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European Patent  
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Chambres de recours



Case Number: T 92 / 82

**DECISION** of 13 May 1985  
correcting errors in the decision **of the Technical Board of Appeal 3.3.1**  
of 15 March 1985

**Appellant:**

Eisai Co.Ltd.  
6-10, Koishikawa 4-chome-Bunkyo-ku  
Tokyo 112  
Japan

**Representative:**

Eitle, Werne, Dipl.-Ing.  
Arabellastraße 4  
8000 München 81

**Composition of the Board:**

Chairman: K. Jahn  
Member: G. Szabo  
Member: M. Prélot

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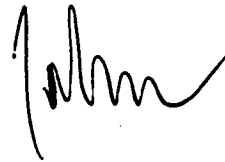
In application of Rule 89 EPC the decision given on  
15 March 1985 is hereby to be corrected as follows:

page 1, Summary of Facts and Submissions, last paragraph,  
insert in line 4 after "to"-: "the use of".

The Registrar



The Chairman





Veröffentlichung im Amtsblatt	<del>XX</del> /Nein
Publication in the Official Journal	<del>XX</del> /No
Publication au Journal Officiel	<del>XX</del> /Non



Aktenzeichen / Case Number / N° du recours : T 92/82

Anmeldenummer / Filing No / N° de la demande : 78 101 367.7

Veröffentlichungs-Nr. / Publication No / N° de la publication : 2051

Bezeichnung der Erfindung: Use of butoxybenzylhyoscyamine bromide in  
Title of invention: pharmaceutical compositions against deafness  
Titre de l'invention : and tinnitus

Klassifikation / Classification / Classement : A61K

### ENTSCHEIDUNG / DECISION

vom / of / du 15 March 1985

Anmelder / Applicant / Demandeur : Eisai Co. Ltd.

~~Patentinhaber / Proprietor of the patent /  
Titulaire du brevet~~

~~Einsprechender / Opponent / Opposant~~

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Art. 111, 112 (2) EPC

"Remitting the case on grounds of a Decision of the Enlarged  
Board of Appeal"

"Second medical indication"

Leitsatz / Headnote / Sommaire

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**DECISION**  
of the Technical Board of Appeal 3.3.1

of 15 March 1985

**Appellant:** Eisai Co.Ltd.  
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Tokyo 112  
Japan

**Representative:** Eitle, Werner, Dipl.-Ing.  
Arabellastraße 4  
8000 München 81

**Decision under appeal:** Decision of Examining Division 001 of the European Patent  
Office dated 12 February 1982 refusing European patent  
application No 78 101 367.7 pursuant to Article 97(1)  
EPC

**Composition of the Board:**

Chairman: K. Jahn

Member: G. Szabo

Member: M. Prélot

SUMMARY OF FACTS AND SUBMISSIONS

- I. European patent application No. 78 101 367.7 filed on 14 November 1978 was refused by decision of the Examining Division of the EPO dated 12 February 1982. This decision was based on a claim which is still on file and is directed to the use of chemical substances for therapeutic purposes (hereinafter : use claim).
- II. The main ground for refusing the application was that the Convention does not permit the grant of a patent with such a use claim.
- III. The applicant lodged an appeal against this decision on 20 May 1981. In the course of the appeal proceedings the Board of Appeal put, in a referral decision of the 20 June 1983, before the Enlarged Board of Appeal of the EPO the question of law as to whether a European patent may be granted with use claims (cf. referral decision in a similar case T 17/81, "Nimodipin/Bayer" of 30 May 1983, OJ EPO 7/1983, p. 266).
- IV. In its decision Gr 05/83 of 5 December 1984 the Enlarged Board of Appeal decided that a European patent may not be granted with the above kind of claims, but may be granted with claims directed to a substance or composition for preparation of a medicament for a specific, new and inventive therapeutic use.



REASONS FOR THE DECISION

1. As stated already in the Referral Decision, the appeal complies with Articles 106 to 108 and Rule 64 EPC, and is therefore admissible.
2. The Decision of the Enlarged Board of Appeal has fundamentally clarified the legal position and created a new type of claim for inventions of this nature.

The application in question in the appeal proceedings still contains a use claim of the kind excluded by the Enlarged Board of Appeal. The grant of a patent now depends on whether the existing claims are redrafted, in conformity with Article 123(2) and Rule 86 (3) EPC, in such a way as to comply with the Decision of the Enlarged Board of Appeal.

3. Therefore the demand for protection needs to be newly formulated. The new approach should be dealt with before the Examining Division, both because this will save time and avoid loss of an instance, and because the substantive examination has still to be carried out. The Board of Appeal therefore remits the case under Article 111(2) EPC to the Examining Division for further prosecution.
4. In the light of Rule 67 EPC, a reimbursement of the fee for appeal is not called for, since there has been no substantial procedural violation within the meaning of that provision.

ORDER


For these reasons it is decided that :

1. The contested decision is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:

  
(Rückerl)

The Chairman:

  
(Jahn)

*Handwritten notes:*  
25/3  
