state of the art, the objective technical problem to be solved can only be seen in providing further swallowable tablets containing an effective amount of a therapeutic drug.

- 3.2.5 The solution to the problem is the provision of swallowable tablets according to claim 1. On the basis of the disclosure in the application and, moreover, in the absence of any evidence to the contrary, the board is satisfied that the technical problem defined above has been plausibly solved.
  
- 3.3 Having examined the prior art documents uncovered by the search report and those introduced during the proceedings before the examining division, the board has reached the conclusion that none of these documents discloses a tablet which does not effervesce in the presence of water and which comprises a therapeutic drug and a salt of an edible organic acid in an amount of between 0.250 g and 1.0 g per tablet as claimed in claim 1. The claimed solution in the appellant's main request is accordingly found to be novel within the meaning of Article 54(1) EPC.
  
- 3.4 It still remains to be examined whether the requirement of inventive step is met by the claimed subject-matter.
  - 3.4.1 As can be seen from the disclosure at lines 43 to 44 on page 13 of (1), the resulting tablets from Example 12 showed U.S.P. dissolution test results of 94% at 30 minutes for acetaminophen and 99.9% at 30 minutes for calcium. Apart from the fact that these results give an adequate preliminary indication that the tablets disclosed in Example 12 of (1) provide fast delivery of the drug and enhanced onset of action, there is no

evidence available that the results obtained in this respect in the application under appeal are significantly better.

Once the development of a swallowable tablet with an enhanced onset of action comprising the constituents (a), (b) and (c) specified in claim 1 as the major ingredients became obvious from the cited state of the art, determining the proportions of the individual constituents required to achieve the desired results, for example, a fast delivery of the therapeutic drug and an enhanced onset of action, was then purely a matter of routine experimentation for the skilled practitioner. Moreover, the amount required for constituent b), ie the alkali metal salt of an edible organic acid, specified in claim 1, which may extend over the extremely wide range from 0.250 g to 1 g per tablet, cannot be considered as providing an unexpectedly advantageous specific teaching or instruction saving the skilled person the necessity of performing his own experiments for the preparation of a suitable tablet; on the contrary, such a wide range would suggest that the alleged invention was essentially the result of performing a certain number of routine experiments required to obtain a suitable tablet for a specific drug. The necessity of carrying out a number of obvious routine experiments to achieve the desired result does not, however, render an invention non-obvious.

- 3.4.2 The appellant has also argued that an indication of an inventive step should be seen in the fact that there was a quantitative difference of 180 mg between the amount (70 mg) of the alkali metal salt of an edible organic acid (trisodium citrate) used in the tablet of Example 12 in citation (1) and the lower limit (250 mg)



of the alkali metal salt of an edible organic acid specified in claim 1 of the application under appeal. However, this difference cannot be considered as significant in view of the more than 4-fold greater quantitative difference of 750 mg which may exist in claim 1 between the lower (0.250 g) and upper limits (1 g) of the alkali metal salt of an edible organic acid present in the claimed swallowable tablets in the application under appeal.

3.4.3 The relevant question is whether the skilled person having studied the closest state of the art and being guided by the technical problem would have been aware, from his common general knowledge and also from his familiarity with related art, what kind of modifications of that art could make the proposed solution to the problem posed available. It is irrelevant if the claimed solution of the problem is possibly unforeseeable on the basis of less close or structurally remote prior art, as long as it is derivable, together with the required function, from some other more relevant prior art, which is, for this very reason, termed as the "closest" state of the art. An invention lacking an inventive step over certain disclosures in the state of the art cannot be rendered patentable in view of non-obviousness over other disclosures. This is why any potential advantages of the claimed swallowable tablets over effervescent tablets were irrelevant to the assessment of inventive step in the present case.

3.4.4 In view of the foregoing observations, in the judgment of the board the claimed subject-matter in the main request does not involve an inventive step, and this request therefore is contrary Articles 52(1) and 56 EPC.

*First Auxiliary Request*

4. In accordance with the first auxiliary request, claim 1 as originally filed has been further amended by including at the end of the claim "*the proviso that said salt is not an aliphatic carboxylic acid component of an effervescent couple.*"

4.1.1 It forms part of the skilled person's common general knowledge that the term salt used in chemistry designates a structurally well defined chemical entity, ie a compound formed when one or more of the hydrogen atoms of an acid are replaced by one or more cations of the base. On the other hand, an effervescent couple is commonly known as the combination of a carboxylic acid, or an acid salt of a carboxylic acid and another salt, usually a carbonate or bicarbonate of an alkali metal or alkaline earth metal. As, from a chemical point of view, a salt as such cannot properly be designated as a carboxylic acid component and the term "effervescent couple" relates to a combination of a carboxylic acid, or an acid salt of a carboxylic acid and another specific type of salt, it remains unclear what could be meant by the proviso stipulating that **the salt** should not be an **aliphatic carboxylic acid component of an effervescent couple.**

4.1.2 Therefore, claim 1 of the appellant's first auxiliary request lacks clarity contrary to the requirements of Article 84 EPC. The appellant's first auxiliary request is therefore likewise not acceptable.

*Second Auxiliary Request*

5. In accordance with the second auxiliary request, claim 1 as originally filed has been amended, *inter alia*, by specifying that the swallowable tablet comprises as the component (b) "*trisodium citrate or an alkaline earth metal salt of malic, fumaric, tartaric or succinic acid or mixtures thereof*" (see paragraph IV above).

5.1 Whereas the use of trisodium citrate as the component (b) of the claimed tablet is adequately supported by the original disclosure, as will be explained in more detail in points 6 and 6.1 below, the specific reference in claim 1 as amended to component (b) being "*an alkaline earth metal salt of malic, fumaric, tartaric or succinic acid or mixtures thereof*" is not properly supported by the disclosure of the application as filed.

5.1.1 As regards suitable components (b) of the claimed tablet in the application, the description discloses at page 4, lines 21 to 28, a **first list** of edible organic acids useful in the alleged invention, including "*citric acid, malic acid, fumaric acid, tartaric acid, succinic acid and mixtures thereof*", and a **second separate list** of useful salts of these acids, including "*alkali metal salts **and** alkali-earth metal salts, such as sodium, potassium, calcium, magnesium [salts] or mixtures thereof*". This means that the description in the application as filed discloses in generic terms a broad group of salts of edible organic acids encompassing **every conceivable combination** of a given acid in the first list with any type of salt mentioned in the second list. It follows that, in contrast to what is actually disclosed in the application as filed, namely a broad, generically defined group of salts of edible organic acids, claim 1 in the second auxiliary request refers in

the context of component (b) to a **specific selection** (sub-group) from the broad range of possibilities offered in this respect in the description. This specific, purposively selected sub-group of salts, including alkaline earth metal salts of either one of malic, fumaric, tartaric or succinic acid, or even specific examples of such salts, are, however, in the context of component (b), nowhere disclosed in the description or claims of the application as filed.

5.1.2 Moreover, the characterising feature in claim 1 of the appellant's second auxiliary request ("*characterized by the inclusion of trisodium citrate in an amount between 0.250 and 1.0 g per tablet*") limits only the content of trisodium citrate in accordance with the disclosure in the application as filed to an amount of from 0.250 g to 1 g per tablet. However, a comparable feature limiting the content of the other options of the salts recited in claim 1, ie an alkaline earth metal salt of malic, fumaric, tartaric or succinic acid or mixtures thereof, to the amount of from 0.250 g to 1 g per tablet, as disclosed in the application as originally filed, is missing from claim 1.

5.1.3 It is thus clear that the application as filed was amended in the second auxiliary request in such a way that it contains subject-matter which finds no adequate support in the originally filed documents and which consequently extends beyond the content of the application as filed. This constitutes an infringement of Article 123(2) EPC. It follows that the second auxiliary request cannot succeed.

*Third auxiliary request*

6. In accordance with the third auxiliary request, claim 1 as originally filed has further been amended by replacing the generically defined component (b), relating in original claim 1 to "a salt of an edible organic acid", with a single specific option for such a salt, namely "trisodium citrate".
  - 6.1 Trisodium citrate is explicitly referred to at page 4, lines 27 to 28 as being a preferred salt of an edible organic acid for use in the claimed swallowable tablet and is moreover used as the component (b) in all Examples 1 to 7 included in the application as filed.
    - 6.1.1 Dependent claims 2 to 6 relate to certain specific drugs to be included as the component (a) in the swallowable tablet according to claim 1. These claims are based on the disclosure in the first and second paragraphs on page 5 of the application as filed. Dependent claim 6 relates to the maximum total amount of materials contained in a tablet according to claim 1. It finds support in the original disclosure at lines 13 to 15 on page 4.
    - 6.1.2 The present version of the claims in the third auxiliary request is therefore acceptable as being adequately supported by the disclosure in the application as filed and complying in this formal respect with Articles 84 and 123(2) EPC.
  - 6.2 As is apparent from the board's observations in points 3.2 and 3.2.1 above, the claimed swallowable tablet in claim 1 of the appellant's third auxiliary request and that disclosed in Example 12 of (1) comprise

exactly the same individual components (a), (b) and (c). The only difference between the claimed tablet in the application and that disclosed in (1) lies in the amount of **trisodium citrate** contained in one single tablet.

- 6.2.1 It appears immediately clear that the limitation of component (b) in claim 1 of the third auxiliary request **to trisodium citrate, which is exactly the salt of an edible organic acid used in Example 12 of citation (1)** (see for more details point 3.2.1 above) cannot overcome any of the objections to lack of inventive step raised in this decision in respect of claim 1 of the main request. Since trisodium citrate is specifically disclosed in the closest state of the art according to (1) as the edible organic acid present in the known swallowable tablets and the only difference between (1) and the tablet claimed in claim 1 of the third auxiliary request remains accordingly the amount of trisodium citrate per tablet, the objections to lack of inventive step of claim 1 in the main request apply equally to claim 1 in the appellant's third auxiliary request. Therefore, this request must also fail.

*Request for continuation in writing*

7. The board will normally consider continuing proceedings in writing, after oral proceedings have taken place before it, in circumstances where the appellant could not reasonably have been expected to deal with an issue that has come up for the first time at the oral proceedings. This is not the case here.

The decision of the first instance was based on exactly the same state of the art as cited in the board's present decision against the patentability of the

claimed subject-matter in the application under appeal. The examining division has already explicitly and clearly indicated in its decision that it could not recognise an inventive step over the effervescent **and** swallowable tablets disclosed in (1).

In its communication accompanying the summons to oral proceedings the board had already informed the appellant that it considered the case to be ready for decision at the conclusion of the oral proceedings. The deciding board is not departing from the established practice used in the EPO for the examination of patent applications in examining proceedings before the examining divisions or the boards of appeal. In the present case, the board is merely applying to an individual case proven practice and principles used in the EPO for the assessment of inventive step. Appeal proceedings are not there for a party to see whether its case might succeed despite inadequate evidence and for that party then to be given a further opportunity to submit evidence. The auxiliary request for continuation in writing is therefore refused.

## **Order**

### **For these reasons it is decided:**

The appeal is dismissed.

The Registrar:

The Chairman:

A. Townend

U. Oswald