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D E C I S I O N
of 15 April 2004

Case Number: T 1184/01 - 3.3.1

Application Number: 93902550.8

Publication Number: 0627420

IPC: C07D 207/448

Language of the proceedings: EN

Title of invention:

Maleimide compound improved in storage stability

Applicant:

NIPPON SHOKUBAI CO., LTD.

Opponent:

-

Headword:

Maleimide/NIPPON SHOKUBAI

Relevant legal provisions:

EPC Art. 54, 111(1), 123(2)

Keyword:

"Claims substantially amended on appeal - fresh case -
remittal"

Decisions cited:

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

Catchword:

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Case Number: T 1184/01 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 15 April 2004

Appellant: NIPPON SHOKUBAI CO., LTD.
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Chuo-ku
Osaka-fu 541 (JP)

Representative: Rees, David Christopher
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20 Red Lion Street
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 April 2001
refusing European application No. 93902550.8
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 31 May 2001 lies from the decision of the Examining Division posted on 3 April 2001 refusing European patent application No. 93 902 550.8 (European publication No. 627 420), which was filed as international application published as WO 93/15048.

II. The decision of the Examining Division was based on the two sets of claims according to the then pending main and auxiliary request. Claim 1 according to either request was a product claim directed to maleimide compositions. The Examining Division found that this subject-matter claimed lacked novelty in view of the document

(5) EP-A-165 574.

The Examining Division held in particular that the product claimed, i.e. the maleimides, was anticipated by document (5). That document disclosed the production of maleimides having a purity of 99.8%. The Examining Division pointed out that a higher degree of purity could anyhow not be considered a suitable feature for distinguishing the claimed maleimides from the known compounds.

III. At the oral proceedings before the Board held on 15 April 2004 the Appellant (Applicant) no longer maintained the former requests. He submitted a fresh request superseding any previous request. The sole claim 1 of that request read as follows:

"1. A process for suppressing discoloration of a maleimide compound characterised in that the process comprises: limiting the content of primary amines to not more than 500 ppm by continuously washing the maleimide compound with water; limiting the content of chlorine compounds to not more than 10 ppm by using compounds containing no chlorine compounds as raw materials; limiting the content of volatile compounds having a boiling point of not more than 200°C at normal pressure to not more than 2000 ppm by ventilating the maleimide compound with inert gas; and limiting the content of 2-amino-N-substituted succinimide compounds to not more than 300 ppm by reacting maleic anhydride and primary amine in a molar ratio of not less than 1."

The Appellant argued in respect of novelty that the objections raised in the decision under appeal were met since any product claim directed to the maleimides was no longer present.

IV. The Appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution on the basis of the request submitted at the oral proceedings on 15 April 2004.

V. 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*

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.

In the present case the Board, thus, restricts itself to examine whether the objection as to lack of novelty pursuant to Article 54 EPC which is stated in the decision under appeal as being the sole ground for refusal of the application has been removed.

3. *Ground for refusal*

The decision under appeal dealt with lack of novelty of exclusively the independent product claim 1 of the then pending requests directed to maleimide (compositions) *per se* and did not consider any further claims. The amendment of the claimed subject-matter made by the fresh request, in particular by dropping any product claim while presenting a fresh process claim, has the

effect that the reasons given in the contested decision for refusing the present application no longer apply since the present claim has never been challenged under Article 54 EPC.

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).

4. *Remittal*

Having so decided, the Board has not, however, taken a decision on the whole matter, since a substantial amendment to the subject-matter claimed has been made by fresh claim 1 which was only presented at the oral proceedings before the Board. The decision under appeal dealt exclusively with deficiencies of the product claims according to the then pending requests and did not consider the fresh process claim of the present request 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 objections raised. Thus, the fresh process claim generates a fresh case not yet addressed in examination proceedings and requiring reexamination.

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

5. In order to streamline the proceedings, the Board, nevertheless, has considered the amendments comprised in fresh claim 1 with respect to the provisions of Article 123(2) EPC. That claim, as regards the indicated process steps, has sufficient support in the application as filed on page 4, paragraph 4, lines 1 and 2, page 9, paragraph 1, line 7, page 12, paragraph 1, lines 11 to 13 and paragraph 3, line 5, and page 7, paragraph 1, lines 5 to 9. While the limits of the particular impurities specified in claim 1 are disclosed in combination in the original claims 13 and 16, the Board has noticed that the limit of 10 ppm indicated for the chlorine compounds was originally stated in relation to chlorine atoms. This issue merits consideration when resuming examination proceedings on the basis of fresh claim 1.

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 the request submitted at the oral proceedings on 15 April 2004.

The Registrar:

The Chairman:

N. Maslin

A. Nuss