

**Internal distribution code:**

- (A)  Publication in OJ  
(B)  To Chairmen and Members  
(C)  To Chairmen  
(D)  No distribution

**D E C I S I O N**  
**of 22 February 2005**

**Case Number:** T 0119/03 - 3.3.1

**Application Number:** 98922946.3

**Publication Number:** 0983227

**IPC:** C07C 231/12

**Language of the proceedings:** EN

**Title of invention:**

Preparation of tri-iodo benzene compounds

**Applicant:**

Amersham Health AS

**Opponent:**

-

**Headword:**

Triiodobenzene/AMERSHAM

**Relevant legal provisions:**

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

**Keyword:**

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

**Decisions cited:**

G 0010/93

**Catchword:**

-



Case Number: T 0119/03 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 22 February 2005

**Appellant:**

Amersham Health AS  
Nycoveien 1-2  
PO Box 4220  
Nydalen  
N-0401 Oslo (NO)

**Representative:**

Dr Hendrik Wichmann  
Postfach 86 08 80  
D-81635 München (DE)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 23 July 2002  
refusing European application No. 98922946.3  
pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** R. Freimuth  
S. C. Perrymann

## Summary of Facts and Submissions

- I. The appeal lodged on 2 October 2002 lies from the decision of the Examining Division posted on 23 July 2002 refusing European patent application No. 98 922 946.3 (European publication No. 983 227), which was filed as international application published as WO 98/52909.
- II. The decision of the Examining Division was based on an amended set of 12 claims according to the then pending request wherein claims 1 to 7 were process claims and claims 8 to 12 product claims directed to compounds defined by way of their chemical names. The Examining Division found that the claimed compounds lacked novelty in view of the prior art cited and, thus, refused the application.
- III. The Appellant no longer maintained in appeal proceedings the former request. Annexed to the letter dated 9 February 2005, he submitted a fresh set of seven process claims superseding any previous request without giving any further explanation as to the substance. These process claims were identical to those process claims already on file and the fresh set of claims no longer comprised any product claim.
- IV. The Appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of claims 1 to 7 filed on 9 February 2005. Subsidiarily he requested oral proceedings. His former request for reimbursement of the appeal fee was withdrawn with letter dated 16 February 2005.

## Reasons for the Decision

1. The appeal is admissible.
2. *Scope of examination on appeal*

While Article 111(1), second sentence, first alternative, EPC gives the Boards of Appeal the power to decide in *ex-parte* proceedings on fresh issues where the application has been refused on other issues, 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), fresh issues normally being left to the Examining Division to consider after a referral back, so that the Appellant has the opportunity for these to be examined and decided upon without "loss of an instance".

In the present case the Board, thus, restricts itself to considering whether the amended set of claims meets the formal requirements of Article 123(2) EPC and 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. *Amendments (Article 123(2) EPC)*

Claim 1 is based on original claim 1 and page 6, line 31 of the application as filed. Claims 2 to 5 are identical to original claims 2 to 5. Claim 6 finds

support on original page 6, line 32 and claim 7 on original page 8, line 24.

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

4. *Novelty*

The decision under appeal dealt with lack of novelty only of the product claims of the then pending request directed to compounds *per se* and did not consider any further claim. The amendment made to the fresh set of claims, in particular dropping any product claim, has 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 54 EPC for lack of novelty.

Thus, the Board considers that the amendment made by the Appellant avoids the sole objection forming the basis of the decision under appeal and is 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.

5. *Remittal*

- 5.1 Having so decided, the Board has not, however, taken a decision on the whole matter, since the substantially amended set of claims was presented for the first time in appeal proceedings before the Board. The decision under appeal dealt exclusively with lack of novelty of the product claims according to the then pending

request 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. The dropping of any product claim has 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 54 EPC for lack of novelty.

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

- 5.2 Since the Appellant's request succeeds there is no need for the Board to consider its subsidiary request for oral proceedings.
- 5.3 The Board has noticed an obvious misprint in step (iv) of present claim 1 insofar as the temperature of 34°C should read 35°C. That point may need consideration by the first instance when resuming examination proceedings.

**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 set of claims 1 to 7 submitted on 9 February 2005 in appeal proceedings.

The Registrar:

The Chairman:

N. Maslin

A. Nuss