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**Datasheet for the decision
of 3 January 2007**

Case Number: T 0565/06 - 3.3.04

Application Number: 00987787.9

Publication Number: 1256351

IPC: A61K 35/84

Language of the proceedings: EN

Title of invention:
Novel immune enhancing compositions

Applicant:
Kureha Corporation

Opponent:
-

Headword:
Immune enhancing compositions/KUREHA

Relevant legal provisions:
EPC Art. 54, 109(1), 111(1)

Keyword:
"New main request - novelty (yes)"
"Rectification - (no)"
"Remittal - (yes)"

Decisions cited:
T 0139/87, T 0870/94

Catchword:
-



Case Number: T 0565/06 - 3.3.04

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 3 January 2007

Appellant: Kureha Corporation
3-3-2, Nihonbashi-Hamacho, Chuo-ku
Tokyo 103-8552 (JP)

Representative: Minderop, Ralph H.
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 16 December 2005
refusing European application No. 00987787.9
pursuant to Article 97(1) EPC.

Composition of the Board:

Chair: U. Kinkeldey
Members: M. Wieser
D. S. Rogers

Summary of Facts and Submissions

I. The appeal was lodged by the Applicant (Appellant) against the decision of the Examining Division to refuse under Article 97(1) EPC the patent application EP 00 987 787.9, having the title: "Novel immune enhancing compositions".

II. The Examining Division decided that the application according to the main request and auxiliary requests I to III before them did not meet the requirements of the EPC as the subject-matter of claim 1 of all requests was not novel in the light of the disclosure in the following document:

(1) US-A-4 177 108

III. Claim 1 of the main request before the Examining Division read:

"An adsorption fraction of a hot water extract of *Tricholoma matsutake* or an alkaline solution extract of *Tricholoma matsutake* by an anion exchange resin."

The wording of Claim 1 of auxiliary request I was identical.

Claim 1 of auxiliary request II before the Examining Division read:

"Use of a hot water extract of *Tricholoma matsutake* or an alkaline solution extract of *Tricholoma matsutake* or an adsorption fraction of a hot water extract of *Tricholoma matsutake* or an alkaline solution extract of

Tricholoma matsutake by an anion exchange resin, in the manufacture of a functional food or a composition with immuno-enhancing activity for the treatment of a patient in need thereof."

Claim 1 of auxiliary request III before the Examining Division read:

"Process for the manufacture of an immuno-enhancing composition comprising:

(i) the extraction of *Tricholoma matsutake* with hot water and performing an anion exchange on an anion exchange resin with the hot water extract, or

(ii) the extraction of *Tricholoma matsutake* with an alkaline solution and performing an anion exchange on an anion exchange resin with the alkaline solution extract."

IV. With the letter setting out the grounds for appeal, dated 25 April 2006, the Appellant submitted a new main request and a new auxiliary request. Claim 1 of the new main request read:

"An adsorption fraction of a hot water extract of *Tricholoma matsutake* or an alkaline solution extract of *Tricholoma matsutake* by an anion exchange resin, wherein said adsorption fraction comprises five compounds having molecular weights of approximately 45,000, approximately 120,000, approximately 160 000, approximately 380 000 and 1,000 000 or more."

Independent claims 2 and 7 refer to an immuno-enhancing composition and an immuno-enhancing functional food respectively, each comprising the adsorption fraction of claim 1. Independent claim 12 refers to the use of the adsorption fraction in the manufacture of a functional food or a composition with immuno-enhancing activity.

With a letter dated 26 May 2006 the Appellant filed a new version of the new main request and new auxiliary request, wherein a clerical error in both requests and wrong back-references in dependent claims of the new auxiliary request had been corrected. The four independent claims of the new main request remained unchanged.

V. The Examining Division did not rectify its decision.

The Board expressed its preliminary opinion in a short note after a telephone conversation with the Appellant's representative on 28 November 2006.

VI. The Appellant requested to examine novelty (Article 54 EPC) of the subject-matter of claims 1 to 16 of the new main request, filed on 26 May 2006, in the light of the disclosure in document (1) and to remit the case to the department of first instance for further prosecution.

Reasons for the decision

1. Claim 1 of the new main request is distinguished from the claims of all requests before the Examining Division by the additional feature whereby the claimed

adsorption fraction is further defined as comprising five compounds having molecular weights of approximately 45,000, approximately 120,000, approximately 160 000, approximately 380 000 and 1,000 000 or more. This characterising feature has also been introduced into independent claims 2, 7 and 12 of the new main request.

2. The basis for this amendment can be found on page 10, line 28 to page 11, line 1 of the application as originally filed. Thus, the claims of the new main request meet the requirements of Article 123(2) EPC.
3. Document (1) refers to a substance, designated "EMITANIN", which has antitumor activity. The substance may be obtained from the mycelium of *Tricholoma matsutake* by hot water extraction, precipitation of the active compounds and further purification of the precipitate by anion exchange resin (see claims and example 1).

Document (1) does not disclose that "EMITANIN" comprises five compounds having molecular weights of approximately 45,000, approximately 120,000, approximately 160 000, approximately 380 000 and 1,000 000 or more.

Accordingly, the subject-matter of claims 1 to 16 of Appellant's new main request, filed on 26 May 2006, is novel over the disclosure in document 1.

4. The decision under appeal deals in its reasons exclusively with the novelty of claim 1 of all four requests before them in the light of the disclosure in

document (1), (see points (2.2), (3.2), (4.2) and (5.2) of the decision). No other reasons for the refusal of the patent application under Rule 97(1) EPC are given.

The decision is based upon sets of claims which are no longer maintained by the Appellant

Therefore, taking into account that there is now a new main request which overcomes the novelty objection given in that decision, the Appellant has carried out amendments which fully meet the only objection on which the refusal of the application was based and notified in the contested decision.

5. It is established jurisprudence of the Boards of Appeal that if an appeal clearly meets the objections on which the appealed decision relies, as in the present case, the Examining Division should have rectified the contested decision pursuant to Article 109(1) EPC. This would have expedited the proceedings and avoided a substantial loss of time for the Appellant (see decisions T 870/94 of 24 June 1998, point (2) and T 139/87, OJ EPO 1990, 68, points (3) and (4)).

The Board finds that the Examining Division did not comply with this established principle of procedural law according to which interlocutory revision must be accorded when amendments to the respective application overcome the substantive objections dealt with in the decision under appeal (see the Guidelines for Examination - Part E, Chapter XI, 7).

6. As decided in point (4) above, the claims according to the new main request meet the objection on which the

appealed decision exclusively relies. Since all other substantive issues required by the EPC before a patent application may proceed to grant have not been examined yet, the Board considers it appropriate to exercise its discretion under Article 111(1) EPC and to remit the case to the department of first instance for further prosecution.

Order

For these reasons it is decided:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

Registrar:

Chair:

N. Maslin

U.Kinkeldey