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**D E C I S I O N**  
**of 14 February 2002**

**Case Number:** T 0632/97 - 3.3.2

**Application Number:** 91918144.6

**Publication Number:** 0554291

**IPC:** A61K 31/60

**Language of the proceedings:** EN

**Title of invention:**

Treatment of non-inflammatory and non-infectious bowel disorders

**Applicant:**

Gastro Services Pty Limited

**Opponent:**

-

**Headword:**

Bowel disorders/GASTRO SERVICES

**Relevant legal provisions:**

EPC Art. 111(1)  
EPC R. 67

**Keyword:**

"Remittal to the first instance: yes - evidence not taken into account during examination proceedings"

**Decisions cited:**

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**Catchword:**

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Case Number: T 0632/97 - 3.3.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.2**  
**of 14 February 2002**

**Appellant:** Gastro Services Pty Limited  
144 Great North Road  
Five Dock  
New South Wales 2046 (AU)

**Representative:** Seaborn, George Stephen  
Edward Evans Barker  
Clifford's Inn  
Fetter Lane  
London EC4A 1BZ (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 23 January 1997  
refusing European patent application  
No. 91 918 144.6 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. A. M. Lançon  
**Members:** J. Riolo  
C. Rennie-Smith

## Summary of Facts and Submissions

- I. European patent application No. 91 918 144.6 published under No. WO 92/06690 was refused by a decision of the Examining Division of 23 January 1997 on the grounds of lack of novelty.
- II. The decision was based on the set of 5 claims filed on 29 May 1996. Independent claim 1 reads as follows:
1. The use of an anti-inflammatory agent, being a salicylic acid derivative, in the manufacture of a medicine for use in the treatment of non-inflammatory bowel disorders.
- III. The following documents were cited inter alia during the proceedings before the Examining Division and during the written proceedings before the Board of Appeal:
- (1) GB-A-2 021 409
  - (4) Statutory declaration of Dr Borodory with its supporting documents
  - (5) Lancet article (341, pages 1569-1572, 1993)
  - (6) Statutory declaration of Professor Barkin
  - (7) Statutory declaration of Dr Philipps
- IV. As set out in the decision under appeal, the Examining Division was of the opinion that the subject-matter of independent claim 1 and of its dependent claims 3 and 4

was anticipated by the disclosure in document (1), which contemplated the use of a salicylic acid derivative for the treatment of irritable bowel syndrome (IBS).

V. The appellant (applicant) lodged an appeal against this decision.

VI. The appellant argued that the disclosure in document (1) was erroneous and should therefore not be taken into account for assessing the merits of the subject-matter of the application in suit.

It also raised the question whether all the evidence submitted during the examination procedure had been taken into account.

VII. In a communication dated 29 February 2001, the Board observed that it was unclear from the file and in particular the various communications of the Examining Division, whether at least part of the evidence (namely documents (4), (5) and (6)) was made available to or considered by the Examining Division and that, depending on the relevance of the apparently missing documents, remittal of the case to the first instance was possible.

VIII. In its answer of 20 June 2001 to this communication, the applicant submitted that documents (4) to (7) (and in particular documents (4) and (6)), discussed in its letter to the Examining Division dated 20 February 1995 and received on 22 February 1995, showed beyond doubt that the disclosure in document (1) was erroneous.

IX. The appellant requested that the decision under appeal

be set aside and that the case be remitted to the first instance.

### **Reasons for the Decision**

1. The appeal is admissible.
  
2. The Board notes that the statutory declaration of Dr Borodory with its supporting documents (4), the statutory declaration of Professor Barkin (6) and the Lancet article (5), mentioned in the appellant's letter of 20 February 1995, were not to be found in the file. In fact, of the three statutory declarations mentioned in that letter, only that of Dr Philipps (7) actually appeared to be present in the file as an enclosure with the confirmation copy of that letter.

It is impossible to tell from the manner in which the enclosures with that letter were numbered in the examination file whether all the documents it referred to were in fact received. If they were not received, one would have expected some form of enquiry to have been made prior to any decision. However, the various communications of the Examining Division and its decision are silent about the documents in question.

It appears therefore that at least some of the evidence was not considered since it was most probably not available to the Examining Division.

The Examining Division found that the subject-matter of the application was not novel over the disclosure in document (1). That finding was therefore obviously reached without the applicant's documents (4) to (6)

having been taken into account.

The applicant is however of the opinion that these documents demonstrate beyond doubt that the disclosure in document (1) is erroneous.

Accordingly, the decision of the Examining Division is unsafe.

3. Remittal to the first instance.

3.1 Although Article 111(1) EPC does not guarantee the parties an absolute right to have all the issues in a case considered by two instances, that may well be appropriate as regards essential issues. Hence, cases are often referred back by a Board of Appeal, if essential questions regarding the patentability of the claimed subject-matter have not been examined and decided by the department of first instance.

In the present case the patentability of the application in suit was not considered in the light of all the evidence provided by the appellant. The Examining Division decided that the subject-matter of the application in suit was not patentable on the grounds that it lacked novelty over document (1). In view of the appellant's opinion that the missing documents demonstrate beyond doubt that the disclosure in document (1) was erroneous, these documents must (unless or until shown otherwise) be considered an essential substantive issue in the present case.

Accordingly, remitting the case to the first instance appears appropriate.

It may be also added that, contrary to the opinion of the Examining Division, it seems that the presence of an established error in a citation would have similar consequences with respect to novelty and inventive step.

4. *Reimbursement of the appeal fee*

In accordance with Rule 67 EPC, reimbursement of an appeal fee shall be ordered when a Board deems an appeal to be allowable "if such reimbursement is equitable by reason of a substantial procedural violation".

This would be indeed the case, if the Examining Division had overlooked relevant filed evidence.

In the present case, however, since it cannot be established beyond doubt that the missing documents were received and thus that the Examining Division deliberately did not consider them, the Board sees no reason to order the reimbursement of the appeal fee.

The Board notes moreover that the appellant did not request such reimbursement.

**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:

A. Townend

P. A. M. Lançon