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D E C I S I O N  
of 28 June 1994

Case Number: T 0311/94 - 3.3.1

Application Number: 88119675.2

Publication Number: 0318 029

IPC: C07D 211/14

Language of the proceedings: EN

Title of invention:  
Cyclic amine and pharmacological composition

Applicant:  
Eisai Co., Ltd.

Opponent:  
-

Headword:  
Remittal/EISAI

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

Keyword:  
"Grounds for refusal no longer in existence"  
"Not all requirements of the EPC considered by the Examining  
Division"

Decisions cited:  
T 0238/88, T 0139/87, T 0153/89, T 0033/93,

Catchword:  
-



Case Number: T 0311/94 - 3.3.1

DECISION  
of the Technical Board of Appeal 3.3.1  
of 28 June 1994

Appellant: Eisai Co., Ltd.  
6-10, Koishikawa 4-chome  
Bunkyo-ku  
Tokyo (JP)

Representative: Hansen, Bernd, Dr.rer.nat.  
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Decision under appeal: Decision of the Examining Division of the  
European Patent Office dated 14 December 1993  
refusing European patent application  
No. 88 119 675.2 pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Jahn  
Members: R.K. Spangenberg  
R.E. Teschemacher

## Summary of Facts and Submissions

- I. European patent application No. 88 119 675.2 filed on 25 November 1988 and published under No. 0 318 029 claimed priority from two earlier applications in Japan of 27 November 1987 and 28 March 1988. The application was refused by the Examining Division on 14 December 1993. This decision was based on Claims 1 to 8 as amended on 12 August 1993.

The application was refused because these claims included subject-matter which was not entitled to either of the claimed priorities. Therefore EP-A-288 563 published on 2 November 1988 was found to belong to the state of the art according to Article 54(2) EPC in respect of the said subject-matter. The Examining Division considered that this subject-matter did not involve an inventive step with respect to the above prior art.

Although not forming part of the grounds of refusal, the Examining Division observed that an objection raised during the examining proceedings concerning the term "cycloalkyl" in the present Claim 1 was still not met. This objection was that the above expression was non-limitative and not supported by the examples in the description as required by Article 84 EPC.

- II. On 11 February 1994 a notice of appeal was filed, accompanied by the payment of the appropriate fee. A Statement of Grounds of Appeal was received on 21 March 1994, comprising an amended Claim 1 which no longer included the subject-matter objected to in the decision under appeal. The Appellant (the Applicant) submitted that the only ground of refusal had thereby

been removed. In addition he submitted that the expression "cycloalkyl" was sufficiently clear and should be allowable having regard to decision T 238/88.

The Appellant requested that the decision under appeal be set aside and a patent be granted. In addition, he asked that the decision be rectified under Article 109(1) EPC and that as the next step a Rule 51(4) communication be issued.

### Reasons for the Decision

1. The appeal is admissible.
2. Since the amended Claim 1 filed with the Statement of Grounds of Appeal no longer contains the subject-matter that was held unpatentable by the Examining Division, the only stated ground of refusal no longer exists. Therefore, and although the examining proceedings were not completed, the decision under appeal should have been rectified by the Examining Division pursuant to Article 109(1) EPC, following the principle laid down in the decision T 139/87 (OJ EPO 1990, 68), see also the Guidelines for Examination in the EPO, E-XI, 7, as amended in January 1992. Accordingly, it was up to the Examining Division on its own motion to decide the question of rectification, solely on the basis of considering whether the stated grounds of refusal were still in existence, taking into account the statement of grounds of appeal and the amendments accompanying it, so that it was not bound by the Appellant's asking it to issue a communication under Rule 51(4) immediately after rectification.

In addition, the Board observes that the goal of "streamlined" proceedings before the EPO can only be reached if a decision to refuse a patent application contains a reasoned statement in respect of all requirements of the EPC which the Examining Division considers not to have been met (see also e.g. decisions T 153/89 of 17 November 1992 and T 33/93 of 5 May 1993, both not intended for publication in OJ EPO). In the present case the Board cannot see any good reason why the Examining Division could not have reached a final opinion in respect of the allowability of the term "cycloalkyl" in the decision under appeal, so that the Board could have dealt with that matter.

3. Since the Examining Division failed to complete the examination of the application, the Board finds it appropriate to exercise its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.
  
4. Nevertheless, the Board would observe that the maintenance of the objection raised in paragraph 3 of the communication dated 21 May 1992 would require a more detailed reasoning, since according to Article 84 EPC it is not mandatory that an "unlimited" definition such as "cycloalkyl" must in all circumstances be supported by more than one example. It would also observe that in the present case the allowability of a claim including this expression might rather be a question of inventive step than one of support by the description.

Order

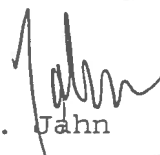
For these reasons it is decided that:

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 21 March 1994..

The Registrar:

  
E. Görgmaier

The Chairman:

  
A. Jahn