

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of 23 October 2007**

Case Number: T 1141/05 - 3.3.01

Application Number: 97905150.5

Publication Number: 0888057

IPC: A01N 43/80

Language of the proceedings: EN

Title of invention:

Herbicidal synergistic composition and method of weed control

Patentee:

Syngenta Participations AG

Opponent:

BASF Aktiengesellschaft

Headword:

Herbicidal compositions/SYNGENTA

Relevant legal provisions:

EPC Art. 100(c), 84, 123(2)(3)

Keyword:

"Main request: allowability of a disclaimer (no)"
"Auxiliary requests I and II: admissibility (no) -
substantially modified requests filed for the first time
during oral proceedings raised new issues"

Decisions cited:

G 0001/93, G 0001/03, T 0092/93, T 0840/93, T 1050/99,
T 1102/00

Catchword:

-



Case Number: T 1141/05 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 23 October 2007

Appellant:
(Patent Proprietor)

Syngenta Participations AG
Schwarzwaldallee 215
CH-4058 Basel (CH)

Representative:

Pfenning, Meinig & Partner GbR
Patent- und Rechtsanwälte
Theresienhöhe 13
D-80339 München (DE)

Respondent:
(Opponent)

BASF Aktiengesellschaft
D-67056 Ludwigshafen (DE)

Representative:

Riedl, Peter
Patentanwälte
Reitstötter, Kinzebach & Partner
Postfach 86 06 49
D-81633 München (DE)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 24 June 2005
revoking European patent No. 0888057 pursuant
to Article 102(1) EPC.

Composition of the Board:

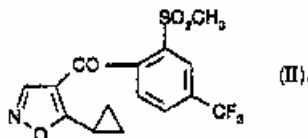
Chairman: A. Nuss
Members: P. Ranguis
C. Brandt

Summary of Facts and Submissions

I. This appeal lies from the decision of the Opposition Division to revoke the European patent No. 888 057 (European patent application No. 97905150.5).

II. Claim 1 of the patent as granted reads as follows:

"1. A herbicidal synergistic composition, comprising besides conventional inert formulation assistants, the compound aRS, 1'S(-)-N-(1'-methyl-2'-methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline or the compound (1S,aRS)-2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide, and a synergistically effective amount of the active ingredient of formula II



provided that the compounds N-(1'-methyl-2'-methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline or 2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide are not present in form of their racemates."

III. The Respondent (Opponent) sought revocation of the patent in suit for lack of novelty or inventive step (Article 100a) EPC) on the basis of *inter alia* the following documents

- (1) WO-A-9603877
- (2) US-A-5 002 606
- (3) US-A-5 457 085

At the oral proceedings before the Opposition Division, the Opponent submitted for the first time that the disclaimer contained in Claim 1 contravened the requirements of Article 123(2) EPC and also for this reason the patent in suit should be revoked.

IV. In its decision, the Opposition Division held that Claim 1 interpreted in view of the description meant that an (unspecified) excess of the S-isomers of metolachlor or dimethenamid had to be present in the compositions. It was immediately apparent in view of such interpretation that the proviso was meaningless and unnecessary. Consequently the proviso in Claim 1 neither *prima facie* nor upon further examination contravened Article 123(2) EPC, since it did not bear any relevant technical information which was not clearly derivable from the application as filed.

The subject-matter of Claim 1 was also novel over document (1) which disclosed the synergistical herbicidal compositions of isoxaflutole and the racemate of metolachlor, i.e. N-(1'-methyl-2'-methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline or dimethenamid, i.e. 2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide.

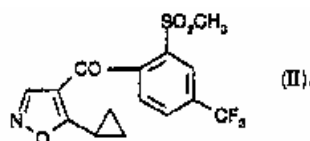
With regard to inventive step, the technical problem to be solved in view of document (1) as the closest prior art was to provide further synergistic herbicidal compositions having improved herbicidal utility. Since the improved herbicidal activity of S-metolachlor or S-dimethenamid compared with the other stereoisomers was already known in view of the disclosures of documents (2) and (3), it would have been obvious

starting from document (1) to arrive at the claimed composition to solve the technical problem in view of the prior art cited.

- V. Oral proceedings before the Board took place on 23 October 2007. At these oral proceedings, the Appellant (Proprietor of the patent) submitted two further sets of six claims as first and second auxiliary requests respectively.

Claim 1 of the first auxiliary request reads as follows:

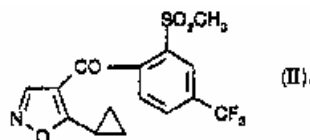
"1. A herbicidal synergistic composition, comprising besides conventional inert formulation assistants, as active ingredient a combination consisting of the enantiomer aRS, 1'S(-)-N-(1'-methyl-2'-methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline or the enantiomer (1S,aRS)-2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide, and a synergistically effective amount of the active ingredient of formula II



Claim 1 of the second auxiliary request reads as follows:

"1. A herbicidal synergistic composition, consisting of, besides conventional inert formulation assistants, as active ingredient a combination consisting of the enantiomer aRS, 1'S(-)-N-(1'-methyl-2'-methoxyethyl)-N-

chloroacetyl-2-ethyl-6-methylaniline or the enantiomer (1S,aRS)-2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide, and a synergistically effective amount of the active ingredient of formula II



VI. The Appellant submitted that the technical feature excluding the racemate of metolachlor or dimethenamid found support in the application as filed. It could not be considered as an undisclosed disclaimer.

It was indeed clear from the description of the application as filed that the intention was to exclude from the claimed herbicidal mixtures, the racemate of metolachlor or dimethenamid respectively. It was indicated therein that synergistic mixtures of compounds of formula II with the racemates of formula I were disclosed in document (1). The examples along with the experiments submitted with the letter of 6 June 2000 showed that the activity of the S-metolachlor and S-dimethenamid were tested with respects to their respective racemates.

Furthermore, the technical feature excluding the racemate mixture, introduced during the examining proceedings, did not provide a technical contribution to the subject-matter of the claimed invention. The reasons for the decisions of the first instance were, therefore, to be approved.

The decisions G 1/93, T 1050/99 and T 1102/00 were referred to by the Appellant in support of his submissions.

The first and second auxiliary requests, although late-filed, were clearly allowable under Article 123(2)(3) and 84 EPC and should be admitted into the proceedings since they represent the last chance for the Appellant to avoid having its appeal dismissed.

- VII. The Respondent argued that the technical feature aiming to exclude the racemate of metolachlor or dimethenamid was not derivable from the application as filed but was to be considered as a disclaimer within the meaning of the decision of the Enlarged Board of Appeal G 1/03 (OJ EPO 2004, 413).

By the term "comprising", Claim 1 as granted was not limited to the components explicitly defined therein. The Opposition Division erred in holding that the fact that Claim 1 properly interpreted required an (unspecified) excess of S-isomers of metolachlor or dimethenamid, implied that the proviso was meaningless and unnecessary. By contrast, a metolachlor or dimethenamid enriched in one enantiomer, comprised necessarily a lower amount of the other enantiomer and, therefore, a 1:1 mixture of S- and R-enantiomer. The disclaimer was not meaningless and unnecessary but very necessary to restore novelty in view of document (1) which document was, furthermore, highly relevant for assessing inventive step. Therefore, the disclaimer was not admissible under Article 100c) EPC.

The two auxiliary requests were not to be admitted in the appeal proceedings as being late-filed. The Appellant was perfectly aware that the objection under Article 100c) EPC was within the opposition/appeal proceedings. The Appellant had however not put forward any serious reasons for such a late-filing.

Furthermore, Claim 1 of the first auxiliary request did not comply with the requirements of Article 123(2) EPC due to the wording "consisting of" and also not with those of Article 84 EPC given that the expression "active ingredient" was not clear and the term "enantiomer" was not correct.

VIII. The Appellant requested that the decision under appeal be set aside and the patent be maintained as granted or as amended on the basis of the auxiliary request I or on the basis of the auxiliary request II both submitted during the oral proceedings before the Board of Appeal.

The Respondent requested that the appeal be dismissed.

IX. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.
2. As a preliminary remark, the Board observes that both parties used in their submissions the denomination **S-metolachlor** and **S-dimethenamid** to designate respectively the components aRS, 1'S(-)-N-(1'-methyl-

2'-methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline and (1S,aRS)-2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide defined in Claim 1. Although this denomination does not comply with the official nomenclature since both components comprise each two asymmetrical carbon atoms so that they relate to diastereoisomers, this "S-isomer" denomination will be adopted for the present decision. Isoxaflutole designates the compound of formula (II) defined in Claim 1.

Main request

3. Article 100c) EPC

3.1 Claim 1 as granted comprises a technical feature intending to exclude N-(1'-methyl-2'methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline or 2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide in form of their racemates, which represents a negative technical feature.

This technical feature was incorporated in Claim 1 during the examining proceedings after a telephone conversation with the representative, the content of which is unknown (see "Comments" in the communication under Rule 51(4) EPC of 12 December 2000).

3.2 The Appellant argued that since the technical feature at issue had been introduced during the examining proceedings and did not provide a technical contribution to the subject-matter of the claimed invention, no objection could be raised thereupon (see G 1/93 (OJ EPO 1994, 541), point 2 of the Order and

T 1050/99 of 25 January 2005, not published in the OJ EPO, point 5 of the reasons).

- 3.3 However, the Board observes that document (1) discloses explicitly an herbicidal composition comprising a mixture of metolachlor (racemate) and isoxaflutole or dimethenamid (racemate) and isoxaflutole to control weeds in maize crops (see pages 9, Tables A1 and A2; 11, Tables C1 and C2; 18, Table F1 and 19, Table F3). It is uncontested that the racemic mixture of metolachlor or dimethenamid contains the same amount of S- and R-isomer (50:50).

Due to the term "comprising", Claim 1 without the negative technical feature at issue is not limited to the compounds explicitly indicated therein but can also encompass further components, in particular the R-isomers of metolachlor and dimethenamid as concomitant compounds. In that context, the technical feature excluding metolachlor or dimethenamid in the form of their racemate aims at restoring novelty over document (1) and cannot be considered as devoid of technical contribution.

The Board observes that this was also the opinion of the Examining Division (see Communication pursuant to Article 96(2) and Rule 51(2) EPC, dated 9 May 2000, in particular point 1, first paragraph on page 2) which raised an objection of lack of novelty against Claim 1 as originally filed over the disclosure of document (1).

For these reasons, the technical feature excluding metolachlor or dimethenamid in the form of their racemate cannot be allowable in view of the established jurisprudence according to G 1/93 (ibid) since it provides a technical contribution to the claimed subject-matter.

3.4 The Appellant, furthermore, contended that it was clear from the description as originally filed that the composition comprising the racemic metolachlor or dimethenamid and isoxaflutole did not belong to the described invention. The Respondent argued in contrast that such exclusion was to be considered as a disclaimer not disclosed in the application as originally filed.

3.5 The first point to be examined is, therefore, whether or not the herbicidal synergistic composition in the form as granted finds support in the application as originally filed.

3.5.1 The application as originally filed contains the statement that synergistic mixtures of compounds of formula II with the racemates of formula I were disclosed in document (1) (see page 2, lines 2-3). The examples of the description relate to the comparison between a composition comprising as active ingredient the S-metolachlor and isoxaflutole and a composition comprising the racemic metolachlor and isoxaflutole (see pages 14 to 16).

3.5.2 As noted correctly by the Respondent a mixture enriched in S-isomer necessarily contains the R-isomer in a minor amount, which forms a racemate with the same

amount of S-isomer. This may be illustrated as follows: a mixture 60 (S-isomer): 40 (R-isomer) contains 20 (S-isomer) and 40:40 (racemate). Such mixtures are thus excluded by Claim 1 given the wording "provided that the compounds ... are not present in form of their racemates". Therefore, the subject-matter excluded from Claim 1 is in any case broader than the technical information relating to a composition comprising a racemate mixture (50:50) as disclosed in document (1) (see point 3.3 above). It derives therefrom that for this reason above the technical feature "provided that the compounds N-(1'-methyl-2'methoxyethyl)-N-chloroacetyl-2-ethyl-6-methylaniline or 2-chloro-N-(2,4-dimethyl-3-thienyl)-N-(2-methoxy-1-methylethyl)acetamide are not present in form of their racemates" extends the content of the European patent beyond that of the application as originally filed.

The decision T 1102/00 (dated 1 June 2004, not published in the OJ EPO, point 4) is not relevant for the present case since the question raised in this decision was whether it was the intention of the Proprietor of the patent to exclude some subject-matter, whereas the question here was, first, to assess whether or not the content of the technical feature excluding metolachlor and dimethenamid in the form of their racemate was commensurate with the information contained in the disclosure.

3.6 Nor could the Board consider the objected negative technical feature as a disclaimer allowable on the basis of decision G 1/03 (ibid).

- 3.6.1 Decision G 1/03 states *inter alia* that a disclaimer should not remove more than is necessary ... to restore novelty ... (see point 2.2 of the Order).
- 3.6.2 Document (1) discloses explicitly an herbicidal composition comprising a mixture of metolachlor (racemate) and isoxaflutole or dimethenamid (racemate) and isoxaflutole to control weeds in maize crops (see pages 9, Tables A1 and A2; 11, Tables C1 and C2; 18, Table F1 and 19, Table F3). A racemic mixture of metolachlor or dimethenamid comprises the same amount of S- and R-isomer (50:50). As noted above the disclaimer present in Claim 1 excludes any mixture which contains the racemic metolachlor or dimethenamid (see point 3.5.2). Therefore, this disclaimer also does not comply with the requirement set out in point 2.2 of the Order of the decision G 1/03 (*ibid*).
- 3.7 Furthermore, it was not disputed by the Appellant in his written submissions that document (1) was the closest prior art to define the technical problem to be solved. The content of document (1) is within the wording of the disclaimer. Therefore, this disclaimer becomes relevant for the assessment of inventive step and for this reason also is not allowable under Article 123(2) EPC (see G 1/03, point 2.3 of the Order).
- 3.8 Since the Board can only decide on a request as a whole, the request of the Appellant to maintain the patent as granted is to be rejected.

First auxiliary request

4. Admissibility

4.1 This present request was submitted at the oral proceedings before the Board. The Appellant did not provide any justification for such late filing.

4.2 The Respondent objected to its admissibility into the appeal proceedings for being late filed as only submitted during the oral proceedings before the Board.

4.3 In comparison to Claim 1 as granted, Claim 1 of the present request was amended as follows:

- incorporation of the feature "as active ingredient a combination consisting of ", after the expression "besides conventional inert formulation assistants," ,
- the terms "enantiomer" replaced the terms "compound",
- the negative technical feature "provided that..." was deleted.

4.4 In the Board's judgement, the amendments cited above raise new issues under Articles 123(2)(3) and 84 EPC.

- There is no unambiguous support for such amendments in the application as originally filed.
- Furthermore, the formulation "...comprising...as active ingredient a combination consisting of..." together with the deletion of the negative technical feature casts serious doubts on whether or not the protection conferred by the patent as

granted (see Claim 1 of the main request, point II above) has been extended.

- Moreover, the term "active ingredient" might render the claim unclear since this expression does not seem to exclude the concomitant R-isomers as possible "inactive ingredients" which again sends back to the Article 123(3) EPC issue.

For these reasons, the amended set of claims according to the first auxiliary request is not clearly allowable.

4.5 On the one hand, if oral proceedings take place, the Board shall endeavour to ensure that the case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary (see Article 11(6) of the Rules of Procedure of the Boards of Appeal, (OJ EPO 2003, 89)). The Proprietor having being aware for long of the objection against Claim 1 of the patent as granted cannot rely upon any special reasons in that respect.

4.6 On the other hand, admission of other requests than those rejected by the Opposition Division is a matter of discretion of the Boards of appeal, and is not a matter of right (see T 840/93, OJ EPO 1996, 335, point 3.1 of the reasons). For exercising due discretion in respect of the admission of requests by the appealing Proprietor of the patent that were not before the Opposition Division, it is established jurisprudence of the Boards of Appeal that one of the crucial criteria is whether the amended claims of those requests are clearly allowable (see Case Law of the Boards of Appeal of the European Patent Office, 4th

edition 2001, VII. D. 14.2.2, in particular T 92/93, dated 31 July 1995, not published in OJ EPO, point B.1). This requirement is not met in the present case (see point 4.4 above).

- 4.7 For the above reasons, the Board exercises its discretion not to admit the Appellant's first auxiliary request into the proceedings.

Second auxiliary request

5. Admissibility

- 5.1 This request was also submitted at the oral proceedings before the Board and likewise the Appellant did not provide any justification for such late filing.

- 5.2 The Respondent objected to its admissibility into the appeal proceedings for being late filed as only submitted during the oral proceedings before the Board.

- 5.3 In comparison to Claim 1 as granted, Claim 1 of this request was amended as follows:

- the term "comprising", after, "A herbicidal synergistic composition," was now replaced by the expression "consisting of",
- the feature "as active ingredient a combination consisting of" was incorporated after the expressions "besides conventional inert formulation assistants",
- the term "the compounds" was replaced by "enantiomer".

5.4 The expression "consisting of" has no unambiguous basis in the application as originally filed. Furthermore, one of the Appellant's experts declared that the examples set out in the application as filed (see pages 14 to 16) related to a mixture of metolachlor enriched in S-metolachlor, i.e. 91% of S-metolachlor and 9% R-metolachlor. These examples, therefore, are inconsistent with the subject-matter claimed according to the second auxiliary request and could not support this amendment. Already for these reasons, Claim 1 is not clearly allowable under Article 123(2) EPC. However, at this stage of the appeal proceedings, only clearly allowable amended claims can be admitted (see points 4.5 and 4.6 above).

5.5 For the reasons set out above, the Board exercises its discretion not to admit the Appellant's second auxiliary request into the proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar

The Chairman

N. Maslin

A. Nuss