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D E C I S I O N
of 18 November 1993

Case Number: T 0288/92 - 3.3.1

Application Number: 87302915.1

Publication Number: 0244948

IPC: C07D 249/12

Language of the proceedings: EN

Title of invention:
Triazolopyrimidine herbicides

Applicant:
Schering Agrochemicals Limited

Opponent:

-

Headword:
Herbicides/SCHERING

Relevant legal norms:
EPC Art. 84, 123(2)
EPC R. 67

Keyword:
"Implicit disclosure (no)"
"Novelty test (not appropriate for deciding the allowability
of amendments)"
"Procedural violations (no)"

Decisions cited:
T 0233/88, G 0003/89, G 0011/91, T 0194/84

.../...

Catchword:

I. The allowability of amendments under Article 123(2) EPC is to be decided solely on the basis of examining whether the amendments are directly and unambiguously derivable (extractable) from the application as filed. Any questions raised by a "novelty test" are hypothetical and therefore irrelevant (point 3.2 of the reasons).

II. It is not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which is arbitrarily selected from chemical entities, such as worked examples, without some support for such restriction in the general part of the description. (point 3.4 of the reasons).

Case Number: T 0288/92 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 18 November 1993

Appellant: Schering Agrochemicals Limited
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Decision under appeal: Decision of the Examining Division of the European Patent Office dated 24 February 1992 refusing European patent application No. 87 302 915.1 pursuant to Article 97(1) EPC.

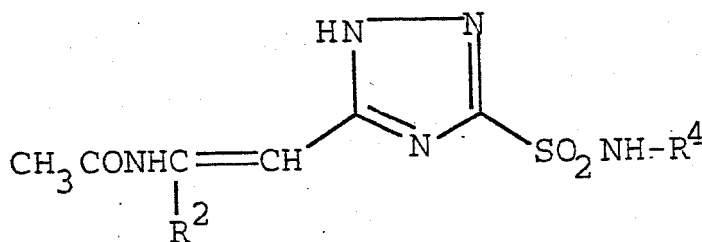
Composition of the Board:

Chairman: K.J.A. Jahn
Members: R.K. Spangenberg
J.A. Stephens-Ofner

Summary of Facts and Submissions

- I. This appeal, which was filed on 6 March 1992, lies against the decision of the Examining Division of 24 February 1992 refusing European patent application No. 87 302 915.1, filed on 25 March 1987 and published under No. 0 239 923. The appropriate fee and a Statement of Grounds of Appeal were received together with the notice of appeal.
- II. The decision under appeal was based on amended application documents received on 13 August 1991 containing one single claim, which read as follows:

"1. The triazole sulphonamides of the formula:



where

- a) R^2 is methyl, and R^4 is substituted phenyl, or
b) R^4 is 2,6-difluorophenyl, and R^2 is substituted or unsubstituted alkyl."

The grounds of refusal were that the application did not meet the requirements of Articles 123(2) and 84 EPC. The Examining Division held that part b) of the above amended claim was a selection from the original broad terms which was not clearly and unambiguously derivable from the application as filed and that the term "substituted" in that claim was not clear and thus

not appropriate for defining the subject-matter for which protection is sought. In respect of that latter objection it was pointed out that a skilled person would not accord this term its ordinary meaning, encompassing absolutely all and any possible substitutions, since the claim related to "a product with an associated activity", and the skilled person would therefore have considered it impossible that all compounds comprised by such a broad definition would display the alleged herbicidal properties. The Examining Division further held that the above claim was not supported by the description.

III. The Appellant (the Applicant) submitted that the objection raised under Article 123(2) EPC was based on a misinterpretation of this Article, leading to a misapplication of the law. He argued that the above claim was the result of a **limitation** of the original broad claim and hence could not comprise subject-matter which extended beyond the content of the application as filed. Moreover, since the application as filed contained two examples falling within the scope of the amended claim, the subject-matter of that claim was not novel in respect of the content of the application as filed, with the consequence that, applying the "novelty test", the amendment satisfied the requirements of Article 123(2) EPC.

In respect of Article 84 EPC the Appellant submitted that terms such as "substituted phenyl" were widely used in chemistry and had a clear meaning, so that there was no need to interpret them in the light of the description.

The Appellant further argued that the decision under appeal suffered from a great number of procedural defects, such as failure to respond to certain requests for clarification of objections, the ignoring of "binding case law" of the Boards of Appeal, such as T 238/88 (crown ethers/KODAK), discrimination against the Appellant, disregard of the expressed view of superior EPO authority, unreasoned objections under Article 56 EPC, and failure to take due account of the Appellant's arguments.

On 6 November 1993 the Appellant filed an alternative Claim 1, which differed from that underlying the decision under appeal only in that the term "the triazole sulphonamides" was replaced by "herbicidal triazole sulphonamides".

- IV. At the beginning of the oral proceedings, which took place on 18 November 1993, the Board indicated its preliminary opinion that in respect of Article 123(2) EPC the only relevant question was whether or not the subject-matter of the amended claim was clearly and unambiguously derivable from the application as filed, and that it was therefore neither relevant whether the amendment resulted in a limitation nor whether it would satisfy any "novelty-test". It further pointed out that the term "substituted" used in the refused claim appeared to be clear within the meaning of Article 84 EPC, but that this claim might be open to objection under Article 56 EPC, because it was likely that not all members of the broad group of compounds defined by that claim would turn out to offer a solution of the technical problem addressed in the

application, namely to provide chemical compounds with herbicidal activity.

During the oral proceedings the Appellant submitted, in response to the Board's observations, that the subgroup of chemical compounds defined by part b) of the present claim met the requirement of Article 123(2) EPC, since the only limitation not expressly mentioned among the generally preferred embodiments on pages 3 and 4 of the published application was the now claimed specific meaning of R⁴, which was present in 14 examples of the invention as originally claimed and was thus also clearly and unambiguously derivable from the content of the description as filed.

- V. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of Claim 1 as amended on 13 August 1991 (main request), or on the basis of amended Claim 1 as submitted on 6 November 1993 (auxiliary request), and that the appeal fee be refunded.

At the end of the oral proceedings the decision to dismiss the appeal and to refuse the request for reimbursement of the appeal fee was announced.

Reasons for the Decision

1. The appeal is admissible.
2. *Procedural violations*

- 2.1. The Appellant has submitted that several procedural violations had occurred during the examining proceedings. The Board has therefore considered whether there were any procedural defects which were so fundamental that it would be necessary to set aside the decision under appeal and to remit the case to the Examining Division without deciding the question whether or not the application met the requirements of the EPC addressed in the decision under appeal.

- 2.2. Such a fundamental defect is normally present if, contrary to Article 113(1) EPC, the Applicant had not been given sufficient opportunity to present his comments in respect of the objections raised against the application. In the Board's judgment, this is not the case here. The two main grounds of refusal, inadmissible amendment and lack of clarity of the definition of the claimed invention, had been duly communicated to the Appellant. Even if the Board would find, however, that the latter objection was raised on the basis of a misinterpretation of the nature of the claimed invention or on a misapplication of the law, such misinterpretations or misapplications undesirable though they may be, cannot amount to procedural, let alone substantial procedural violations within the meaning of Rule 67 EPC. More particularly, it is not a procedural violation for an Examining Division to refuse to answer a request for more detailed explanations of the objections raised and properly communicated by them, provided that their subsequent decision is not based on fresh matter.

- 2.3. In addition, it follows from Article 23(3) EPC that the Boards of Appeal can only decide whether or not a

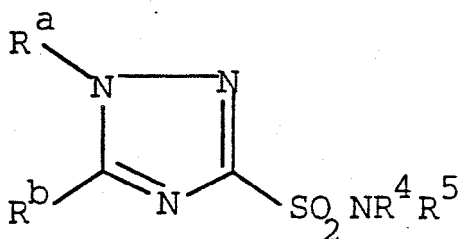
decision under appeal was taken in conformity with the provisions of the EPC. Therefore, it is not within the Board's competence to decide whether or not the Examining Division failed to comply with additional administrative requirements within the responsibility of the Vice-President of DG2.

- 2.4. Furthermore, it follows from Article 111(2) EPC that decisions of the Boards of Appeal are only binding if a case had been remitted to the department whose decision was appealed. Thus decision T 238/88 (OJ EPO 1992, 709), which did not remit the present case to the Examining Division, is not binding. Therefore, any disregard of this decision by the Examining Division might be undesirable, but is not a procedural violation within the meaning of Rule 67 EPC.
- 2.5. Likewise, it does not follow from the mere fact that patents had been granted with claims containing practically unlimited definitions, such as "substituted", that such definitions must be allowed in each and every case, since each case has to be decided on its own merits. Thus, there is no evidence before the Board that the Examining Division had discriminated against the Appellant.
- 2.6. The decision under appeal stated, in addition to the grounds of refusal mentioned in point II, that the application still remained open to objections under Article 56 EPC raised in a communication relating to Claim 1 as filed. The Appellant rightly observed that these objections were based on prior art which was no longer relevant to the subject-matter of the refused claim, so that this objection was unfounded. However,

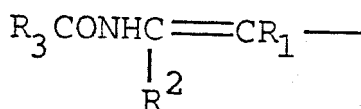
since this objection was not a ground of refusal, this lack of proper reasoning is not a substantial procedural violation which would prevent the Board from examining the merits of the appeal in respect of the grounds of refusal properly raised and reasoned in the decision under appeal.

3. *Admissibility of the amendments*

3.1. The application as filed related to triazole sulphonamides of the formula

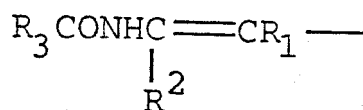


wherein R^a represents hydrogen and R^b represents a group



or R^a and R^b together represent a chain of formula -C(R³)=N-C(R²)=C(R¹)- or -C(=Y)-N(R⁶)-C(R²)=C(R¹)-, where R¹, R² and R³, which may be the same or different, each represent *inter alia* hydrogen or substituted or unsubstituted alkyl, R⁴ represents *inter alia* substituted phenyl and R⁵ represents *inter alia* hydrogen.

The sole claim according to the main request comprises two separate groups of compounds, namely a) the group wherein the substituent in the 5-position of the triazole ring is limited to 2-Acetamido-1-propenyl and R⁴ is substituted phenyl, and b) the group wherein R⁴ is 2,6-difluorophenyl, and the substituent in the 5-position can be described by the formula



wherein R¹ is hydrogen, R² is substituted or unsubstituted alkyl, and R³ is methyl.

It is therefore clear that the amended claim is the result of a limitation of the original Claim 1. Nevertheless, the Board cannot accept the Appellant's submission that the amended claim cannot for this reason alone contravene Article 123(2) EPC. This submission, upon which the Appellant no longer relied during the oral proceedings, is based on a narrowly semantic construction of the expression "subject-matter which extends beyond the content of the application as filed", as set out in that Article. This expression, however, cannot be construed to mean that only such amendments are prohibited which seek to introduce subject-matter not comprised in the broadest disclosure contained in the application as filed. On the contrary, what that Article prohibits is the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so that the examination of the allowability of an amendment according to Article 123(2) EPC is directed

at the process of "derivation" or "extraction" (see Concise Oxford Dictionary), as distinct from a simple comparison of the scopes of amended and unamended subject-matters. This construction of Article 123(2) is in agreement with the consistent jurisprudence of the Boards of Appeal, see e.g. point 2 of the reasons in G 3/89 (OJ EPO 1993, 117) and G 11/91 (OJ EPO 1993, 125) as well as T 194/84 (OJ EPO 1990, 59), point 2.4 of the reasons.

- 3.2. During the oral proceedings the Board expressed its view that the "novelty-test" was irrelevant to the determination of the allowability of the amendments here at issue. Since the Appellant abandoned this strand of argument during the oral proceedings, it is not necessary to expound the matter in much more detail, save the following.

Since the jurisprudence as explained above is clear, and provides a definitive method for deciding the allowability of an amendment, any other "test", such as the "novelty test", must, of necessity, pose hypothetical questions which is not the real task of an appellate body of final jurisdiction to answer. Thus, in the Board's judgment there is no more reason to apply a "novelty test" in the present situation than there would be to apply an "allowability-test" if the question of novelty were at issue. In addition, the use of terms such as "test" encourages an oversimplified and hasty approach, and therefore carries the risk of overlooking the facts and merits of individual cases.

- 3.3. The decision under appeal states that, having regard to the disclosure in the application as filed, the

restrictions of original Claim 1 which resulted in the definitions contained in part a) of the above claim "could be considered acceptable". It is therefore not clear to the Board whether the Examining Division has decided that this amendment was allowable.

Although the Board has reached the conclusion that the appeal has to be dismissed for other reasons, it nevertheless wishes to observe that the limited group of compounds defined by part a) of the present Claim was, in its judgment, clearly and unambiguously derivable from the disclosure of the application as filed. As it was correctly appreciated in the decision under appeal, all the definitions of substituents contained in that part of the present claim were either alternatives mentioned in Claim 1 as filed or were disclosed as definitions of preferred sub-classes of compounds comprised by the broad terms of this claim.

In addition, the combination of these limitations defining the particular sub-class to be considered here is not arbitrary, since this substitution pattern was derivable from the technical information provided by Preparative Example B, which describes the preparation of seven chemical compounds falling within this sub-class. Compounds B1, B2 and B4 to B7 have in common a substituent in the position occupied by R^b in Claim 1 as filed, which corresponds to the specific definitions of R^1 to R^3 contained in part a) of the present claim. In addition, the meaning of R^5 in these compounds is always hydrogen. However, the substitution of the phenyl substituent occupying the position of R^4 differs in all six of these compounds. This illustrates the broader definition of R^4 as "substituted phenyl" in context with

the respective specific meanings of the other substituents (R^1 to R^3 and R^5). Moreover, this broader definition is expressly contained in the heading of the table listing Examples B2 to B7, making it clear that the meanings of R^4 given therein are examples for the generic expression "substituted phenyl". Thus no additional information was required to arrive at the definition of the above particular sub-class of compounds.

- 3.4. Regarding part b) of the present claim, the situation is quite different, since there is no original disclosure, neither in the claims nor in the description, from which it could be objectively derived that the sub-class of compounds defined in that part of the present claim was an embodiment of the claimed invention. More particularly, the definition of R^4 as 2,6-difluorophenyl was only disclosed as part of the structure of individual compounds, as was admitted by the Appellant during the oral proceedings.

However, most of these compounds, such as N-(2,6-difluorophenyl)-5,7-dimethyl-[1,2,4]triazolo[1,5-c]pyrimidine-2-sulphonamide (page 4, lines 19 to 20 of the description as published), and Preparative Example A, compounds A4, A13, A16, A17, A19, A22, A23, A25, A26, A29, A30, A36 and A47, as well as Preparative Examples C and E, relate to the preparation of triazolopyrimidines which were intentionally excluded from the claimed group of compounds. In the Board's judgment, a person skilled in the art would therefore not have derived from the disclosure of these compounds any information relevant to a group of compounds not containing the triazolopyrimidine ring system.

In Preparative Example B, only compounds B1 (which is also mentioned on page 4, lines 20 and 21 of the published description) and B3 contain the 2,6-difluorophenyl substituent in the position occupied by R⁴ in Claim 1 as originally filed. In these examples R¹ of original Claim 1 is hydrogen, R² is methyl or trifluoromethyl, R³ is methyl and R⁵ is hydrogen. Consequently, only those entities fall within the scope of part b) of the present claim.

In the Board's judgment, a person skilled in the art would not have derived from this technical teaching anything other than the bare disclosure of the said structural elements in these particular combinations. Therefore, the original disclosure of not more than these two individual compounds cannot form the basis for the generalisation resulting in the sub-class of compounds according to part b) of the present claim, comprising an unlimited number of chemical entities, since R² is substituted or unsubstituted alkyl. Consequently, the respective amendment is unallowable pursuant to Article 123(2) EPC.

The same result would be obtained if one would not consider the question of the allowability of the above amendment starting from the specific information contained in the examples but rather from the generic information provided on pages 3 and 4 of the published original description, as set out in respect of part a) of the present claim in point 3.3 above. The sub-class defined in part b) of the present claim differs from that defined in part a) in that the definition of R² is now extended to "substituted or unsubstituted alkyl" instead of "methyl" and the definition of R⁴ is limited

from "substituted phenyl" to "2,6-difluorophenyl". In addition, the two sub-classes defined in part a) and part b) of the present claim overlap, since compound B1 belongs to both of them. Thus the comparison of the two amendments in the light of the information derivable from Preparative Example B as a whole already reveals that the second one is arbitrary. This finding is further confirmed by the fact that this latter amendment is the result of taking the meaning "2,6-difluorophenyl", which is nowhere disclosed in the application as filed in generic terms as a possible definition of the substituent R⁴, out of the only context in which it has been mentioned in the application as filed, namely, that of compounds B1 and B3, and introducing it into a generic formula, which comprises an unlimited number of chemical compounds. In the Board's judgment, such an amendment is wholly arbitrary and hence inadmissible.

In short, although examples do form part of the "content of the application as filed" and therefore need to be considered when deciding the question what information is clearly and unambiguously derivable from that content, in contrast to a generically defined group or class of chemical compounds, in which the meaning of the substituents is variable, an individual chemical entity only discloses its structural elements in their specific combination, to the exclusion of any such variability. Thus any information which can **only** be obtained by mentally disassembling the structural formula of individual chemical compound into its constituent components and then **arbitrarily** reassembling them cannot be directly and unambiguously derivable from the application as filed. It follows

that it is not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent, such as "substituted phenyl" for R⁴ in the present original Claim 1, to a specific (individual) one, such as "2,6-difluorophenyl" in the present amended claim, which is arbitrarily derived from disassembling the structure of individual chemical entities, without some support for such restriction in the general part of the description.

- 3.5. Therefore the Board finds that the sub-class of compounds defined in part b) of the present claim is not clearly and unambiguously derivable from the technical information contained in the application as filed, so that the claim according to the main request does not meet the requirements of Article 123(2) EPC. Consequently this request must fail.
- 3.6. Since the sole claim according to the auxiliary request contains the same general formula and the same definitions of the substituents as the sole claim of the main request, it is open to the same objection under Article 123(2) EPC and, accordingly, this request must likewise fail.
4. Since the appeal is unsuccessful in respect of the ground of refusal under Article 123(2) EPC the Board need not consider whether the present claims of the main and the auxiliary request meet the other requirements of the EPC, in particular those of Article 84 EPC. Nevertheless the Board observes, as was said in point IV above, that in its judgment at least the wording of Claim 1 according to the main request is

clear, since there is no good reason to assume that the term "substituted" used therein has a meaning other than that normally given to that term by a skilled person, comprising any possible substitution, because the claim is directed to chemical compounds as such and not limited to any "associated activity".

5. According to Rule 67 EPC the appeal fee can only be refunded if the appeal is allowable and if the reimbursement is equitable by reason of a substantial procedural violation. It follows from what is said in points 2 and 3 above that neither of these conditions is met in the present case. Consequently the request that the appeal fee be refunded has to be refused.

Order

For these reasons, it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is consequently refused.

The Registrar:

The Chairman:

E. Görgmaier

A. Jahn