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D E C I S I O N
of 24 September 1999

Case Number: T 0684/96 - 3.3.1

Application Number: 91914348.7

Publication Number: 0543858

IPC: C07D 235/08

Language of the proceedings: EN

Title of invention:

Benzimidazole derivatives, process for their preparation and application

Applicant:

British Biotech Pharmaceuticals Limited

Opponent:

-

Headword:

Benzimidazole derivatives/BRITISH BIOTECH

Relevant legal provisions:

EPC Art. 123(2), 111(1)

Keyword:

"Extension beyond the content of the originally filed application (no) - admissible limitation of a generic chemical formula"

"Remittal to the first instance for further prosecution"

Decisions cited:

G 0001/93

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: T 0684/96 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 24 September 1999

Appellant: British Biotech Pharmaceuticals Limited
Watlington Road
Cowley
Oxford OX4 5LY (GB)

Representative: Walls, Alan James
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 21 March 1996
refusing European patent application
No. 91 914 348.7 pursuant to Article 97(1) EPC.

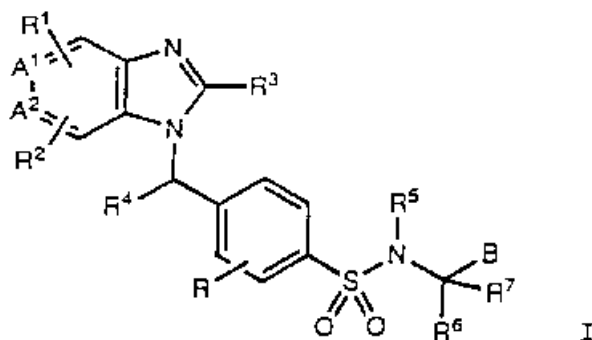
Composition of the Board:

Chairman: A. J. Nuss
Members: J. M. Jonk
W. Moser

Summary of Facts and Submissions

- I. This appeal lies from the Examining Division's decision refusing the European patent application No. 91 914 348.7 (published as WO 92/03423) on the ground that the subject-matter as claimed did not comply with the requirements of Article 123(2) EPC.
- II. The application as filed comprised Claims 1 to 29. Claim 1 of this set of claims read as follows:

"1. A compound of general formula I



wherein:

A¹ is =N-, =CH- or =CR¹-;

A² is -N=, -CH= or -CR²=;

provided that, when one of A¹ and A² is a nitrogen atom, the other of A¹ and A² is other than a nitrogen atom;

R represents hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl,

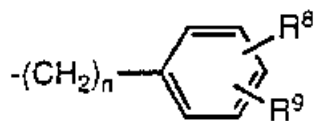
halogen or $-OC_1-C_6$ alkyl;

each of R^1 and R^2 independently represents hydrogen, $-C_1-C_6$ alkyl, $-C_2-C_6$ alkenyl, halogen, $-CN$, $-CO_2H$, $-CO_2C_1-C_6$ alkyl, $-CONH_2$, $-CHO$, $-CH_2OH$, $-CF_3$, $-OC_1-C_6$ alkyl, $-SC_1-C_6$ alkyl, $-SOC_1-C_6$ alkyl, $-SO_2C_1-C_6$ alkyl, $-NH_2$, $-NHCOMe$ or NO_2 or R^1 and R^2 together with the carbon atoms to which they are attached form a fused phenyl ring;

R^3 represents hydrogen, $-C_1-C_6$ alkyl, $-C_2-C_6$ alkenyl, $-C_2-C_6$ alkynyl, $-OC_1-C_6$ alkyl, $-SC_1-C_6$ alkyl, $-(C_1-C_6$ alkyl) OC_1-C_6 alkyl, $-(C_1-C_6$ alkyl) SC_1-C_6 alkyl, $-CF_3$, $-(C_1-C_6$ alkyl)phenyl, $-C_3-C_8$ cycloalkyl, $-C_4-C_8$ cycloalkenyl, $-(C_1-C_6$ alkyl) C_3-C_8 cycloalkyl, $-(C_1-C_6$ alkyl) C_4-C_8 cycloalkenyl or thiophenyl;

R^4 represents hydrogen, $-C_1-C_6$ alkyl, $-C_2-C_6$ alkenyl, $-C_2-C_6$ alkynyl, $-CO_2C_1-C_6$ alkyl, $-SC_1-C_6$ alkyl, $-(C_1-C_6$ alkyl) SC_1-C_6 alkyl, $-(C_1-C_6$ alkyl) OC_1-C_6 alkyl, $-(C_1-C_6$ alkyl)phenyl, or thiophenyl;

R^5 represents hydrogen, $-C_1-C_6$ alkyl, $-C_2-C_6$ alkenyl, $-C_2-C_6$ alkynyl, $-COC_1-C_6$ alkyl, $-CO_2C_1-C_6$ alkyl, $-(COC_1-C_6$ alkyl)phenyl, $-(CO_2C_1-C_6$ alkyl)phenyl, $-(C_1-C_6$ alkyl) OC_1-C_6 alkyl, $-(C_1-C_6$ alkyl) SC_1-C_6 alkyl, $-(C_1-C_6$ alkyl) $CO_2C_1-C_6$ alkyl, $-C_3-C_8$ cycloalkyl, $-C_4-C_8$ cycloalkenyl or a group $-D$ wherein D represents a group:



wherein n is an integer from 0 to 3, and each of R^8 and R^9 is independently hydrogen, $-C_1-C_6$ alkyl, $-C_2-C_6$ alkenyl, $-C_2-C_6$ alkynyl, halogen, $-CN$, $-CO_2H$, $-CO_2C_1-C_6$ alkyl, $-CONH_2$, $-CONHC_1-C_6$ alkyl, $-CONH(C_1-C_6$ alkyl) $_2$, $-CHO$, $-CH_2OH$, $-CF_3$, $-OC_1-C_6$ alkyl, $-SC_1-C_6$ alkyl, $-SOC_1-C_6$ alkyl, $-SO_2C_1-C_6$ alkyl, $-NH_2$ or $-NHCOMe$;

each of R^6 and R^7 independently represents hydrogen, halogen, $-C_1-C_6$ alkyl optionally substituted by one or more halogen atoms, $-C_2-C_6$ alkenyl, $-C_2-C_6$ alkynyl, $-(C_1-C_6$ alkyl) $CO_2C_1-C_6$ alkyl, $-(C_1-C_6$ alkyl) SC_1-C_6 alkyl, $-(C_1-C_6$ alkyl) OC_1-C_6 alkyl, $-(C_1-C_6$ alkyl) $N(C_1-C_6$ alkyl) $_2$, $-C_3-C_8$ cycloalkyl, $-C_4-C_8$ cycloalkenyl, $-(C_1-C_6$ alkyl) C_3-C_8 cycloalkyl, $-(C_1-C_6$ alkyl) C_4-C_8 cycloalkenyl, $-(C_1-C_6$ alkyl) OC_3-C_8 cycloalkyl, $-(C_1-C_6$ alkyl) OC_4-C_8 cycloalkenyl, $-(C_1-C_6$ alkyl) SC_3-C_8 cycloalkyl, $-(C_1-C_6$ alkyl) SC_4-C_8 cycloalkenyl, a side chain of a naturally occurring amino acid, a group $-D$ as defined above or a $-(C_1-C_6$ alkyl) OD group wherein D is defined above;

or R^6 together with R^5 and the atoms to which they are attached form a 5 to 8 membered nitrogen-containing heterocyclic ring;

or R^6 and R^7 together with the carbon atom to which they are attached form a C_3-C_8 cycloalkyl ring;

B represents

a) a ZR^{10} group wherein Z is $-C(=O)-$, $-C(=O)O-$, $-C(=S)-$, $-C(=S)O-$, and R^{10} is $-C_1-C_{18}$ alkyl optionally substituted by one or more halogen atoms, $-C_2-C_{18}$ alkenyl, $-C_2-C_{18}$ alkynyl, $-(C_1-C_6 \text{ alkyl})OC_1-C_6 \text{ alkyl}$, $-(C_1-C_6 \text{ alkyl})SC_1-C_6 \text{ alkyl}$, $-(C_1-C_6 \text{ alkyl})O(C_1-C_6 \text{ alkyl})OC_1-C_6 \text{ alkyl}$, $-C_3-C_8$ cycloalkyl, $-C_4-C_8$ cycloalkenyl, pyridyl, a group -D as defined above or a $-(C_1-C_6 \text{ alkyl})OD$ group wherein D is as defined above;

b) a $-CONR^{11}R^{12}$ group wherein each of R^{11} and R^{12} is independently hydrogen, $-C_1-C_{18}$ alkyl optionally substituted by one or more halogen atoms, $-C_2-C_{18}$ alkenyl, $-C_2-C_{18}$ alkynyl, $-C_3-C_8$ cycloalkyl, $-C_4-C_8$ cycloalkenyl, pyridyl, a group -D as defined above or R^{11} and R^{12} together with the nitrogen atom to which they are attached form a 5 to 8 membered nitrogen-containing heterocyclic ring;

or a pharmaceutical or veterinarily acceptable acid addition salt or hydrate thereof."

III. The decision under appeal was based on Claims 1 to 50 filed on 21 September 1995 for the Contracting States AT, BE, CH, DE, DK, FR, GB, IT, LI, LU, NL and SE, and Claims 1 to 40 (part) filed on 21 September 1995 and 40 (part) to 43 filed on 3 November 1995 for the Contracting States ES and GR.

Claim 1 of the claims for all the designated Contracting States except ES and GR corresponded to the originally filed Claim 1, and Claim 21 of this set of claims read as follows:

"21. A compound as claimed in claim 1 wherein:

A¹ is =N-, =CH- or =CR¹-;

A² is -CH=;

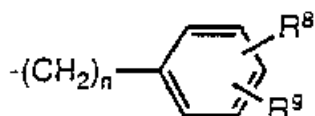
R represents hydrogen;

each of R¹ and R² independently represents hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl, halogen, -CN, -CO₂H, -CO₂C₁-C₆ alkyl, -CONH₂, -CHO, -CH₂OH, -CF₃, -OC₁-C₆ alkyl, -SC₁-C₆ alkyl, -SOC₁-C₆ alkyl, -SO₂C₁-C₆ alkyl, -NH₂, -NHCOME or NO₂ or R¹ and R² together with the carbon atoms to which they are attached form a fused phenyl ring;

R³ represents hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl, -OC₁-C₆ alkyl, -SC₁-C₆ alkyl, -(C₁-C₆ alkyl)OC₁-C₆ alkyl, -(C₁-C₆ alkyl)SC₁-C₆ alkyl, -CF₃, -(C₁-C₆ alkyl)phenyl, -C₃-C₈ cycloalkyl, or thiophenyl;

R⁴ represents hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl, -CO₂C₁-C₆ alkyl, -SC₁-C₆ alkyl, -(C₁-C₆ alkyl)SC₁-C₆ alkyl, -(C₁-C₆ alkyl)OC₁-C₆ alkyl, -(C₁-C₆ alkyl)phenyl, or thiophenyl;

R⁵ represents hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl, -C₃-C₈ cycloalkyl, -C₄-C₈ cycloalkenyl or a group -D wherein D represents a group:



wherein n is an integer from 0 to 3, and each of R⁸ and R⁹ is independently hydrogen;

each of R⁶ and R⁷ independently represents hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl, -(C₁-C₆ alkyl)CO₂C₁-C₆ alkyl, -(C₁-C₆ alkyl)SC₁-C₆ alkyl, -(C₁-C₆ alkyl)OC₁-C₆ alkyl, benzoxy(C₁-C₆ alkyl), a side chain of a naturally occurring amino acid, a group -D as depicted above in this claim, wherein n is an integer from 0 to 3, and each of R⁸ and R⁹ is independently hydrogen, -C₁-C₆ alkyl, -C₂-C₆ alkenyl, halogen, -CN, -CO₂H, -CO₂C₁-C₆ alkyl, -CONH₂, -CHO, -CH₂OH, -CF₃, -OC₁-C₆ alkyl, -SC₁-C₆ alkyl, -SOC₁-C₆ alkyl, -SO₂C₁-C₆ alkyl, -NH₂, or NHCOME;

or R⁶ together with R⁵ and the atoms to which they are attached form a 5 to 8 membered nitrogen containing heterocyclic ring;

or R⁶ and R⁷ together with the carbon atom to which they are attached form a C₃-C₈ cycloalkyl ring;

B represents

a) a ZR¹⁰ group wherein Z is -C(=O)-, -C(=O)O-, -C(=S)- or -C(=S)O- and R¹⁰ is -C₁-C₁₈ alkyl, -C₂-C₁₈ alkenyl, -(C₁-C₆ alkyl)OC₁-C₆ alkyl, -(C₁-C₆ alkyl)SC₁-C₆ alkyl, -C₃-C₈ cycloalkyl, -C₄-C₈ cycloalkenyl, pyridyl, a group -D as defined above or a -(C₁-C₆ alkyl)OD group wherein D is as defined above in relation to R⁶ and R⁷;

b) a -CONR¹¹R¹² group wherein each of R¹¹ and R¹² is independently hydrogen, -C₁-C₆ alkyl, -C₃-C₈ cycloalkyl, pyridyl, a group -D as defined above in relation to R⁶

and R⁷ or R¹¹ and R¹² together with the nitrogen atom to which they are attached form a 5 to 8 membered nitrogen-containing heterocyclic ring;

or a pharmaceutical or veterinarily acceptable acid addition salt or hydrate thereof."

IV. The Examining Division held that said Claim 21, and Claims 22 to 38 depending on that claim, contravened Article 123(2) EPC, because the subject-matter of said Claim 21 related to a particular subgroup selected from the compounds as defined in the originally filed Claim 1, which subgroup could not be derived from the patent application as filed. In this context, they emphasised that a limitation of structural features could in principle result in an unallowable extension of the content of the application as filed.

V. The Appellant contested that the subject-matter of said Claims 21 and 22 to 38 contravened Article 123(2) EPC arguing that the subject-matter of these claims was directly and unambiguously derivable from the broader subject-matter of the originally filed Claim 1.

Moreover, he submitted together with his statement of grounds of appeal a set of claims for the designated Contracting States except ES and GR and another set of claims for ES and GR as auxiliary request.

VI. In a communication dated 14 February 1997 the Board informed the Appellant in particular that the structural features of the claims of the main request then on file seemed to be well supported by the application as filed as required under Article 123(2)

EPC, except that the meaning of residue B as defined in said Claim 21 under b), namely "a $-\text{CONR}^{11}\text{R}^{12}$ group wherein each of R^{11} and R^{12} is independently ... $-\text{C}_1-\text{C}_6$ alkyl ..." (emphasis added) appeared to lack such a mandatory support.

Moreover, the Board held that said Claim 21 did not seem to meet the clarity requirement under Article 84 EPC, because the term "independently" in relation to the meaning of both R^8 and R^9 in the definition of R^5 appeared to be meaningless, and because the meaning of "a group -D as defined above" in connection with the meaning of residue B appeared to be unclear.

Furthermore, the Board observed that Claims 44 to 48 also lacked clarity under Article 84 EPC, because these claims did not comprise a definition for the various symbols A^1 , A^2 , R , R^1 etc. in the general formula.

Finally, the Board noted that these observations, *mutatis mutandis*, also applied to the respective claims for the Contracting States ES and GR.

VII. In reply, the Appellant filed on 21 February 1997 amended Claims 21, 36 and 44 to 48 on replacement pages 138, 139, 141 and 149 to 151 for the designated Contracting States except ES and GR, and amended Claims 21 and 36 on replacement pages 162, 163 and 165 for the Contracting States ES and GR.

Amended Claims 21, 36 and 44 to 48 of the main request for the designated Contracting States except ES and GR, differed from the corresponding claims submitted on 21 September 1995, in that:

(i) in Claim 21:

- the term "**independently**" with respect to the meaning of R⁸ and R⁹ in the definition of R⁵ was deleted,
- the meaning of residue B indicated under a) was specified by replacing "a group -D as defined above" by "a group -D as defined above **in relation to R⁵**" (emphasis added), and
- the meaning of residue B as indicated under (b) was replaced by:

"b) a -CONR¹¹R¹² group wherein **R¹¹** is hydrogen, -C₁-C₆ alkyl, -C₃-C₈ cycloalkyl, pyridyl, or a group -D as defined above in relation to R⁶ and R⁷ and **R¹² is hydrogen, methyl, ethyl, propyl, isopropyl, butyl, isobutyl, sec-butyl, tert-butyl, pentyl, neopentyl, hexyl, -C₃-C₈ cycloalkyl, pyridyl,** or a group -D as defined above in relation to R⁶ and R⁷ or R¹¹ and R¹² together with the nitrogen atom to which they are attached form a 5 to 8 membered nitrogen-containing heterocyclic ring;" (emphasis added).

(ii) in Claim 36:

- the meaning of residue B as indicated under (a) was specified with respect to the group -D by referring to Claim 21, and

(iii) in Claims 44 to 48:

- it was indicated that the symbols for the residues had the meaning as defined in Claim 1 or Claim 21.

Furthermore, amended Claims 21 and 36 of the main request for the Contracting States ES and GR comprised the same amendments as indicated above for the corresponding claims for the other Contracted States.

VIII. The Appellant requested that the decision under appeal be set aside and the case be remitted to the Examining Division for further prosecution on the basis of

(a) the following claims for all the designated Contracting States except ES and GR:

- Claims 1 to 20 and 21 (part) on pages 132 to 137 filed on 21 September 1995,
- Claims 21 (part) and 22 to 24 on pages 138 and 139 filed on 21 February 1997,
- Claims 25 to 31 on page 140 filed on 21 September 1995,
- Claims 32 to 38 on page 141 filed on 21 February 1997,
- Claims 39 to 43 and 44 (part) on pages 141 (last line) to 148 filed on 21 September 1995,
- Claims 44 (part) and 45 to 48 on pages 149 to

151 filed on 21 February 1997, and

- Claims 49 and 50 on pages 152 to 154 filed on 21 September 1995, and

(b) the following claims for the Contracting States ES and GR:

- Claims 1 to 20 and 21 (part) on pages 155 to 161 filed on 21 September 1995,
- Claim 21 (part) and 22 to 24 on pages 162 and 163 filed on 21 February 1997,
- Claims 25 to 31 and 32 (part) on page 164 filed on 21 September 1995,
- Claim 32 (part), Claims 33 to 38, and Claim 39 (part) on page 165 filed on 21 February 1997,
- Claim 39 (part) to Claim 40 (part) on pages 166 to 171 filed on 21 September 1995, and
- Claim 40 (part) and Claims 41 to 43 on pages 172 and 173 filed on 3 November 1995,

as his main request, or

on the basis of two sets of claims, both filed together with the statement of the grounds of appeal, namely Claims 1 to 32 for the designated Contracting States except ES and GR, and Claims 1 to 25 for the Contracting States ES and GR, as his auxiliary request.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*
 - 2.1 The substantial issue to be dealt with is whether or not the subject-matter of the claims of this request meets the requirements of Article 123(2) EPC.

 - 2.2 In the decision under appeal, the rejection of the application in suit was essentially based on the non-compliance of the then pending Claim 21 for all the designated Contracting States except ES and GR with the requirements of Article 123(2) EPC. The Examining Division held that the deletion of meanings from the lists of meanings for the symbols A² and R to R¹² of the formula I defining the compounds as claimed in the originally filed Claim 1 narrowing its scope to a subgroup of compounds as claimed in that Claim 21, constituted a novel selection.

 - 2.3 On the other hand, the Appellant disputed this point of view by arguing that the subject-matter of that Claim 21 could clearly be derived from the originally filed Claim 1.

 - 2.4 Present Claim 21 for all the designated Contracting States except ES and GR still contains in essence the amendments objected to by the Examining Division. Therefore, the Board deems it appropriate first to deal with the amendments causing the rejection of the application in suit.

- 2.5 Article 123(2) EPC requires that a European patent application may not be amended in such a way that it contains subject-matter extending beyond the content of the application as filed. The idea underlying this provision is that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed giving him an unwarranted advantage and possibly being detrimental to the legal security of third parties relying on the contents of the application as filed (see G 1/93, OJ 1994, 541, No. 9 of the reasons for the decision).
- 2.6 The same principle governs also a situation where the amendment results in a limitation of the scope of the claims be it by the addition of a technical feature, be it - as in the present case - by the deletion of originally disclosed meanings from the definitions of symbols of a generic chemical formula standing for a class of chemical compounds.
- 2.7 In this context, the Board observes that there are certainly cases in which a limitation of the scope of a claim may generate subject-matter not disclosed in or not derivable from the original application; but a limitation of a claim will not necessarily result in novel subject-matter, i.e. different from that as originally disclosed. A limitation may indeed merely exclude protection for a part of the subject-matter disclosed and claimed in the application as filed without giving any unwarranted advantage to the applicant and without any adverse impact on legal security (see G 1/93, OJ 1994, 541, No. 16 of the reasons for the decision).

- 2.8 With this in mind, the question to be answered is whether or not the subject-matter of the present dependent Claim 21, representing a subgroup of the class of compounds as claimed in the originally filed Claim 1 is supported by the application as filed.
- 2.9 It follows from a comparison of the subject-matter of originally filed Claim 1 with that of present Claim 21 that the subject-matter of Claim 21 still relates to a generic group of compounds differing from the originally claimed group of compounds by its smaller size as a consequence of the deletions of originally disclosed alternative meanings of the respective symbols and the restriction of the meanings of R^{11} and R^{12} on the basis of the description of the patent application as filed, page 4, second paragraph, in combination with page 10, fourth paragraph, with respect to R^{11} , and page 4, penultimate paragraph, with respect to R^{12} . Moreover, it follows from the description and the examples of the originally filed patent application that present Claim 21 includes substantially all the particularly preferred compounds (see page 9, eighth paragraph to page 10, first paragraph; the Examples 1 to 30, 50, 52 and 54 relating to compounds wherein A^1 and A^2 are both "-CH=" and R is hydrogen; and the Examples 31 to 44, 46 to 49, 51, 53, 55 to 64, 67, 68, 73, 74 and 77 concerning Regioisomers (B) wherein A^1 is =N-, A^2 is -CH=, and R is hydrogen).
- 2.10 Under these circumstances, the Board concludes that a skilled person cannot derive any information from present Claim 21 which was not already present in the patent application as filed, and that consequently no new subject-matter has been generated by the amendments

in question. Moreover, the Board observes that, in view of the many disclosed examples of the application as filed falling under the scope of present Claim 21, that claim cannot represent a so-called "new selection" as was held by the Examining Division.

2.11 Furthermore, all the other claims of the present set of claims for all the Contracting States except ES and GR meet the requirements of Article 123(2) EPC too, because:

present Claim 1 corresponds to the originally filed Claim 1,

Claim 2 finds its support on page 9, ninth and tenth paragraph, of the originally filed application,

the subject-matter of Claims 3 to 8 corresponds to the originally filed Claims 4 to 9, respectively,

Claims 9 and 10 are supported by the originally filed Claim 10,

Claims 11 and 12 are supported by the originally filed Claim 11,

the subject-matter of Claims 13 and 14 corresponds to the originally filed Claims 12 and 13, respectively, and

Claims 15 to 20 find their support in the originally filed Claims 14 to 19, respectively,

Claim 22 finds its support on page 9, ninth paragraph,

of the application as filed,

Claims 23 to 27 are supported by the originally filed
Claims 5 to 9, respectively,

Claims 28 and 29 are supported by the originally filed
Claim 10,

Claims 30 to 35 are supported by the originally filed
Claims 11 to 16, respectively,

Claim 36 is supported by the originally filed Claim 17
and by the support indicated above for Claim 21 with
respect to the definition of the group "-D",

Claims 37 and 38 find their support in the originally
filed Claims 18 and 19, respectively,

Claim 39 is supported by Claim 20 and Example 53
(compound (B)) of the application as filed, as well as
Claim 1 and the description (page 4, third paragraph,
and page 7, third paragraph) of the application as
filed indicating that the compounds of the claimed
invention include the pharmaceutically or veterinary
acceptable salts thereof,

Claim 40 corresponds to the originally filed Claim 20,
except that the compound of present Claim 39 is
deleted,

Claims 41 to 43 find their support in the originally
filed Claims 21 to 23, respectively,

Claims 44 to 48 are based on the originally filed

Claims 24 and 26 to 29, respectively, and also supported by the originally filed Claim 1 and the above indicated support for present Claim 21.

Claim 49, which corresponds to the originally filed Claim 1 except that B is defined as a carboxylic acid group, or a salt thereof, is supported by page 22, lines 17 to 23, of the application as filed disclosing the base catalysed hydrolysis of esters of the claimed invention to the corresponding carboxylic acids followed by the re-esterification of these intermediates, and by page 22, lines 4 to 9, of the application as filed disclosing the reduction of benzylesters of the claimed invention to the corresponding carboxylic esters, and

Claim 50 is based on Example 77 of the application as filed, in particular part (a), disclosing the base catalysed hydrolysis of the corresponding ethyl ester and the separation of the corresponding acid after acidification.

2.12 Further, the Board observes that these considerations with respect to the support of the present claims for the Contracting States AT, BE, CH, DE, DK, FR, GB, IT, LI, LU, NL and SE apply also to the present claims for the Contracting States ES and GR mutatis mutandis.

2.13 Therefore, the Board concludes that all the present claims comply with the requirements of Article 123(2) EPC.

Auxiliary request

3. In the light of the above findings, it is not necessary to consider the Appellant's auxiliary request.

Remittal

4. The decision to refuse the application in suit was solely based on Article 123(2) EPC. As the Examining Division did not decide on the other requirements for granting a European patent, the Board makes use of its competence under Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of the present claims. This will not preclude the Appellant to further amend these claims as may become necessary.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

E. Görgmaier

A. Nuss