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Aktenzeichen / Case Number / N^o du recours :

J 12/85

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80 107 209.1

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

0 030 299

Bezeichnung der Erfindung:

Title of invention: Steroid esters of methylated prostaglandin derivatives
Titre de l'invention: and their pharmaceutical compositions

Klassifikation / Classification / Classement :

C07 C117/00, C07 J1/00

C07 J5/00, C07 J71/00

ENTSCHEIDUNG / DECISION

vom / of / du

7 February 1986

Anmelder / Applicant / Demandeur :

KUREHA KAGUKU KOGYO

~~Patentinhaber / Proprietor of the patent /~~

~~Titulaire du brevet :~~

~~Einsprechender / Opponent / Opposant :~~

Stichwort / Headword / Référence :

Inadmissible appeal/KUREHA

EPÜ / EPC / CBE

Articles 21(1), 97(2)(a), 107, 167(2)
Rules 51(4), 89

Leitsatz / Headnote / Sommaire

1. A Board of Appeal can only examine the appeals from decisions of other instances of the EPO (Article 21(1) EPC). Thus it cannot examine a request for a correction, based on Rule 89 EPC, of the decision under appeal. A decision on this request must be first rendered by the Examining Division before the matter can be referred to the Board of Appeal.

An applicant for a European patent may only be "adversely affected" within the meaning of Article 107 EPC by a decision to grant the patent if such a decision is inconsistent with what he has specifically requested.

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Case Number: J 12 / 85

DECISION
of the Legal Board of Appeal
of 7 February 1986

Appellant:

Kureha Kagaku Kogyo Kabushiki Kaisha
9-11, 1-chome, Nihonbashi Horidome-cho,
Chuo-ku, Tokyo 103
(JP)

Representative:

Dr. Günter Wächtershäuser
Tal 29
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Decision under appeal:

Decision of the Formalities Officer of the
Examining Division of the European Patent
Office dated 22 November 1984

Composition of the Board:

Chairman:

P. Ford

Member:

C. Payraudeau

Member:

R. Schulte

Summary of Facts and Submissions

I. On 19 November 1980, the Appellant filed a European patent application under n° 80 107 209.1 claiming priority from two Japanese national patent applications made respectively on 6 December 1979 and 19 March 1980.

Ten Contracting States, including Austria, were designated in the European patent application. Three of the six claims of the application as filed were directed to methylated prostaglandin derivatives having various formulae and three other independent claims were respectively directed to an abortifacient, a parturifacient and a contraceptive agent. The title of the application as filed and as modified on request of the Receiving Section also indicated that it related to such derivatives and pharmaceutical compositions.

II. Under Article 167(2) EPC, Austria has reserved the right to provide in its national law that European patents insofar as they confer protection on pharmaceutical products as such, shall, in accordance with the provisions applicable to national patents, be ineffective or revocable.

III. The European search report was sent to the Appellant's representative on 6 March 1981 and the request for substantive examination was filed on 14 October 1981.

On 15 April 1982, an Examiner acting for the Examining Division issued a first communication pursuant to Article 96(2) and Rule 51(2) EPC in answer to which the Appellant filed a set of comparative tests intended to demonstrate the inventiveness of the invention.

On 11 July 1983, the Examiner issued a second Communication informing the Appellant that the claims were now considered

as being allowable and asking him to make some amendments to the description.

The Appellant's representative filed these amendments on 21 November 1983.

- IV. Thereafter, on 4 April 1984, advance notice of intention to grant a European patent was issued and the Appellant was given a period of two months within which to submit any desired amendments. None were submitted. Then, on 27 June 1984, the Examining Division issued a Communication under Rule 51(4) and (5) EPC indicating that it was intended to grant the patent in the text previously submitted.
- V. On 22 August 1984, the Appellant's representative responded to the Communication under Rule 51(4) and (5) EPC by filing the translations of the claims and paying the grant and printing fees.
- VI. On 22 November 1984, a Formalities Officer acting for Directorate General 2 of the EPO issued a decision to grant the patent which would take effect from 16 January 1985 pursuant to Article 97(4) EPC.
- VII. On 19 December 1984 the Appellant's representative filed a request based on Rule 89 EPC asking for a correction to be made in the granted Claim 1 and for a corresponding amendment to be made in the description and also for the addition of a new Claim 4 directed to a process for preparing methylated prostaglandin derivatives having a certain formula. The Appellant required also that the printing of the patent document be deferred until the requested corrections had been made.

VIII. On 9 January 1985, a Formalities Officer acting for Directorate General 2 of the EPO answered the above-mentioned request, indicating :

"Having declared your approval of the text as communicated with the advance notice and the communication pursuant to Rule 51(4) and (5) EPC respectively, the decision to grant the patent was issued on 22 November 1984. Amendments following this decision, under Rule 89 EPC, would necessitate a new decision by the Examining Division. This can only be considered after the printed patent specification has been issued. Upon receipt of the printed text, you can apply for such a decision."

IX. On 14 January 1985, the Appellant filed the present appeal requesting :

1. that the documents for grant be amended in accordance with the revised documents filed on 19 December 1984, or
2. that the decision for grant dated 22 November 1984 be set aside and a new decision for grant based on the above indicated documents be issued, or
3. that the decision for grant as well as the communication pursuant to Rule 51(4) and (5) EPC dated 27 June 1984 be set aside and a new communication pursuant to Rule 51(4) and (5) based on the above indicated documents be issued.

The appeal fee was duly paid and a statement giving the grounds of appeal was filed on 2 April 1985.

X. In his statement of grounds, the Appellant essentially argued that there existed in the decision to grant the patent a first logical contradiction between the set of

claims covering only compounds claims and pharmaceutical composition claims which are not acceptable by Austrian law and the designation of Austria and a second logical contradiction between the set of claims not covering a process and the description which states that the invention relates to the preparation of the compounds.

Consequently, the absence of a formal disapproval as well as the payment of the fees and the filing of the translations of the claims could not be considered as an approval of the text communicated since this text was in itself inconsistent. In an earlier decision J 12/83 (OJ EPO 1985, 6-10) the Board has stated that "in some circumstances, an Applicant for a European patent can be "adversely affected" within the meaning of 107 EPC, by a decision to grant a patent. This would clearly be so, for example, if the patent were granted with a text not approved by the Applicant contrary to Article 97(2)(a) EPC". Such being the present case, the appeal should be admissible and allowable.

XI. In a Communication issued on 31 July 1985, the Appellant's attention was drawn to the fact that the main request for correction based on Rule 89 EPC seemed inadmissible because no decision had previously been made on this request by the Examining Division. Thus, the Board of Appeal was not competent to decide on this question. The two subsidiary requests to revoke the decision to grant the patent were also to be considered as not admissible since it appeared from the documents on file that the Appellant had approved the text submitted within the meaning of Article 97(2)(a) and Rule 51(4) EPC and that consequently the Appellant could not be considered as a party "adversely affected" by the decision to grant the patent within the meaning of Article 107 EPC.

No answer to the Communication was received from the Appellant within the time limit set in this Communication. By letter dated 31 October 1985, the Appellant's representative applied for an extension of time of two months. This was granted but no answer and no further request for extension of time was received within the extended period.

Reasons for the Decision

1. In order for an appeal to be admissible, it must comply with the provisions of Articles 106-108 and Rule 64(b) EPC. An appeal that does not comply with these Articles and Rule has to be rejected as inadmissible unless any deficiency has been remedied before the relevant time limit laid down in Article 108 has expired : Rule 65(1) EPC.
2. In the present case, the Legal Board of Appeal considers the main request of the Appellant for correction based on Rule 89 EPC of the decision under appeal as not admissible because the Board can only examine appeals from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and of the Legal Division of EPO (Article 21(1) EPC).
3. The Board considers that the alleged existence of inconsistencies in the decision to grant a patent may be a ground for filing a request for correction based on Rule 89 EPC such as the one filed by the Appellant on 19 December 1984, although as indicated in point 2 above, a decision on such request must have been rendered by the Examining Division before the matter can be referred to the Board of Appeal.

However, such alleged inconsistencies do not affect the validity of the decision to grant the patent nor imply that the Appellant is "adversely affected" by this decision, within the meaning of Article 107 EPC. In fact, the Board considers that an Applicant for a European patent can only be adversely affected by a decision to grant the patent when such a decision is inconsistent with what he has specifically requested (The French text of Article 107 EPC states clearly "pour autant qu'elle (la décision) n'ait pas fait droit à ses prétentions").

4. In the present case, the description, claims and drawings of the granted patent correspond to the documents filed on the 19 November 1980 as amended by the Appellant respectively on 15 October 1981, 25 October 1982 and 21 November 1983. No disapproval of the patent being granted on the text indicated in the Communication of the EPO dated 27 June 1984 was communicated to the EPO but, on the contrary, the Appellant paid the fees requested and filed the translations within the time limit set.
5. The Board considers, having regard to the provision of Article 97(2)(a) and Rule 51(4) EPC, that no positive approval is required : positive disapproval is required to ensure that examination is resumed (cf. J 12/83 already cited).
6. It follows that the Legal Board is not satisfied that the Appellant is a party "adversely affected" by the decision to grant the European patent, within the meaning of Article 107 EPC.

ORDER

For the foregoing reasons,

It is decided that

The appeal against the decision dated 22 November 1984 of a Formalities Officer acting for Directorate General 2 is rejected as inadmissible.

U
Schmitt 28.2.86

The Registrar:

Josef Rie

The Chairman:

Peierlind