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D E C I S I O N
of 19 February 2004

Case Number: T 0978/99 - 3.3.2

Application Number: 92201264.6

Publication Number: 0499344

IPC: A61K 9/12

Language of the proceedings: EN

Title of invention:
Medicinal aerosol formulations

Patentee:
RIKER LABORATORIES, INC.

Opponent:
Professor Sylvain RAULT
SkyePharma AG

Headword:
Medical aerosol formulations/RIKER

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Main and first auxiliary requests - unallowable
generalisation Article 123(2)"
"Auxiliary requests 2 to 4 - allowable under Article 123(2)
since they relate to preferred modes of the invention"
"Remittal (yes): two instances for the essential issues"

Decisions cited:

-

Catchword:

-



Case Number: T 0978/99 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 19 February 2004

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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 30 July 1999
revoking European patent No. 0499344 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: M. Ortega Plaza
P. Mühlens

Summary of Facts and Submissions

- I. European patent No 0 499 344 based on application No. 92 201 264.6 was granted on the basis of 16 claims.

Claim 1 of the set of claims for DE, GB, FR, IT, NL, SE, CH, LI, BE (set A) as granted read as follows:

"1. An aerosol formulation suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation, comprising a drug, 1,1,1,2-tetrafluoroethane, a surface active agent and at least one compound having a higher polarity than 1,1,1,2-tetrafluoroethane selected from alcohols, saturated hydrocarbons, and mixtures thereof, the formulation being in the form of a solution or a suspension of drug particles having a median particle size of less than 10 microns."

- II. Opposition was filed and revocation of the patent in its entirety was requested pursuant to Article 100(a) EPC for lack of novelty and inventive step and pursuant to Article 100(b) EPC for insufficiency of disclosure.

- III. The following documents *inter alia* were cited in the proceedings:

(1) US-A-4 174 295

(16) GB-A-837 465

(21) US-A-3 219 533

IV. The appeal lies from a decision of the opposition division revoking the patent under Article 102(1) EPC.

The opposition division considered that claim 1 of the main request (claims as granted) did not meet the requirements of novelty (Article 100(a) EPC).

In particular, the opposition division considered that the subject-matter of claim 1 was anticipated by document (1). In the opposition division's view, claim 1 encompassed the aerosol formulations disclosed in document (1), since the word "comprising" did not exclude the A-group of propellant which was present in the formulations of document (1). Among the ternary propellant compositions disclosed in document (1) were mentioned those comprising Freon 22, 134a and n-butane or Freon 143a, 134a and n-butane and Freon 32, 134a and n-butane (column 3, lines 65, 67 and column 4, line 2, column 4, line 2).

Furthermore document (1) disclosed the presence of ethanol as a dispersing agent. The aerosol formulations of document (1) also disclosed the presence of an active ingredient such as a pharmacological active ingredient.

The opposition division considered that the technical feature concerning the particle size was not relevant for the assessment of novelty since the formulations could be in the form of a solution.

With respect to the feature "suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation", the opposition division

considered that the pharmacological compositions of document (1) were also suitable for that use since they were in the form of an aerosol.

The opposition division took the view that the auxiliary request filed by the patentee prior to the oral proceedings but after the time limit set out within Rule 71a EPC was inadmissible since it was late-filed.

The opposition division rejected the opponents request for apportionment of costs since the grounds for it were "not bound separately to the present opposition case".

- V. The appellant (patentee) lodged an appeal against that decision.
- VI. Opponents 01 and 04 (respondents) contested with arguments to the grounds of appeal.
- VII. Opponents 02 and 03 withdrew their opposition during the appeal proceedings.
- VIII. A communication from the Board was sent as an annex to the invitation for oral proceedings, reminding the parties of the following : "Additionally, the appellant should be also prepared to argue in how far the specifications and restrictions introduced inter alia in claim 1 of the first and second auxiliary requests do not individualise certain combinations (e.g. choice of nature of drug and synergistic combinations and nature of surfactant) which were only disclosed generally in the application as filed and hence could

result in an unallowable selection (Article 123(2) EPC)".

- IX. The appellant filed with its letter of 22 December 2003 three further auxiliary sets of claims.
- X. Oral proceedings were held before the Board on 19 February 2004.

During the oral proceedings the appellant withdrew the set of claims as granted after discussion of the novelty of the subject-matter claimed.

It renumbered the remaining requests as main and auxiliary requests 2 to 4.

Claim 1 of the set of claims for DE, GB, FR, IT, NL, SE, CH, LI, BE (set A) of the main request reads as follows:

"1. An aerosol formulation suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation, consisting of a drug selected from anti-allergics, bronchodilators, anti-inflammatory and synergistic combinations thereof, 1,1,1,2-tetrafluoroethane, a non-fluorinated surface active agent and at least one compound having a higher polarity than 1,1,1,2-tetrafluoroethane selected from alcohols, saturated hydrocarbons, and mixtures thereof, the formulation being in the form of a suspension of drug particles having a median particle size of less than 10 microns."

Claim 1 of the set of claims (set A) of the first auxiliary request reads as follows:

"1. An aerosol formulation suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation, comprising a drug selected from antiallergics, bronchodilators, anti-inflammatory preparations and synergistic combinations thereof, 1,1,1,2-tetrafluoroethane, a surface active agent and at least one compound having a higher polarity than 1,1,1,2-tetrafluoroethane selected from alcohols, saturated hydrocarbons, and mixtures thereof, the formulation being in the form of a suspension of drug particles having a median particle size of less than 10 microns."

Claim 1 of the set of claims (set A) of the second auxiliary request reads as follows:

"1. An aerosol formulation suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation, comprising a drug selected from salbutamol, beclomethasone dipropionate, disodium cromoglycate, pirbuterol, isoprenaline, adrenaline, rimiterol, and ipratropium bromide, 1,1,1,2-tetrafluoroethane, a surface active agent and at least one compound having a higher polarity than 1,1,1,2-tetrafluoroethane selected from alcohols, saturated hydrocarbons, and mixtures thereof, the formulation being in the form of a suspension of drug particles having a median particle size of less than 10 microns."

Claim 1 of the set of claims (set A) of the third auxiliary request reads as follows:

"1. An aerosol formulation suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation, comprising a drug selected from salbutamol, beclomethasone dipropionate, disodium cromoglycate, pirbuterol, isoprenaline, adrenaline, rimiterol, and ipratropium bromide, 1,1,1,2-tetrafluoroethane, a surface active agent and at least one compound having a higher polarity than 1,1,1,2-tetrafluoroethane selected from alcohols, saturated hydrocarbons, and mixtures thereof, the formulation being in the form of a suspension of drug particles having a median particle size of less than 10 microns, and wherein the 1,1,1,2-tetrafluoroethane is present in an amount in the range 60 to 95% by weight of the formulation and the weight ratio of 1,1,1,2-tetrafluoroethane : compound of high polarity is in the range 85:15 to 95:5."

Claim 1 of the set of claims (set A) of the fourth auxiliary request reads as follows:

"1. An aerosol formulation suitable for drug delivery to the human lung by administration to a patient by oral or nasal inhalation, comprising a drug selected from salbutamol, beclomethasone dipropionate, disodium cromoglycate, pirbuterol, isoprenaline, adrenaline, rimiterol, and ipratropium bromide, 1,1,1,2-tetrafluoroethane, a surface active agent selected from sorbitan trioleate, sorbitan mono-oleate, sorbitan monolaurate, polyoxyethylene (20) sorbitan monolaurate, polyoxyethylene (20) sorbitan mono-oleate, natural lecithin, oleyl polyoxyethylene (2) ether, stearyl polyoxyethylene (2) ether, lauryl polyoxyethylene (4) ether, block copolymers of oxyethylene and oxypropylene,

Oleic acid, Synthetic lecithin, Diethylene glycol dioleate, Tetrahydrofurfuryl oleate, Ethyl oleate, Isopropyl myristate, Glyceryl trioleate, Glyceryl monooleate, Glyceryl monostearate, Glyceryl monoricinoleate, Cetyl alcohol, Stearyl alcohol, Polyethylene glycol 400 and Cetyl pyridinium chloride, olive oil, glyceryl monolaurate, corn oil, cotton seed oil and sunflower seed oil and at least one compound having a higher polarity than 1,1,1,2-tetrafluoroethane selected from alcohols, saturated hydrocarbons, and mixtures thereof, the formulation being in the form of a suspension of drug particles having a median particle size of less than 10 microns, and wherein the 1,1,1,2-tetrafluoroethane is present in an amount in the range 60 to 95% by weight of the formulation and the weight ratio of 1,1,1,2-tetrafluoroethane : compound of high polarity is in the range 85:15 to 95:5."

XI. The appellant's arguments may be summarised as follows: The main and first auxiliary requests relate to a restriction with respect to the nature of the drug by deletion from a list, and the compound classes are supported by the original disclosure since they are exemplified. With respect to the feature "synergistic combinations thereof", it does not individualise new combinations since the compounds are defined as broad compound classes which are well known in the art to be used as mixtures (documents (21) and (16)).

With respect to the admissibility of the second to fourth auxiliary requests (filed as auxiliary requests 3 to 5 with the letter of 22 December 2003), these requests related to a fair response in order to overcome the objections mentioned in the Board's

preliminary opinion sent as an annex to the grounds of appeal. The respondents were not taken by surprise since the requests were filed almost two months before the oral proceedings.

Auxiliary requests 2 to 4 related to a clear limitation of the scope claimed. Initially both suspension and solution were claimed. Both possibilities were disclosed and exemplified in the originally filed description for the aerosol formulations and now the claims were restricted to the suspensions. This was a mere cancellation of one alternative among two. With respect to the other amendments, they related merely to the introduction of the features of dependent claims into claim 1 as granted and were also supported by the application as originally filed. In particular, claims 12, 5, 2 and 1 were cited together with claims 9, 8, 7 for the third auxiliary request and with additionally claim 10 for the fourth auxiliary request. Additionally, page 7 of the description was cited for the third and fourth auxiliary requests.

The reference term "as claimed in any preceding claim" was generally admitted in European patents and meant that the subject-matter was taken in combination with that of any preceding claim. This was a shortening so as to avoid having too many dependent claims.

XII. The respondent's arguments may be summarised as follows:

The main and first auxiliary requests did not meet the requirements of Article 123(2) EPC since they related to an arbitrary selection of the disclosure as originally filed. Particularly, among fifteen groups,

four had been picked up and the description of the patent in suit did not disclose what had to be done to provide synergistic combinations, which are different to just a mixture of compounds. The respondents also objected to the other amendments of claim 1 of the main and first auxiliary requests under Article 123(2) EPC.

With respect to the requests filed with the letter of 22 December 2003, the respondents contended that their introduction into the opposition appeal proceedings should be considered inadmissible at such a late stage, especially since they were prima facie unallowable under Article 123(2) EPC. Furthermore, the appeal proceedings should basically relate to a revision of the first-instance decision.

The respondents raised an objection under Article 123(2) EPC against the last three auxiliary requests (auxiliary requests 2 to 4). In particular, opponent 4 put forward for the amended claim 1 of the three requests that they related to an unallowable combination of previous claims since the claims were drafted as "according to any preceding claim". Furthermore it attacked some of the terms already present in claim 1 of the granted version, such as the delivery to the human lung and the selected components ethanol and saturated hydrocarbons. The deletion of the alternative "solution" was also objected to, since only "suspensions" remained and not all the examples were suspensions.

XIII. The appellant (patentee) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the set of

claims filed before the Opposition Division (main request), or on the basis of the set of claims filed with the grounds of appeal (auxiliary request 1), or, as auxiliary requests 2 to 4, on the basis of one of the set of claims filed as 3rd, 4th and 5th auxiliary requests with letter dated 22 December 2003.

The respondents (opponents) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. *Main and first auxiliary requests*
 - 2.1 Both requests include the amendment relating to the specification of the drug as selected from antiallergics, bronchodilators, antiinflammatories (or anti-inflammatory preparations) "and **synergistic combinations thereof**" (emphasis added by the Board).

The support given on page 9 of the description does indeed relate to a list of fifteen classes of compounds followed by the expression "and synergistic combinations of these". However, the application as originally filed does not disclose explicitly or implicitly any synergistic effect and does not show where (certain mixtures within a class, or some classes together) or how this is to be found.

The restriction introduced in claim 1 amounts to the fact that three groups in combination show a

synergistic effect. This feature relates to an unallowable individualisation of the original contents.

Therefore, the said amendment is not allowable under Article 123(2) EPC.

This applies to the main and first auxiliary requests.

The appellant put forward the argument that some documents of the state of the art (documents 16 and 21) related to mixtures of the now specified classes of compounds, some of which could be synergistic. However, the originally filed application does not include any reference to that teaching nor does it give any indication as to a synergistic effect.

Accordingly, the main and first auxiliary requests are rejected.

3. *Admissibility of auxiliary requests 2 to 4.*

- 3.1 These requests are a clear response to the Board's communication sent as an annex to the oral proceedings. Therefore, it cannot be concluded that they represent an attempt at the last minute to surprise the respondents. They represent a fair replacement for the objected auxiliary request filed before the opposition division and the auxiliary request filed with the grounds of appeal.

The appeal proceedings are concerned primarily with the revision of the first-instance decision but it is legitimate for the appellant to have a fair chance of

amending the claims by limitation, in order to overcome the adverse first-instance decision.

Therefore, requests 2 to 4 are admitted into the appeal proceedings.

4. *Auxiliary requests 2 to 4.*

- 4.1 Several of the terms attacked by the respondent opponent 4 under Article 123(2) EPC were already present in claim 1 as granted. Article 100(c) EPC was not a ground for opposition and the incorporation of the dependent claims into claim 1 has not changed the meaning or the context of the said terms.

Claim 1 as granted relates to an aerosol formulation, which can be either in the form of a solution or in the form of a suspension (originally filed claim 2). The skilled person understands that independently from the active ingredient (drug) the composition can be formulated either as a solution or as a suspension. The suspension is further defined by reference to the median particle size of the drug, i.e. by physical parameters of the drug.

Both solutions and suspensions are exemplified as alternatives in the description as originally filed. The deletion of the solutions is merely a one-dimensional restriction of one alternative of two for the formulation. This amendment does not contravene the requirements of Article 123(2) EPC.

This restriction is shared by all requests 2 to 4.

4.2 Additionally, the specifications introduced into the claims must be assessed under Article 123(2) EPC.

4.3 Apart from the deletion of solutions, claim 1 of the second auxiliary request differs from claim 1 as granted in that claim 11 has been incorporated. By incorporation of the chemical nature of the active ingredient, those active ingredients preferred in the light of the originally filed application (originally filed claim 12) are specified. This specification of the active ingredients corresponds generically to any galenic formulation (e.g. physical form of the drug).

Therefore the incorporation of claim 11 into claim 1 only provides for a specification of the chemical nature of the active ingredient (those preferred in the originally filed application) but without introducing or individualising any new matter over that originally disclosed.

4.4 Claim 1 of the third auxiliary request additionally differs in that the amounts and ratio of the propellant 134a have been specified according to the preferred ranges (pages 7, lines 30 to 37, and 8, lines 1 and 2 of the description as originally filed). These ranges are also disclosed in dependent claims 9, 8 and 7 as originally filed (cf. also dependent claims 8 and 7 as granted).

4.5 Claim 1 of the fourth auxiliary request additionally incorporates the list of preferred surfactants as defined in claim 10 of the application as originally filed.

4.6 It becomes apparent in view of the above that the amended sets of claims of auxiliary requests 2 to 4 correspond to restrictions relating to the preferred modes of the invention according to the application as originally filed together with a one-dimensional limitation for the formulation (one alternative of two). By doing so, no new combinations arise since the now claimed combinations were foreseen by means of dependent claims of the application as originally filed. Accordingly, the amendments do not contravene the requirements of Article 123(2) EPC.

4.7 Moreover, in the circumstances of the present case, the expression "as claimed in any preceding claim" has to be read meaningfully by the skilled person, and in principle it allows a combination with any previous claim, and naturally also with claim 1.

Furthermore, the restriction to suspensions does not mean that all the examples have to relate to suspensions in order to be allowable under Article 123(2) EPC. The fact that solutions were also exemplified should not deprive the appellant from the right to limitation of the subject-matter claimed.

4.8 Therefore the Board concludes that the amended sets of claims of the auxiliary requests 2 to 4 are allowable under Article 123(2) EPC.

4.9 Finally, the amended sets of claims of the auxiliary requests 2 to 4 meet the requirements of Article 123(3) EPC since the claims relate to restrictions of the subject-matter claimed in the granted patent.

5. Remittal to the department of first instance

Article 100(b) was stated and substantiated as a ground of opposition. During the oral proceedings before the Board, respondent opponent 1 raised an objection under Article 83 EPC since the claims were restricted to suspensions. In particular, respondent opponent 1 argued that the description did not give any information on how to put in suspension Beclomethasone, listed in claim 1, in the presence of ethanol.

Furthermore, the appellant had requested remittal of the case in order not to be deprived of the right to have the issues assessed by two instances.

The Board considers that although Article 111(1) EPC does not guarantee a general right to have all issues in a case considered by two instances, that may be appropriate as regards essential issues.

In the present case, only the novelty of the claims as granted was examined by the opposition division. Moreover, the objection concerning Article 83 EPC mentioned above was raised for the first time in relation to the newly filed claims. Therefore, in the Board's view, it appears appropriate to remit the case to the opposition division for further prosecution.

Questioned by the Board, the respondents did not disagree with the remittal.

In these circumstances, the Board makes use of its discretionary power under Article 111(1) EPC to remit the case to the opposition division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the auxiliary requests 2 to 4.

The Registrar:

The Chairman:

A. Townend

U. Oswald