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Boards of Appeal

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Chambres de recours



Case Number : J 27/86

D E C I S I O N
of the Technical Board of Appeal
of 13 October 1987

Appellant : KUREHA KAGAKU KOGYO KABUSHIKI
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9-11 Horidome-cho, 1-chome, Nikonbashi
Chuo-ku
Tokyo
Japan

Representative : Dr. Günter Wächtershäuser
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Decision under appeal : Decision of Examining Division of
the European Patent Office
dated 13 May 1986 refusing a request
for correction of errors.

Composition of the Board :

Chairman : P. Ford
Members : C. Payraudeau
R. Schulte

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : J 27/86

Anmeldenummer / Filing No / N^o de la demande : 80 107 209.1

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 030 299

Bezeichnung der Erfindung: Steroid esters of methylated prostaglantin
Title of invention: derivatives and their pharmaceutical compositions
Titre de l'invention :

Klassifikation / Classification / Classement : C07C 177/00

ENTSCHEIDUNG / DECISION

vom / of / du 13 October 1987

Anmelder / Applicant / Demandeur : KUREHA KAGAKU KOGYO KABUSHIKI KAISHA

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Unreasoned decision/Kureha Kagaku

EPO/EPC/CBE Article 111 EPC, Rules 67, 68(2), 89 EPC, Rules of
procedure of the Boards of Appeal: Article 10

Kennwort / Keyword / Mot clé : "Correction of errors in decisions" -
"fundamental deficiency in first instance
decision" - "lack of reasons in a decision"

Leitsatz / Headnote / Sommaire

Summary of Facts and Submissions

- I. By decision of 7 February 1986, the Legal Board of Appeal rejected an appeal filed by the present Appellant to amend under Rule 89 EPC the decision to grant the European patent No. 0 030 299 in order to modify the wording of Claim 1 and to add a new process Claim 4 or to set aside the decision to grant and issue a new decision correspondingly amended or to set aside the decision to grant as well as the Communication pursuant to Rule 51(4) and (5) EPC and issue a new communication.
- II. In the reasons for the decision, the Board of Appeal stated that the main request of the Appellant was not admissible because the Board could only examine appeals from decisions of the first instance (Article 21(1) EPC) and the Examining Division had not yet given any such decision on the request for correction under Rule 89 EPC, which the Appellant had presented before it on 19 December 1984. The subsidiary requests of the Appellant were also inadmissible because the Appellant, not having disapproved of the patent being granted in the text indicated in the Communication of the EPO was not a party adversely affected by the decision to grant the European patent (Article 107 EPC).
- III. The granted patent had been published on 16 January 1985 with the added mention "the file contains technical information submitted after the application was filed and not included in this specification".
- IV. The request for correction under Rule 89 EPC was rejected by the Examining Division in a decision dated 13 May 1986, as regards the correction to Claim 1, on the ground that

"there is no discrepancy between both definitions in terms of the possible acylation "contrary to the Appellant's assertion and, as regards the addition of a new process Claim 4, on the ground that "The proposed Claim 4 is not allowable (see Decision J 12/85 of 7 January 1986 in the subject case)".

- V. On 11 July 1985 the Appellant filed an appeal against this decision requesting the decision to be reversed to such an extent as to allow the patent to be amended under Rule 89 EPC by addition of a new process Claim 7 identical with the former proposed Claim 4. The Appellant also requested an oral hearing. The appeal fee was duly paid in time.
- VI. In his Statement of Grounds filed on 12 September 1986, the Appellant argued that the decision of refusal of his request for adding a process claim was unreasoned because instead of giving reasons for supporting the statement that such claim was not allowable, it referred only to the previous decision of the Board which did not contain anything which could be construed as a ground for supporting such a refusal.

As regards the request itself, the Appellant argued that logical inconsistencies were the paradigm of an obvious mistake and that the decision to grant contained two logical inconsistencies:

- (a) the designation of Austria and the granting of a patent not having any claim acceptable under Austrian law and
- (b) the indication in the description of the patent that the invention relates to the preparation of methylated prostaglandin derivatives (lines 3, 4, page 2) and the

description of a corresponding process (lines 32-42, page 2) and the absence of any process claim.

- VII. On 7 October 1986, the Appellant also requested that a typographical error should be corrected in the address of one of the inventors.
- VIII. In a Communication dated 9 February 1987, the Rapporteur of the Legal Board of Appeal drew the Appellant's attention to the fact that the omission of a process claim in a patent granted with product claims, even if the process is disclosed in the specification, could not be considered as an obvious mistake in the decision to grant, correctable under Rule 89 EPC.

The granted patent satisfies the conditions of the EPC even if its scope is narrower than it could have been and even if it does not satisfy the conditions of the Austrian patent law.

- IX. In his answer to this Communication, the Appellant withdrew his former requests and presented a new main request to substitute for Austria only the proposed process claim to the set of product claims. The Appellant also requested subsidiarily that the claims as granted should be maintained for all designated States including Austria in case the request for correction would be rejected.
- X. The Appellant also maintained his request for an oral hearing which was held on 13 October 1987.
- XI. At the hearing, after discussion of the case, the Appellant withdrew his former requests and presented the

request that the decision under appeal should be set aside, that the case should be remitted to the Examining Division and that the appeal fee should be reimbursed.

Reasons for the Decision

1. The appeal complies with Articles 106, 108 and with Rule 64 EPC and is therefore admissible.
2. The Appellant has not appealed against the part of the decision rejecting the request for correction of Claim 1 but only against the part of the decision refusing the addition of a process Claim 4. The present request of the Appellant must be consequently construed as only requesting the revocation of the impugned part of the decision and not of the other part which is res judicata.
3. The impugned part of the decision contains the single sentence "The proposed Claim 4 is not allowable (see decision J 12/85 of 7 February 1986 in the subject case)".
4. This sentence cannot be considered as a reason for the decision under appeal, even by implication, since the former decision J 12/85 (published in the OJ EPO 1986, page 155) to which it refers, had not examined the substance of the case with respect to this request which it has rejected as inadmissible (see point 2 of the decision J 12/85 summarised in point II hereinabove).
5. Consequently, this part of the decision under appeal is unreasoned and contravenes, therefore, the provisions of Rule 68(2) EPC.

6. The Board holds that this absence of reasons is a substantial procedural violation and a fundamental deficiency in the first instance proceeding.

Since remittal of the case to the Examining Division in application of Article 111 EPC has been requested by the Appellant and since the Board considers that there exists no special reason to do otherwise, the case should be remitted to the first instance in application of Article 10 of the Rules of Procedure of the Boards of Appeal (published in OJ EPO 1983, page 7).

In view of the above considerations, the Board considers that the reimbursement of the appeal fee is equitable and should be ordered under Rule 67 EPC.

Order

For these reasons, it is decided that:

1. The impugned part of the decision under appeal insofar as it concerns the refusal of the addition of a process claim is set aside and the case is remitted to the Examining Division.
2. The reimbursement of the appeal fee is ordered.

The Registrar:

J. Rückerl

The Chairman:

P. Ford