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D E C I S I O N
of 15 September 1994

Case Number: T 0830/91 - 3.3.2

Application Number: 87116757.3

Publication Number: 0268222

IPC: A61K 47/00

Language of the proceedings: EN

Title of invention:

Penetration enhancers for transdermal delivery of systemic agents

Applicant:

WHITBY RESEARCH, Inc.

Opponent:

-

Headword:

Amendments/WHITBY

Relevant legal provisions:

EPC Art. 167(2)

EPC R. 51(4), (6), 86(3), 111(1)

Keyword:

"Approval of text for grant of patent not binding after issue of Rule 51(6) EPC communication"

"Request for substantial amendments of claims at the appeal stage - further examination required - cause for remittal to first instance"

Decisions cited:

G 0007/93

Catchword:

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Case Number: T 0830/91 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 15 September 1994

Appellant:

WHITBY RESEARCH, Inc.
2801 Reserve Street
Richmond, VA 23261-7426 (US)

Representative:

KOHLER SCHMID + PARTNER
Patentanwälte
Ruppmannstrasse 27
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Decision under appeal:

Decision of the Examining Division of the European Patent Office dated 5 June 1991 refusing European patent application No. 87 116 757.3 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: C. Holtz
U. M. Kinkeldey

Summary of Facts and Submissions

- I. By an interlocutory decision of 25 May 1993, the Board of appeal referred two questions to the Enlarged Board of Appeal concerning the binding nature of an approval made under Rule 51(4) EPC when a communication under Rule 51(6) EPC has been issued and the obligation of the EPO to consider reservations under Article 167(2) EPC.
- II. On 13 May 1994, the Enlarged Board issued its Decision, G 7/93, on the referred questions. The answers were as follows:
1. An approval of a notified text submitted by an applicant pursuant to Rule 51(4) EPC does not become binding once a communication in accordance with Rule 51(6) EPC has been issued. Following issue of such a communication under Rule 51(6) EPC and until issue of a decision to grant the patent, the Examining Division has a discretion under Rule 86(3) EPC, second sentence, whether or not to allow amendment of the application.
 2. The European Patent Office is not obliged to consider reservations under Article 167(2) EPC as constituting requirements of the EPC which have to be met according to Article 96(2) EPC.
- III. In a communication of 22 June 1994, the Board stated that it found reason, in view of the Enlarged Board of Appeal decision, to remit the case for further prosecution by the Examining Division.
- IV. The Appellants, after having suggested in their response to the communication that the Board of Appeal take a

decision itself on the requested amendments, accepted a remittal in a subsequent telephone conversation.

Reasons for the Decision

1. The appeal is admissible.
2. In its Decision G 7/93 the Enlarged Board of Appeal considered the effect of the wording of Rule 86(3) EPC, which gives the Examining Division a discretion to consider late amendments, and found that in view of the object of Rule 51(6) EPC to conclude the granting procedure, the allowance of an amendment after issue of such a communication would be an exception rather than the rule. According to the Enlarged Board of Appeal, the Examining Division must consider both the applicant's interest in obtaining a patent which is legally valid in all of the designated States and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. Although the allowance of amendments would be exceptional, the Enlarged Board of Appeal nevertheless found a clear example of such an exceptional situation where separate sets of claims were requested to be substituted for States which had made reservations under Article 167(2) EPC (points 2.3 to 2.5 of the reasons).
3. In a situation, as the present one, where the first instance has not yet exercised its discretion under Rule 86(3) EPC, in respect of the submitted amendments, the case should be remitted to this instance, at least unless the requested amendments are very minor in character and **prima facie** allowable (cf. for example T 63/86, OJ EPO 1988, 224, in particular point 2 of the reasons).

4. On appeal, the Appellants filed a large number of sets of claims, to be considered in descending order (for details see the interlocutory decision, point VIII).

In view of the nature of the requested amendments it does not appear possible to decide without further examination which of these requests is allowable under the EPC. A remittal to the Examining Division would preserve the right to two instances as regards the discretion under Rule 86(3) EPC to admit the amendments for consideration, as well as - if the Examining Division decides the admission issue in favour of the Appellants - the subsequent substantive examination of the requested amendments. Consequently, the Board finds it appropriate to exercise its power under Article 111(1) EPC and remit the case for further prosecution by the Examining Division, as also accepted by the Appellants.

Order

For these reasons it is decided that:

The case is remitted to the Examining Division for further prosecution in relation to the requested amendments filed on 8 April 1992.

The Registrar:

The Chairman:

E. Görgmaier

A. Nuss