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D E C I S I O N
of 6 March 2003

Case Number: T 0902/01 - 3.3.1

Application Number: 96927644.3

Publication Number: 0871625

IPC: C07D 403/06

Language of the proceedings: EN

Title of invention:

Preparation of triazoles by organometallic addition to ketones and intermediates therefor

Applicant:

Pfizer Research and Development Company, N.V./S.A., et al

Opponent:

-

Headword:

Preparation of triazoles/PFIZER

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Removal of ground of appeal during prosecution of appeal - remittal to the first instance for further prosecution"

Decisions cited:

G 0010/93

Catchword:

-



Case Number: T 0902/01 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 6 March 2003

Appellant: Pfizer Research and
Development Company, N.V./S.A.
La Touche House
International Financial Services Centre
Dublin 1 (IE)

Representative: Ruddock, Keith Stephen
Pfizer Limited
European Patent Department
Ramsgate Road
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Kent CT13 9NJ (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 March 2001
refusing European patent application
No. 96 927 644.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: P. F. Ranguis
R. T. Menapace

Summary of Facts and Submissions

- I. The present appeal lies from the Examining Division's decision to reject the European patent application No. 96 927 644.3 (publication No. 871 625) on the ground that Claim 37 of the then pending request (Claims 1 to 39 as originally filed) did not involve an inventive step.
- II. In the reasons for the decision, the Examining Division held, by reference to the previous communications dated 16 June 2000 and 14 November 2000, that the subject-matter of Claims 1 to 36, 38 and 39 was novel and involved an inventive step over the cited prior art.
- However, the Examining Division held that the subject-matter of Claim 37 could not be considered as involving an inventive step.
- III. In his letter dated 11 February 2003, the Appellant informed the Board of his decision not to pursue any longer the subject-matter of the refused Claim 37 and requested that the case be remitted to the first instance with the order to grant a patent on the basis of Claims 1 to 36 as originally filed and Claims 37 and 38 (former Claims 38 and 39) submitted with the response dated 11 February 2003. The Appellant also submitted amended pages 13 and 14 of the description.

Reasons for the Decision

1. The appeal is admissible.
2. Proceedings before the Boards in ex parte cases are

primarily concerned with examining the contested decision (cf. G 10/93, OJ EPO 1995, 172, point 4 of the reasons). It is moreover 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 overcomes the objections on which the decision under appeal lies.

3. The sole ground of rejection relates to the lack of inventive step of Claim 37 as originally filed (cf. point II above). Since in the sole pending request, original Claim 37 was deleted, the reason for the refusal of the application is thereby removed.

4. *Remittal - Article 111(1) EPC*

Having regard to the fact that the function of the Board of Appeal is primarily to give a judicial decision upon the correctness of the earlier decision taken by the first instance, the Board makes use of its competence under Article 111(1) EPC and remits the case to the first instance for further prosecution.

5. Since the Appellant's request succeeds, there is no need for the Board to consider its precautionary, i.e. 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.

The Registrar:

The Chairman:

N. Maslin

A. Nuss