

Veröffentlichung im Amtsblatt	Ja/ No
Publication in the Official Journal	Yes/ No
Publication au Journal Officiel	Oui/ Non



Aktenzeichen / Case Number / N° du recours : T 150/82

Anmeldenummer / Filing No / N° de la demande : 79 101 037.4

Publikations-Nr. / Publication No / N° de la publication : 4914

Bezeichnung der Erfindung: Process for the production of compounds useful
Title of invention: in perfumery
Titre de l'invention :

ENTSCHEIDUNG / DECISION

vom / of / du 7 February, 1984

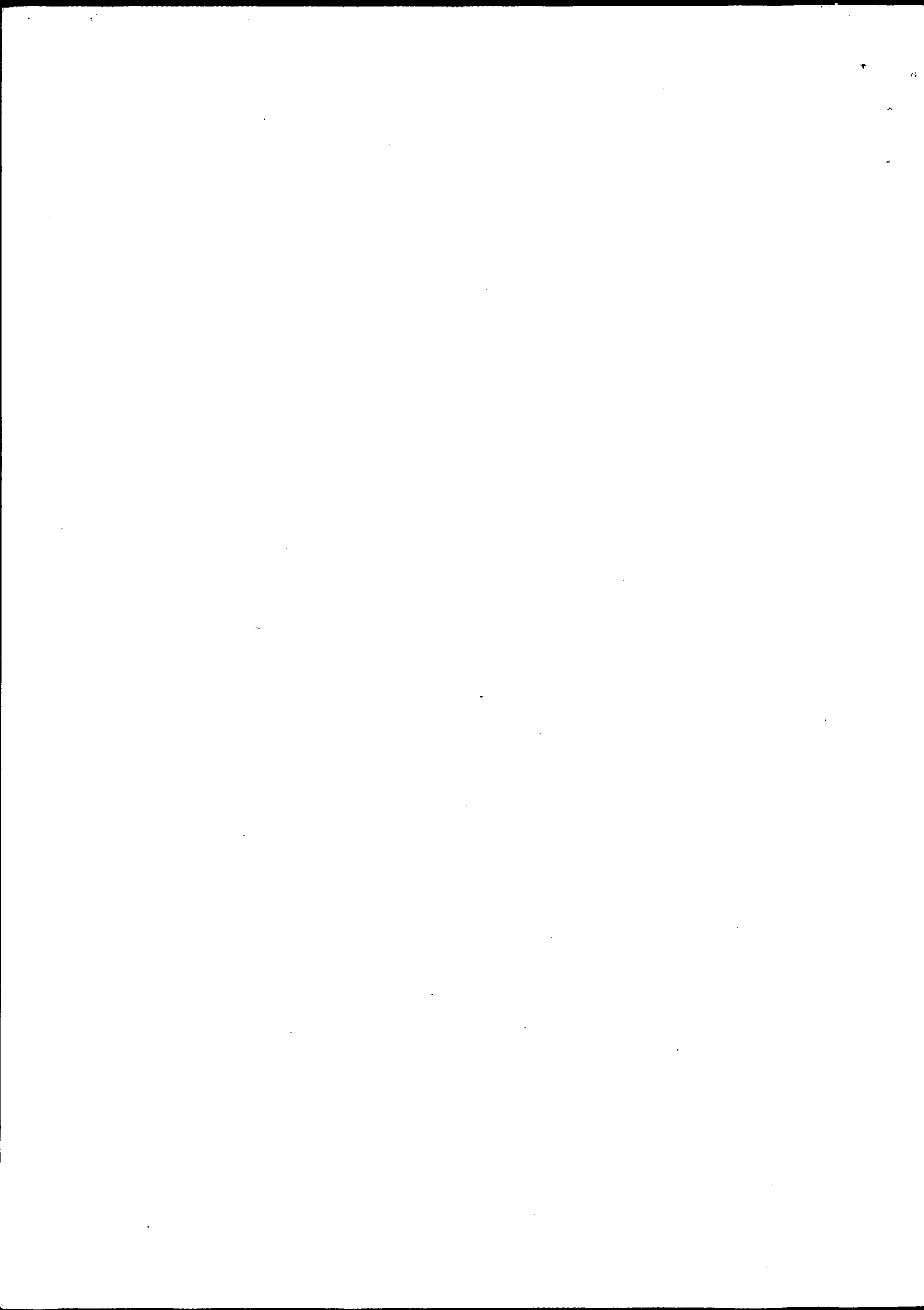
Anmelder/Patentinhaber: INTERNATIONAL FLAVORS & FRAGRANCES INC.
Applicant/Proprietor of the patent:
Demandeur/Titulaire du brevet :

Stichwort / Headword / Référence : "Claim Categories/IFF"

EPÜ / EPC / CBE Articles 52(1), 64(2) and 84, Rules 29(4) and 29(6) EPC

Leitsatz / Headnote / Sommaire

- I. Claims relying on references to the description in the specification in respect of all their technical features (known in the patent practice of the United Kingdom as "omnibus" claims) are unallowable as contrary to Rules 29(4) and 29(6) EPC, unless absolutely necessary, e.g. when a plurality of conditions would not lend themselves to verbal expression without such a reference. The onus is on the applicant to show such exceptionality.
- II. Claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) are admissible only if the products themselves fulfil the requirements for patentability and there is no other information available in the application which could enable the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter.



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Boards of Appeal

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des brevets

Chambres de recours



Case Number: T150 / 82

DECISION
of the Technical Board of Appeal 3.3.1
of 7 February 1984

Appellant: INTERNATIONAL FLAVORS & FRAGRANCES INC.
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Decision under appeal: Decision of Examining Division 007 of the European Patent
Office dated 20 March 1982 refusing European patent
application No 79 101 037.4 pursuant to Article 97(1)
EPC

Composition of the Board:

Chairman: D. Cadman
Member: G. Szabo
Member: L. Gotti Porcinari

Summary of Facts and Submissions

I. European patent application 79 101 037.4 filed on 5 April 1979 and published on 31 October 1979 with publication number 4914 claiming priority of the prior application of 19 April 1978 (US-897 903), was refused by the decision of the Examining Division 007 of the European Patent Office dated 20 March 1982. The decision was based on claims 17 to 21. Claims 9 and 17 were worded as follows:

"9. A product whenever produced by the process of claim 1.

17. A process in accordance with claim 1 substantially as described in the foregoing Example I."

II. Claims 1 to 8 related to processes for preparing certain isochroman derivatives. Claims 10 to 16, like the above claim 9, related to the products of processes according to Claims 2 to 8, respectively. Such claims are often referred to in literature as "product-by-process claims". Claims 18 to 21, on the other hand, related, like the above claim 17, to processes defined with reference to Examples II to V of the specification. These claims are of the type known from the practice in the United Kingdom as "omnibus claims".

III. The reason given for the refusal was that the claims 17 to 21 failed to comply with the provisions of Rule 29(6) EPC in that they relied on the description in respect of their technical features. This sub-rule mentioned in particular that claims should not rely on

such references as "as described in part ... of the description ...", except where absolutely necessary. The decision stated that the allowability of claims 9 to 15 had not been considered, although such claims were also objected to in an earlier communication.

- IV. The applicant lodged an appeal against the decision received on the 22 March 1982 with payment of the fee and filed a statement setting out the grounds of appeal dated 15 July 1982 (received 19 July 1982).

- V. The Board also raised objections against claims 9 to 15 in its communication to the appellant. The appellant filed a reply in due time but also expressed a desire to study the matter in greater depth in view of its importance and to be able to submit additional observations. Accordingly further arguments were filed with letter dated 17 October 1983 together with sets of new claims with appropriate auxiliary requests for relief. Claims 1 to 21 of Set I were identical with those which had been before the Examining Division. Claims 1 to 16 of Set II were the same except that the "omnibus" claims 17 to 21 had been omitted. Claims 1 to 8 of Set III were confined to the normal process claims of the original set.

- VI. An oral hearing took place at the request of the appellant on 2 November 1983. The Board declared after the hearing that it would reserve its decision until additional documents had been received or, if no such evidence were to be submitted, until the expiry of a specified term. The appellant filed certain documents in due time.

VII. The arguments submitted to the Board by the appellants can be summarised as follows:

- (a) As regard the "omnibus" claims, i.e. claims 17 to 21, Rule 29(6) EPC should not be construed as an absolute bar against such type of claims. The negotiations and conferences leading to the ratification of the EPC are understood to have intended to avoid references to figures and examples in the specification, except where "absolutely necessary". There was no intention to forbid "omnibus" claims, commonly present in United Kingdom patents, at least as far as that country was concerned. Had there been a total ban intended, the qualifying phrase would have been omitted. The requirement in Article 84 EPC that the claim must be concise, supports that view. The recommendations of the Guidelines for Examination should not be taken as binding on the Examination Division (cf. C III, 4.10).
- (b) As far as "product-by-process" claims are concerned, i.e. claims 9 to 16, the protection of direct products afforded by Article 64(2) EPC for the corresponding process claims may be similar to that provided by claims to the products defined by reference to the processes, but is not identical therewith. It is doubtful whether or not the above article would protect the patentee against the importation of the product manufactured outside the United Kingdom according to the patented process.
- (c) Furthermore, it is also doubtful whether or not the incorporation of such products of the claimed processes in further products would be protected, for

instance, in Germany. Whilst the use of the active ingredient in a pharmaceutical formulation may, according to some opinions, be construed as a direct product, no confirmation has so far appeared from a competent court in that country. It appears that the further processing of intermediates or raw materials into an end-product is not the preparation of a direct product in Germany. A great uncertainty prevails in the UK where the courts have had no opportunity yet to interpret the terms of Section 60(1)(c), Patents Act 1977. There is therefore a necessity for additional protection.

VIII. The appellant requested that the appealed decision be set aside and the patent be granted on the basis of one of the three sets of claims. A refund of the appeal fee under Rule 67 EPC was also requested.

Reasons for the Decision

1. The appeal complies with Article 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. There can be no objection against any one of claims 9 to 21, included in Sets I and II, on grounds of lack of support in the specification and in the claims as originally filed. Since the substantive examination was not completed on claims 1 to 8, submitted in an amended form with letter dated 16 March 1981, the matter of formal acceptability of these claims need not be considered by the Board.
3. The "omnibus" claims 17 to 21 define particular processes by reference to each of the Examples I to V, respectively, in the specification. It appears that these

claims are in a form which is contrary to the express provisions of Rule 29(6) EPC. According to this sub-rule "Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description ... In particular, they shall not rely on such references as "as described in part ... of the description, ...". The language of the claims under appeal falls within the terms of the prohibition, since examples are parts of the description of the invention in the specification, and no evidence has been submitted which would have suggested that such definition is "absolutely necessary" in the application under appeal. The Board confirms the position taken by the Guidelines for Examination in the EPO (C-III, 4.10) that the onus is on the applicant to show such exceptionality.

4. The Guidelines give examples of cases where an exception would be allowable. These include inventions containing features or limitations which can only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions. There is no reason yet to assume that the same should also apply to other integers in the case which lend themselves to verbal expression. In any case, the application under appeal only contains examples in which all or any features could have proper verbal counterparts.
5. Claims 17 to 21 are dependent on claim 1 and carry its general features. It seems that the further limitation to such features as well as all additional features should have been stated separately and expressly in view of the requirements of Rule 29(4) EPC. It is also open to doubt as to which instructions and data in the

Examples are essential for the definition of the particular "process" and this could render the interpretation of such claims uncertain with regard to Article 69(1) EPC and the Protocol on the Interpretation of Article 69 of the Convention. If, on the other hand, many unessential features are meant to be included in the claim in this manner, this would only increase the confusion about the real scope of protection and be contrary to Article 84 EPC as regard the requirement of clarity. The decision of the Examining Division against the allowability of claims 17 to 21 on the basis of Rule 29(6) and Article 84 must, therefore, be confirmed.

6. The "product-by-process" claims 9 to 16 represent a definition of the products which are obtained by the use of the allegedly inventive processes referred to. Whether or not the importation of such products is prohibited in view of the provisions of Article 64(2) EPC whenever the manufacture has taken place in another country, is a matter which must be decided by the national courts. It is a characteristic of national laws that they contain provisions as to the effect of patents, in accordance with the requirements of their jurisdictions. The statutory conditions and case law in this respect may vary from country to country. National laws might refer to certain acts which would or would not be interpreted as an unauthorised use of the claimed invention. Such matters are, however, outside the terms of reference of the EPC, which has been established to enable patents to be granted by a single procedure. This calls for patents with claims which define the invention as a subject-matter for which the protection is sought.

7. Inventions fall either into the category of products, e.g. articles, devices or materials, or of processes, e.g. methods of preparing a product, or using an article, or obtaining a result. Nevertheless, the invention defined in the claims for products or for processes must all be novel, inventive and industrially applicable according to Article 52(1). Whilst a process may well be novel and deserves full protection in view of its inventiveness, the same may not be true for its product if that is known or obvious in the light of the state of the art. Notwithstanding this, the special protection provided by Article 64(2) EPC extends even to products which are not themselves inventions. According to the submissions of the appellants, the protection provided by "product-by-process" claims should go beyond the limits of "direct products" in Article 64(2) and ought to be equal to that enjoyed by products which are claimed per se, with no restriction to the details of their preparation. This, irrespective of the fact that the product protected in this manner may not represent an invention at all, as such.
8. The Guidelines for Examination in the EPO (C.III. 4.7b) allows claims for products defined in terms of a process of manufacture provided the products themselves fulfil the requirements for patentability. This may well be the only way to define certain natural products or macromolecular materials, of unidentified or complex composition which have not yet been defined structurally. Nevertheless before such claims are allowable their patentability as products must be established since such definition is in lieu of the normal definition by structure.

9. The appellants referred to German law in this respect and alleged that product-by-process claims had also been validly granted in cases where the product itself was not patentable. The evidence submitted in this respect by Dr. Goddar refers to Benkard 7. Ed. page 353 and 355. It is clear that the statements there relate to the question of direct product protection for processes under §9(2)(3) of the Patent Law which is analogous to Article 64(2) EPC. It is apparent that the submitted Opinion is silent about the more relevant entries in the same textbook (e.g. Benkard, 7. Ed. §1.14 on page 124, 86 on pages 158 and 159, and 88(dc) on page 159) where it is clearly indicated that a claim to a patentable product is allowable as long as neither the structure nor the physical characteristics of the material are known. This is based on the appropriate decisions of the Supreme Court and the Federal Patent Court ("Trioxan" B1PMZ, 1971, 73, pp. 374-33; BPatGE-20, pp. 20-25, 1 BGHZ 57,1.). There is no suggestion in the attached documents that unpatentable products could be expressly claimed in this manner.
10. An earlier decision of the Board already established that "the effect of a process manifests itself in the result, i.e. in the product in chemical cases, together with all its internal characteristics and the consequence of its origin, e.g. quality, yield and economic value". ("Gelation/Exxon" T 119/82, 12.12.1983). Although problems may be recognised in processes known in the state of the art which are then removed by appropriate modifications or by an altogether different approach, the effect of such measures en route ultimately manifests itself in the technical and economic characteristics of the product, the real purpose of the exer-

cise. Whilst some features of such end-effects may be drawn into the definition of the process for reasons of clarity and of conciseness, the product is in consequence of the invention, without being the invention itself, which is rather the novel interaction represented by the process in such cases. Any attempt to claim the in itself non-inventive product by means of product-by-process claims is claiming the mere effects instead. Whilst reliance on the provisions on Article 64(2) EPC may nevertheless provide protection beyond the invention in processes leading to known or patentable products alike, this should not be afforded for both kinds of product themselves on the same footing, irrespective of their character. This must therefore be rejected as unjustified and contrary to the requirements of Article 52(1) and 84 EPC. The Board takes the view that in order to minimise uncertainty, the form for a claim to a patentable product as such defined in terms of a process of manufacture (i.e. "product-by-process claims"), should be reserved for cases where the product cannot be satisfactorily defined by reference to its composition, structure or some other testable parameters.

11. The Board has seriously considered the well known fact that both "omnibus" and "product-by-process" claims were commonly admitted in the United Kingdom, one of the member states of the Convention. Nevertheless, it is also important to note that in no other member state have they gained acceptance beyond a manner of claiming structurally undefinable product inventions, and there

appears to be no room under the Articles or Rules of the Convention to admit such claims on the basis of practice in a single Contracting State. Since the appeal is unsuccessful as regards the issues under consideration, the refund of the appeal fee must be rejected.

Order

It is decided that:

1. The decision of the Examining Division dated 20 March 1982 is set aside.
2. The request for the reimbursement of appeal fee is rejected.
3. The appeal, insofar as it relates to claim Sets I and II submitted with the letter dated 13 October 1983, is rejected.
4. The application is remitted to the first instance for further substantive examination on the basis of claims 1 to 8 in Set III, relating to processes.

Registrar:

Chairman:

J. 16/84

D. Cadman

*W.
G.K.*

