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D E C I S I O N
of 16 July 1999

Case Number: T 0606/94 - 3.3.1

Application Number: 90314192.7

Publication Number: 0435632

IPC: C07D 239/26

Language of the proceedings: EN

Title of invention:

Phenylpyrimidine derivates, process for preparing the same, liquid crystal compositions containing said derivatives a sactive ingredient, and liquid crystal elements using such compositions

Applicant:

SUMITOMO CHEMICAL COMPANY LIMITED

Opponent:

-

Headword:

Phenylpyrimidines/SUMITOMO

Relevant legal provisions:

EPC Art. 54(1), 111(1)

Keyword:

"Novelty (yes) - after amendment"

Decisions cited:

-

Catchword:



Case Number: T 0606/94 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 16 July 1999

Appellant:

SUMITOMO CHEMICAL COMPANY LIMITED
5-33, Kitahama 4-chome
Chuo-ku
Osaka-shi
Osaka 541-0041 (JP)

Representative:

Ablewhite, Alan James
Marks & Clerk
57/60 Lincoln's Inn Fields
London WC2A 3LS (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 23 February 1994
refusing European patent application
No. 90 314 192.7 pursuant to Article 97(1) EPC.

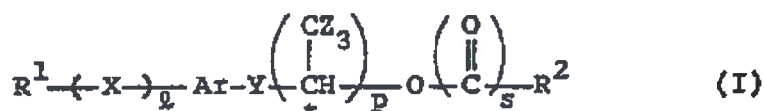
Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
J. P. B. Seitz

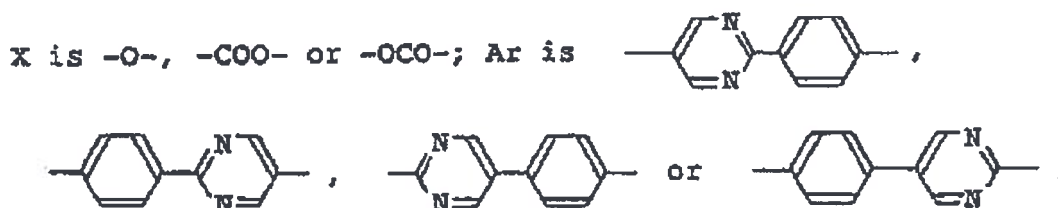
Summary of facts and submissions

- I. This appeal is from the Examining Division's decision, dispatched on 23 February 1994, refusing European patent application No. 90 314 192.7, published as EP-A-0 435 632, due to lack of novelty.
- II. More particularly, the Examining Division found that the phenylpyrimidines according to the then pending Claim 1 were not novel over the teaching of document (3), EP-A-0 347 943, and that the alcohols according to the then pending Claims 14 and 15 were not novel over the teaching of document (1), EP-A-0 255 219.
- III. With telefax of 15 July 1999 the Appellant filed a set of 20 claims, wherein Claims 1 and 6 read:

"1. Phenylpyrimidine derivatives represented by the general formula I:

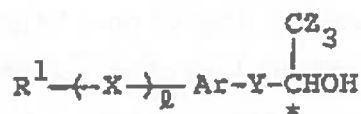


wherein R¹ is an alkyl group having 3-20 carbon atoms; R² is an alkyl group having 1-20 carbon atoms or an alkoxyalkyl group having 2-20 carbon atoms, which may be substituted with a halogen atom;

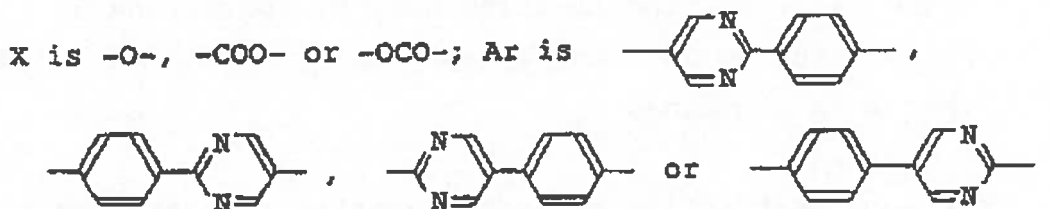


Y is $\{CH_2\}_m$ or $-CH=CH\{CH_2\}_n$, Z is a fluorine atom; p is 1; l and s are each 0 or 1; m is an integer of 0 to 10; n is an integer of 0 to 8; and the * mark denotes an asymmetric carbon atom."

"6. Alcohols represented by the following general formula:



wherein R¹ is an alkyl group having 3 to 20 carbon atoms;



Y is $\{CH_2\}_m$ or $-CH=CH\{CH_2\}_n$, Z is a fluorine atom; l is a number of 0 or 1; m is an integer of 0 to 10; n is an integer of 0 to 8; and the * mark denotes an asymmetric carbon atom."

Furthermore, he submitted that the claimed subject-matter was novel over any of the disclosures of documents (1) and (3).

IV. The Appellant requested that the case be remitted to the Examining Division.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

Present Claims 1 and 6 correspond with Claims 1 and 14 underlying the contested decision. Since Claim 15 underlying the contested decision related to alcohols wherein Z is hydrogen, there is no corresponding claim in the present set of claims.

Claims 1 and 6 differ from Claim 1 respectively Claim 14 as originally filed only by specifying in Claim 1 that p is 1 and by specifying in Claims 1 and 6 that Z is fluorine.

By such restriction no subject-matter extending beyond the content of the application as filed is added to Claims 1 and 6.

3. *Novelty*
 - 3.1 Document (3) is concerned with compositions containing at least one phenylpyrimidine bearing a **methyl-**substituted alkoxyalkyl radical.

Since present Claim 1 is restricted to phenylpyrimidines bearing a **trifluoromethyl-**substituted radical and such compounds are not disclosed in document (3), this document can no longer be considered as destroying the novelty of present Claim 1.

3.2 Document (1) discloses á-**methyl**-substituted alcohols.

Since present Claim 6 is restricted to á-**trifluoromethyl**-substituted alcohols and such alcohols are not disclosed in document (1), this document can no longer be considered as destroying the novelty of present Claim 6.

4. Consequently, the Board comes to the conclusion that present Claims 1 and 6 are novel over the teachings of documents (1) and (3).

5. Since the decision of the Examining Division only concerned the novelty of present Claims 1 and 6 over the disclosures of documents (1) and (3), the Board considers that, in accordance with standard practice, it would not be appropriate at the present stage of the proceedings for the Board to deal with the other requirements of the EPC, such as the issue of novelty of the other claims over documents (1) and (3) or the issue of novelty of the complete set of claims over other documents or that of inventive step, in order not to deprive the Appellant of the possibility of having these issues decided by two instances. Therefore, the Board has decided to use its powers under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The matter is remitted to the Examining Division for further examination on the basis of the set of claims filed with telefax of 15 July 1999.

The Registrar:

The Chairman:

E. Görgmaier

A. Nuss