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**Datasheet for the decision
of 6 October 2008**

Case Number: T 0945/05 - 3.3.02

Application Number: 00948895.8

Publication Number: 1200128

IPC: A61K 47/18

Language of the proceedings: EN

Title of invention:

Preserved pharmaceutical formulations

Applicant:

Aventis Pharmaceuticals Inc.

Opponent:

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Headword:

Preserved pharmaceutical formulations/AVENTIS PHARMACEUTICALS

Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 111(1)
EPC R. 67, 68(2)

Keyword:

"Remittal to the first instance - yes: Substantial procedural violation; subject-matter of decision not defined; grounds not identifiable"

"Reimbursement of appeal fee - yes"

Decisions cited:

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Catchword:

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Case Number: T 0945/05 - 3.3.02

D E C I S I O N
of the Technical Board of Appeal 3.3.02
of 6 October 2008

Appellant: Aventis Pharmaceuticals Inc.
300 Somerset Corporate Boulevard
Bridgewater
New Jersey 08807 (US)

Representative: Perry, Robert Edward
Gill Jennings & Every LLP
Broadgate House
7 Eldon Street
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 22 March 2005
refusing European application No. 00948895.8
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: U. Oswald
Members: H. Kellner
J. Van Moer

Summary of Facts and Submissions

- I. European patent application No. 00 948 895.8, filed as WO 01/07086 together with amended claims and based on international patent application No. PCT/US00/20040, was refused by decision of the examining division on the basis of Article 97(1) EPC 1973.
- II. The decision to reject the application was issued by the examining division on 22 March 2005 as a reaction to the appellant's reply to the summons to oral proceedings, where by letter of 16 February 2005 it announced that it would not be represented and requested a decision according to the state of the file.

The grounds for this decision read in full:

"In the communication(s) dated 06.10.2004 the applicant was informed that the application does not meet the requirements of the European Patent Convention. The applicant was also informed of the reasons therein.

The applicant filed no comments or amendments in reply to the latest communication but requested a decision according to the state of the file by a letter received in due time on 16.02.2005.

The application must therefore be refused."

- III. The relevant first-instance file history can be summarised as follows:
- (a) The "communication(s) dated 06.10.2004" was annexed to the summons to attend oral proceedings,

handed over to the EPO postal service on 6 October 2004 and posted on 11 October 2004.

In this communication the following is pointed out:

- The communication relates to the European application No. 00 948 895.8.
- A synergistic effect is not recognised.
- If the presence of an inventive step were to be based on a synergistic effect, the expression "in a synergistic amount" had to be introduced into the independent claims.
- For clarity reasons and because of Rule 29(2) EPC 1973, claim 3 had to be reformulated as a dependent claim.

(b) In its letter of 28 September 2004, the applicant had reasoned that it failed to understand why it was necessary to introduce the wording "in a synergistic amount" and had maintained claim 3 as an independent claim, since there was "no justification for making it dependent on claim 1, because there is no justification for the particular proportions of the given ingredients to exclude compositions for topical administration".

(c) With respect to the set of claims to be decided on, only the communication of the examining division of 24 August 2004, not referred to in either the communication "dated 6 October 2004" or the decision itself, mentions claims 1 to 36, received on 9 July 2004 by letter of 8 July 2004.

Deviating from this definition of the claims, however, in this communication of 24 August 2004, formerly existing claims 45/46 and 48/49 are commented even while not existing any longer in the set of claims of 8 July 2004.

- IV. The applicant (appellant) lodged an appeal against the decision of the examining division and filed grounds of appeal.
- V. In a communication dated 28 April 2008, the board pointed out that remittal to the first instance could be an option in the current case.
- VI. With its letter of 18 July 2008, the appellant *inter alia* withdrew its request for oral proceedings.
- VII. The appellant requested remittal to the first instance and refund of the appeal fee.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department. This presupposes that the first-instance department has taken a reasoned decision meeting the requirements of Rule 68(2) EPC 1973.
- 3. In that respect, the Board observes that the decision of the examining division only refers to the

"communication(s) of 6 October 2004" without containing in itself any definition of the subject-matter to be decided or any reasoning or conclusions as to the grounds for the decision.

The "communication of 6 October 2004" in its turn does not contain any explicit mention of the claims to be decided.

Additionally, although the communication states that

- a synergistic effect was not recognised,
- if the presence of an inventive step were to be based on a synergistic effect, the expression "in a synergistic amount" had to be introduced into the independent claims and,
- for clarity's sake and because of Rule 29(2) EPC 1973, claim 3 had to be reformulated as a dependent claim,

the really relevant reason why the application had to be refused is not defined.

Therefore, the decision containing nothing other than the reference to the "communication(s) dated 6 October 2004" does not meet the provisions of Rule 68(2) EPC 1973.

4. Consequently, in accordance with the established case law of the boards of appeal, the case is remitted to the department of first instance for further prosecution.
5. The appeal is allowed to the extent that the decision under appeal is set aside, the case is remitted to the first instance for further prosecution

(Article 111(1) EPC 1973) and the appeal fee is reimbursed pursuant to Rule 67 EPC 1973 on account of the substantial procedural violation constituted by non-compliance with Rule 68(2) EPC 1973.

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.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

N. Maslin

U. Oswald