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17

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Anmeldenummer / Filing No / N° de la demande : 83 305 694.8

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Bezeichnung der Erfindung: Arthropodocidal compounds

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C07C 43/29

ENTSCHEIDUNG / DECISION

vom / of / du 21 July 1988

Anmelder / Applicant / Demandeur : Commonwealth Scientific and Industrial
Research Organization

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Articles 54(3), 54(4), 87, 88, 89, Rule 67

Schlagwort / Keyword / Mot clé :

- priority of a part of a generic claim (yes);
- implicit disclosure in a priority document of a specific compound by a generic formula (no);
- novelty; earlier European patent application; claims having different priority dates.
- reimbursement of appeals fee (no)

Leitsatz / Headnote / Sommaire

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Case Number : T 85/87 - 3.3.1



D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 21 July 1988

Appellant : Commonwealth Scientific and Industrial
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Decision under appeal : Decision of Examining Division 002
of the European Patent Office
dated 9 October 1986 refusing
European patent application
No. 83 305 694.8 pursuant to
Article 97(1) EPC.

Composition of the Board :

Chairman : K. Jahn
Members : R. Spangenberg
E. Persson

Summary of Facts and Submissions

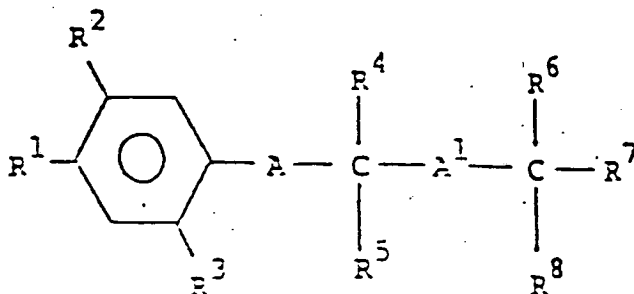
I. European patent application No. 83 305 694.8, designating the Contracting States BE, CH, DE, FR, GB, IT, LI, NL, SE filed on 23.9.83 claiming priority of 24.9.82 from a patent application in Australia (AU 6041/82) was published on 4 April 1984 with publication number EP-A-104 908.

During the examining proceedings the Applicant in accordance with Legal Advice No. 9/81 (OJ EPO 3/1981, 68) submitted two sets of claims taking into account certain conflicting national patent applications.

II. By a decision dated 9.10.86 the Examining Division refused the application on the ground that the subject-matter of Claims 1, 2, 8, 11, 14 and 15 of Claims Set A for the Contracting States BE, CH, GB, IT, and the corresponding Claims 1 to 3, 9, 12, 15 and 16 of Set B for the Contracting States DE, FR, NL, SE lacks novelty within the meaning of Art. 54(3) and (4) EPC with respect to (4) EP-A-94 085.

Claims 1, 2, 8, 11, 14 and 15 of Set A read as follows:

"1. Compounds of the general formula (1) or an isomeric form thereof:



(I)

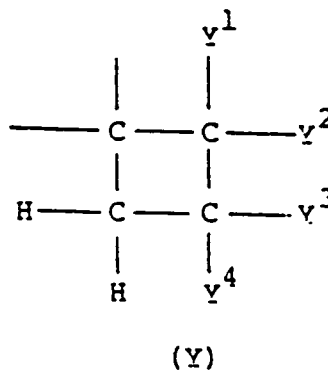
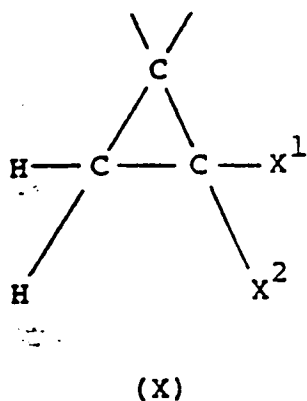
wherein

R¹ is a halo group; or a lower alkyl, lower alkoxy or lower alkylthio group, in each of which the alkyl group may be substituted with one or more halo groups;

R² is hydrogen or a halo or halomethyl group; or R¹ and R² together form a methylenedioxy, or a difluoro-methylenedioxy group or, R¹ and R² together with the carbon atoms to which they are attached, an aromatic ring;

R³ is hydrogen or a halo group;

A is one of the groups X or Y



wherein X¹ and X² are the same or different and each is a fluoro, chloro, bromo or methyl group, and Y¹, Y², Y³ and Y⁴ are the same or different and each is hydrogen or a fluoro, bromo, chloro, or methyl group;

A¹ is CH₂, CF₂, CCl₂, O, S, SO, NH or NZ

where Z is a halo group or C $\begin{matrix} \diagup v^1 \\ - v^2 \\ \diagdown v^3 \end{matrix}$ where v¹,

v^2 , v^3 are the same or different and each is fluorine, chlorine or hydrogen;

R^4 is hydrogen, chlorine or fluorine; and
 R^5 is hydrogen, chlorine or fluorine; or
 R^4 and R^5 together form =O when A^1 is CH_2 ;
and

R^6 is hydrogen, deuterium, CN, or $C=CH$; and
 R^7 is 3-phenoxyphenyl, 2-phenoxy-6-pyridyl,
2-phenoxy-3-fluoro-6-pyridyl, pentafluorophenyl,
4-fluoro-3-phenoxyphenyl, N-pyrrollyl-3-benzyl,
3,4-methylene-dioxy phenyl; or 3-(4-methoxyphenoxy)-
phenyl;

R^8 is hydrogen or deuterium.

2. A compound as claimed in Claim 1, characterised in that the group A^1 is -O-.

8. A compound according to Claim 1 which is 3-phenoxy-benzyl-1-(4-ethoxyphenyl)-2,2-difluorocyclopropyl-1-methyl ether;

11. An arthropodocidal composition, characterised in that it comprises as an active ingredient a compound according to any preceding claim in admixture with a diluent or carrier.

14. A method of combating arthropods, characterised in that a compound according to any of Claims 1 to 10 alone or in the form of a composition as claimed in any one of Claims 11 to 13 is applied to the arthropods, or to a habitat thereof.

15. The use of a compound according to any of Claims 1 to 10 in the manufacture of a composition for use in a method of freeing or protecting domesticated animals from parasitical insects or acarids by applying said composition to said animals."

The Examining Division found that the compound of Claim 8 was not entitled to the claimed priority of 24.9.82 because it was not disclosed in the priority document. The same subject-matter, however, was disclosed in (4), page 18, together with its insecticidal and/or acaricidal properties as well as insecticidal compositions containing it. Therefore, this compound representing the state of the art was prejudicial to the novelty of the subject-matter of the claims including this entity and an exclusion of this compound from the application was considered necessary.

- III. The Appellant filed a notice of appeal on 1 December 1986 and paid the appeal fee on the following day. A Statement of the Grounds of Appeal was filed by telecopy on 17 February 1987 and confirmed on 18 February 1987.

- IV. The Appellant argued that (4) should not be considered as prior art within the meaning of Article 54(3) EPC, because the application-in-suit enjoyed the Australian priority, i.e. the filing date of 24 September 1982 which is prior to the date of filing of (4) which is 10 May 1983. The priorities claimed in (4) were of no relevance in this case, since neither of the priority applications disclosed the compounds claimed by the Appellant in his European application. Therefore, no delimitation vis-à-vis (4) was necessary.

- V. As regards the specific compound covered by Claim 8 of set A and Claim 9 of set B of the present application, the Appellant submitted that, although this compound was

explicitly disclosed in (4) before it was explicitly disclosed in the present application (10 May 1983 and 23 September 1983, respectively), this did not destroy the novelty of the present application, since the latter was entitled to the Austrian priority also with regard to this specific compound. Nothing done after the filing of AU 6041/82 on 24 September 1982 could affect the right to priority established by the filing of that application. Thus, the subsequent disclosure in (4) of a single compound falling within the scope of the general formula covered by the priority application could not in any way adversely affect the Appellant's rights as far as the present application is concerned. An opposite view of this point would be contrary, inter alia, to Article 4B of the Paris Convention for the protection of industrial property.

- VI. At the oral proceedings on 21 July 1988, the Appellant requested that the decision under appeal be set aside and the case be remitted to the first instance for further prosecution. Furthermore, it was requested that the appeal fee be reimbursed.

In the latter respect the Appellant argued that the lack of clear grounds for the apparent opinion of the Examining Division that Claim 1 of the present application was not entitled to priority from AU 6041/82 constituted a substantial procedural violation in the sense of Rule 67 EPC.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. The question whether and, if so, to what extent document (4) is in the present case to be considered as comprised in the state of the art in accordance with Article 54(3) EPC depends on the date (or the dates) of filing, to be accorded to the present application taking into account the effect of any priority right to which this application may be entitled as prescribed by Article 89 EPC. This question has to be decided on the basis of Articles 87-89 (and Rule 38) EPC, the provisions of which together form a complete, self-contained, code of rules of law on the subject of claiming priority for the purpose of filing a European patent application (see J 15/80, OJ EPO 1981, 213, where the relationship between the EPC and the Paris Convention is elucidated).

3. In Art. 88(3) it is stated that if one or more priorities are claimed in respect of a European patent application, the right of priority shall cover only those elements of the European patent application which are included in the application(s) whose priority is claimed. It follows from this that a claim in a European patent application may contain subject-matter going beyond what is disclosed in the priority document. In other words a claim in a European patent application may only partially be entitled to a priority, i.e. only for those elements disclosed in the priority document. Therefore the whole claim 1 need not be entitled to the claimed priority date of 24.9.82.

4. The priority document AU 6041/82 on pages 1 to 3 contains a generic disclosure of the same general formula as in Claims 1 (set A and B) under consideration. However some differences occur in the meanings of some of the various residues as follows:

R^2 is H, Hal or methyl (instead of halomethyl in the present Claims 1) A^1 in the priority document has two additional meanings ($-SO_2-$ and $-P(O)O(\text{lower alkyl})-$ which are not contained in the present claims and for the meaning $A^1 = NZ$ the residue Z in the priority document does not mean halogen.

For the residues R^6 and R^8 the meaning "deuterium" is not disclosed in the priority document and for R^7 various meanings are changed. However the priority document contains a clear disclosure of $R^7 = 3\text{-phenoxyphenyl}$.

However, there is full agreement between the priority document and the application-in-suit regarding the meaning of "A" which is of particular relevance with respect to (4).

In the Board's view, therefore, the relevant elements of the present invention covered by the general formula (I) in Claim 1 (of each set of claims) of the present application were properly disclosed in AU 6041/82 filed on 24 September 1982 from which application the Appellant is claiming priority. On the other hand, these elements are not disclosed in the two Japanese patent applications from which (4) claims priority. The fact that a specific structural formula which may be considered as a selection from this general formula (i.e. the entity covered by Claims 8 and 9 of the respective sets of claims) was explicitly disclosed for the first time in (4) on 10 May 1983, which was prior to the date of filing (23.9.83) of the present application in which the above specific

formula was also explicitly disclosed does therefore not affect the Appellant's right to priority from AU 6041/82 in respect of the general formula as such.

Consequently, (4) is not to be considered as comprised in the state of the art insofar as Claim 1 (of each set of claims) of the present application is concerned. For this reason, (4) is not prejudicial to the novelty of the subject-matter of Claim 1 (of each Set of Claims) of the application-in-suit and a delimitation against (4) of this claim cannot be required.

5. Turning now to the question, whether the Appellant is entitled to a right of priority from AU 6041/82 also in respect of the specific compound covered by Claim 8 of set A and Claim 9 of set B of the present application, it is undisputedly so that this compound does not appear among any claims formulated in AU 6041/82 (being a provisional specification). However, priority may according to Article 88(4) EPC nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose this compound. In considering whether this requirement is fulfilled, account cannot, as suggested by the Appellant, be taken of any national (Australian) provisions of patent law or national practice. For the purpose of a European patent application the right of priority is in this respect exclusively to be considered on the basis of the relevant provisions of the EPC and the jurisprudence established within the EPO.
6. It is therefore now to be considered whether or not the previous application AU 6041/82 as a whole discloses this specific entity. In the Board's view the principles developed earlier by this Board considering the question of the novelty of a specific (individual) chemical compound with respect to a generic disclosure of a group of compounds are applicable in this case.

The most important earlier decision relevant to this question are T 12/81 (OJ EPO 8/1982, 296) T 181/82 (OJ EPO 9/1984, 401) and T 7/86 (to be reported in the October issue of the Official Journal of the EPO).

In T 12/81 the Board stated that in a case where a specific structural formula is disclosed in a document this disclosure also comprised a particular steric configuration because it was the inevitable but undetected result of one of a number of processes adequately described in the said document by indication of the starting compound and the process. In item 13 of the reasons for this decision the Board intimate that in a case where two different classes of starting substances are required to prepare the end products and examples of individual entities in each class are given in two lists of some length, there a substance resulting from the reaction of a specific pair from the two lists can nevertheless be regarded as selection and hence as new. In T 181/82 the Board also held that a document sufficiently discloses a chemical compound by description of starting materials and the process applied thereto. In this case one of the starting materials was to be selected from a group of generically described compounds (C₁-C₄ alkyl bromides) and the Board found that this generic disclosure did not imply a specific disclosure of any of the 8 individual members of this group for lack of individualisation except the C₁ alkyl bromide which is unambiguously a synonym of methyl bromide (see item 8 of this decision). The Board made a strict distinction between the purely intellectual content of the definitions and their information content in the sense of a specific teaching with regard to technical action. The recent decision T 7/86 of this Board which directly relates to the question of the novelty of an individual compound vis-à-vis a generic disclosure confirms this position. It was found that the principle applied in T 12/81 to starting

materials of a chemical process also applies to polysubstituted chemical substances where the individual substituents have to be chosen from two different lists of some length.

7. In the present case it is not disputed that the generic disclosure in the priority document contains more than two lists of substituents from which the individual substituents of the specific formula covered by the respective Claims 8 and 9 under consideration have to be selected. The Appellant however argues that some guidance to this particular selection is given by the worked examples in the priority document. These examples relate to the following compounds:

Example 1: 3'-phenoxybenzyl-1-(4-ethoxyphenyl)-2,2-dichloro-cyclopropylmethyl ether

Example 2: 3'-phenoxyphenyl-1-(4-ethoxyphenyl)-2,2,3,3-tetrafluoro-cyclobutylmethyl ether.

The subject-matter of the above Claims 8 and 9 differs from Example 1 by replacement of the two chloro substituents in position 2 of the cyclopropane ring by two fluoro substituents, such substituents being specified in Example 2 in a different context.

In the Appellant's view this replacement is implicitly disclosed in the priority document. However, the Board cannot accept the Appellant's argument since it is not permitted to derive a specific technical teaching from the priority document to make a compound similar to that of the above Example 1, i.e. the compound wherein both halogen substituents at the cyclopropane ring are fluoro. The Board finds that in close analogy to the situation underlying the decision T 181/82 one has to make a strict distinction between a modification which might be regarded

as an obvious alternative to the specific disclosure of the priority document and a modification which is actually disclosed therein in the sense of a specific teaching with regard to technical action. Such disclosure however, is neither constituted by combining the technical disclosure of the above two examples which relate to two cycloaliphatic compounds of different ring size which are clearly distinguished from one another in the generic formula I of the priority document (see residue A and the two partial formulas (X) and (Y) given therefor) nor by combining Example 1 with an arbitrarily selected combination of specific residues from the generic formula I. In the latter the two substituents X¹ and X² represent, similar to the situation underlying the decision T 7/86, two different lists of substituents of some length from which the two individual substituents must be selected without any specific guidance.

The Appellant further relied on page 3 of the priority document referring to two Australian patent applications which disclose the difluorocyclopropane moiety as being representative for the residue "A" of formula I and argued that a skilled person would recognise that the claimed invention is only concerned with the modification of the ester function of these known compounds, which in the application-in-suit is replaced by the group $-C(R^4R^5)-A^1-$, leaving the identical residue "A" unchanged.

However, there is no information derivable from the priority document that the invention disclosed therein relates to a modification of the subject-matter of the two Australian patent applications referred to. These applications are only cited as disclosing "related prior art compounds" of formula II which are in no way distinguished from other such compounds of formulas III to VI disclosed in further documents also cited, i.e. they are only cited in order to indicate the background art in

the way which is required for European patent applications in Rule 27(1)(c). The reference in formula II of the priority document (describing the prior art) to formula I (describing the claimed compounds) with respect to inter alia the meaning of "A" does therefore not justify to consider all acids specifically mentioned in the cited documents as being part of the disclosure of the invention to which the priority document relates; this finding being further supported by the absence of any disclosure that and how the acids of formula II can be converted to the starting materials of formula VIII (see page 7 of the priority document) containing the structural element -A-C(R⁴R⁵)-P.

Even if however the relevant starting materials of formula VIII could be regarded as being comprised by the disclosure of the priority document, this would not be sufficient to disclose the compound of Claim 8 individually because this compound would only be the result of a mental combination of a pair of starting materials which must be selected from two lists of considerable length. Such combination however cannot be regarded as a specific teaching with respect to technical action and hence cannot implicitly disclose the product of such a combination.

Consequently in the Board's view the subject-matter of the respective Claims 8 and 9 of the two sets of claims under consideration is not entitled to the claimed priority date of 24.9.82 from AU 6041/82 according to Art. 88(4) EPC. This means that the disclosure in (4), which is entitled to the earlier filing date of 10 May 1983 is prejudicial to the novelty of this specific subject-matter according to Art. 54(3) and (4) EPC for the Designated Contracting States except BE and SE.

8. It is not disputed by the Appellant that (4) discloses athropocidal compositions containing the "compound 25" which is identical to the subject-matter of Claims 8 and 9 of the respective sets of claims, a method for making such compositions and a method for combating arthropods using them. Therefore, Claims 14, 15 of Claims set A and 15, 16 of Claims set B as far as they refer to Claims 8 of set A and 9 of set B are also not allowable for the same reason.

9. Thus, having clarified the situation with regard to the priority issues involved, the Board does not consider it meaningful to pursue the examination of the present appeal any further. It seems now most appropriate to remit the case to the first instance for further prosecution on the basis of the Board's ruling on the priority issues, as requested by the Appellant.

10. The question whether the disclosure of the structural formula of "compound 25" in (4), which is identical to that covered by the present Claims 8 and 9 of the respective sets of claims, also implicitly includes the disclosure of the two optical antipodes of this racemate was not an issue in these appeal proceedings and the Board does not wish to decide on this question now, because the Appellant should not be deprived of the opportunity to have this matter considered by two instances.

11. As regards the request for reimbursement of the appeal fee, the Board does not share the view of the Appellant that there occurred a substantial procedural violation in the course of the proceedings before the Examining Division. The way the matter was handled by this department was rather a result of a mistake in law which cannot be regarded as a procedural violation. The request for reimbursement must consequently be rejected.

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 request for reimbursement of the appeal fee is rejected.

The Registrar:



S.Fabiani

The Chairman:



K.Jahn