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**Datasheet for the decision
of 19 April 2010**

Case Number: T 1126/08 - 3.3.10

Application Number: 99968056.4

Publication Number: 1135359

IPC: C07C 215/64

Language of the proceedings: EN

Title of invention:

Derivatives of (-)-Venlafaxine and methods of preparing and using the same

Patentee:

Sepracor Inc.

Headword:

Derivatives of (-)-Venlafaxine/SEPRACOR

Relevant legal provisions:

EPC Art. 111(1)

Keyword:

"Remittal (yes): claims substantially amended on appeal"

Decisions cited:

G 0010/93

Catchword:

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Case Number: T 1126/08 - 3.3.10

D E C I S I O N
of the Technical Board of Appeal 3.3.10
of 19 April 2010

Appellant: Sepracor Inc.
84 Waterford Drive
Marlborough, Massachusetts 01752 (US)

Representative: Killin, Stephen James
Venner Shipley LLP
20 Little Britain
London EC1A 7DH (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 27 November 2007
refusing European patent application
No. 99968056.4 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: R. Freimuth
Members: J.-C. Schmid
F. Blumer

Summary of Facts and Submissions

- I. The appeal lodged on 23 January 2008 lies from the decision of the Examining Division posted on 27 November 2007 refusing European patent application No. 99968056.4 (International publication Number WO-A-00/32556).
- II. The sole ground for the refusal of the application by the Examining Division was the lack of novelty of the compound claims directed to (-)-O-desmethylvenlafaxine selected from the group consisting of a salt of (-)-(O)-desmethylvenlafaxine, a solvate of (-)-(O)-desmethylvenlafaxine and a purified (-)-(O)-desmethylvenlafaxine, i.e. claims 1, 6 and 7 of the then pending main request; claim 1 to 3 of the then pending auxiliary request 1 which were identical to claim 1, 6 and 7 of the then pending main request; and claims 1 and 2 of the then pending auxiliary request 2 which were based on the combination of claims 1, 6 and 7 of the then pending main request, with respect to document
(5) J. Clin. Pharmacol., vol. 32, (1992), pages 716 to 724,
disclosing (-)-(O)-desmethylvenlafaxine.
- III. In the communication of 25 January 2010 accompanying the summons to attend oral proceedings on 19 April 2010, the Board drew the Appellant's attention on formal requirements of claims 1, 6 and 7 of the main request under Article 84 EPC and 123(2) EPC) and indicated that the findings of the Examining Division with respect to the lack of novelty of the product

claim directed to (-)-(0)-desmethylvenlafaxine appeared to be justified.

- IV. Taking account of the observations of the Board, the Appellant (Applicant) filed on 24 March 2010 a fresh main request differing from the main request on which the decision was based by the deletion of claims 1, 6 and 7.
- V. The Appellant requested that the decision under appeal be set aside and that the case be remitted to the Examining Division for further prosecution.
- VI. Oral proceedings took place on 19 April 2010 in the absence of the Appellant, which had informed the Board with letter of 13 April 2010 that it would not attend. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

- 1. The appeal is admissible.
- 2. *Scope of examination on appeal*

While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in ex-parte proceedings where the application has been refused on other grounds, 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), other objections normally being left to the Examining Division to

consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance. In the present case the Board, thus, restricts itself to examining whether the objection as to lack of novelty (Article 54 EPC) as formulated in the decision under appeal and forming the sole ground for refusal of the application, can still be considered as applying to the amended claims.

3. *Main request*

The decision under appeal exclusively dealt with lack of novelty of claims directed to a compound selected from the group consisting of a salt of (-)-(O)-desmethylvenlafaxine, a solvate of (-)-(O)-desmethylvenlafaxine and a purified (-)-(O)-desmethylvenlafaxine. Such claims are no longer present in the fresh main request.

The amendments made to the claimed subject-matter by deleting those claims, i.e. claim 1, 6 and 7, which the Examining Division considered to be anticipated by document (5) and on which the decision under appeal was based, have the effect that the sole ground for refusing the present application no longer applies to this fresh request, with the consequence that the appeal is well founded.

4. *Remittal*

Having so decided, the Board has not, however, taken a decision on the substantive matter, since the decision under appeal was solely based on the lack of novelty of

claims 1, 6 and 7 of the then pending main request which are no longer present in the current request. As the Examining Division has not yet ruled on the requirements for patentability on the present claims and the Appellant having requested remittal, the Board considers it appropriate to exercise the power conferred on it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution in order to enable the first instance to decide on the outstanding issues.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution on the basis of the main request (claims 1 to 28) filed on 24 March 2010.

The Registrar:

The Chairman:

C. Rodríguez Rodríguez

R. Freimuth