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File Number: T 0033/93 - 3.3.1  
Application No.: 88 305 429.8  
Publication No.: 0 296 749  
Title of invention: (Substituted aralkyl) heterocyclic compounds  
Classification: C07D 249/04

D E C I S I O N  
of 5 May 1993

Applicant: Imperial Chemical Industries Plc

Headword: Refused rectification/ICI  
EPC Art. 109, 111(1), Rule 67  
Keyword: "procedural violation (no)"

Catchword

Citation of a decision of a Board of Appeal for the first time in the decision to refuse the application - in the present case not contrary to Art. 113(1) EPC



Case Number : T 0033/93 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 5 May 1993

**Appellant :** Imperial Chemical Industries Plc  
Imperial Chemical House  
Millbank  
London SW1P 3JF (GB)

**Representative :** Atkinson, John David  
ICI Group Patents Services Dept.  
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Welwyn Garden City  
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**Decision under appeal :** Decision of the Examining Division of the  
European Patent Office dated 7 August 1992  
refusing European patent application  
No. 88 305 429.8 pursuant to Article 97(1) EPC.

**Composition of the Board :**

**Chairman :** K.J.A. Jahn  
**Members :** R.K. Spangenberg  
J.A. Stephens-Ofner

**Summary of Facts and Submissions**

- I. European patent application No. 88 305 429.8 filed on 14 June 1988 and published under No. 0 296 749 was refused by the Examining Division on 7 August 1992. This decision was based on Claims 1 to 8 as amended on 12 July 1991. The only stated ground of refusal was that in these claims reference was made to separate formula sheets and that, therefore, the requirement of Rule 29(6) was not met.
- II. On 3 September 1992 a notice of appeal was filed, accompanied by the payment of the appropriate fee, and by a statement of grounds of appeal, comprising a fresh set of nine claims, wherein in Claims 1 to 8 the references to the formula sheet have been replaced by the corresponding chemical formulae. The Appellant (the applicant) submitted that the only ground of refusal had thereby been removed. In addition, so he argued, the decision under appeal was based on a substantial procedural violation, since it cited for the first time a decision of a Board of Appeal on which the Appellant had no opportunity to present his comments.

The Appellant requested that the decision under appeal should be rectified under Article 109(1) EPC, that the application be allowed to proceed, and that the appeal fee be refunded.

**Reasons for the Decision**

1. The appeal is admissible.
2. Since the references to the description, i.e. the formula sheet, have been cancelled, the only stated ground of refusal has been removed. Therefore, the decision under appeal should have been rectified by the Examining Division, following the principle laid down in the decision T 139/87 (OJ EPO 1990, 68), see also the Guidelines for Examination in the EPO, Part E, Chapter XI, 7, as amended in January 1992.
3. If the Examining Division wanted to put the Board of Appeal in a position to take a final decision on the allowability of the application in suit - a decision which was obviously intended by the refusal of the requested rectification - the Examining Division should not have taken its decision on the sole ground of non-compliance with the requirement of Rule 29(6), but should have dealt with the matters referred to in paragraph IV of the decision under appeal as well, in particular with the question of inventive step. The Appellant had filed a substantive reply to the objections raised in the official letter dated 2 April 1992, and, therefore, the Examining Division should have been in the position to give an appealable decision on all the issues which had been properly raised in the above official letter. In the absence of such a decision, the Board does not see fit to decide these matters on its own motion, since by doing so it would deprive the Appellant from one instance of jurisdiction.

For this reason, it is in the Board's judgment appropriate not to examine the case on its merits on the basis of the amended claims, but to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.

4. The Board has already expressed its opinion earlier (see T 153/89 of 17 November 1992) that such "incomplete" decisions of the first instance are highly undesirable, since they cause an unnecessary delay in the proceedings. However, the only remedy the Board can offer is to deal with such cases as quickly as possible and to express its expectation that further prosecution before the Examining Division is resumed without delay.

Nevertheless, the present decision is based on a valid ground of refusal which was properly raised and argued. In the present case, the citation of the decision T 271/88 in support of the refusal is not a fresh ground or piece of evidence within the meaning of Art. 113(1) EPC, but is a mere repetition of arguments, since it only confirmed the position properly brought to the Appellant's attention. Therefore, no substantial procedural violation within the meaning of Rule 67 EPC had occurred which would have justified the requested refund of the appeal fee.

**Order**

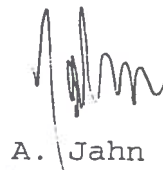
**For these reasons, it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution on the basis of the set of claims submitted on 3 September 1992.
3. The request to refund the appeal fee is rejected.

The Registrar:

  
E. Görgmeier

The Chairman:

  
A. Jahn