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**Datasheet for the decision  
of 6 October 2009**

**Case Number:** T 0870/07 - 3.3.01

**Application Number:** 03018398.2

**Publication Number:** 1375498

**IPC:** C07D 405/14

**Language of the proceedings:** EN

**Title of invention:**  
Optically active epoxy compound

**Applicant:**  
NISSAN CHEMICAL INDUSTRIES LTD.

**Opponent:**

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**Headword:**  
Epoxy enantiomer/NISSAN

**Relevant legal provisions:**  
EPC Art. 76(1), 123(2), 84, 83, 111(2), 92, 108  
RPBA Art. 12(1), 13(1)(3)  
EPC R. 71(2)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Request filed in the appeal proceedings: within the scope of the appeal (yes); search report encompassing the new claimed subject-matter (yes); novelty (yes); sufficiency of disclosure (yes); remittal for assessment of inventive step (yes) since the decision of the first instance is silent regarding this issue."

**Decisions cited:**  
G 0010/93, T 0087/05

**Catchword:**

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Case Number: T 0870/07 - 3.3.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 6 October 2009

**Appellant:**

NISSAN CHEMICAL INDUSTRIES LTD.  
3-7-1, Kanda Nishiki-cho  
Chiyoda-ku  
Tokyo... (JP)

**Representative:**

Hartz, Nikolai,  
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D-80333 München (DE)

**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 13 December 2006  
refusing European patent application  
No. 03018398.2 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. Ranguis  
**Members:** J.-B. Ousset  
T. Bokor

## Summary of Facts and Submissions

I. An appeal has been lodged against the decision of the examining division to refuse the European patent application No. 03 018 398.2 on the basis of the then pending main and first auxiliary requests. Both requests comprised identical claims 1 and 2 which read as follows:

- "1. (2R,2'R,2''R)-tris(2,3-epoxypropyl)-isocyanurate."
- "2. (2S,2'S,2''S)-tris(2,3-epoxypropyl)-isocyanurate."

II. In its decision, the examining division considered that the claimed subject-matters of claims 1 and 2 of both requests are not novel in view of the disclosures of the following documents:

- (1) Journal of Medicinal Chemistry, (1989), vol. 32, pages 648-651.
- (2) DE-A-2953309.

The examining division contended that the enantiomeric forms of the racemates alpha and beta of the triglycidyl isocyanurate (TGIC) are unambiguously disclosed in documents (1) and (2). Moreover, document (2) suggested the resolution of the racemic mixture of alpha- and beta-TGIC. It concluded therefore that the individual enantiomers were accessible to the person skilled in the art and were not regarded as novel.

III. With the statement of grounds of appeal, the appellant requested that a patent be granted on the basis of the refused main and first auxiliary requests. In response to the communication of the Board accompanying the

summons to oral proceedings and citing two further documents

- (3) Die Angewandte Makromolekulare Chemie **228** (1995), 25-40
- (4) Grundlage der stereochemischen Methodik (1983), pp. 162-167

the appellant submitted a second auxiliary request and requested that a question be referred to the Enlarged Board of Appeal if the board was inclined to find that the claims on file lack novelty.

- IV. Oral proceedings took place before the board on 6 October 2009.
- V. During the oral proceedings, the appellant filed a second auxiliary request to replace the former one submitted (point III) and thereafter withdrew the main and the first auxiliary requests. The request of referral to the Enlarged Board of Appeal was also withdrawn. This second auxiliary request was thus promoted to main and sole request and reads as follows:

"1. Use of (2R, 2'R, 2''R)-tris(2,3-epoxypropyl)-isocyanurate or (2S, 2'S, 2''S)-tris(2,3-epoxypropyl)-isocyanurate or cured products thereof, as a stationary phase of an optical resolution agent."

The appellant argued as follows:

- Each enantiomer was not a resolving agent per se but are used in order to make an optical resolution agent.

- Although no use claim was present in the parent application as filed nor in the current divisional application as filed, the search has been carried out exhaustively, since the enantiomers *per se* were claimed originally and since such compound claims gave an absolute protection on the claimed compounds, all the fields must have been searched.
  
- In document (2), relating to medicinal application, the diastereoisomers (2R,2'R,2''R)-tris(2,3-epoxypropyl)-isocyanurate / (2S,2'S,2''S)-tris(2,3-epoxypropyl)-isocyanurate were cited. This showed that a search in other fields has been carried out by the search examiner and no further search was therefore required to assess the patentability of the main request.
  
- There was no shift to another invention by filing such a main request, since the main request related only to use of the originally claimed enantiomers, which were exhaustively searched.

VI. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the single claim filed during oral proceedings under the title of second auxiliary request, promoted to main request.

VII. At the end of the oral proceedings, the decision of the board was announced.

## Reasons for the Decision

1. The appeal is admissible.
2. Admissibility of the late-filed main request
  - 2.1 The main request was filed during oral proceedings before the board.
    - 2.1.1 According the Rules of Procedure of the Boards of Appeal, the *ex parte* appeal proceedings shall be based on the notice of appeal and statement of grounds of appeal pursuant to Article 108 EPC (see Article 12(1) of the RBPA, supplement to OJ EPO 1/2008). Any amendment to the party's case after it has filed its grounds of appeal may be admitted and considered at the board's discretion (Article 13(1) RBPA, first sentence).
    - 2.1.2 Therefore, in the present case, the main request having not been filed with the statement of grounds of appeal is late-filed and its admissibility is left to the board's discretion. The discretion shall be exercised in view of inter alia the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy (see Article 13(1) RPBA, second sentence). This last requirement applies, in particular, to the stage after the summons to oral proceedings since the requested amendments after the oral proceedings have been arranged shall not be admitted if they raise issues which the Board cannot reasonably be expected to deal with without adjournment of the oral proceedings (see Article 13(3) RBPA, second sentence).

- 2.1.3 One of the criteria to be applied is whether the amended claim generates for the assessment of the patentability a new situation such that the Board is not in the position to consider it without unjustified procedural delay, which would be contrary to the principle of procedural economy mentioned above (T 87/05, point 2).
- 2.1.4 In the present case, the question to be addressed is whether it can be ascertained that the search encompassed the applications of the enantiomers.
- 2.1.5 In that respect, the board observes that a search report must be drawn up on the basis of the claims, with due regard to the description (see Article 92 EPC). This is confirmed by the Guidelines for examination in the EPO which state: "In principle, and insofar as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (see B. III. 3.5).
- 2.1.6 The board has thus no reason to doubt that the specific use of the originally claimed enantiomers has also been searched.
- 2.1.7 The board is therefore satisfied that a search has been carried out for the outstanding claimed subject-matter.
- 2.1.8 In view of the above, the situation is not new in the sense that the board is not in a position to examine the claimed subject-matter (due to an incomplete search) and for this reason, the board using its discretionary power admits this request into the procedure.

3. Substantive examination of this request
  - 3.1 Proceedings before the boards of appeals in *ex parte* are primarily concerned with examining the contested decision (G 10/93, OJ EPO 1995, 172). That means that the objection(s) which have led to the refusal of the application are to be examined. In that respect, it should be noted that requirements having not led to an objection in the examining proceedings but which have nevertheless been taken into account at least implicitly by the examining division should be considered at this stage.
  - 3.2 In the present case, it is clear that the examining division has examined the requirement of sufficiency in addition to that of novelty even though no objection has been raised in that respect (see Rule 51(3) EPC 1973 or Rule 71(2) EPC 2000). Only the requirement of Article 56 EPC was not examined by the examining division.
  - 3.3 The board, thus, restricts itself to examining whether the amended claim meets the requirements of Articles 76(1), 123(2), 84, 83 EPC and whether the objection as to lack of novelty pursuant to Article 54 EPC as formulated in the decision under appeal and forming the sole ground for refusal of the application, can still be considered as applying to the amended claims.



4. Formal matters

4.1 The wording of claim 1 of the main request is based on page 17, line 27 to page 18, line 4 of the description of the parent application and the present divisional application.

4.2 The requirements of Article 76(1) and 123(2) EPC are thus fulfilled.

4.3 The wording of claim 1 is unambiguous and in accordance with the content of the description as originally filed.

4.4 The requirements of Article 84 EPC are thus met.

5. Sufficiency of disclosure

5.1 Example 9 of the description as originally filed gives an application of the enantiomer (2R,2'R,2''R)-tris(2,3-epoxypropyl)-isocyanurate as cured product on a stationary phase as an optical resolution agent. In this example, 1,1'-bi-2-naphthol was resolved in its enantiomers. In view of this example, the board has no reason to believe that further racemates cannot be resolved by this method.

5.2 Therefore, the board is satisfied that the person skilled in the art can carry out the invention in its whole scope (Article 83 EPC).

6. Novelty

6.1 Document (1) relates to the crystallographic resolution and to the crystal and molecular structures of the

- alpha- and beta-tris(2,3-epoxypropyl)-isocyanurate. It is only mentioned in this document, that these compounds have antineoplastic properties (see abstract).
- 6.2 Document (2) discloses the enantiomers 2R,2'R,2''R)-tris(2,3-epoxypropyl)-isocyanurate or (2S,2'S,2''S)-tris(2,3-epoxypropyl)-isocyanurate (see page 5, lines 10 to 14), which can be used as cytostatic compounds (see claim 1 on page 1).
- 6.3 Document (3) relates to the separation and the crystallisation of the alpha- and beta-tris(2,3-epoxypropyl)-isocyanurate and their characterisation by analytical methods like 1H-NMR, 13C-NMR or IR-spectroscopy (see "Summary" on page 25). No use for these compounds is described therein.
- 6.4 Document (4) is a citation from a textbook illustrating the general knowledge, which details physical methods to differentiate stereoisomers. Examples of the methods mentioned in this document range from chromatography using a chiral stationary phase, derivatisation by using a chiral reagent to resolution by crystallisation in presence of an optically active base or acid. Neither the said enantiomers nor their use are disclosed in this document.
- 6.5 In view thereof, none of the cited documents mentions that the enantiomers 2R,2'R,2''R)-tris(2,3-epoxypropyl)-isocyanurate or (2S,2'S,2''S)-tris(2,3-epoxypropyl)-isocyanurate can be used for the making of a stationary phase of an optical resolution agent.

6.6 Hence, the board concludes that the claimed subject-matter satisfies the requirement of novelty as set out in Article 54 EPC.

7. Remittal

7.1 The board has come to the conclusion that the subject-matter of the main request meets the requirement of Article 54 EPC and therefore, overcomes the sole reason supporting the refusal of the present application by the department of the first instance (see II above).

7.2 Having regard to the fact that the function of the boards of appeal is primarily to give a judicial decision upon the correctness of the earlier decision taken by the department of the first instance, the board exercises its discretion under Article 111(1) EPC to remit the case to the department of the first instance for the assessment of inventive step.

**Order**

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

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance for further prosecution.

The Registrar:

The Chairman:

B. Atienza

P. Ranguis