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**Datasheet for the decision
of 12 November 2013**

Case Number: T 1344/11 - 3.3.10
Application Number: 02728658.2
Publication Number: 1379485
IPC: C07C6/02, C07C6/04, C07C6/06,
B01J31/22
Language of the proceedings: EN

Title of invention:

SELECTIVE RING-OPENING CROSS-METATHESIS OF CYCLOOLEFINS

Applicant:

CALIFORNIA INSTITUTE OF TECHNOLOGY

Headword:

Relevant legal provisions:

EPC Art. 111(1), 113(2)
EPC R. 71(3)

Keyword:

Remittal to the department of first instance - (yes)
On the basis of the request on the basis of which the
Examining Division intended to grant a patent

Decisions cited:

G 0010/91

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1344/11 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 12 November 2013

Appellant:
(Applicant)

CALIFORNIA INSTITUTE OF TECHNOLOGY
1200 East California Boulevard,
Mail Code 201-85
Pasadena, CA 91125 (US)

Representative:

Mallalieu, Catherine Louise
D Young & Co LLP
120 Holborn
London EC1N 2DY (GB)

Decision under appeal:

**Decision of the Examining Division of the
European Patent Office posted on 27 December
2010 refusing European patent application No.
02728658.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: J. Mercey
D. Rogers

Summary of Facts and Submissions

I. This appeal lies from the decision of the Examining Division dated 27 December 2010 refusing European patent application No. 02728658.2 with the European publication No. 1 379 485 and International publication No. WO 02/079127.

II. A communication under Rule 71(3) EPC had been issued on 2 July 2010 informing the Appellant (Applicant) that the Examining Division intended to grant a European patent on the basis of auxiliary request 3 filed during oral proceedings on 4 May 2010. The only claim of this request reads as follows:

"A method for carrying out a ring-opening cross-metathesis (ROCM) reaction between a cyclic olefin and a second olefinic reactant, comprising contacting the cyclic olefin with the second olefinic reactant in the presence of a catalyst composed of a Group 8 transition metal alkylidene, wherein the catalyst is $\text{RuCl}_2(\text{=CH-Ph})(\text{IMesH}_2)(\text{PCy}_3)$, the cyclic olefin is a monocyclic olefin selected from cyclooctadiene (COD), 1,5-dimethyl-1,5-cyclooctadiene, cyclopentene and cyclohexene and the second olefinic reactant is an α,β -unsaturated carbonyl compound."

III. With letter dated 10 November 2010 the Appellant disapproved the text proposed for grant (Article 113(2) EPC) and requested an appealable decision on the main and auxiliary requests 1 and 2 then on file.

IV. In the decision under appeal, the Examining Division found that the subject-matter of the then pending main request contained subject-matter which extended beyond the content of the application as filed and also lacked

- novelty. The subject-matter of auxiliary requests 1 and 2 lacked inventive step and auxiliary request 1 also contained subject-matter which extended beyond the content of the application as filed.
- V. With its statement setting out the grounds of appeal filed 5 May 2011, the Appellant filed a main request and auxiliary requests 1 to 4. Auxiliary request 4 was identical to auxiliary request 3 on the basis of which which the Examining Division had indicated in its communication under Rule 71(3) EPC that it intended to grant a patent.
- VI. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal annexed to a summons to oral proceedings, the Board indicated that it was of the provisional opinion that the subject-matter of the main request contained subject-matter which extended beyond the content of the application as filed, that the subject-matter of the main and auxiliary request 1 lacked novelty, and the subject-matter of auxiliary requests 1 to 3 was not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. The Board further indicated that it would be minded to remit the case to the first instance for further prosecution on the basis of auxiliary request 4.
- VII. With letter dated 6 November 2013, the Appellant withdrew the main and auxiliary requests 1 to 3 and made auxiliary request 4 its main (and only) request. The Appellant requested that a patent be granted on the basis of this request and withdrew its request for oral proceedings.

VIII. At the end of the oral proceedings which were held on 12 November 2013 in the absence of the Appellant, the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. The withdrawal of the main and auxiliary requests 1 to 3 filed with the statement of grounds of appeal has as a consequence that the reasons given in the contested decision for refusing the present application no longer apply, the only request remaining being that on the basis of which the Examining Division had indicated it intended to grant a patent (see points II, V and VII above).
3. Since proceedings before the Boards of Appeal in *ex-parte* cases are primarily concerned with examining the contested decision (see G 10/93, OJ EPO 1995, 172, points 4 and 5 of the reasons), the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of the claim according to the main request.

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 first instance for further prosecution on the basis of the main request.

The Registrar:

The Chairman:



D. Magliano

P. Gryczka

Decision electronically authenticated