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D E C I S I O N
of 23 January 2002

Case Number: T 0509/00 - 3.3.1

Application Number: 96114552.1

Publication Number: 0763522

IPC: C07C 233/47

Language of the proceedings: EN

Title of invention:

N-Vinylformamide/alkyl acrylate michael adducts

Applicant:

UNIVERSITY OF PITTSBURGH

Opponent:

-

Headword:

N-Vinylformamide/UNIVERSITY OF PITTSBURGH

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Withdrawal on appeal of main request which caused refusal by first instance removes all the objections given in the decision under appeal - remittal on basis of auxiliary request intended for grant by first instance"

Decisions cited:

G 0010/93

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0509/00 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 23 January 2002

Appellant: UNIVERSITY OF PITTSBURGH
5th Avenue and Bigelow Boulevard
Pittsburgh
PA 15260 (US)

Representative: Schwabe, Sandmair, Marx
Stuntzstrasse 16
D-81677 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 28 December 1999
refusing European patent application
No. 96 114 552.1 pursuant to Article 97(1) EPC.

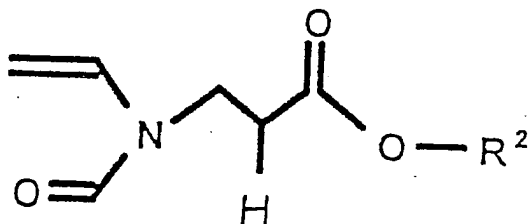
Composition of the Board:

Chairman: J. M. Jonk
Members: R. Freimuth
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal filed on 4 February 2000 lies from the decision of the Examining Division posted on 28 December 1999 refusing European patent application No. 96 114 552.1 (European publication number 763 522).
- II. By its communication under Rule 51(4) EPC dated 13 July 1999 the Examining Division informed the Appellant (Applicant) that it intended to grant a European patent on the basis of claims 1 to 7 according to the then pending auxiliary request. Claim 1 read as follows:

"1. N-vinyl compositions comprising the structural formula:



wherein R² is selected from the group consisting of: isobornyl, benzyl, allyl, N,N-dimethylaminoethyl and hexafluorobutyl."

In the Annex to the communication under Rule 51(4) EPC the Examining Division specified in detail the deficiencies preventing grant of a European patent on the basis of the then pending main request. The Examining Division held that the amendments made to the claims of that request contravened the requirements of Article 123(2) EPC.

The Examining Division requested the Appellant-Applicant to indicate his approval to the text notified to him, i.e. to the then pending auxiliary request, and informed him that the European patent application would be refused if he failed to communicate his approval. Since the Appellant disapproved the text intended for grant, there was no text agreed by him which could serve as a basis for the grant of a European patent as required by Article 113(2) EPC with the consequence that the Examining Division refused the European patent application pursuant to Article 97(1) EPC.

III. The Appellant no longer maintained in appeal proceedings the former main request. He requested on 21 December 2001, as sole request, grant of a patent on the basis of the text notified by the Examining Division in its communication under Rule 51(4) EPC dated 13 July 1999, i.e. on the basis of the former auxiliary request, while his subsidiary request for oral proceedings submitted in his Statement of Grounds of Appeal dated 19 April 2000 was maintained.

Reasons for the Decision

1. The appeal is admissible.
2. The decision under appeal dealt exclusively with deficiencies of the claims of the then pending main request and did not object to the claims according to the then pending auxiliary request. Thus, the Appellant's withdrawal of the former main request while maintaining the former auxiliary request as sole request in appeal proceedings has the effect that the objections given in the contested decision for refusing

the present application have been removed and that the present claims relate to subject-matter upon which the Examining Division intended to grant a European patent. Consequently, the Board considers that the appeal is well founded.

This finding is in line with established jurisprudence of the Boards of Appeal that an appeal is to be considered well founded if the Appellant no longer seeks grant of the patent with a text as refused by the Examining Division and if he proposes a text for grant which clearly meets the objections on which the decision relies since proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons).

3. Under these circumstances, the Board considers it appropriate to exercise the power conferred on it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division for further prosecution.
4. Since the Appellant's request succeeds there is no need for the Board to consider its subsidiary request for oral proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution on the basis of the text notified by the Examining Division in its communication under Rule 51(4) EPC dated 13 July 1999.

The Registrar:

The Chairman:

N. Maslin

J. Jonk