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D E C I S I O N
of 23 November 2000

Case Number: T 0588/97 - 3.3.1

Application Number: 90125656.0

Publication Number: 0436940

IPC: C07D 493/04

Language of the proceedings: EN

Title of invention:

Process for producing benzodi-furanone compounds useful for dyeing or printing hydrophobic fiber materials

Applicant:

SUMITOMO CHEMICAL COMPANY LIMITED

Opponent:

-

Headword:

Benzodifuranone/SUMITOMO

Relevant legal provisions:

EPC Art. 84, 111(1), 123(2)

Keyword:

"Clarity (yes) - after amendment"

"Claims substantially amended on appeal - remittal"

Decisions cited:

G 0010/93, T 0063/86, T 0139/87, T 0047/90

Catchword:

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Case Number: T 0588/97 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 23 November 2000

Appellant: SUMITOMO CHEMICAL COMPANY LIMITED
(Opponent) 5-33, Kitahama 4-chome
Chuo-ku
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 13 January 1997
refusing European application No. 90 125 656.0
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. J. Nuss
Members: R. Freimuth
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal lodged on 24 March 1997 lies from the decision of the Examining Division posted on 13 January 1997 refusing European patent application No. 90 125 656.0 (European publication No. 436 940).
- II. The decision of the Examining Division was based on amended claims 1 to 14 according to the main request and on amended claims 1 to 13 according to seven auxiliary requests filed with letter dated 29 October 1996. Claim 13 according to any of those then pending requests was directed to benzodifuranone compounds *per se*.

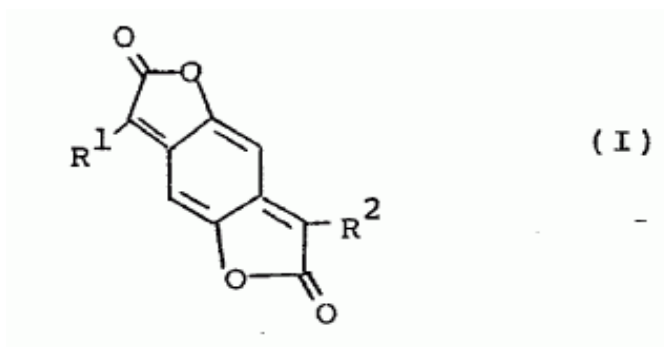
The Examining Division held in particular that the independent product claim 13 according to the then pending first, third, fourth, fifth, sixth and seventh auxiliary request was amended by deleting numerous alternative meanings for the substituents R¹ and R² of general formula (I) thereby creating new subject-matter which extended beyond the content of the application as filed which was not in keeping with the requirements of Article 123(2) EPC. With respect to the product claim 13 as amended according to the then pending main and second auxiliary request the Examining Division objected to the numerous disclaimers introduced into that claim for establishing novelty since those disclaimers required an undue burden for the skilled person to determine the exact scope of what was actually claimed and what was actually disclaimed. This was considered to be at variance with the provision of clarity imposed by Article 84 EPC.

- III. In a communication pursuant to Article 11(2) of the

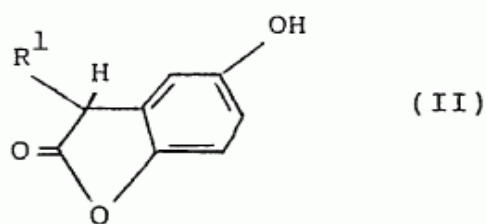
rules of procedure of the Boards of Appeal annexed to the summons for oral proceedings, the Board indicated *inter alia* that the incorporation of several disclaimers in the amended claims directed to the compounds *per se* needed discussion since a disclaimer could solely be allowed if the anticipating disclosure of the state of the art was accidental, i.e. has no relevance for any further examination of the claimed invention.

IV. At the Oral proceedings before the Board, held on 23 November 2000, the Appellant (Applicant) submitted a fresh set of claims 1 to 11 superseding any previous request. The amended claims 1 and 6 read as follows:

"1. A process for producing benzodifuranone compounds of the following formula (I),



wherein R¹ and R² are each independently a naphthyl group or an unsubstituted or substituted phenyl group, which comprises allowing benzofuran compounds of the following formula (II),



wherein R^1 is as defined above, to react at a temperature of 30° to 180°C in the presence of acid catalysts with acetonitrile compounds of the following formula (III),



wherein R^2 is as defined above, and L is $-\text{COR}^3$, $-\text{CO}_2\text{R}^4$ or $-\text{SO}_2\text{R}^5$ in which R^3 , R^4 and R^5 are each independently an alkyl or phenyl group, followed by oxidation."

"6. The process according to any one of claims 1 to 5, wherein the reaction between the benzofuran compounds of the formula (II) and the acetonitrile compounds of the formula (III) is carried out at a temperature of 50° to 120°C ."

- V. The Appellant argued that this fresh set of claims comprised exclusively process claims omitting any product claim directed to the benzodifuranone compounds *per se*. Since product claim 13 has exclusively been objected to, the reasons given in the decision under appeal for refusing the present application no longer apply.

- VI. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 11 submitted at the oral proceedings on 23 November 2000.
- VII. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Scope of examination on appeal*
 - 2.1 While Article 111(1) EPC gives the Boards of Appeal the power to raise new grounds in ex-parte proceedings where the application has been refused on other grounds, proceedings before the Boards of Appeal in ex-parte cases are primarily concerned with examining the contested decision (see decision G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), other objections normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be considered without loss of an instance.
 - 2.2 In the present case the Board, thus, restricts itself to considering whether the amended claims meet the requirements of Article 123(2) EPC and whether the objection as to lack of clarity pursuant to Article 84 EPC which are stated in the decision under appeal as being the grounds for refusal of the application have

been removed.

3. *Amendments (Article 123(2) EPC)*

The subject-matter of claim 1 is based on claim 1 of the application as filed. The temperature of 30° to 180°C and the presence of acid catalysts in the reaction of the benzofuran compounds of formula (II) with the acetonitrile compounds of formula (III) are supported by claims 2 and 7 of the application as filed. Claims 2 to 7 and 9 to 11 are based on original claims 3 to 8 and 11 to 13, respectively. The reaction temperature of 50° to 120°C indicated in claim 6 is found on page 7, line 26 of the application as filed. Claim 8 is backed up by original claims 9 and 10.

For these reasons, the Board concludes that the present claims as amended comply with the requirements of Article 123(2) EPC.

4. *Clarity (Article 84 EPC)*

The decision under appeal dealt with the lack of clarity of exclusively the independent product claim 13 of the then pending requests directed to benzodifuranone compounds *per se* and did not consider any further claim. The amendments made to the fresh set of claims, in particular dropping any product claim, have the effect that the reasons given in the contested decision for refusing the present application no longer apply since the present claims have never been challenged under Article 84 EPC for lack of clarity.

Thus, the Board considers that the amendments made by the Appellant remove that objection raised in the

decision under appeal and are substantial in the sense that in the present case the examination has to be done on a new basis, with the consequence that the appeal is well founded.

This finding is in line with established jurisprudence of the Boards of Appeal that an appeal is to be considered well founded if the Appellant no longer seeks grant of the patent with a text as refused by the Examining Division and if substantial amendments are proposed which clearly meet the objections on which the decision relies (see decisions T 63/86, OJ EPO 1988, 224; T 139/87, OJ EPO 1990, 68 and T 47/90, OJ EPO 1991, 486).

5. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since substantial amendments have been made in the fresh set of claims which was only presented at the oral proceedings before the Board. The decision under appeal dealt exclusively with deficiencies of product claim 13 according to the then pending requests and did not consider a set of claims in the form of the present request omitting any product claim as such request was never submitted to the first instance. It is only before the Board that the Appellant has dropped any product claim in order to overcome the deficiencies raised.

Under these circumstances, the examination not having been concluded, the Board considers it appropriate to exercise its power conferred to it by Article 111(1), second sentence, second alternative, EPC to remit the case to the Examining Division for further prosecution.

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 on the basis of claims 1 to 11 submitted at the oral proceedings on 23 November 2000.

The Registrar:

The Chairman:

N. Maslin

A. Nuss