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**Datasheet for the decision
of 9 November 2016**

Case Number: T 1628/12 - 3.3.01
Application Number: 05721391.0
Publication Number: 1728791
IPC: C07D453/02, A61K9/20,
A61K31/439, A61K47/34,
A61P1/12, A61P13/02, A61P27/08
Language of the proceedings: EN

Title of invention:

COMPOSITION FOR SOLID PHARMACEUTICAL PREPARATION OF
SOLIFENACIN OR SALT THEREOF

Applicant:

Astellas Pharma Inc.

Headword:

Solifenacin/ASTELLAS

Relevant legal provisions:

EPC Art. 111
RPBA Art. 13

Keyword:

Late-filed request - admitted (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 1628/12 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 9 November 2016

Appellant: Astellas Pharma Inc.
(Applicant) 3-11, Nihonbashi-Honcho 2-chome,
Chuo-ku
Tokyo 103-8411 (JP)

Representative: Hoffmann Eitle
Patent- und Rechtsanwälte PartmbB
Arabellastraße 30
81925 München (DE)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 7 December 2011
refusing European patent application No.
05721391.0 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman A. Lindner
Members: M. Pregetter
M. Blasi

Summary of Facts and Submissions

- I. The present appeal lies from the decision of the examining division refusing the European patent application No. 05721391.0, which was filed as an international application published as WO 2005/092889 and, by the EPO in one of its official languages, as EP-A-1 728 791.
- II. The decision under appeal was based on the main request filed during oral proceedings.

The examining division considered that the subject-matter of claims 1-12 was novel but lacked inventive step.

- III. With its statement of grounds of appeal, the appellant submitted a main request and two auxiliary requests. The main request corresponded to the main request considered in the decision under appeal with some minor editorial amendments.
- IV. In a communication dated 18 August 2016, sent as annex to the summons to oral proceedings, attention was drawn by the board to certain additional points. Apart from considerations under Articles 56 and 123(2) EPC for all the requests then on file, additional points arising with respect to the auxiliary requests under Article 84 EPC were addressed.
- V. By letter dated 6 October 2016 the appellant filed a new main request and new auxiliary requests 1 and 2. The new main request differed from the former main request by the deletion of claims 5-15. Analogous deletions had been effected in auxiliary requests 1

and 2.

- VI. Oral proceedings were held on 9 November 2016. In the course of the oral proceedings the appellant filed a new set of claims as auxiliary request 3 that, after withdrawal of the requests filed with the letter dated 6 October 2016, became its sole (main) request.
- VII. The appellant argued that the new main request was to be admitted into the appeal proceedings, since certain new aspects concerning the product-by-process claim of auxiliary request 2 had been raised by the board. The appellant raised no objections to remitting the case to the examining division.
- VIII. The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the sole request filed at the oral proceedings.
- IX. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

Admission of auxiliary request 3 (Article 13(1) RPBA)

Auxiliary request 3 was filed at an advanced stage of the appeal proceedings, namely towards the end of the oral proceedings before the board, after the discussion of the main request and auxiliary requests 1 and 2 of 6 October 2016 had been completed.

However, the submission of the new claim request was a reaction of the appellant to the objections raised by the board for the first time at the oral proceedings in connection with auxiliary request 2. As the board's objections were directed to a product claim additionally defined by features pertaining to its method for preparation, it appeared to be a logical consequence for the appellant to change the claim category from a product claim to a method claim, as has been effected in the new claim request. The board, exercising its discretion under Article 13(1) RPBA, therefore decided in the present case to admit the new claim request into the proceedings.

2. *Remittal to the examining division (Article 111(1) EPC)*

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 new claim 1 depriving the decision under appeal of its basis. The decision under appeal dealt exclusively with deficiencies of the product claims according to the then pending requests. A method claim comparable to claim 1 of the present request was not object of an assessment by the examining division. It is only before the board that the appellant has dropped any product claim in order to overcome the objections raised by the board. Thus, the new method claim involves questions not yet addressed by the examining division and requiring further examination. Under these circumstances the board considers it appropriate to exercise its power conferred on it by Article 111(1), second sentence, EPC to remit the case to the examining division for further prosecution. The appellant had also raised no objections in this respect.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution on the basis of claims 1 to 3 of the sole request filed at the oral proceedings before the board.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated