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**D E C I S I O N**  
of 23 June 1997

**Case Number:** T 0946/96 - 3.3.1

**Application Number:** 90402693.7

**Publication Number:** 0420763

**IPC:** C07D 239/60

**Language of the proceedings:** EN

**Title of invention:**

6-substituted acyclopyrimidine nucleoside derivatives and  
antiviral agent containing the same as active ingredient  
thereof

**Applicant:**

Mitsubishi Chemical Corporation

**Opponent:**

-

**Headword:**

Acyclopyrimidine nucleosides/MITSUBISHI

**Relevant legal provisions:**

EPC Art. 78(1)(c), 113(1), (2)  
EPC R. 67, 86(3)

**Keyword:**

"No opportunity to comment on basis of decision"  
"Decision taken on claims not agreed to by the applicant"  
"Substantial procedural violation (yes)"  
"Reimbursement of the appeal fee (yes)"

**Decisions cited:**

T 0867/91

**Catchword:**

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Case Number: T 0946/96 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 23 June 1997

**Appellant:** Mitsubishi Chemical Corporation  
5-2, Marunouchi 2-chome  
Chiyoda-ku  
Tokyo (JP)

**Representative:** Gutmann, Ernest  
Ernest Gutmann - Yves Plasseraud S.A.  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 3 June 1996  
refusing European patent application  
No. 90 402 693.7 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** P. Krasa  
S. C. Perryman

## Summary of Facts and Submissions

- I. This appeal lies from the decision of the Examining Division refusing the European patent application No. 90 402 693.7 (publication No. 0 420 763), filed on 28 September 1990 relating to 6-substituted acylclopypyrimidine nucleoside derivatives and antiviral agent containing the same as active ingredients.
- II. Insofar as relevant, the prosecution history of the application can be summarized as follows:
- A first five page communication was issued by the Examining Division on 25 February 1994, objecting to the novelty of the then claim 1 on the basis of documents D2 to D9 and D13, and making provisional comments on inventive step and lack of clarity, and warning of the need for any amendments to comply with Article 123 EPC. In response, on 7 July 1994 the Appellant (applicant) filed an amended set of twenty-nine claims with substantial amendments being made to the claims compared to the original claims.
  - A second communication was issued by the Examining Division on 3 November 1994, objecting under Article 123(2) EPC to the first set of amended claims as containing technical information which could not be derived from mere reading of the application as filed. In response, on 15 May 1995 the Appellant filed a second amended set of twenty-nine claims and an amended description, and indicated that these were believed to meet the objections and that the claims were in a condition for allowance.

- A third four page communication was issued by the Examining Division on 29 June 1995, setting out objections under Article 123(2)EPC, under Article 84 EPC that the forty disclaimers introduced into claim 1 rendered it obscure, under Article 82 EPC that there did not appear to be a single inventive concept linking together all the inventions, so that subject to any clarification the applicant could provide, an objection would be raised, under Article 54 EPC that the novelty objection raised in the previous communication of 25 February 1994 had not been removed by the disclaimers of individual compounds in claim 1, and further possible problems on inventive step were indicated.
  
- In response, on 3 April 1996 the Appellant filed a third amended set of fourteen claims, in which the claims were substantially different from those objected to in the communication of 29 June 1995, in that, for example, the forty disclaimers no longer appeared in claim 1, to avoid, as stated by the Appellant, its being considered obscure. No oral proceedings were requested.
  
- No further communication was issued by the Examining Division, nor was there any telephone contact with the Appellant nor did oral proceedings take place, before the Examining Division issued the written decision under appeal on 3 June 1996 refusing the application.

III. In the decision under appeal it was stated inter alia that:

- "The Applicant did not request Oral Proceedings (Art. 116 EPC). Consequently, a decision can be taken on the basis of the written procedure."  
(Facts and Submissions Point 8)
  
- "The Examining Division decides to use its power of discretion under Rule 86(3) EPC and does not allow the set of claims submitted by the Applicant with his letter of 3.04.96 since it infringes the requirements of Art. 123(2) EPC and hence cannot be used as basis for a grant." (Reasons point 1)
  
- "This decision is based on the following documents:  
Description  
Pages 1-133 as originally filed  
Claims  
Claims 1 - 29 as filed with your letter of 15.05.95 (copy annexed)" (Reasons point 2)

The decision went on to detail the objections made to these twenty-nine claims and to state that the application was rejected for contravening Articles 123(2), 54(2) and 84 EPC in conjunction with Article 97(1) EPC.

IV. The Appellant filed an appeal requesting in the Grounds of Appeal filed 14 October 1996 that the decision by the Examining Division be set aside and as primary request that the Board decide that the examination proceedings be resumed before the Examining Division, particularly on the ground that the conditions of Article 113(1) EPC had not been fulfilled, and as secondary request that the Board itself decide by virtue of its powers pursuant to Article 111 EPC that

the patent be granted on the basis of a set of twenty-nine claims headed "Main request" or a set of claims headed "Auxiliary request" filed with the Statement of Grounds of Appeal.

The Appellant also requested refund of the appeal fee, and an oral hearing in case the Board considered that the case could not proceed directly to grant on the basis of the submissions made.

V. In response to an enquiry by the Board, the Appellant confirmed that his request for an oral hearing would not apply, if the Board intended to refer the matter back for further examination.

VI. Insofar as relevant to the present decision the Appellant's submissions were as follows:

- The Examining Division decided to use its power of discretion under Rule 86(3) EPC to refuse the set of claims submitted with letter of 3 April 1996 on the grounds that they infringed the requirements of Article 123(2) EPC and that they were not novel over document D8, but the Appellant had not been giving the opportunity of either refuting these grounds or of amending the claims to meet the objections made.
- The part of the decision refusing the set of claims filed with letter of 15 May 1995 raised new grounds of objection which the Appellant had been given no opportunity to either refute or to amend the claims to meet.
- The rejection of the claims under Article 84 EPC on the ground that the presence of forty disclaimers created an undue burden on the public trying to establish the scope of the protection

sought was for the first time supported in the decision relying on decision T 867/91, point 2.3, and the Appellant had had no opportunity to comment on the pertinency of the decision, and he would have been in a better position to do so if he had been informed of T 867/91.

- The refund of the appeal fee was thus justified as the Appellant had been forced to engage in unwarranted appeal proceedings in circumstances where he had not been afforded the opportunity to either refute or meet newly raised objections of the Examining Division. Decisions T 951/92 (OJ EPO 1996, 53) and T 640/91 (OJ EPO 1994, 918) were relied on.
  
- The Appellant expressed surprise that the Examining Division based its refusal among other grounds on the fact that the Appellant had not requested oral proceedings under Article 116 EPC. This was not a ground for refusing the application but rather should have been a reason for the Examining Division itself to issue a summons to oral proceedings pursuant to its powers under Article 116 EPC where this was considered expedient. Here the only difficulty was the formulation of appropriate disclaimers which it would have been appropriate to resolve at oral proceedings, or otherwise by contacting the representative as had been requested.
  
- The claims of the Main request filed with the Statement of Grounds of Appeal were the same as the claims filed with the letter of 15 May 1995, and decided on in the decision under appeal. Reasons were given why the objections raised were not justified.

- The claims of the Auxiliary request filed with the Statement of Grounds of Appeal were based on the claims filed with letter of 15 May 1995 further amended to avoid the objections raised in the decision under appeal.

### Reasons for the Decision

1. The appeal is admissible.
2. *Article 113(1) and Rule 86(3) EPC*
  - 2.1 Article 113(1) EPC states that the decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This applies also to the situation where an Examination Division refuses its consent to a further amendment under Rule 86(3) EPC. The recognised correct procedure for the Examining Division to follow is clearly set out in Part C of the Guidelines for Substantive Examination, Chapter VI 4.12:

"If a request for amendment is to be refused under Rule 86(3), the applicant must first in compliance with Art. 113(1) be sent a communication giving the reasons for refusing the amendment."



2.2 Here the first indication given the Appellant that the Examining Division was not prepared to consent to the introduction of the claims submitted on 3 April 1996 was in the decision under appeal. This was a substantial procedural violation by the Examining Division. Article 113 EPC must be complied with also in the case of a refusal of consent under Rule 86(3) EPC, irrespective of however many previous communications have been issued.

3. *Article 113(2) EPC*

3.1 Article 113(2) EPC states that the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent. Here the Examining Division refused to consent to the introduction into the procedure of the claims submitted on 3 April 1996, which had been put forward in substitution for the claims put forward with letter of 15 May 1995, and then proceeded to discuss and refuse the claims of 15 May 1995 which were, at the time, not put forward by the Appellant for consideration. Deciding to refuse an application on the ground that claims are not allowable contravenes Article 113(2) EPC if the applicant is no longer putting forward these claims, and amounts to a substantial procedural violation.

3.2 If the Examining Division refuses consent to the latest submitted amended set of claims under Rule 86(3) EPC this does not automatically revive the previous set of claims that the Examining Division had consented to consider under Rule 86(3) EPC, unless the applicant has indicated that he was relying on these as an auxiliary request. There was no such indication here. The correct procedure is to notify the applicant of the grounds for intending to refuse consent to the latest set of claims

and to ask him whether he wants a decision on that basis. If the applicant then maintains his request solely on the basis of these claims, and any further arguments by the applicant do not persuade the Examining Division to change its mind, then a decision should be given in which the reasons for the refusal of consent under Rule 86(3) EPC are stated, and the application is refused under Articles 97(1) and 78(1)(a) EPC on the basis that the application contains no claims to which the applicant has agreed.

4. *Informing applicant of case law*

4.1 The Appellant complained that in the decision under appeal reliance was placed for the first time on decision T 867/91, point 2.3 in relation to lack of clarity, thus depriving the Appellant of any opportunity to comment thereon.

4.2 The requirement of Article 113(1) EPC that the decisions of the European Patent Office be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments, requires that the applicant be given a preliminary indication of why specified parts of the application are considered objectionable to a specified provision of the European Patent Convention, but not that he be provided with references to or a discussion of case law. Decisions of the Boards are merely explanatory of the law as set out in the European Patent Convention, and the fact that a Board decision is referred to for the first time in the decision of the Examining Division does not in itself amount to a procedural violation, provided the applicant has been given an adequate preliminary indication of the objection. Even so, it would obviously assist applicants if they are informed in advance of case law considered to be particularly pertinent.

5. *Premature decision by the Examining Division*

5.1 The Board considers that in view of the substantial procedural violations referred to in points 2.2 and 3.1 above, the only correct course is for the Board to set aside the decision under appeal and remit the case back for further prosecution, on the basis of the requests now before the Board so that a decision not vitiated by substantial procedural violations can be made by the first instance.

5.2 The Appellant also complained that the decision under appeal in rejecting the claims of 15 May 1995 relied on some grounds of which the Appellant had been given no prior indication. In view of the fact that the decision under appeal has to be set aside and the case referred back for further prosecution, it is not necessary or appropriate for the Board to comment on this, or on any question relating to the allowability of the main or auxiliary request.

6. *Repayment of appeal fee (Rule 67 EPC)*

6.1 In view of the substantial procedural violations referred to in points 2.2 and 3.1, which necessitate remittal of the case to the Examining Division, the Board considers it equitable that the appeal fee be repaid pursuant to Rule 67 EPC.

Order

For these reasons it is decided that:

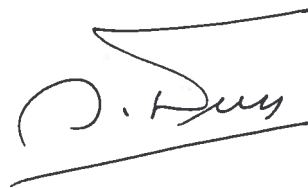
1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:



E. Görgmaier

The Chairman:



A. Nuss