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Case Number: T 1160/18 - 3.3.07

Application Number: 14172398.1

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IPC: A61K9/20, A61K9/50

Language of the proceedings: EN

Title of invention:
Controlled release pharmaceutical compositions comprising a fumaric acid ester

Patent Proprietor:
FWP IP APS

Opponents:
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Generics [UK] Limited
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Headword:
Controlled release pharmaceutical compositions comprising a fumaric acid ester/FWP IP APS

Relevant legal provisions:
EPC Art. 76(1)
RPBA Art. 12(4)

Keyword:
All requests - Basis in the parent application (No)
Admission of auxiliary requests 2A, 5A-7A, 9A-12A (Yes)

Decisions cited:
T 0449/90, T 2237/10, T 1420/11

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 1160/18 - 3.3.07

D E C I S I O N
of Technical Board of Appeal 3.3.07
of 6 September 2021

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 22 March 2018 revoking European patent No. 2801355 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman A. Usuelli
Members: D. Boulois
A. Jimenez

Summary of Facts and Submissions

I. European patent No. 2 801 355 was granted on the basis of a set of 10 claims.

Independent claim 1 as granted read as follows:

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethylfumarate as the active substance, wherein the composition is provided with an enteric coating wherein the daily dosage is from 480 to 720 mg active substance given in one to three doses for use in the treatment of psoriatic arthritis, neurodermatitis, inflammatory bowel disease, or an autoimmune disease."

II. Eleven oppositions were filed against the patent on the grounds that its subject-matter lacked novelty and inventive step, was not sufficiently disclosed and extended beyond the content of the application as filed.

III. The appeal lies from the decision of the opposition division to revoke the patent. The decision was based on 33 sets of claims, namely the main request as filed with letter of 29 November 2017, auxiliary requests 1-4 filed during the oral proceedings of 29 January 2018, and auxiliary requests 5-32 filed as auxiliary requests 1-28 with letter of 29 November 2017.

IV. According to the decision under appeal, none of the requests met the requirements of Articles 76(1) and 123(2) EPC, in view of the multiple selections necessary to arrive at the claimed subject-matter.

V. The patent proprietor (hereinafter the appellant) filed an appeal against said decision. With the statement setting out the grounds of appeal dated 1st August 2018 the appellant submitted a main request, auxiliary requests 1-28 and 2A, 3A, 4A, 5A, 6A, 9A, 10A, 11A, 12A and the following items of evidence:

Annex – Overview of the examples
HBP 14 – Expert Report of Professor Clive Page

Independent claim 1 of the following requests read as follows, difference(s) compared with claim 1 as granted being shown in bold:

Main request

Independent claim 1 of the main request read as follows, difference(s) compared with claim 1 as granted being shown in bold:

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethylfumarate as the active substance, wherein the composition is provided with an enteric coating wherein the daily dosage is **480 mg** active substance given in one to three doses for use in the treatment of psoriatic arthritis, neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from
i. polyarthritis
ii. multiple sclerosis (MS)
iii. juvenile-onset diabetes mellitus
iv. Hashimoto's thyroiditis
v. Grave's disease
vi. SLE (systemic lupus erythematosus)
vii. Sjögren's syndrome

viii. pernicious anemia
ix. chronic active (lupoid) hepatitis
x. rheumatoid arthritis (RA)
xi. optic neuritis.".

Independent claim 1 of auxiliary requests 13-28 read as follows, difference(s) compared with claim 1 of the main request being shown in **bold**:

Auxiliary request 13

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by some limitations in the list of autoimmune disease, namely:

"...an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anemia
viii. chronic active (lupoid) hepatitis
~~**x.rheumatoid arthritis (RA)**~~
ix optic neuritis.".

Auxiliary request 14

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by a limitation in the list of diseases, namely:

"...for use in the treatment of ~~**psoriatic arthritis,**~~ neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjögren's syndrome
vii. pernicious anemia
Viii. chronic active (lupoid) hepatitis
~~**x. rheumatoid arthritis (RA)**~~
xi. optic neuritis.".

Auxiliary request 15

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by a limitation of the autoimmune disease and by a further amendment, namely:

"...an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anemia
viii. chronic active (lupoid) hepatitis
~~**x.rheumatoid arthritis (RA)**~~
ix optic neuritis;
wherein the composition includes a diffusion-controlled drug delivery system, an osmotic pressure controlled

drug delivery system, or an erodible drug delivery system.".

Auxiliary request 16

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by a limitation of the autoimmune disease and by the addition of a further feature, namely:

"...an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anemia
viii. chronic active (lupoid) hepatitis
~~**x.rheumatoid arthritis (RA)**~~
ix optic neuritis;
wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a rotating basket for a capsule and a paddle dissolution apparatus for a tablet - is as follows:
within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and,

within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released."

Auxiliary request 17

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by a limitation of the autoimmune disease and by a further amendment, namely:

"...an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anemia
viii. chronic active (lupoid) hepatitis
ix. optic neuritis;
~~**x.rheumatoid arthritis (RA)**~~
wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules,
wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%,
and wherein the tablet is enteric coated.".

Auxiliary request 18

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by a limitation of the autoimmune disease and by a further amendment, namely:

"...an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anemia
viii. chronic active (lupoid) hepatitis
~~**x.rheumatoid arthritis (RA)**~~
ix. optic neuritis;
wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules,
wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%,
and wherein the tablet is enteric coated;
wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a paddle dissolution apparatus for a tablet - is as follows:

**within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and,
within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released.".**

Auxiliary request 19

In comparison to claim 1 of the main request, claim 1 of this request has been further restricted by a limitation of the autoimmune disease and by a further amendment, namely:

"...an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Grave's disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anemia
viii. chronic active (lupoid) hepatitis
~~**x.rheumatoid arthritis (RA)**~~
ix. optic neuritis;
**wherein the pharmaceutical composition is in the form of a tablet obtained by a process comprising the following steps:
a) granulating a mixture of 50 g dimethyl fumarate with 12 g ethylcellulose and 3 g polyethylene glycol 400 dissolved in 150 ml ethanol 96 %, passing the granulate through a 1.0 mm sieve, drying at 50°C to 60°C over 30 min and repeating passing of the granulate through a 1.0 mm sieve to obtain a DMF-granulate;**

b) granulating a mixture of lactose and microcrystalline cellulose in equal shares with 2 % povidone dissolved in water, passing the granulate through a 1.0 mm sieve, drying at 50°C to 60°C over 30 min and repeating passing of the granulate through a 1.0 mm sieve to obtain a placebo granulate;

c) mixing 60 parts of the DMF-granulate produced according to step a) with38 parts of the placebo-granulate produced according to step b) for 30minutes in a mixer; and adding one part colloidal silicon dioxide and one part magnesium stearate and mixing the blend for 5 minutes;
or
mixing 60 parts of the DMF-granulate produced according to step a) with 37parts of the placebo-granulate produced according to step b) for 30 minute sin a mixer; and adding one part carboxymethylcellulose, one part colloidal silicon dioxide and one part magnesium stearate and mixing the blend for 5 10 minutes;
d) compressing the blend to obtain tablets with a diameter of 10 mm. a weight of 260 mg and a hardness of about 50 N; and
e) providing the tablets produced according to step d) with an enteric coating.".

Auxiliary request 20

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethylfumarate as the active substance, wherein the composition is provided with an enteric coating **wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg substance ~~wherein the daily dosage is 480 mg active substance given in one to three doses~~** for use in the treatment of psoriatic arthritis,

neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from

~~**i. polyarthritis**~~

i. multiple sclerosis (MS)

ii. juvenile-onset diabetes mellitus

iii. Hashimoto's thyroiditis

iv. Grave's disease

v. SLE (systemic lupus erythematosus)

vi. Sjögren's syndrome

vii. pernicious anemia

viii. chronic active (lupoid) hepatitis

~~**x. rheumatoid arthritis (RA)**~~

ix. optic neuritis.".

Auxiliary request 21

In comparison to claim 1 of auxiliary request 20, claim 1 of auxiliary request 21 has been further restricted by the suppression of "**psoriatic arthritis**" as disease to be treated, namely "...for use in the treatment of ~~**psoriatic arthritis,**~~ neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from...".

Auxiliary request 22

In comparison to claim 1 of auxiliary request 20, claim 1 of auxiliary request 22 has been further amended by the introduction of the following feature: "...**wherein the composition includes a diffusion-controlled drug delivery system, an osmotic pressure controlled drug delivery system, or an erodible drug delivery system**".

Auxiliary request 23

In comparison to claim 1 of auxiliary request 20, claim 1 of auxiliary request 23 has been further amended by the introduction of the following feature: "...**wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a rotating basket for a capsule and a paddle dissolution apparatus for a tablet - is as follows: within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and, within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released.**"

Auxiliary request 24

In comparison to claim 1 of auxiliary request 20, claim 1 of auxiliary request 24 has been further amended by the introduction of the following feature: "...**wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules, wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%, and wherein the tablet is enteric coated**".

Auxiliary request 25

In comparison to claim 1 of auxiliary request 20, claim 1 of auxiliary request 25 has been further amended by

the introduction of the following feature: "...**wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules, wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%, and wherein the tablet is enteric coated; wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a paddle dissolution apparatus for a tablet - is as follows: within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and, within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released.**"

Auxiliary request 26

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethylfumarate as the active substance, wherein the composition is provided with an enteric coating **wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg substance ~~wherein the daily dosage is 480 mg active substance given in one to three doses~~** for use in the treatment **~~of psoriatic arthritis,~~**

~~**neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from**~~
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
~~**iii. juvenile-onset diabetes mellitus**~~
~~**iv. Hashimoto's thyroiditis**~~
~~**v. Grave's disease**~~
~~**vi. SLE (systemic lupus erythematosus)**~~
~~**vii. Sjögren's syndrome**~~
~~**viii. pernicious anemia**~~
~~**ix. chronic active (lupoid) hepatitis**~~
~~**x. rheumatoid arthritis (RA)**~~
~~**xi. optic neuritis."**~~

Auxiliary request 27

In comparison to claim 1 of auxiliary request 26, claim 1 of auxiliary request 27 has been further amended by the introduction of the following feature: "...**wherein the composition includes a diffusion-controlled drug delivery system, an osmotic pressure controlled drug delivery system, or an erodible drug delivery system**".

Auxiliary request 28

In comparison to claim 1 of auxiliary request 26, claim 1 of auxiliary request 28 has been further amended by the introduction of the following feature: "...**wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm**

using a rotating basket for a capsule and a paddle dissolution apparatus for a tablet - is as follows: within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and, within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released."

VI. A communication from the Board, dated 17 January 2020, was sent to the parties. In it the Board expressed its preliminary opinion and stated *inter alia* that the main request did not meet the requirements of Article 76(1) EPC.

VII. With a letter dated 5 May 2020, the appellant filed new auxiliary requests 1-12 and 1A, 2A, 5A-7A, 9A-12A (corresponding respectively to auxiliary requests 3A, 10A, 9A, 11A, 12A, 2A, 4A-6A filed with letter of 1 August 2018).

The subject-matter of claim 1 of the auxiliary requests 1-12 read as follows, the difference with respect to claim 1 of the main request being indicated in **bold.**

Auxiliary requests 1

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethyl fumarate as the active substance, wherein the composition is provided with an enteric coating, wherein the daily dosage is 480 mg active substance given in one to three doses, for use in the treatment of psoriatic arthritis, neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from

i. polyarthritis
ii. multiple sclerosis (MS)
iii. juvenile-onset diabetes mellitus
iv. Hashimoto's thyroiditis
v. Graves' disease
vi. SLE (systemic lupus erythematosus)
vii. Sjogren's syndrome
viii. pernicious anemia
ix. chronic active (lupoid) hepatitis
x. rheumatoid arthritis (RA)
xi. optic neuritis^
wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a rotating basket for a capsule and a paddle dissolution apparatus for a tablet - is as follows:
within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and,
within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released."

Auxiliary request 2

"1.A pH controlled release pharmaceutical composition for oral use which consists of dimethyl fumarate as the active substance, wherein the composition is provided with an enteric coating, **wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance ~~wherein the~~**

~~**amount in a dosage form is 480 mg active subsatnce given in one to three doses,**~~ for use in the treatment of psoriatic arthritis, neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from
i. polyarthritis
ii. multiple sclerosis (MS)
iii. juvenile-onset diabetes mellitus
iv. Hashimoto's thyroiditis
v. Graves' disease
vi. SLE (systemic lupus erythematosus)
vii. Sjogren's syndrome
viii. pernicious anemia
ix. chronic active (lupoid) hepatitis
x. rheumatoid arthritis (RA)
xi. optic neuritis;
wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a rotating basket for a capsule and a paddle dissolution apparatus for a tablet - is as follows:
within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and, within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released."

Auxiliary request 3

The subject-matter of claim 1 of auxiliary request 3 differs from claim 1 of the main request only through

the dosage regimen, namely "...**wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance...**".

Auxiliary request 4

The subject-matter of claim 1 of auxiliary request 4 differs from claim 1 of the main request by the dosage regimen, namely "...**wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance...**" and by the suppression of "**i. polyarthritis**" from the list of autoimmune diseases.

Auxiliary request 5

The subject-matter of claim 1 of auxiliary request 5 differs from claim 1 of the main request by the dosage regimen, namely "...**wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance...**" and by the addition of the feature "...**wherein the composition includes a diffusion-controlled drug delivery system, an osmotic pressure controlled drug delivery system, or an erodible drug delivery system**".

Auxiliary request 6

The subject-matter of claim 1 of auxiliary request 6 differs from claim 1 of the main request in the definition of the dosage regimen, namely "...**wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance...**" and by the addition of the feature "...**wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on**

granules, wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%, and wherein the tablet is enteric coated".

Auxiliary request 7

The subject-matter of claim 1 of auxiliary request 7 differs from claim 1 of the main request in the definition of dosage regimen, namely "**...wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance...**" and by the addition of the features:
- "**...wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules, wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%, and wherein the tablet is enteric coated...**", and
- "**wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a paddle dissolution apparatus for a tablet - is as follows:**
within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and,

within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released."

Auxiliary request 8

The subject-matter of claim 1 of auxiliary request 8 differs from claim 1 of the main request in the suppression of psoriatic arthritis and polyarthritis as diseases to be treated:

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethyl fumarate as the active substance, wherein the composition is provided with an enteric coating, wherein the daily dosage is 480 mg active substance given in one to three doses, for use in the treatment of ~~**psoriatic arthritis,**~~ neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from
~~**i. polyarthritis**~~
i. multiple sclerosis (MS)
ii. juvenile-onset diabetes mellitus
iii. Hashimoto's thyroiditis
iv. Graves' disease
v. SLE (systemic lupus erythematosus)
vi. Sjogren's syndrome
vii. pernicious anaemia
viii. chronic active (lupoid) hepatitis
ix. rheumatoid arthritis (RA)
x. optic neuritis."

Auxiliary request 9

The subject-matter of claim 1 of auxiliary request 9 differs from claim 1 of the main request in the addition of the feature "...**wherein the composition**

includes a diffusion-controlled drug delivery system, an osmotic pressure controlled drug delivery system, or an erodible drug delivery system".

Auxiliary request 10

The subject-matter of claim 1 of auxiliary request 10 differs from claim 1 of the main request in the addition of the features **"...wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules, wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%, and wherein the tablet is enteric coated",**

Auxiliary request 11

The subject-matter of claim 1 of auxiliary request 11 differs from claim 1 of the main request in the addition of the features:
- **"...wherein the pH controlled release pharmaceutical composition is in the form of a tablet based on granules, wherein the granules are prepared by mixing and granulating the active substance at a concentration of 10 to 90% with ethylcellulose at a concentration between 2 to 40% and polyethylene glycol (PEG) at a concentration of 1 to 40%, and wherein the tablet is enteric coated;..."** and
- **"...wherein the release of dimethyl fumarate - when subjected to an in vitro dissolution test employing 0.1 N hydrochloric acid as dissolution medium during the first 2 hours of the test and then 0.05 M phosphate buffer pH 6.5 as dissolution medium, wherein the dissolution profile is determined as described in the**

United States Pharmacopoeia at 37°C and a rotation speed of 100 rpm using a paddle dissolution apparatus for a tablet - is as follows:
within the first 3 hours after start of the test at the most 70% w/w of the total amount of dimethyl fumarate contained in the composition is released, and,
within the first 4 hours after start of the test at the most 92% w/w of the total amount of dimethyl fumarate contained in the composition is released."

Auxiliary request 12

The subject-matter of claim 1 of auxiliary request 12 differs from claim 1 of the main request in the addition of the features:
"...wherein the pharmaceutical composition is in the form of a tablet obtained by a process comprising the following steps:
a) granulating a mixture of 50 g dimethyl fumarate with 12 g ethylcellulose and 3 g polyethylene glycol 400 dissolved in 150 ml ethanol 96 %, passing the granulate through a 1.0 mm sieve, drying at 50°C to 60°C over 30 min and repeating passing of the granulate through a 1.0 mm sieve to obtain a DMF-granulate;
b) granulating a mixture of lactose and microcrystalline cellulose in equal shares with 2 % povidone dissolved in water, passing the granulate through a 1.0 mm sieve, drying at 50°C to 60°C over 30 min and repeating passing of the granulate through a 1.0 mm sieve to obtain a placebo granulate;
c) mixing 60 parts of the DMF-granulate produced according to step a) with38 parts of the placebo-granulate produced according to step b) for 30minutes in a mixer, and adding one part colloidal silicon dioxide and one part magnesium stearate and mixing the blend for 5 minutes,

or
mixing 60 parts of the DMF-granulate produced according to step a) with 37parts of the placebo-granulate produced according to step b) for 30 minutesin a mixer, and adding one part carboxymethylcellulose, one part colloidal silicon dioxide and one part magnesium stearate and mixing the blend for 5 10 minutes,
d) compressing the blend to obtain tablets with a diameter of 10 mm, a weight of 260 mg and a hardness of about 50 N, and
e) providing the tablets produced according to step d) with an enteric coating."

The subject-matter of claim 1 of all auxiliary requests 1A, 2A, 5A-7A, 9A-12A differed from claim 1 of the corresponding numbered auxiliary requests 1, 2, 5-7, 9-12, in the addition of the feature "psoriasis", namely "for use in the treatment of **psoriasis**, psoriatic arthritis, neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from...".

VIII. Oral proceedings took place on 6 September 2021 by videoconference.

IX. The arguments of the appellant may be summarised as follows:

Main request - Article 76(1) EPC

With regard to the daily dosage (feature (d) of claim 1), it was disclosed in the passage at page 36, lines 13-23, of the parent application. This passage presented the information on possible daily dosages in the form of a limited number of ranges defined by specific end points, among them 480 mg. According to

the established case law, end points of ranges were explicitly disclosed. Moreover, the claims as filed contained a pointer to a daily dosage of 480 mg, which was achieved by administration of 240 mg twice daily. In particular, this followed from claims 27, 30, 32, 33 and 37 from the parent application. Also, from the fact that a claim was directed to this specific dosage, it was clear that this dosage was a preferred embodiment and therefore did not constitute a selection.

With regard to the list of diseases to be treated (feature (e) of claim 1), the original claims 44 and 45 contained the same list of diseases, and the original description also referred to these same diseases. In the description, however, the diseases were split into two groups. A first group to be found at pages 37-38 of the parent application, where the only difference between the conditions referred to in the present claim and the disclosure in the indicated passage was the deletion of one condition, namely psoriasis. The deletion of this condition could not lead to singling out of any subject-matter. The second group of diseases were referred to at page 38, which group was not recited in the present claim. Omitting these conditions from the claim did not amount to selecting any specific condition. The list of conditions remained generic. It had a reduced size, which was not objectionable. The possibility of deleting members from lists was also in line with the considerations of the Enlarged Board in G 2/10 in the context of disclaiming subject-matter. It was further noted that the primary focus of the invention was the treatment of autoimmune, inflammatory, or hyperproliferative conditions. The conditions according to the second group would not have been classified as autoimmune, inflammatory, or hyperproliferative conditions *per se*, as confirmed by

Professor Page in HBP 14. Thus, the treatment of the conditions of the second group was a less preferred aspect of the original disclosure. The present claim related to the more preferred aspect.

With regard to the combination of features, the treatment of the conditions was by administering the compositions to patients at a daily dosage of the active substance. The skilled person would read information on conditions and on dosing in combination, and understand that in the passage at page 36, lines 16 to 23, of the parent application, a daily dosage of 480 mg DMF given in one to three doses was explicitly disclosed as an alternative dosage for the whole range of conditions. There was nothing in the parent application which would link particular daily dosages to particular conditions. To the contrary, the skilled person would have concluded that patients would benefit from a systemic therapy using dimethylfumarate at the same labelled dose independent of the specific disease. An additional pointer was provided by original claims 44 and 45, which referred to claims 1 to 43 and thus also to claims 27, 32, and 37. The original claims supported the treatment of all conditions, including those referred to in the present claim, by two times 240 mg daily, i.e a daily dosage of 480 mg dimethylfumarate.

Admission of auxiliary requests 1A, 2A, 5A-7A, 9A, 10A-12A into the proceedings

In all these requests, the term "psoriasis" was reintroduced in claim 1. This change did not create a new case.

Auxiliary requests 1 and 1A- Article 76(1) EPC

The same arguments submitted for the man request applied to these requests.

Auxiliary request 2 - Article 76(1) EPC

The claim according to auxiliary request 2 differed from the claim according to auxiliary request 1 with respect to the dosing feature, and required that the composition was for administration twice daily and the amount in a dosage form was 240 mg active substance. The amended feature of twice daily followed from the combination of original claims 30, 32, and the amount in a dosage form of 240 mg active substance followed from original claims 33 and 37. Finally, the diseases to be treated followed from original claim 45, as discussed. Combining original claims to define a narrower claim was common practice and supported by the case law.

The further auxiliary requests- Article 76(1) EPC

The claim according to auxiliary requests 3, 4, 5, 5A, 6, 6A, 7, 7A contained the dosing feature also present in the claim of auxiliary request 2. The same arguments applied to all auxiliary requests.

X. The arguments of the respondents may be summarised as follows:

Main request - Article 76(1) EPC

According to respondent 01, the claimed dosage regimen constituted a selection, since none the disclosed small ranges was identified as being preferred, and its

selection alone violated the requirements of Article 76(1) EPC. The dosage regimen depended also on the disease to be treated. Moreover, the diseases to be treated constituted a further selection, in view of the omission of some diseases from original claims 44 and 45 or from the description. The combination of these features lacked a direct and unambiguous disclosure in the parent application.

Respondents 03, 04, 05, 10, 11 essentially submitted the same arguments.

Admission of auxiliary requests 1A, 2A, 5A-7A, 9A, 10A-12A into the proceedings

According to respondent 01, by not submitting these requests in opposition proceedings, the appellant prevented the opposition division to take a decision on said requests. These requests should therefore not be admitted.

Respondent 05 considered that none of said requests would overcome the deficiencies of the main request, and should accordingly not be admitted.

Respondent 10 added that the appellant should not have been able to present a new case on appeal with a scope of claims which it had the opportunity to present during opposition proceedings.

Respondent 11 considered also that it should not be admitted to open a discussion that should have taken place in opposition proceedings.

Auxiliary requests 1 and 1A- Article 76(1) EPC

The same arguments submitted in relation to the main request applied to these requests.

Auxiliary request 2 - Article 76(1) EPC

According to respondent 01, all dosage regimen which were present in the original claims were equally ranking. The new dosage regimen of "240 mg" was an arbitrary selection of the subject-matter of original claim 37. The same arguments applied for "twice daily" which originated from claim 32. There was no pointer for these selections and their combination and there were no convergent lists of preference which could have justified these selections.

Respondent 03 pointed furthermore out that the original claims 44 and 45 relating to the diseases, comprised the term "any one of" the previous claims and did refer not to a specific dosage regimen.

Respondents 5 and 10 argued that the claimed dosage regimen and the claimed diseases originated from multiple options which had the same level of preference, and that there was not any combination which could be singled out in comparison to the other combinations.

The further auxiliary requests- Article 76(1) EPC

The same arguments submitted for the main request and for auxiliary request 2 applied to the remaining requests.

XI. Requests

The appellant requested that the decision under appeal be set aside and the patent be maintained according to the set of claims filed as main request with the statement of grounds of appeal on 1 August 2018, or alternatively on the basis of one of auxiliary requests 1-12 and 1A, 2A, 5A-7A, 9A, 10A-12A filed with letter of 5 May 2020 or auxiliary requests 13-28 filed with the statement of grounds of appeal on 1 August 2018 (each "A" request immediately following the request with the corresponding number). The appellant also requested a remittal to the opposition division division for further prosecution of all issues except for basis in the parent application and the application as filed.

Respondents 01, 03, 04, 05, 10 and 11 requested that the appeal be dismissed.

The respondent 05 also requested that auxiliary requests 2A, 5A-7A, 12A filed with letter of 5 May 2020 not be admitted into the proceedings.

Respondents 01, 10 and 11 also requested that auxiliary requests 1A, 2A, 5A-7a, 9A, 10A-12A filed with letter of 5 May 2020 not be admitted into the proceedings.

The opponents 09, 06 and 07 withdrew their opposition with letters dated respectively 5 June 2018, 6 December 2018 and 16 October 2020.

The respondents 02 and 08 did not file any request nor submissions in the appeal proceedings.

Reasons for the Decision

1. Main request - Article 76(1) EPC

1.1 Claim 1 of the main requests reads:

"1. A pH controlled release pharmaceutical composition for oral use which consists of dimethylfumarate as the active substance, wherein the composition is provided with an enteric coating, wherein the daily dosage is 480 mg active substance given in one to three doses, for use in the treatment of psoriatic arthritis, neurodermatitis, inflammatory bowel disease, or an autoimmune disease selected from
i. Polyarthritis
ii. Multiple sclerosis(MS)
iii. Juvenile-onset diabetes mellitus
iv. Hashimoto's thyroiditis
v. Grave's disease
vi. SLE (systemic lupus erythematosus
vii. Sjögren's syndrome
viii. Pernicious anemia
ix. Chronic active (lupoid) hepatitis
x. Rheumatoid arthritis (RA)
xi. Optic neuritis."

Claim 1 is therefore a combination of the following main features:
a) A pH controlled release pharmaceutical composition,
b) Dimethylfumarate as the active substance,
c) The composition is provided with an enteric coating,
d) A daily dosage of 480 mg in one to three doses,
e) A list of diseases to be treated.

According to established jurisprudence, a combination of features originally disclosed in separate

embodiments or lists must emerge clearly and unambiguously from the content of the application as filed and, in case of divisional applications, also from the parent application.

1.2 With regard to feature d), namely "wherein the daily dosage is 480 mg active substance given in one to three doses", the description of the parent application (WO 2006/037342) discloses on page 36 several possibilities.

As regards the daily dosage, the passage on page 36, lines 13-23 discloses the following:
"In one aspect of the invention the daily dosage can be e.g. from 240 to 360 mg active substance given in one to three doses, in another aspect from 360 to 480 mg active substance given in one to three doses, in another aspect 480 to 600 mg active substance given in one to three doses, in another aspect 600 to 720 mg active substance given in one to three doses, in another aspect 720 to 840 mg active substance given in one to three doses, in another aspect 840 to 960 mg active substance given in one to three doses and in yet another aspect 960 to 1080 mg active substance given in one to three doses."

It emerges from this disclosure on page 36 that a daily dosage of 480 mg is explicitly given as lower value of the range of "480 to 600 mg" and as the higher value of the range "360 to 480 mg". However, even if the value of "480 mg" is directly and unambiguously disclosed, it has been selected among 8 different lower or higher values of ranges, which are non-convergent and which are presented as equally suitable ranges without any pointer towards a preferred dosage.

Such pointer for a preference can indeed not be found in any example of the parent application, and even not in the Table on pages 35-36 of the parent application which presents several possibilities of daily dosages for use in situations where an increasing dosage is required over time. A daily dose of 480 mg is given for the seventh weeks, with a specific administration of 240 mg of fumarate in the morning and 120 mg of fumarate at noon and in the evening, this among 9 different up-scaling daily dosage schedules.

There is also no further pointer for a preferred daily dosage in the original claims. Original dependent claim 30 discloses indeed a composition "for administration once, twice or three times daily", while dependent claims 33-38 mention a dosage form "from 90 mg to 360 mg" or more precisely, "90, 120, 180, 240, or 360 mg of active substance" per dosage form. Hence, the choice of a daily dosage of 480 mg on the basis of the disclosure of the claims would therefore also necessitate a selection among numerous equal possibilities.

Consequently, the feature "wherein the daily dosage is 480 mg active substance given in one to three doses" constitutes an arbitrary selection among several equally ranking possibilities.

1.3 With regard to feature e), i.e. the list of diseases to be treated, a disclosure thereof is given in claims 44 and 45 and on pages 37-39 of the parent application.

Original claims 44 and 45 referred however to claims 1-43 relating to a different subject-matter than present claim 1. Moreover, claims 44 and 45 related to a longer list of diseases, i.e "psoriasis, **psoriatic arthritis, neurodermatitis, inflammatory bowel disease,**

such as Crohn's disease and ulcerative colitis, **autoimmune diseases, such as polyarthritis, multiple sclerosis (MS), juvenile-onset diabetes mellitus, Hashimoto's thyroiditis, Grave's disease, SLE (systemic lupus erythematosus), Sjögren's syndrome, Pernicious anemia, Chronic active (lupoid) hepatitis, Rheumatoid arthritis (RA) and optic neuritis,** pain such as radicular pain, pain associated with radiculopathy, neuropathic pain or sciatica/sciatic pain, organ transplantation (prevention of rejection), sarcoidosis, necrobiosis lipoidica or granuloma annulare" from which only the part shown in bold has been taken in claim 1 of the main request.

The same conclusion applies to the disclosure of the disorders to be treated in the description (see pages 37, line 17 to page 39, line 10). Pages 37-38 give in particular the following two lists (a. to e. and 1 to 5) of disorders to be treated, with the claimed disorders shown in bold:
"The compositions and kits according to the invention are contemplated to be suitable to use in the treatment of one or more of the following conditions:
a. Psoriasis
b. **Psoriatic arthritis**
c. **Neurodermatitis**
d. **Inflammatory bowel disease,** such as
    i. Crohn's disease
    ii. Ulcerative colitis
e. **autoimmune diseases:**
    i. Polyarthritis
    ii. Multiple sclerosis (MS)
    iii. Juvenile-onset diabetes mellitus
    iv. Hashimoto's thyroiditis
    v. Grave's disease
    vi. SLE (systemic lupus erythematosus)

vii. Sjögren's syndrome
viii. Pernicious anemia
ix. Chronic active (lupoid) hepatitis
x. Rheumatoid arthritis (RA)
xi. Optic neuritis

Moreover, the novel composition or kit according to the invention may be used in the treatment of
1. Pain such as radicular pain, pain associated with radiculopathy, neuropathic pain or sciatica/sciatic pain
2. Organ transplantation (prevention of rejection)
3. Sarcoidosis
4. Necrobiosis lipoidica
5. Granuloma annulare.".

The Board cannot see in the lists given in these pages any kind of hierarchical split or subdivision between a first group of preferred disorders to be treated and forming the basis of the claimed disorders, and a second group of less preferred disorders to be treated which has been excluded from the subject-matter of claim 1 of the main request, as argued by the appellant. There is indeed nothing in the wording used in the description which would indicate a preference for a list or another. Besides, the two first paragraphs of page 39 group again the indications in a single list, as do original claims 44 and 45.

The further citation by the appellant of a passage from the part "Field of the invention" on page 1 of the description of the parent application, i.e. "the compositions are suitable for use in the treatment of e.g. psoriasis or other hyperproliferative, inflammatory or autoimmune disorders", to prove that the invention's main focus is the treatment of these specific classes of disorders is neither convincing, in

view of the non-exhaustive nature of this passage. Moreover, as also confirmed by document HBP14 (see page 4) filed by the appellant in support of this argument, most of the disorders mentioned in said second list have an inflammatory component, and cannot be excluded by the statement on page 1 of the description.

In the present case, even if there has not been a singling out from the list of disorders, the original lists of disorders to be treated has been significantly shrunk and, for this reason, cannot be considered to remain generic.

1.4 The selection of an explicitly disclosed range value or the shrinkage of a list are, as such, not contestable under Article 76(1) EPC. However, the combination of the features resulting from these limitations must emerge directly and unambiguously from the content of the parent application. This can occur in particular, in the presence of a pointer to choose exactly such a combination of features. For instance, said features might have been disclosed in combination in one or more examples of the parent application.

In the present case, there is nothing like this. The claimed daily dosage of "480 mg" is indeed an arbitrary selection among several equally ranking limits of ranges of daily dosages, and the claimed disorders to be treated result from an arbitrary limitation of the list of original disorders to be treated. Thus, claim 1 is based on a new particular combination of features which cannot be derived directly and unambiguously from the parent application.

1.5 Consequently, the main request does not meet the requirements of Article 76(1) EPC.

2. Admission of auxiliary requests 1A, 2A, 5A-7A, 9A-12A into the proceedings

Auxiliary requests 1A, 2A, 5A-7A, 9A-12A, have been filed after the Board has issued its preliminary opinion, and correspond respectively to auxiliary requests 3A, 10A, 9A, 11A, 12A, 2A, 4A, 5A, 6A filed with the statement of grounds of appeal, hence at the earliest stage of the appeal proceedings. They differ from the corresponding auxiliary requests 1, 2, 5-7, 9-12 in the addition of the feature "psoriasis" in claim 1.

In the opposition proceedings, the patent proprietor considered in particular that a single deletion in a list of diseases could not infringe Articles 76(1) EPC or 123(2) EPC. The feature "psoriasis" was indeed comprised in the list of first diseases mentioned in the description, and its reintroduction addresses directly the opposition division's conclusion that the conditions defined in the main request constituted a selection.

The Board is furthermore not convinced that the respondent should have filed these requests already before the opposition division.

Accordingly, the Board decides to take these auxiliary requests into account in the appeal proceedings (Article 12(4) RPBA 2007).

3. Auxiliary requests 1 and 1A - Article 76(1) EPC

The subject-matter of claim 1 of auxiliary request 1 is similar to claim 1 of the main request with the further

addition of a feature defining an *in vitro* release profile. As for the main request, the combination of the features d), a daily dosage of 480 mg in one to three doses and e), a list of diseases to be treated, constitutes a new combination which cannot be derived directly and unambiguously from the parent application.

The subject-matter of claim 1 of auxiliary request 1A comprises the addition of "psoriasis" as a disorder to be treated. The conclusions as to the requirements of Article 76(1) EPC remain unchanged by the reintroduction of psoriasis in the list of therapeutic disorders, as multiple selections are still required to arrive at the subject-matter of claim 1.

Consequently, auxiliary requests 1 and 1A do not meet the requirements of Article 76(1) EPC.

4. Auxiliary request 2 - Article 76(1) EPC

4.1 The subject-matter of claim 1 of auxiliary request 2 comprises the feature "**wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance**" instead of "wherein the amount in a dosage form is 480 mg active substance given in one to three doses".

According to the appellant, the basis for claim 1 with regard to the amount in the dosage form and the diseases to be treated could be found in claims 30, 32, 37 and 44 of the parent application.

4.2 The Board notes that the amount in the dosage form is also mentioned in the description on page 36, lines 6-12: "the amount of... in a dosage form is from 90 mg to 360 mg active substance, such as 90, 120, 180, 240

or 360 mg active substance, is provided. In a further aspect of the invention the amount of active substance is 120, 180 or 240 mg active substance. In yet a further aspect of the invention, the amount of active substance is 180 or 360 mg.". In this disclosure, the claimed amount of 240 mg constitutes a selection among several possibilities and is never disclosed in combination with an administration twice daily.

In the following passage on page 36, lines 13-23 mentioned under point 1.2 above, an amount of 240 mg given twice daily might only be the result of a selection among several possibilities.

Consequently, the feature "**wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance**" is not derivable directly and unambiguously from the description of the parent application.

4.3 With regard to the original claims, claims 30-37 of the parent application read:

"30. The controlled release composition according to any one of the preceding claims for administration **once**, **twice** or **three times daily**.
31. The controlled release composition according to claim 30 for administration **once daily**.
32. The controlled release composition according to claim 30 for administration **twice daily**.
33.The controlled release pharmaceutical composition according to any one of the preceding items, wherein the amount of one or more fumaric acid esters selected from di-(C1 -C5)alkylesters of fumaric acid and mono-(C1 -C5)alkylesters of fumaric acid or a

pharmaceutically acceptable salt thereof, in a dosage form is **from 90 mg to 360 mg** active substance.
34. The controlled release pharmaceutical composition according to claim 33, wherein the amount In a dosage form is **90, 120, 180, 240 or 360 mg** active substance.
35. The controlled release pharmaceutical composition according to claim 33, wherein the amount in a dosage form is **120 mg** active substance.
36. The controlled release pharmaceutical composition according to claim 33, wherein the amount in a dosage form is **180 mg** active substance.
37. The controlled release pharmaceutical composition according to claim 33, wherein the amount in a dosage form is **240 mg** active substance.
38.The controlled release pharmaceutical composition according to claim 33, wherein the amount in a dosage form is **360 mg** active substance.

It is therefore true that a twice daily administration and an amount of 240 mg in a dosage form are disclosed in the different dependent claims. These features are however not the only alternative presented in the dependent claims.

The subject-matter of claim 32, namely "for administration twice daily" is indeed an equal alternative to "three times daily" present in claim 30, and "for administration once daily" in claim 31.

The same applies to the amount in the dosage, which might be any of the equally suitable alternatives of 90, 120, 180, 240 or 360 mg active substance. The dependent claims 35-38 are furthermore non-convergent dependent claims which confirms that all amounts are considered as equal alternatives in the parent application.

There is furthermore no pointer, hint or incentive in the whole parent application towards a preference of an amount of 240 mg and an administration twice daily. There is particular no example with said amount and schedule of administration, and none of the 9 dosages schedules presented in the Table on pages 35 and 36 corresponds to this particular combination.

The features defining the daily administration are further combined with a selected list of disorders to be treated. This constitutes a new particular combination in respect of which no pointer can be found in the parent application. In this regard the Board observes that claim 44 and 45, which disclose a list of diseases which is broader than the list of diseases actually claimed in claim 1, refer back to any of the preceding claims not only to the claims defining the specific dosage administration claimed in auxiliary request 2. Accordingly, as for the main request, the combination of the feature pertaining to the daily administration with the features defining the diseases to be treated cannot be derived directly and unambiguously from the parent application. Consequently, auxiliary request 2 does not meet the requirements of Article 76(1) EPC.

4.4 The appellant cited several decisions of the jurisprudence to support its argumentation that it was possible to make a combination of dependent claims.

Hence, in the decision T 449/90, it was considered that any combination of dependent claim 15, referring back to claim 14, which in turn referred back to claims 1 to 13, with one of the foregoing claims was to be considered as having been disclosed originally (see

point 2.5). Originally filed Claims 1 to 13 related to a method for treating a composition comprising heating said composition; the feature from claim 15 introduced in claim 1, i.e a heating temperature range, did however not have any alternative in the dependent claims, which distinguishes this case from the present one.

In the decision T 2237/10 (point 4.5), the subject-matter of claim 1 resulted from the incorporation of the broadest possible definition of features from claims 19, 21, 22 and 15 as filed with one alternative out of four, from claim 20. It was considered that, by doing so, no new combinations arose since the now-claimed combination was foreseen by means of dependent claims in the application as originally filed. All the selected features of dependent claims 19, 21, 22 and 15 were however convergent and preferred alternatives. Moreover, the working examples provided an additional pointer to the combination of all these features. None of these conditions are met in the present case.

In decision T 1420/11 (see point 3), it was considered that the application as originally filed directly points to the combination of the features of original claims 1, 4 and 7. This case is also irrelevant since not presenting any alternative possibilities, and showing a pointer for the combination.

4.5 Consequently, auxiliary request 2 does not meet the requirements of Article 76(1) EPC.

5. Auxiliary request 2A, 3-5, 5A, 6, 6A, 7 and 7A - Article 76(1) EPC

Claim 1 of all these requests comprise the feature **"wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg active substance"**

Additionally, as for auxiliary request 2, claims 1 of these requests comprise a further selection of disorders to be treated, with the addition of "psoriasis" in the "A" requests. This results in a particular combination of the disease to be treated with the dosage regimen which cannot be derived directly and unambiguously from the parent application.

Consequently, these requests do not meet the requirements of Article 76(1) for the same reasons than auxiliary request 2.

6. Auxiliary request 8

The subject-matter of claim 1 of auxiliary request 8 differs from claim 1 of the main request in the suppression of **"psoriatic arthritis"** and **"polyarthritis"** as diseases to be treated, and accordingly a further restriction of the claimed list of diseases.

As for the main request, the claimed daily dosage of "480 mg active substance given in one to three doses" is a selection among several equally ranking limits of ranges of daily dosages, and the claimed disorders to be treated result from a limitation in the list of original disorders. The particular combination of daily dosage and diseases cannot be derived directly and

unambiguously from the parent application for the same reasons set out in respect to the main request. Thus, the conclusions reached for the main request as to the requirements of Article 76(1) EPC apply also to auxiliary request 8.

7. Auxiliary requests 9-12, 9A-12A - Article 76(1) EPC

In all claims 1 of auxiliary requests 9-12, the claimed daily dosage of **"480 mg active substance given in one to three doses"** is present in association with the same list of disorders as in claim 1 of the main request. Consequently, these requests do not meet the requirements of Article 76(1) EPC for the same reason than the main request.

The addition of the feature **"psoriasis"** in claim 1 of all these requests "A" has no incidence on this conclusion as multiple selections are still required to arrive at the subject-matter of claim 1. Consequently, all auxiliary requests 9A-12A do not meet the requirements of Article 76(1) EPC.

8. Auxiliary requests 13-19 - Article 76(1) EPC

All the claims 1 of these requests comprise the feature **"480 mg active substance given in one to three doses"** in association with a list of disorders to be treated. Said list of disorders has been further shrunk by the deletion of the features **"i. polyarthritis"** and **"x. rheumatoid arthritis"** in auxiliary requests 13, 14-19 and additionally by the feature **"psoriatic arthritis"** in auxiliary request 14.

Consequently, these requests do not meet the requirements of Article 76(1) EPC for the same reason than the main request.

9. Auxiliary requests 20-28

In all claims 1 of auxiliary requests 20-28, the claimed daily dosage of "wherein the composition is for administration twice daily and wherein the amount in a dosage form is 240 mg substance" is present.

Said daily dosage is claimed in combination with a list of disorders which is more restricted than the one in claim 1 of auxiliary request 2. The subject-matter of claim 1 of auxiliary request 26-28 is even restricted to the treatment of one unique disorder, i.e. "multiple sclerosis" which constitutes a singling out among the initial list, made without any pointer of preference for it. The combination of the daily dosage and the disorder(s) constitutes a combination that cannot be derived directly and unambiguously from the parent application (Article 76(1) EPC).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

L. Malécot-Grob A. Usuelli

Decision electronically authenticated