



Case Number : T 47/90 - 3.3.1

**D E C I S I O N** of 13 February 1991  
correcting an error in the Decision  
of the Technical Board of Appeal 3.3.1.  
of 20 February 1990

**Appellant :** Sumitomo Chemical Company, Limited  
Kitahama 4-chome 5-33  
Chuo-ku, Osaka 541 (JP)

**Representative :** Allard, Susan Joyce et al  
Boult, Wade & Tennant  
27 Furnival Street  
London EC4A 1PQ (GB)

**Decision under appeal :** Decision of Examining Division 004 of the  
European Patent Office dated 25 August 1989  
refusing European patent application  
No. 84 303 578.3 pursuant to Article 97(1) EPC.

**Composition of the Board :**

**Chairman :** K.J.A. Jahn  
**Members :** G.D. Paterson  
R.W. Andrews


In application of Rule 89 EPC the Decision given on  
20 February 1990 is hereby ordered to be corrected as follows:

Page 2, chapter 5, line 4 the word "rejecting" is substituted for  
"indicating an intention to reject".

The Registrar:

The Chairman:

  
E. Gorgmeier

  
K. Jahn

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N<sup>o</sup> du recours : T 47/90 - 3.3.1

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 84 303 578.3

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 0 127 990

Bezeichnung der Erfindung: Fungicidal aniline derivatives  
Title of invention:  
Titre de l'invention :

Klassifikation / Classification / Classement : C07C 125/067

### ENTSCHEIDUNG / DECISION

vom / of / du 20 February 1990

Anmelder / Applicant / Demandeur : Sumitomo Chemical Company, Limited

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Remittal/SUMITOMO

EPÜ / EPC / CBE Articles 109(1), 111(1)

Schlagwort / Keyword / Mot clé : "Claims substantially amended on appeal to meet decision of refusal by Examining Division" - "remittal" - "interlocutory revision"

### Leitsatz / Headnote / Sommaire

An appeal may be considered as well founded for the purpose of Article 109(1) EPC if an appellant no longer seeks grant of the patent with text as refused by the Examining Division, but proposes substantial amendments to the text which are clearly intended to overcome the objections raised in the decision under appeal (following Decision T 139/87 - 3.2.1 "Governor valve/BENDIX", OJ EPO 1990, 68).

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



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Decision

1. This is an appeal from a Decision of the Examining Division in which it was held that the claimed invention lacked an inventive step. The text of the claims which were refused had been limited twice as compared to the claims as originally filed, but in its Decision the Examining Division held that the claims before them were still not sufficiently limited. In particular, the claimed herbicidal compounds encompassed many compounds which were not the subject of the comparative tests which had been submitted in support of inventive step.
2. In the grounds of appeal, the Appellant has requested that the proceedings should be continued on the basis of claims which have been even further limited as to the compounds covered. Furthermore, additional comparative tests have been submitted in support of the inventive step of the latest proposed claims. Thus, the Appellant is in effect requesting that the examination of the application should be continued on the basis of a new text for the claims and with supporting evidence and arguments which is intended to meet the present objections of the Examining Division.
3. In these circumstances, in the Board's judgement, it is appropriate to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution. By this procedure, the patentability of the claimed subject-matter can be decided at first instance, and the right to an appeal to the second instance is maintained for use if appropriate. This is in line with what has been stated in a number of previous decisions, namely that the essential function of appeal proceedings is to determine whether a decision at first instance was correct on its

merits (see, e.g. Decisions T 26/88 dated 7 July 1989, to be published, paragraph 12; T 522/88 dated 19 December 1989, paragraph 4; and T 52/88 dated 5 September 1989, where in paragraph 2 it is also stated that "Appeals, therefore, should not be used ... as a continuation of first instance proceedings by other means").

4. Furthermore, remittal of this case is in line with what was stated in Decision T 63/86 (OJ EPO 1988, 224), namely "in a case ... where substantial amendments have been proposed which require a substantial further examination in relation to both the formal (i.e. Article 123(2) EPC) and substantive requirements of the EPC, such further examination should be carried out, if at all, by the Examining Division as the first instance, only after the Examining Division has itself exercised its discretion under Rule 86(3) EPC. In this way, the applicant's right to appeal to a second instance is maintained, both in relation to the exercise of discretion under Rule 86(3) EPC, and ... in relation to the formal and substantive allowability of the amended claims". In the Board's view, in the present case, the proposed amendments are substantial amendments within the meaning of Decision T 63/86.
  
5. The Board observes that the procedure before the Examining Division can be more streamlined, and the time and expense of an appeal possibly avoided, if in response to communications rejecting the application such as occurred in the present case, the applicant presented one or more auxiliary requests progressively limiting the claims, simultaneously with his main request, accompanied if appropriate by evidence and arguments in support of each request. The Examining Division should then decide upon the allowability of each request in succession (assuming the previous request is not allowable), and if the applicant is not satisfied by the decision of the

Examining Division insofar as certain requests have been refused, an appeal can be filed in respect of all such refusals.

6. Finally, in the Board's judgement, in the circumstances of the present case, the Examining Division could have rectified its decision under the procedure for interlocutory revision set out in Article 109(1) EPC. In this connection, the Board follows Decision T 139/87, OJ EPO 1990, 68. Furthermore, in the Board's view, an appeal may be considered as well founded for the purpose of Article 109(1) EPC if the Appellant no longer seeks grant of the patent with a text corresponding to that which was rejected by the Examining Division, and if substantial amendments (in the sense discussed in paragraph 4 above) are proposed which are clearly intended to overcome the objections raised in the decision under appeal. Rectification of the previous decision under Article 109(1) EPC by the Examining Division does not preclude a further adverse decision in respect of the amended text.

Order

For these reasons, it is decided that:

The case is remitted to the Examining Division for further prosecution.

The Registrar:

  
M. Beer

The Chairman:

  
K. Jahn

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