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**D E C I S I O N**  
of 18 January 2000

**Case Number:** J 0003/99 - 3.1.1

**Application Number:** 97104162.9

**Publication Number:** -

**IPC:** A61K 31/195

**Language of the proceedings:** EN

**Title of invention:**

The use of glutamine (GLN) in the preparation of a medicament

**Applicant:**

BRIGHAM AND WOMEN'S HOSPITAL

**Opponent:**

-

**Headword:**

Divisional application/BRIGHAM

**Relevant legal provisions:**

EPC R. 25(1), 51(4), 51(6)

**Keyword:**

"Belated divisional application filed after a valid approval in accordance with Rule 51(4) EPC, when the amendments requested by an applicant after the issuing of a communication under Rule 51(6) EPC are not accepted and are eventually withdrawn"

**Decisions cited:**

G 0007/93, G 0010/92

**Catchword:**

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Europäisches  
Patentamt

European  
Patent Office

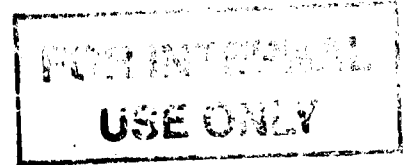
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Boards of Appeal

Chambres de recours

Case Number: J 0003/99 - 3.1.1



**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 18 January 2000

**Appellant:**

BRIGHAM AND WOMEN'S HOSPITAL  
75 Francis Street  
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Massachusetts 02115 (US)

**Representative:**

Wibbelmann, Jobst, Dr., Dipl.-Chem.  
Wuesthoff & Wuesthoff  
Patent- und Rechtsanwälte  
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D-81541 München (DE)

**Decision under appeal:**

Decision of the Receiving Section of the European  
Patent Office dated 11 August 1998 refusing to  
treat European patent application  
No. 97 104 162.9 as a European divisional  
application.

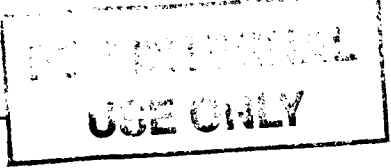
**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** J. C. M. De Preter  
B. J. Schachenmann

**Summary of Facts and Submissions**

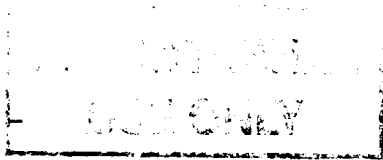
- I. The European patent application No. 97 104 162.9 was filed as divisional application based on the parent application No. 90 306 062.2 on 12 March 1997.
  
- II. A notice under Rule 51(4) EPC dated 19 June 1995 had been sent to the appellant informing him of the text in which the Examining Division intended to grant a patent on the earlier application.
  
- III. On 15 December 1995 the appellant amended its earlier application by introducing a new claim 2 and gave approval to the version of the revised application.
  
- IV. On 19 April 1996 a communication under Rule 51(6) EPC was sent to the appellant informing it that the Examining Division had accepted the proposed amendment.
  
- V. With a letter of 2 May 1996 the appellant filed a further amendment of claim 1 and also submitted the auxiliary request that the application be further processed on the basis of the text submitted with the communication under Rule 51(4) EPC dated 19 June 1995.
  
- VI. Thereupon the Examining Division cancelled the communication under Rule 51(6) EPC dated 19 April 1996 and stated on 13 May 1996 that the requested amendments could not be accepted as there was no reason to permit these amendments at this late stage in the procedure. The appellant was therefore requested to state within two months whether it requested grant of the patent on the basis of the approved text already notified.

- VII. By letter of 26 July 1996 the appellant maintained its request for further amendments and finally withdrew this request in a letter of 19 March 1997 so that a new communication pursuant to Rule 51(6) EPC was sent by the Examining Division, namely on 25 April 1997.
- VIII. On 24 April 1997 a "Noting of loss of rights pursuant to Rule 69(1) EPC was issued by the Receiving Section in connection with the appellant's later European application No. 97 104 162.9 stating that it could not be treated as a European divisional application because it had been filed on 12 March 1997, i.e. after approval had been given in respect of the pending earlier patent application No. 90 306 062.2 in accordance with Rule 51(4) EPC.
- IX. As the appellant applied for an appealable decision a communication was issued on 30 December 1997 informing the appellant of the reasons for which a negative decision in respect of the later application would be taken.
- X. By a decision of 11 August 1998 the appellant's request to set aside the notification pursuant to Rule 69(1) EPC was refused and it was decided that the European application No. 97 104 162.9 would not be treated as a European divisional application, as it had been filed after approval of the pending earlier European patent application No. 90 306 062.2 in accordance with Rule 51(4) EPC. In the reasons for the decision the Receiving Section referred *inter alia* to the Enlarged Board of Appeal's opinion G 10/92.
- XI. The appellant lodged an appeal against this decision on 24 September 1998, paying the appeal fee and submitting grounds of appeal which were received on 2 December 1998.



XII. The submissions of the appellant in its grounds of appeal can be summarised as follows:

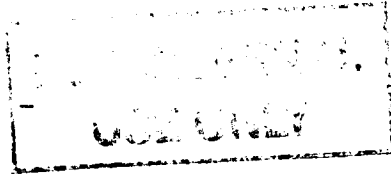
The decision of the Receiving Section conveyed the impression that once an approval in accordance with Rule 51(4) EPC had been given to the text of a patent application, an applicant would be barred from the possibility of filing a further divisional application. However, as explained in J 29/95 (OJ EPO 1996, 489) under certain circumstances the approval of the text might not be valid. Furthermore it was clearly not the intention of the Enlarged Board of Appeal in its opinion G 10/92 to state that once an applicant had given approval to the text he had sacrificed any possibility of filing a divisional application. This would be in stark contrast to and conflict with the earlier decision of the Enlarged Board of Appeal, namely G 7/93, where it was made plainly clear that the examination proceedings could be reopened even after the communication under Rule 51(6) EPC had been issued. However, as soon as a case was reopened and amendments of the claims were effected as in the present case, it followed logically that the filing of divisional applications had to be allowed then. Only at the end of the reopened examination proceedings did the applicant who had withdrawn its request for amendments give approval to the text of the specification on which the decision to grant a patent should be based. This approval was dated 19 March 1997 whereas the divisional application was filed on 12 March 1997. Accordingly the filing date of the divisional application clearly predated the date on which the applicant had given approval to the filed text in accordance with Rule 51(4) EPC and in accordance with G 10/92.



- XIII. A communication was issued by the Board on 19 July 1999 together with a summons to oral proceedings.
  
- XIV. At the oral proceedings held on 18 January 2000 the appellant maintained its request to set aside the decision under appeal and to remit the case to the first instance with the order to treat the European patent application No. 97 104 162.9 as a divisional application.

**Reasons for the Decision**

As set out by the appellant an approval of the notified text submitted by an applicant pursuant to Rule 51(4) EPC does not become binding for the Examining Division even if a communication in accordance with Rule 51(6) EPC has been issued. Following the issuing of such a communication the Examining Division has indeed a discretion under Rule 86(3), second sentence, EPC whether or not to allow further amendment of the application (G 7/93, OJ EPO 1994, 775). However, the mere fact that after a communication under Rule 51(6) EPC has been issued, an applicant withdraws its prior approval by filing amendments as in the present case does not mean that it acquires the right to file a divisional application (cf. opinion G 10/92, OJ EPO, 1994, 633, point 5 of the reasons). This right lapses on the deadline set by Rule 25(1) EPC i.e. when the text in which the European patent is to be granted is validly approved in accordance with Rule 51(4) EPC. It is true that when examination proceedings are reopened after the approval in accordance with Rule 51(4) EPC because the proposed text for grant is to be amended, Rule 51(4) EPC requires that the applicant once again be informed of the text in which the Examining Division intends to grant the European patent. In such a case,



for Rule 25(1) EPC to apply, it is the last approval given by the applicant that is decisive (cf. G 10/92, point 7 of the reasons). However, in the present case, upon the reopening of the examination proceedings following the appellant's request for amendments after the issuing of a communication under Rule 51(6) EPC, no new communication under Rule 51(4) EPC had to be sent to inform the appellant again of the text in which the Examining Division intended to grant a European patent, as the Examining Division stated that it could not accept the appellant's request for further amendments, which was eventually withdrawn.

What the appellant calls its final approval by the withdrawal of its request for amendments cannot be construed as an approval within the meaning of Rule 25(1) EPC as this approval was not given within the framework of Rule 51(4) EPC, which prescribes a certain form for the approval.

After the appellant's withdrawal of its request for further amendments it was clear that the only approval in accordance with Rule 51(4) EPC was that given by the appellant on 15 December 1995. Consequently the application No. 97 104 162.9 filed by the appellant on 12 March 1997 could not be treated as divisional application.

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**Order**

**For these reasons it is decided that:**

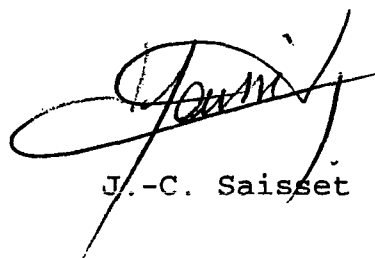
The appeal is dismissed.

The Registrar:

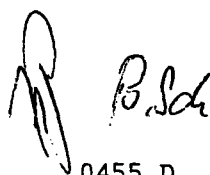


M. Beer

The Chairman:



J.-C. Saisset



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