Decision

of the Court of First Instance of the Unified Patent Court
Local Division Munich
delivered on 29 October 2026

HEADNOTES:

1. The disclosure of a generic chemical structural formula in a document does not, in principle, disclose the individual compounds or more specific subclasses falling within that formula. A subject matter described in this way is generally very broad. There are numerous variants that may be covered by it. Individual compounds or more specific subclasses which are embraced by such a generic formula are only disclosed if they are directly and unambiguously derivable by a person skilled in the art from the complete teaching of the document.

2. The same applies when the generic chemical structural formula disclosed in a document contains variable groups and the description explains how the substituents can be identified, for example, by selecting elements or groups of elements from one or more lists. Such disclosure content does not necessarily encompass the more specific teaching to combine individual elements and groups of elements defined in the description. As a rule, such a document does not disclose every single technically feasible and sufficiently implementable combination of specific representatives of the variable groups.

3. Even if a patent claim is entitled to partial priority and would, in that respect, be valid in relation to the state of the art while another part of its scope remains invalid, it cannot be regarded as partially valid and upheld without the patent proprietor filing an Application to amend the patent.

CLAIMANT AND COUNTERDEFENDANT (HEREINAFTER REFERRED TO AS "ENANTA")

Enanta Pharmaceuticals, Inc., 4 Kingsbury Avenue, MA 02472, Watertown, United States of America,

represented by: Dr Dirk Schüßler-Langeheine, HOFFMANN EITLE Patent- und Rechtsanwälte Partnerschaftsgesellschaft mbB, Arabellastraße 30, 81925 Munich, Germany.

DEFENDANTS AND COUNTERCLAIMANTS (HEREINAFTER REFERRED TO AS "PFIZER")

1. **Pfizer Inc.**, 66 Hudson Boulevard East, 10001-2192, New York, United States of America,
2. **C.P. Pharmaceuticals International C.V.**, Rivium Westlaan 142, 2909 LD, Capelle aan den Ijssel, Netherlands,
3. **Pfizer Europe MA EEIG**, Boulevard de la Plaine 17, 1050, Ixelles, Belgium,
4. **Pfizer Manufacturing Deutschland GmbH**, Friedrichstraße 110, 10117 Berlin, Germany,
5. **Pfizer Italia S.r.L.**, Via Isonzo 71, 04100, Latina, Italy,
6. **Pfizer Ireland Pharmaceuticals Unlimited Company**, Operations Support Group, Cork P43 X336, Ringaskiddy, Ireland,
7. **Pfizer Corporation Austria Gesellschaft m.b.H.**, Floridsdorfer Hauptstraße 1, 1210, Wien, Austria,
8. **Pfizer nv/SA**, Boulevard de la Plaine 17, 1050, Ixelles, Belgium,
9. **Pfizer Luxembourg SARL**, 51, Avenue J.F. Kennedy, L-1855, Luxembourg, Luxembourg,
10. **Pfizer ApS**, Lautrupvang 8, 2750, Ballerup, Denmark,
11. **Pfizer Oy**, Tietokuja 4, 00330, Helsinki, Finland,
12. **Pfizer SAS**, 23-25 Avenue du Dr Lannelongue, 75014, Paris, France,
13. **Pfizer Pharma GmbH**, Friedrichstraße 110, 10117 Berlin, Germany,
14. **Pfizer S.r.L.**, Via Isonzo 71, 04100, Latina, Italy,

15. **Pfizer B.V.,** Rivium Westlaan 142, 2909 LD, Capelle aan den IJssel, Netherlands,

16. **Laboratórios Pfizer, Lda.**, Lagoas Park, Edifício 10, 2740-271, Porto Salvo, Portugal,

17. **Pfizer Romania SRL**, Şos. Bucureşti-ploieşti, Nr. 172-176, Willbrook Platinum Business and Convention Center, Cladirea B, Etaj 5, 013686, București Sectorul 1, Romania,

18. **Pfizer AB**, Solnavägen 3H, 113 63, Stockholm, Sweden,

Defendants 1 – 18 represented by: Dr Tobias Hessel, CLIFFORD CHANCE Partnerschaft mbB, Königsallee 59, 40215 Düsseldorf, Germany.

PATENT AT ISSUE

EP 4 051 265

PANEL/DIVISION

Panel 2 of the Local Division Munich

DECIDING JUDGES:

This Decision has been issued by the Presiding Judge Dr Daniel Voß, the legally qualified Judge Dr Georg Werner (Judge-rapporteur), the legally qualified Judge Rute Lopes and the technically qualified Judge Dr Rudi Goedeweeck.

LANGUAGE OF THE PROCEEDINGS:

English

SUBJECT-MATTER OF THE PROCEEDINGS

Infringement action and Counterclaim for revocation

DATE OF THE ORAL HEARING

29 September 2026

BACKGROUND AND FACTS

1 ENANTA is suing PFIZER for pre-grant use of the published application and for infringement of European Patent with Unitary Effect 4 051 265 (hereinafter referred to as "Patent in Suit") with respect to PFIZER's product Paxlovid™ and its active pharmaceutical ingredient Nirmatrelvir.

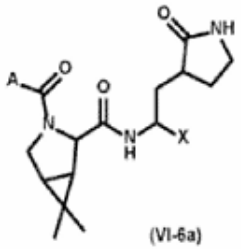
2 ENANTA is the proprietor of the Patent in Suit. It is titled "Functionalized Peptides Containing Two Pyrrolidine Rings As Anticoronavirus Agents".

3 The Patent in Suit claims priority to US provisional patent application US 2020 63 054 048 (Exhibit CC16), dated 20 July 2020. The Patent in Suit (Exhibit HE56) was filed on 19 July 2021.

4 On 19 August 2025, a request for unitary effect of the Patent in Suit was filed at the European Patent Office (EPO) pursuant to Rule 6 of the Implementing Regulations for Unitary Patent Protection (Exhibit HE8). The date of publication and mention of the grant of the patent was on 20 August 2025. The Patent in Suit is in force in all Contracting Member States of the Agreement on a Unified Patent Court.

5 Claims 1 and 2 of the Patent in Suit are as follows:

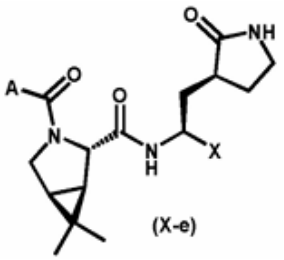
1. A compound, represented by Formula (VI-6a), or a pharmaceutically acceptable salt thereof:



(VI-6a)

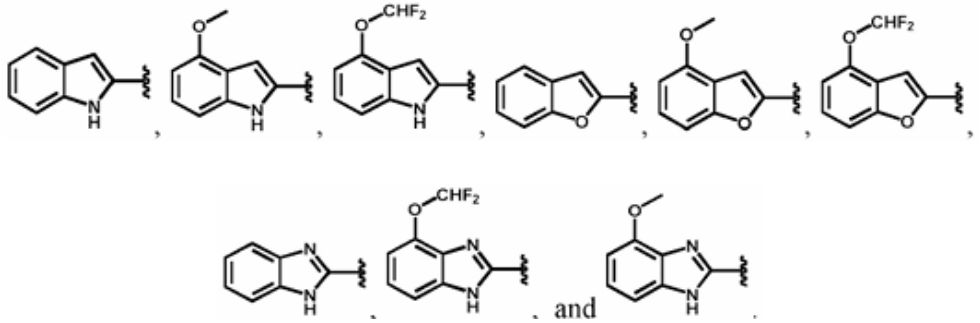
wherein X is -CN; and
Ais selected from optionally substituted -C_1-C_8 alkyl and optionally substituted heteroaryl.

2. The compound of claim 1, which is represented by Formula (X-e), or a pharmaceutically acceptable salt thereof:



(X-e)

wherein X is -CN; and A is selected from optionally substituted -C_1-C_8 alkyl and optionally substituted heteroaryl, preferably selected from the group consisting of



6 Regarding the remaining claims 3 to 5 of the Patent in Suit, reference is made to the contents of Exhibit HE56.

7 All Defendants are part of the PFIZER Group. They are cooperating in the manufacture, offering, sale, and delivery of Paxlovid™ in the territory where the Patent in Suit is in force.

8 Paxlovid™ is the brand name of PFIZER for the co-packaged medication containing oral tablets of Nirmatrelvir and Ritonavir for co-administration as a treatment for COVID-19, the disease caused by SARS-CoV-2. Nirmatrelvir acts by inhibiting the SARS-CoV-2 main protease, which the virus needs for replication, while Ritonavir is an inhibitor of the liver enzyme CYP3A, slowing down the body's metabolism of Nirmatrelvir and thereby extending, or boosting, its effect. Nirmatrelvir is the active drug substance in Paxlovid™ for the treatment of COVID-19.

9 Regarding the further facts of this case, reference is also made to the written pleadings exchanged by the parties and the Exhibits thereto.

10 The Interim Conference held by the Judge-rapporteur on 31 July 2026 was conducted as a video conference. Reference is made to the Order of 31 July 2026, which summarises the key points of the Interim Conference. Furthermore, the values of the dispute were set out in this Order.

11 Following the Interim Conference, the parties reached an agreement regarding the settlement of the parties' costs.

REQUESTS

12 ENANTA requested the Court to

I. declare that the Defendants are jointly and severally obliged to pay Claimant

1. a reasonable compensation for all acts of making, offering, placing on the market or using, or importing or storing for those purposes,

    a) compounds falling within the scope of protection of Claim 1 of the European patent EP 4 051 265,

    in particular compounds falling within the scope of protection of Claim 2 of the European patent EP 4 051 265,

    in particular Nirmatrelvir,

    and/or

    b) pharmaceutical compositions comprising any compound according to a), or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier or excipient [Claim 3 of the European patent EP 4 051 265],

    in particular Paxlovid™,

    the Defendants engaged in within the territories of

    Austria (from 31 August 2022), Belgium (from 27 September 2022), Bulgaria (from 17 October 2022), Denmark (from 13 June 2022), Estonia (from 15 June 2022), Finland (form 15 June 2022), France (from 16 September 2022), Germany (from 21 July 2022), Italy (from 9 June 2022), Latvia (from 20 August 2022), Lithuania (from 10 August 2022), Luxembourg (from 10 June 2022), Malta (from 27 January 2021), Portugal (from 6 June 2022), Romania (30 January 2023), and Sweden (from 5 July 2022)

    in the period until and including 19 August 2025; and

2. damages appropriate to the harm actually suffered by Claimant as a result of the acts described in 1. a) and/or b) above the Defendants have engaged in or will engage in, in Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Portugal, Romania, Slovenia, and Sweden since 20 August 2025;

II. order the Defendants to inform Claimant

to what extent they have engaged in the acts described in I.1. and/or I.2 above,

by providing a written list and a separate list in a computer-analyzable electronic form on

1. the origin and distribution channels of infringing products,

2. the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for infringing products;

3. the identity of any third person involved in the production or distribution of infringing products;

4. the individual deliveries, specified according to the delivery amounts, dates and prices including the product designations as well as the names and addresses of purchasers;

5. the individual offers, specified according to quantities, dates and prices offered including the product designations as well as the names and addresses of recipients of offers;

6. the advertising activities, specified according to advertising media, their distribution amount, period of distribution and territory of distribution; and

7. the production costs, specified according to individual cost factors, and the profits earned;

all of the above to be substantiated by copies of relevant documentation in electronic, searchable form, such as purchase orders and agreements, order confirmations, invoices and delivery notes and other purchase, sales and inventory documents

within four weeks after the date of service of the decision to be rendered in these proceedings on one of the Defendants;

III. order the Defendants to pay the Court a recurring penalty payment of up to EUR 100,000 for each violation of, or non-compliance with any of the orders according to II. above, as well as for each day that this violation or non-compliance continues; and

IV. order the Defendants to bear the costs of these proceedings.

13 DEFENDANTS requested that

I. European patent 4 051 265 is revoked entirely with effect to the territory of all UPC member states, i.e. Austria (AT), Belgium (BE), Bulgaria (BG), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Germany (DE), Italy (IT), Latvia (LV), Lithuania (LT), Luxembourg (LU), Malta (MT), Netherlands (NL), Portugal (PT), Romania (RO), Slovenia (SI), Sweden (SE).

II. the claimant bears the costs of the counterclaim for revocation.

III. the claimant be ordered to reimburse the costs of the counterclaim for revocation on a provisional basis (R. 150.2 RoP) in the amount of EUR 1,020,000.00.

IV. the Division orders that the infringement action is dismissed (R. 23, 24(g) RoP),

V. the Division orders the claimant to bear the costs of the infringement action,

VI. the claimant be ordered to reimburse the costs of the infringement action on a provisional basis (R. 150.2 RoP) in the amount of EUR 1,000,000.00.

14 With respect to PFIZER's Counterclaim for Revocation, ENANTA requested the Court to

I. dismiss the action in its entirety; and

II. order the Defendants to bear the costs of the proceedings.

15 ENANTA **further** requested the Court to disregard,

I. pursuant to R. 9.2 RoP, submissions contained in and/or based on Exhibits CC 25 and CC 31; and

II. pursuant to R. 263 RoP, or, in the alternative, pursuant to R. 9.2 RoP, the added matter attack raised by Defendants in Section D II. of their Reply.

POINTS AT ISSUE

16 Claimant argued that the Patent in Suit relates to inhibitors of the SARS-CoV-2 main protease and protects, for the first time, such inhibitors as represented by compounds of formula (VI-6a) in the Patent in Suit. Nirmatrelvir squarely and literally falls under this formula.

17 Defendants argued that the Patent in Suit will be found invalid. The invalidity is both due to the overly broad claims of the Patent in Suit and to the lack of novelty arising from invalid priority claims. Defendants further argued non-infringement, setting out why the asserted claims of the Patent in Suit are not infringed by the attacked embodiments even if found valid.

18 With respect to the Defendants' Counterclaim for Revocation, Claimant argued that the Patent in Suit is valid.

19 Further arguments and defences will be, to the extent relevant for this decision, discussed below.

GROUNDS FOR THE DECISION

20 The Infringement action and the Counterclaim for revocation are admissible. The Counterclaim for revocation is successful on the merits. The Infringement action is unfounded.

I. Patent in Suit and its interpretation

21 In [0002] of the description of the Patent in Suit, it is described that the technical field concerns compounds and methods for inhibiting coronavirus replication activity by contacting the 3C-Like protease with a therapeutically effective amount of a 3C-Like protease inhibitor.

22 According to the description of the Patent in Suit, coronaviruses known to infect humans include SARS-CoV and MERS-CoV, [0003] (paragraphs without a reference are those from the patent specification).

23 Coronaviruses are enveloped, positive-sense, single-stranded RNA viruses. The genomic RNA of CoVs has a 5' cap structure and 3'-poly-A tail, and contains at least 6 open reading frames (ORFs). The first ORF (ORF 1a/b) directly translates two polyproteins: pp1a and pp1ab. These polyproteins are processed by a 3C-Like protease (3CLpro), also known as the main protease (Mpro), into 16 non-structural proteins. These non-structural proteins engage in the production of subgenomic RNAs that encode four structural proteins, namely envelope, membrane, spike, and nucleocapsid proteins, among other accessory proteins. As a result, it is understood that 3C-Like protease has a critical role in the coronavirus life cycle, [0004].

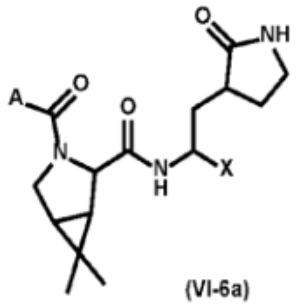
24 The description of the Patent in Suit explains that, although compounds have been reported to inhibit 3CLpro activity, they have not been approved as coronavirus therapies. (Refer to WO2018042343, WO2018023054, WO2005113580, and WO2006061714), [0005].

25 Effective therapies for coronavirus infections are needed due to this high unmet clinical need, [0006]. The Patent in Suit states that there is a need in the art for novel therapeutic agents that treat, ameliorate, or prevent coronavirus infection. Administration of these therapeutic agents to a coronavirus-infected patient, either as monotherapy or in combination with other coronavirus treatments or ancillary treatments, will lead to significantly improved prognosis, diminished progression of the disease, and enhanced seroconversion rates, [0007].

26 This need is purportedly met by the subject-matter of claims 1 to 5 of the Patent in Suit.

27 The subject-matter of claim 1 can be broken down into the following features:

1.1 A compound, represented by Formula (VI-6a), or a pharmaceutically acceptable salt thereof:



(VI-6a)

1.2 wherein X is -CN; and

1.3 wherein A is selected from

a) optionally substituted $-C_1$-C_8 alkyl and

b) optionally substituted heteroaryl.

Interpretation of Claim 1 from the perspective of the skilled person

28 Some features of claim 1 require further explanation as to how they are understood by a person skilled in the art.

29 The relevant skilled person is a medicinal chemist specialising in organic chemistry (who possesses a Ph.D. degree and several years of research experience), who has access to, or works within, a team that has additional expertise in medicine, virology, molecular modelling methods, pharmacology, and drug formulation. This definition largely corresponds to that of the parties, who (apart from minor differences) essentially define the person skilled in the art in the same way.

30 **Feature 1.1**: In Formula (VI-6a), the carbon atoms are not labelled, and hydrogen atoms linked to carbon are not shown. The person skilled in the art knows this is the typical representation of an organic compound and is generally known. Formula (VI-6a) contains two 5-membered rings (called pyrrolidine, see the title of the patent), each consisting of one nitrogen and four carbon atoms; both rings are linked by -CO-NH-CX-CH_2-. The left 5-membered ring is fused to a cyclopropane (3-membered) ring which carries two methyl (-CH_3) substituents. Contrary to the right ring, the nitrogen atom of the left ring is substituted by -CO-A, i.e. a variable group A which is linked to the ring by a carbonyl group.

31 The claimed compounds are, for instance, inhibitors of the enzyme 3C-Like protease which plays a crucial role in the replication of the coronavirus. This anti-coronal functionality, however, does not limit claims 1 and 2.

32 Since Formula (VI-6a) does not represent a specific stereoconfiguration (contrary to claim 2), it embraces all possible combinations, as confirmed by [0055] and [0096] of the Patent in Suit.

33 **Feature 1.2**: This feature narrows the scope of Formula (VI-6a) by restricting X to a nitrile (also called cyano) group, which consists of a carbon and nitrogen atom mutually linked by a triple bond (-C≡N). As a result, the claimed formula contains only one variable group A, which is further defined by feature 1.3.

34 **Feature 1.3**: This feature restricts A to a C_1-C_8 alkyl (lit. a) or a heteroaryl group (lit. b), which each may carry one or more substituents.

35 The definitions of the terms “alkyl” and “heteroaryl” in [0067] and [0065] are in line with the general knowledge of the skilled person: The term "alkyl" refers to saturated, straight- or branched-chain hydrocarbon radicals (i.e. consisting of carbon and hydrogen atoms which are all linked by single bonds only), and “C_1-C_8” means that the alkyl group contains from 1 to 8 carbon atoms, [0067]. The term "heteroaryl" refers to a mono- or polycyclic aromatic radical having one or more ring atoms (also called heteroatoms) selected from S, O, and N; and the remaining ring atoms are carbon, wherein any N or S contained within the ring may be optionally oxidized, [0065].

36 According to [0027], the A group of Formula (VI-6a) is “as previously defined”, so the examples of suitable C_1-C_8 alkyl groups disclosed in [0015] to [0019] and the heteroaryl groups in [0013] to [0014] on page 6 of the Patent in Suit (Exhibit HE56) are embodiments thereof.

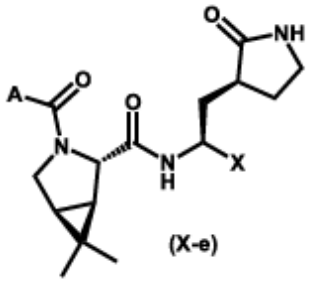
37 The definition of the term “substituted” in [0078] is in line with the general knowledge: one or more hydrogen atoms of the C_1-C_8 alkyl or the heteroaryl group are replaced by another chemical group (called “substituent”). The number of substituents is not limited (“one, two, three, or more”), while zero substituents are implied by the word “optional”.

38 [0078] also gives a very long list of possible substituents, which, however, does not reduce the scope of the term “substituted”, as it is explicitly stated that the definition is “not limited” thereto, so the optional substituent(s) of A can be any group. At the end of [0078], it is disclosed that each substituent of A may itself be substituted. That means that any substituent may be further substituted. As this is a Markush formula, the approach described is permissible despite the associated lack of specificity.

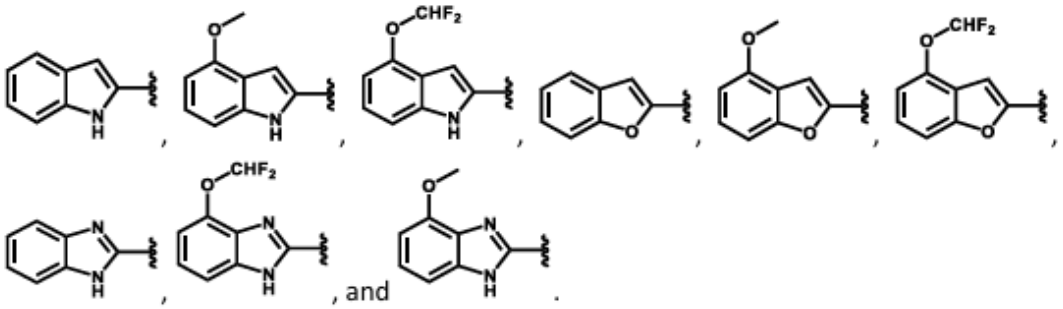
39 However, contrary to PFIZER’s view, this does not mean that the possibilities are virtually unlimited. The relevant skilled person seeking a technically reasonable interpretation will understand this to refer only to such substituents, which are generally considered reasonable and realistic. The skilled person knows that macromolecular substituents hinder the interaction with an enzyme such as the 3C-Like protease. Therefore, the skilled person does not interpret the optional substituent of group A so broadly that it would extend to such ‘exotic’ groups.

Claim 2

40 Claim 2 of the Patent in Suit is directed to a compound of claim 1, which is represented by Formula (X-e), or a pharmaceutically acceptable salt thereof:

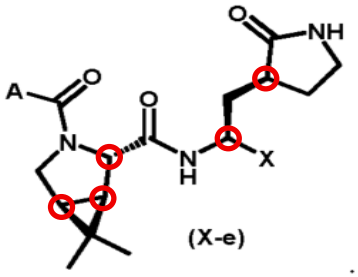


wherein X is -CN; and A is selected from optionally substituted −C1-C8 alkyl and optionally substituted heteroaryl, preferably selected from the group consisting of



41 Claim 2 differs from claim 1 in that Formula (X-e) specifies the stereochemistry of the protected compounds while Formula (VI-6a) does not.

42 Formula (X-e) represents just one specific stereoisomer, which the person skilled in the art understands as the pharmaceutically active compound. Formula (X-e) contains 5 chiral centers (marked below by red circles):



43 Each of these atoms is linked to four different atoms or groups. Groups A and X have the same meaning as in claim 1. Claim 2 further defines 9 specific embodiments of group A, but these are “preferred” and therefore not limiting the scope of protection.

Claims 3 to 5

44 Claims 3 to 5 do not require further explanation.

II. Counterclaim for Revocation

45 The Counterclaim for revocation is admissible and is successful on the merits.

46 The Patent in Suit lacks novelty (Art. 65 (2) UPCA, Art. 138 (1) lit. a), Art. 54 EPC). The asserted subject matter of the Patent in Suit's claims 1 to 5 is anticipated by the prior art. The subject matter of both documents D1 and D2 discloses all features of the asserted Patent in Suit's claims. D1 and D2 belong to the state of the art under Art. 54 EPC.

47 Contrary to ENANTA's view, the priority of US application 2020 63 054 048 (Exhibit CC16) dated 20 July 2020 cannot be validly claimed for the subject-matter of claims 1 to 5 of the Patent in Suit.

48 The relevant date for assessing the patentability of the subject-matter of claims 1 to 5 of the patent is therefore the filing date of the Patent in Suit on 19 July 2021.

49 However, as PFIZER had already publicly disclosed the structural formula of Nirmatrelvir in accordance with document D2 (Exhibit CC11) on 6 April 2021, this disclosure has just as adverse an effect on the novelty of the subject-matter of claims 1 to 5 of the Patent in Suit as the disclosure content of document D1 (Exhibit CC10). Although this document was not filed until 6 August 2021, it validly claims the stated priorities – a fact which the parties rightly do not dispute – and thus has an effective date of 3 September 2020.

1. Priority

50 ENANTA is not entitled to claim priority from 20 July 2020 for the subject-matter of claims 1 to 5 of the Patent in Suit. The priority document (US application 2020 63 054 048 = Exhibit CC16) does not disclose the technical subject-matter of the claims of the Patent in Suit to a person skilled in the art.

51 The priority document does not disclose the 'same invention' as the Patent in Suit. The subject-matter of the claims of the Patent in Suit is not directly and unambiguously derivable from the content disclosed in Exhibit CC16.

52 It is true that individual components of the subject-matter of claims 1 to 5 of the Patent in Suit are contained within the overall content of the priority document referred to in US application 2020 63 054 048 (Exhibit CC16).

53 However, the claimed combination is not disclosed to the person skilled in the art in this priority document in an individualised form as a technical teaching. The full content of Exhibit CC16 merely discloses, as a general teaching, that there are numerous different possible combinations of the individual components. The specific combination of the individual elements as set out in the subject-matter of claims 1 to 5 of the Patent in Suit is not yet disclosed therein. This solution is not provided to the person skilled in the art.

Principles

54 According to Art. 65(2) UPCA, Art. 138(1) lit. a), Art. 54 EPC, and Art. 87(1) and 88 EPC, a priority can only be validly claimed if the priority document discloses the "same invention" as the document claiming priority. According to case law of the CFI (CD Munich, decision of 16 July 2024, UPC_CFI_1/2023), a claimed invention is to be considered the “same invention” as meant in Art. 87 EPC if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. This complies with the standard of EPO’s Enlarged Board from G2/98. The concept of "the same invention" referred to in Art. 87(1) EPC means that the extent of the right of priority derivable from a priority application for a later application is determined by, and at the same time limited to, what is at least implicitly disclosed in the priority application. The subject-matter of a claim defining the invention in the European patent application, i.e. the specific combination of features present in the claim, must at least implicitly be disclosed in the application whose priority is claimed.

55 When assessing whether the subject-matter of the patent validly claims priority, the full content of the disclosure in the priority document must be identified and compared with the claimed subject-matter of the patent. Priority may only be claimed if the subject-matter of the patent is directly and unambiguously disclosed in the priority document. The invention must be the same. The technical information disclosed to the person skilled in the art is decisive for determining the technical significance of the priority document. The disclosed state of the art may also include elements which are not expressly mentioned in the patent claims or the description, but which are derivable by a person skilled in the art. Consequently, they do not require an explicit verbal disclosure. They are therefore deemed to be implicitly included and thus form part of the scope of disclosure of the document. However, the person skilled in the art’s general knowledge must not be used to further extend the scope of this implicit understanding. Any such extension beyond this is no longer a direct and unambiguous disclosure of the priority document.

56 The disclosure of a generic chemical structural formula in a document does not, in principle, disclose the individual compounds or more specific subclasses falling within that formula. A subject matter described in this way is generally very broad. There are numerous variants that may be covered by it. Individual compounds or more specific subclasses which are embraced by such a generic formula are only disclosed if they are directly and unambiguously derivable by a person skilled in the art from the complete teaching of the document.

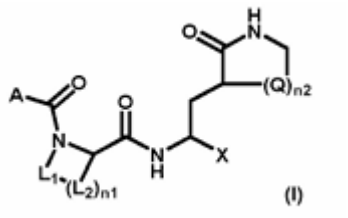
57 The same applies when the generic chemical structural formula disclosed in a document contains variable groups and the description explains how the substituents can be identified, for example, by selecting elements or groups of elements from one or more lists. Such disclosure content does not necessarily encompass the more specific teaching to combine individual elements and groups of elements defined in the description. As a rule, such a document does not disclose every single technically feasible and sufficiently implementable combination of specific representatives of the variable groups.

58 The fact that the individual elements of the teaching claimed in the patent can be derived from the priority document does not, as a rule, say anything about the disclosure of their combination. In principle, it is necessary for the specific combination of the individual elements to be disclosed. This is because, for a teaching to be disclosed, the person skilled in the art generally requires information enabling them to carry out the specific teaching – in this case, the specific combination of individual elements or groups of elements to form a chemical compound – and thus to obtain the protected substance.

59 However, to specify a particular combination for the person skilled in the art from among several possible variants, that combination must be individualised. This is because, given the mathematically determined number of theoretically possible combinations, the person skilled in the art needs further information to narrow down such a broadly defined subject-matter – with its numerous possible sub-combinations – to the extent that a specific combination is advantageous or even necessary. The decisive factor in determining whether such a selection has been made is the content of the entire disclosure of the priority document, as understood by the person skilled in the art.

Disclosure of US application 2020 63 054 048 (Exhibit CC16)

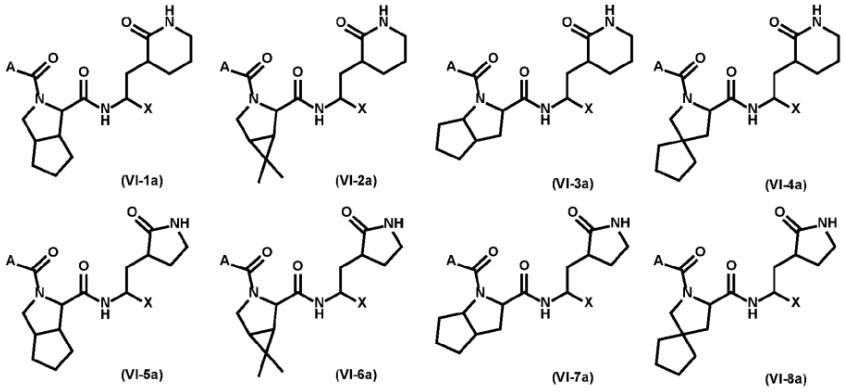
60 The Markush Formula (I) can be found, for example, in the proposed claim on page 66 and in the description on page 2 of the US application 2020 63 054 048 (Exhibit CC16).



.

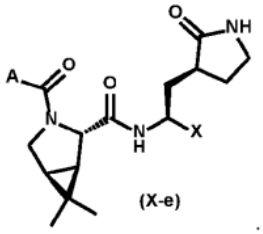
61 The proposed sub-claims of the priority document relate solely to Formulae (IV), (V), and (VI).

62 Formulae (VI-6a) and (X-e) are disclosed in the description of US application 2020 63 054 048 (Exhibit CC16) on pages 10



and on page 24 as possible variants of Markush Formula (I).

In certain embodiments, the compound of Formula (I) is represented by Formula **(X-e)** or a pharmaceutically acceptable salt thereof, wherein A and X are previously defined,



(X-e)

63 According to the description of the US application 2020 63 054 048 (Exhibit CC16) on page 5, in certain embodiments of Formula (I), X is:

-CN;

-$C(O)CH_2OC(O)R_{21}$, -$C(O)CH_2C(O)_2R_{21}$, -$C(O)CH_2OR_{21}$, or -$C(O)CH_2R_{22}$; R_{21} is hydrogen, optionally substituted -C_1-C_6 alkyl, optionally substituted -C_3-C_8 cycloalkyl, optionally substituted 3- to 8-membered heterocycloalkyl, optionally substituted aryl, or optionally substituted heteroaryl; and R_{22} is halogen, or -$NR_{13}R_{14}$;

-$C(O)C(O)NHR_{21}$, and R_{21} is as previously defined. Preferably, R_{21} is optionally substituted benzyl, optionally substituted methyl, optionally substituted isopropyl, optionally substituted t-butyl, or optionally substituted cyclohexyl;

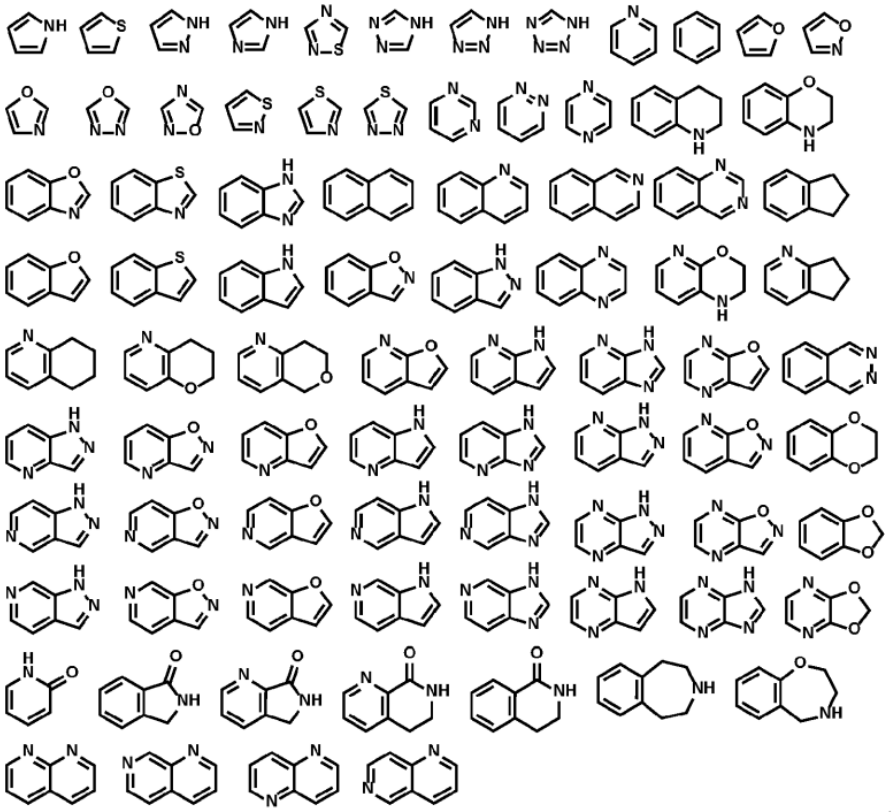
-$C(O)R_{21}$, and R_{21} is previously defined;

-$CHR_{21}OC(O)R_{21}$, -$CHR_{21}C(O)_2R_{21}$, -$CHR_{21}(OR_{21})$, or -$CH(OR_{21})_2$, and R_{21} is previously defined.

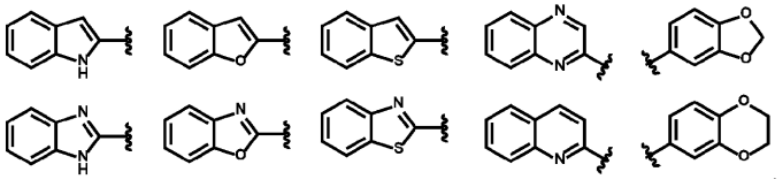
64 In claim 1 relating to Formula (I), the following is claimed with respect to X:

X is optionally substituted -C_1-C_6 alkyl, -CN, -$C(O)R_{15}$, -$C(O)NR_{13}R_{14}$, or -$C(O)C(O)NR_{13}R_{14}$;

65 According to the description of US application 2020 63 054 048 (Exhibit CC16) on pages 5/6, in certain embodiments of Formula (I), A is derived from one of the following by removal of a hydrogen atom and is optionally substituted:



In certain embodiments of the compounds of Formula (**I**), A is selected from the following groups, and A is optionally substituted:



66 Furthermore, with regard to A, the following is disclosed on page 6:

In certain embodiments of the compounds of Formula (**I**), A is -CH_2R_{23}, and R_{23} is -$NR_{13}R_{14}$, optionally substituted –C_3-C_{12} cycloalkyl, optionally substituted 3- to 12-membered heterocycloalkyl, optionally substituted aryl, or optionally substituted heteroaryl.

67 Claim 1, which relates to Formula (I), claims the following regarding A:

A is selected from:

1) Optionally substituted –C_1-C_8 alkyl;
2) Optionally substituted –C_3-C_{12} cycloalkyl;
3) Optionally substituted 3- to 12-membered heterocycloalkyl;
4) Optionally substituted aryl; and
5) Optionally substituted heteroaryl;

68 Furthermore, the description of US application 2020 63 054 048 (Exhibit CC16) relating to Formula (X-e) contains 54 examples of possible active substances, with variants for X and A set out in Table 5 on pages 25 to 27 of the priority document.

69 The seven examples described in detail on pages 54 to 65 of the US application 2020 63 054 048 (Exhibit CC16) do not relate to Formulae (VI-6a) or (X-e).

Comparison with Patent in Suit

70 The overall disclosure of US application 2020 63 054 048 (Exhibit CC16) falls short of the subject-matter of claims 1 to 5 of the Patent in Suit in crucial respects. Formulae (VI-6a) and (X-e) are subclasses of compounds, covered by Formula (I) of the priority document, but their specific combination of elements is not disclosed in the priority document. This remains true even when the implicit understanding of a person skilled in the art is considered. The priority document is on the one hand broader and lacks on the other hand relevant information contained in the Patent in Suit. For instance, the 14 examples described in detail in the patent in suit relating to formula (X-e) (Reference Ex11, Ex 16 to 18, Ex 20 to 29) are all absent from the priority document.

Regarding A

71 The selection as defined in the Patent in Suit goes beyond the scope of disclosure in the priority document. [0016–0018] of the Patent in Suit are not contained in the priority document. Whilst the Patent in Suit is limited here, in addition to feature 1.3a), to optionally substituted C_1–C_8-alkyl in accordance with feature 1.3b), the US application 2020 63 054 048 indicates several possibilities for A in various places.

72 The priority document does not disclose any reason for the selection of optionally substituted C_1–C_8-alkyl. Rather, the person skilled in the art would infer from the priority document that the different substances disclosed therein are equally valid variants for A. Optionally substituted C_1–C_8 alkyl is also not specifically highlighted for the person skilled in the art. Whilst optionally substituted C_1–C_8 alkyl is mentioned in the proposed claim 1 of US application 2020 63 054 048 alongside five other substances for A, optionally substituted C_1–C_8 alkyl is not otherwise expressly listed in the priority document. Regarding A, in the description of the US application 2020 63 054 048 (Exhibit CC16) only one example from this group of substances is discussed on page 6 as it states: “A is -CH_2R_{23}, and R_{23} is -$NR_{13}R_{14}$, optionally substituted -C_3-C_{12} cycloalkyl, optionally substituted 3- to 12-membered heterocycloalkyl, optionally substituted aryl, or optionally substituted heteroaryl”. Nor is it implicitly disclosed in its seven detailed examples. Nor does optionally substituted C_1–C_8 alkyl follow directly and unambiguously from the other formulae and tables. In particular, the compounds in Table 5 of the US application 2020 63 054 048 do not disclose any use of C_1–C_8 alkyl groups or their substituents for A. Instead, each of those compounds has substitutions in which A contains a benzoheteroaromatic group.

Regarding X

73 Unlike the Patent in Suit in claim 1, the priority document does not favour -CN for X.

74 In US application 2020 63 054 048 (Exhibit CC16), -CN is disclosed merely as one of several possibilities for X. The priority document lacks any disclosure justifying an advantageous or even necessary selection of -CN over the other variants. That the priority document states on page 5, line 1, “In certain embodiments of the compounds of Formula (I), X is -CN” is not sufficient to constitute individualisation. This is because, in the following lines, further variants are presented with the same introduction: “In certain embodiments of the compounds of Formula (I), X is …”. The person skilled in the art therefore regards the possibilities for X set out in US application 2020 63 054 048 (Exhibit CC16) as equal. This is also demonstrated by Table 5. Of the 54 variants for X shown there, only nine have -CN. The fact that three of the seven detailed examples in US application 2020 63 054 048 (pages 54 et seq.) have -CN for X does not alter this. This is because these do not relate to formulae (VI-6a) or (X-e). Moreover, these examples do not reveal any preference for -CN either. Finally, ENANTA’s following assumption is not convincing: “Scheme 9 of the priority application provides a general synthesis scheme by which a –CN group can be introduced into an intermediate compound 2, which can then be further reacted to form a compound of the invention by general synthesis scheme 2, … would have led a skilled person to the unambiguous conclusion that X = -CN was actually the most preferred meaning for this substituent in the priority document as a whole”. This is because this assumption is neither clearly nor unambiguously apparent to a person skilled in the art from the priority document. Nor is it self-evident. Rather, ENANTA’s line of argument shows that this is not a matter of the content disclosed in the document under examination but essentially concerns technical considerations that go beyond the meanings clearly and unambiguously disclosed in the document. The person skilled in the art does not derive this information from the text itself; rather, it arises, if at all, from reflection on what has been read.

Interim conclusion

75 In any event, the priority document (US application 2020 63 054 048 = Exhibit CC16) does not disclose the subclasses of Formula (I) which are claimed in the Patent in Suit, represented by formula (VI-6a) or (X-e), in such a way that X stands for -CN and A is selected from optionally substituted C_1-C_8-alkyl.

76 This combination is not directly and unambiguously disclosed in the priority document. Although Claimant argues that there are differentiated disclosures of the respective individual elements and their combinations, with some highlighted, albeit not as a preferred embodiment, this is not sufficient to conclude that the disclosure meets the required standard. No such specific combination can be directly and unambiguously inferred from this priority document. Simply being able to combine them is not enough. Rather, the specific combination must be disclosed and individualised.

Shrinking

77 Contrary to ENANTA's view, the selection made in Patent in Suit is not justified even from the perspective of "shrinking" of lists. This is because the EPO case law of the Boards of Appeal cited by ENANTA primarily concerns "added matter" within the meaning of Art. 123(2) of the EPC, and not Art. 87 of the EPC. Furthermore, the case law is based on the EPO's more formalistic approach, according to which the decisive factor is that a selection was made from lists. This formal reference to lists does not, as such, appear in the Court's case law.

78 Consequently, the substantive legal principles set out above remain applicable. However, even when considering the technical teaching in its entirety, the conditions for an admissible "shrinking" are not met in the present case, as it involves a specific combination which, as such, is not disclosed to a person skilled in the art by the content of US application 2020 63 054 048 (Exhibit CC16).

2. Novelty

79 PFIZER argued that the subject matter claimed in the Patent in Suit lacks novelty over several prior art disclosures. The attack succeeds. The Court finds that claims 1 to 5 (as granted) are not novel.

Principles

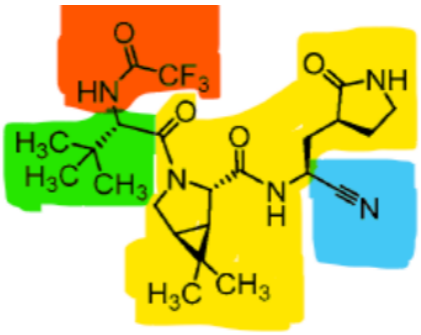
80 For the purposes of Art. 54 EPC, an invention shall be considered to be new if it does not form part of the state of the art.

81 The assessment of novelty within the meaning of Art. 54(1) EPC requires determination of the whole content of the prior publication. However, the content of a prior art document must not be treated as a reservoir from which features may be drawn to create a particular embodiment, but rather different passages in a document may only be combined if there is a clear and unmistakable teaching suggesting this. A feature may also be disclosed implicitly, but this requires that the skilled person would objectively consider such feature to be necessarily implied in the explicitly disclosed content, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be considered as part of its content. Knowledge that a skilled person only acquires as a result of further deliberation beyond this cannot be considered a direct and unambiguous disclosure. It is decisive whether the subject-matter of the claim with all its features is directly and unambiguously disclosed in the prior art citation (see UPC_CoA_312/2025, UPC_CoA_333/2025, UPC_CoA_880/2025, UPC_CoA_882/2025, decision of 2 June 2026, *Kodak/Fujifilm*, UPC_CoA_182/2024, order of 25 September 2024, App 21143/2024, *Mammut/Ortovox*).

Lack of novelty vis-à-vis document D1

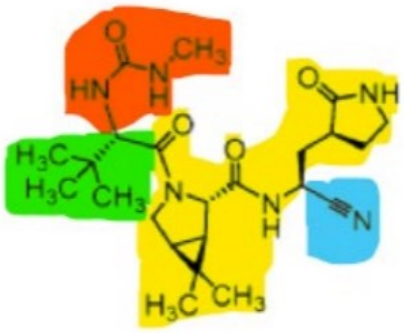
82 The subject-matter of **claim 1** of the Patent in Suit lacks novelty over D1 (WO 2021/250648 A1) under Art. 54(3) EPC

83 Example 13 of D1 (page 119, claim 5) is also present in its first priority document P1 (US-63/073,982 = Exhibit CC19, page 100) and discloses the structure of Nirmatrelvir. This structure does not benefit from partial priority because it is not disclosed in the priority document of the Patent in Suit. Example 13 has all the mandatory features of Formula (VI-6a) (highlighted in yellow), a -CN group corresponding to "X" (highlighted in blue), a C_5 group corresponding to the "-C_1-C_8 alkyl" of "A" (highlighted in green) and a - NHC(O)-CF_3 substituent (highlighted in red) on the C_5 (alkyl) group:



13

84 The same applies, for instance, to Example 78 of D1 (page 212), which is also present in P2 (US-63/143,435 = Exhibit CC20, page 155) and has all the mandatory features of Formula (VI-6a) (highlighted in yellow), a -CN group corresponding to "X" (highlighted in blue), a C_5 group corresponding to the "-C_1-C_8 alkyl" of "A" (highlighted in green) and a - NHC(O)NH-CH_3 substituent (highlighted in red) on the C_5 (alkyl) group:

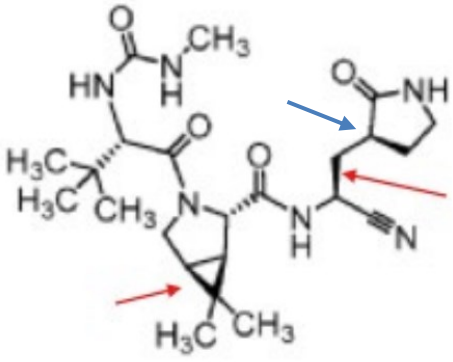


78

85 As claim 1 of the Patent in Suit allows for a substitution of a -C_5 alkyl (highlighted in green) with any substituent, -NHC(O)NH-CH_3 (highlighted in red) is such a substituent, especially as it is listed as "-NHC(O)NH-C_1-C_{12}-alkyl" as a potential substituent in the Patent in Suit, [0078].

86 **Claims 2 to 5** of the Patent in Suit are equally anticipated by D1, as all additional features named in these claims are disclosed as well, in D1 and its priority documents.

87 D1 represents the structure 78 with the same stereoconfiguration as Formula (X-e) in claim 2 of the Patent in Suit (cf. red arrows below):



78

88 Also, the chirality of the carbon atom indicated by the blue arrow matches with Formula (X-e) because the skilled person knows that the hydrogen atom, which is not shown, points the opposite way compared to the upward bond with the carbon atom in the ring. It is thus clear in the above structure that the link with the hydrogen atom is facing downwards, just as in Formula X-e. Furthermore, the structure of Nirmatrelvir, represented above as Example 13 of D1, has the same stereoconfiguration as Formula (X-e) of claim 2.

89 The same applies to claims 3 to 5 of the Patent in Suit, since D1 discloses pharmaceutical compositions comprising a pharmaceutically acceptable carrier (e.g., page 33, lines 8-10; pages 65-70) and the treatment or prevention of a coronavirus infection (e.g. page 33, lines 20-22) in which the coronavirus is SARS-CoV-2 (e.g. page 33, lines 28-29) or MERS (e.g. page 46, lines 1-3). The anti-coronal activity of Nirmatrelvir is further disclosed in claim 19. Claim 19 refers to claims 5 to 14, which all relate to Nirmatrelvir. Claim 20 specifically relates to the treatment of COVID-19, which is caused by a SARS-CoV-2 virus. Similar claims can be found in, e.g. the fourth priority document of D1 (US-63/194,241 = Exhibit CC22): claims 52 to 54 define Nirmatrelvir by its chemical name and relate to its anti-coronal activity, while COVID-19 is specifically mentioned in claim 55.

Lack of novelty vis-à-vis document D2

90 The disclosure of the structure of Nirmatrelvir in D2 (p.13 and 14) and its synthesis (page 16) is novelty destroying under Art. 54(2) EPC to claims 1 and 2 of the Patent in Suit. D2 (page 18) also discloses the suitability of Nirmatrelvir for the inhibition of SARS-CoV-2 and treatment of COVID-19.

Interim conclusion

91 The conclusion based on the above is that the subject matter of claims 1 to 5 is not novel and therefore invalid. Consequently, the Patent in Suit cannot be maintained as granted and requested by ENANTA.

Partial Priority

92 As there is no application to amend the Patent in Suit in accordance with auxiliary requests, the partial priority asserted by ENANTA is not relevant. The Patent in Suit is to be examined as granted. Since the subject-matter of the granted claims of the Patent in Suit is not novel, the Patent in Suit has no validity. Even if a patent claim is entitled to partial priority and would, in that respect, be valid in relation to the state of the art while another part of its scope remains invalid, it cannot be regarded as partially valid and upheld without the patent proprietor filing an Application to amend the patent.

93 ENANTA has not requested any amendment to the patent.

3. Conclusion

94 In conclusion, the Patent in Suit as granted is invalid. Consequently, the Patent in Suit must be revoked in its entirety.

4. ENANTA's Request regarding PFIZER's further submissions

Rule 263 RoP

95 Contrary to ENANTA's further Request (see above under REQUESTS) and the associated written submissions (cf. Reply to the Defendant's (CfR) Statement of Defence of 18 May 2026, para. 8 et seq.), PFIZER's alleged raising of the 'added matter objection' in its pleading of 17 April 2026 does not change the claim or constitute an amendment to the case pursuant to Rule 263 RoP.

96 This is because this objection was already the subject of the Statement of Defence and Counterclaim for Revocation of 16 December 2026 (cf. para. 197). PFIZER's further submissions in the subsequent written pleading of 17 April 2026 therefore do not alter the case but merely constitute a more detailed elaboration of this objection which had already been raised. ENANTA has also responded to PFIZER's comments regarding the 'added matter objection'.

Rule 9.2 RoP

97 There is no reason to rule on the further Requests to disregard pursuant to Rule 9.2 RoP:

- the submissions contained in and/or based on Appendices CC 25 and CC 31; and

- (in the alternative), the added matter attack raised by Defendants in Section D II. of their Reply.

98 These Requests may be left open. Firstly, PFIZER's submissions at issue are not relevant to the Court's decision on the merits of the case. They have no bearing on the Decision reached and are therefore of no significance to it. Secondly, ENANTA's Request is not one that requires

a formal Decision, but is merely a proposal, essentially to make use of the subject-matter of Rule 9.2 RoP and the associated discretion.

99 The same applies to PFIZER's communication dated 18 September 2026 and Exhibit CC38. As this submission concerns the US proceedings, it is irrelevant to decide the present case.

100 The EPO's Opposition Division's preliminary view dated 28 September 2026, which was filed by PFIZER as Exhibit CC39 on the same day and in which it was held that the Patent in Suit was not patentable, was issued one day before the oral hearing. This preliminary opinion is also disregarded, as it was received only shortly before the oral hearing and ENANTA had no opportunity to comment on it in good time.

III. The infringement action

101 The infringement action is unfounded. The Patent in Suit is not valid.

IV. Legal consequences

102 The legal consequences of the above are that the Patent in Suit must be revoked in its entirety with effect to the territory of Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia, and Sweden.

103 The infringement action is dismissed.

104 The Court shall decide on the obligation to bear legal costs based on Art. 69(1) UPCA in connection with Rule 118.5 RoP.

105 ENANTA is regarded as the unsuccessful party in the Infringement action and must bear the costs of PFIZER. ENANTA is regarded as the unsuccessful party in the Counterclaim for Revocation and must bear the costs of Pfizer.

106 Considering the Parties' Cost agreement, no further decision is required as the parties agreed that the reimbursement entitlements of 'Aggregate Costs' shall be calculated in accordance with the apportionment of costs determined by the Court.

DECISION

1. The European Patent with Unitary Effect 4 051 265 is revoked in its entirety with effect for the territory of Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia, and Sweden.

2. The Infringement action is dismissed.

3. The costs of the Infringement action and of the Counterclaim for revocation are to be borne by ENANTA.

Daniel Voß (Presiding Judge)	Daniel Voß Digital unterschrieben von Daniel Voß Datum: 2026.10.27 07:57:03 +01'00'
Georg Werner (Legally Qualified Judge)	GEORG EDGAR WERNER Digital unterschrieben von GEORG EDGAR WERNER Datum: 2026.10.26 17:09:23 +01'00'
Rute Lopes (Legally Qualified Judge)	RUTE ALEXANDRA DA SILVA SABINO LOPES Assinado de forma digital por RUTE ALEXANDRA DA SILVA SABINO LOPES Dados: 2026.10.26 17:46:55 Z
Rudi Goedeweeck (Technically Qualified Judge)	Rudi Auguste B Goedeweeck Digitally signed by Rudi Auguste B Goedeweeck Date: 2026.10.26 18:09:55 +01'00'
For the sub-registrar	Sofia Katharina Haseneder Digital unterschrieben von Sofia Katharina Haseneder Datum: 2026.10.27 09:03:48 +01'00'

INFORMATION ON APPEAL

An appeal against this decision may be brought before the Court of Appeal by any party whose claims have been unsuccessful, in whole or in part, within two months of service of the decision (Art. 73(1) UPCA, R. 220.1 (a) RoP, 224.1 (a) RoP).

INFORMATION ON ENFORCEMENT (ART. 82 UPCA, ART. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 ROP)

An authentic copy of the enforceable order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.

INSTRUCTION TO THE REGISTRY

A certified copy of the decision shall be sent to the European Patent Office and the national Patent and Trademark offices as soon as the decision on the revocation action has become legally binding.

This decision was read in open court on 29 October 2026.

Daniel Voß
Digital unterschrieben
von Daniel Voß
Datum: 2026.10.29
14:07:23 +01'00'