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**Datasheet for the decision
of 22 June 2021**

Case Number: T 0486/17 - 3.3.02

Application Number: 08732176.6

Publication Number: 2125824

IPC: C07D489/08, A61K31/485

Language of the proceedings: EN

Title of invention:

IMPROVED PREPARATION OF OXYMORPHONE FROM ORIPAVINE

Patent Proprietor:

Mallinckrodt LLC

Opponents:

JOHNSON MATTHEY PUBLIC LIMITED COMPANY
Garberg, Morten

Headword:

Relevant legal provisions:

Keyword:

Main request - withdrawn - no objections to the subject-matter
of the first auxiliary request

Decisions cited:

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0486/17 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 22 June 2021

Appellant: JOHNSON MATTHEY PUBLIC LIMITED COMPANY
(Opponent 1) 25 Farringdon Street
London EC4A 4AB (GB)

Representative: Lawrie IP Limited
310 St. Vincent Street
Glasgow G2 5RG (GB)

Respondent: Mallinckrodt LLC
(Patent Proprietor) 675 McDonnell Boulevard
Hazelwood, MO 63042 (US)

Representative: Jones, Nicholas Andrew
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4 More London Riverside
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Party as of right: Garberg, Morten
(Opponent 2) c/o Hofmann Eitle
Arabellastrasse 4
81925 München (DE)

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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
20 December 2016 concerning maintenance of the
European Patent No. 2125824 in amended form.

Composition of the Board:

Chairman	M. O. Müller
Members:	P. O'Sullivan
	E. Mille

Summary of Facts and Submissions

- I. The appeal of opponent 1 (hereinafter appellant) lies from the decision of the opposition division according to which European patent 2 125 824 in amended form met the requirements of the EPC.
- II. Two notices of opposition were filed against the patent, invoking Article 100(a) (lack of novelty and inventive step) and 100(b) EPC.
- III. With a communication pursuant to Article 15(1) RPBA the board set out its preliminary opinion. In particular the board set out the opinion that the subject-matter of claim 1 of the main request lacked novelty.
- IV. Oral proceedings were held on 22 June 2021. During oral proceedings the appellant stated that it had no objection to the set of claims according to the first auxiliary request. The respondent, in turn, withdrew the set of claims of the main request according to its written requests, corresponding to the set of claims found allowable by the opposition division.
- V. Final Requests

The appellant requests the right to comment on the first to sixth auxiliary requests filed by the respondent.

The respondent requests that the patent be maintained on the basis of the set of claims of the first auxiliary request filed with the reply to the statement setting out the grounds of appeal or on the basis of the set of claims of one of the second to sixth

auxiliary requests filed with the letter dated 24 March 2021.

Opponent 2 is party as of right in the present proceedings, and did not file any written submissions in appeal.

VI. The sole independent claim 1 of the first auxiliary request reads as follows:

"1. A method for producing oxymorphone comprising:

a) oxidizing oripavine with a peroxyacid RCO_3H , wherein R is H, an alkyl group or an aryl group, to form 14-hydroxymorphinone and 14-hydroxymorphinone N-oxide;

b) neutralising an excess portion of the peroxyacid with a neutralizing agent, wherein the excess portion of the peroxyacid is peroxyacid that does not react with the oripavine; and

c) catalytically hydrogenating the 14-hydroxymorphinone and 14-hydroxymorphinone N-oxide with a reducing agent to form oxymorphone,

wherein the reducing agent is hydrogen in the presence of a transition metal catalyst."

Reasons for the Decision

First auxiliary request - Allowability

1. The appellant stated that it had no objections against the subject-matter of claims 1-7. The board also sees no reason to doubt the allowability of the claimed subject-matter.

In consequence, the set of claims of the first auxiliary request is allowable.

Order

For these reasons it is decided that:

The decision under appeal is set aside. The case is remitted to the opposition division with the order to maintain the patent with the following claims and a description to be adapted thereto:

Claims 1-7 of the first auxiliary request filed with the reply to the statement setting out the grounds of appeal.

The Registrar:

The Chairman:



N. Maslin

M. O. Müller

Decision electronically authenticated