

BESCHWERDEKAMMERN
DES EUROPÄISCHEN
PATENTAMTS

BOARDS OF APPEAL OF
THE EUROPEAN PATENT
OFFICE

CHAMBRES DE RECOURS
DE L'OFFICE EUROPEEN
DES BREVETS

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 15 September 1998

Case Number: T 0917/97 - 3.3.1

Application Number: 94917917.0

Publication Number: 0698013

IPC: C07D 239/95

Language of the proceedings: EN

Title of invention:
Fungicidal fused bicyclic pyrimidinones

Applicant:
E.I. DU PONT DE NEMOURS AND COMPANY

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 54(1), (2),

Keyword:
"Novelty (yes, after amendment) - combination of substituents
not previously disclosed"

Decisions cited:
T 0124/87

Catchword:
-



Case Number: T 0917/97 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 15 September 1998

Appellant:

E.I. DU PONT DE NEMOURS AND COMPANY
1007 Market Street
Wilmington
Delaware 19898 (US)

Representative:

Woodman, Derek
Frank B. Dehn & Co.
European Patent Attorney
179 Queen Victoria Street
London EC4V 4EL (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 10 April 1997
refusing European patent application
No. 94 917 917.0 pursuant to Article 97(1) EPC.

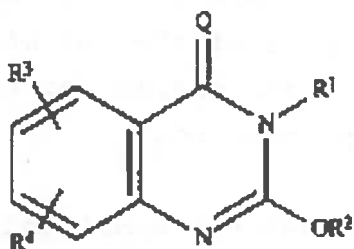
Composition of the Board:

Chairman: A. J. Nuss
Members: P. P. Bracke
S. C. Perryman

Summary of Facts and Submissions

- I. This appeal is from the Examining Division's decision, dispatched on 10 April 1997, refusing European patent application No. 94 917 917.0, published as WO 94/26722, due to lack of novelty.
- II. More particularly, the Examining Division found that the generic definition of the compounds of formulas (I), (II) and (III) in the then pending set of claims overlapped with the generic definition of the compounds disclosed in documents
- (2) US-A-3 755 582 and
(4) US-A-3 867 384.
- III. With the statement setting out the grounds of appeal the Appellant filed a set of 10 claims with the independent claims reading:

"1. A fungicidal compound of Formula I



wherein

Q is independently O or S;

R¹ is C₃-C₁₀ alkyl, C₃-C₅ cycloalkyl or cyclopropylmethyl;

R² is C₃-C₁₀ alkyl or C₆-C₇ cycloalkyl;

R³ is halogen; and

R⁴ is hydrogen or halogen;
provided that when R¹ is cyclopropylmethyl, Q is O, R²
is CH₂CH₂CH₃, R³ is 6-Br and R⁴ is H."

"7. A fungicidal composition for controlling wheat powdery mildew comprising an effective amount of a compound according to any one of Claims 1-6 and at least one of (a) a surfactant, (b) an organic solvent and (c) at least one solid or liquid diluent."

"9. A method of controlling wheat powdery mildew comprising applying to the plant or portion thereof to be protected, to the media in which the plant to be protected is growing, or to the plant seed or seedling to be protected an effective amount of a compound according to any one of Claims 1-6."

Furthermore, he submitted that the claimed subject-matter was novel over the teaching of documents (2) and (4).

IV. The Appellant requested, as a main request, that the appealed decision be set aside and that the application be found allowable on the basis of the set of claims filed on 18 August 1997 with the grounds of appeal, and as auxiliary request oral proceedings.

With letter of 4 September 1998 the Appellant confirmed that oral proceedings were only requested if the Appeal Board were minded not to allow the applicant's main request.

Reasons for the Decision

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

Claim 1 concerns a restricted version of the compounds of formula (I), supported, in particular, by the definitions given on page 1 of the originally filed application, wherein R¹, R², R³ and R⁴ have the meanings as described on page 1, line 19 (R¹ is C₃-C₁₀ alkyl or C₃-C₅ cycloalkyl), and page 2, line 1 (R² is C₃-C₁₀ alkyl or C₆-C₇ cycloalkyl), line 15 (R³ is halogen) and line 23 (R⁴ is hydrogen or halogen) and also compound 46, disclosed on page 36 of the application as originally filed.

Claim 2 concerns the compounds "Preferred 1" as described in the originally filed application on page 6, line 31 to page 7, line 11, wherein R¹ and R² have the meaning as described on page 6, line 33 (R¹ is C₃-C₈ alkyl) and page 7, line 1 (R² is C₃-C₈).

Claim 3 is supported by the compounds described on page 9, lines 20 and 22, and Claim 4 is supported by the compound described on page 9, line 21 and compound 46, described on page 36.

Claim 5, which relates to 17 groups of compounds, is supported by one or several compounds listed in:

Table 1 [group (1)]; Table 2 [group (2)]; Table 3 [group (3)]; Table 4 [groups (4) to (8)]; and Table A:

- compounds 1, 2, 3, 8, 13, 14 and 25 [group (9)],
- compounds 22, 23, 26, 27 and 31 [group 10)],

- compounds 17, 18 and 37 [group (11)],
- compounds 28 and 34 [group (12)],
- compounds 29 and 38 [group (13)],
- compounds 35 and 51 [group (14)],
- compounds 45, 46 and 47 [group (15)],
- compound 48 [group (16)] and
- compounds 52 and 53 [group (17)].

Claim 6 corresponds with compound 25 of Table A.

Claim 7 is directed to a combination of the compositions mentioned on page 30, lines 4 to 7, and the preferred use of controlling wheat powdery mildew, mentioned on page 32, lines 20 to 22.

Claim 8 depends on Claim 7 and specifies that the compound is compound 25 of Table A.

Claim 9 is a combination of the method mentioned on page 32, lines 22 to 26, and the preferred use of controlling wheat powdery mildew, mentioned on page 32, lines 20 to 22.

Claim 10 depends on Claim 9 and specifies that the compound is compound 25 of Table A.

Claims 1 to 10 thus meet the requirements of Article 123(2) EPC.

3. *Novelty*

3.1 Document (4) was considered to destroy the novelty of the set of claims underlying the contested decision as far as compounds of formula (III) were concerned. Since the present set of claims is restricted to compounds of formula (I) and since document (4) does not mention compounds of formula (I), the Board comes to the conclusion that the disclosure of document (4) is not prejudicial to the novelty of the present set of claims.

3.2 Having examined document (2), the Board has reached the conclusion that none of the exemplified compounds is embraced within the scope of present Claim 1, that the preferred compounds described in column 1, lines 66 to 72, differ from the presently claimed ones by a substituted sulfide radical instead of a substituted oxide radical in the 2-position and, consequently, that the only remaining question is whether the general teaching of document (2) is prejudicial to the novelty of the present set of claims. The relevant passage in this respect relates to compounds of formula (I) wherein

Q is oxygen or sulfur,

R¹ is *inter alia* C₁-C₁₂ alkyl, C₃-C₈ cycloalkyl or C₄-C₉ cycloalkylalkyl,

R² is *inter alia* C₁-C₁₂ alkyl or C₃-C₈ cycloalkyl and

R³ and R⁴ are each *inter alia* hydrogen or halogen in the 6- and in the 8-position respectively (see column 1, lines 29 to 64).

3.3 The Examining Division was of the opinion that the compounds claimed in the then pending set of claims were only the result of a mere selection of the compounds generically disclosed in document (2) and that such selection was no more than a repetition of what already belongs to the state of the art and, consequently, that, according to the principle laid down in T 124/87, OJ EPO 1989, 491, reasons 3.2, such set of claims was not novel over the disclosure of document (2).

3.4 Reason 3.2 of T 124/87 concerns the generally accepted principle, that in assessing novelty it is to be considered whether the disclosure of a document as a whole is such as to make the subject-matter for which protection is sought available to a skilled person.

Therefore, in assessing novelty of present Claim 1, whose scope was considerably restricted during the appeal procedure, the question to be answered is whether the claimed compounds were made available by the disclosure of document (2).

More particularly, since the claimed compounds may have as Q, R³ and R⁴ the same substituents as the compounds generically disclosed in document (2), it falls to be decided whether compounds of formula (I) bearing a R¹ substituent **as well as** a R² substituent with the meanings as defined in present Claim 1, are to be considered as already disclosed by teaching of document (2).

In order to arrive at the claimed compounds starting from the teaching of document (2), a mandatory requirement is that R¹ has to be selected as C₃-C₁₀ alkyl, C₃-C₅ cycloalkyl or cyclopropylmethyl and R² has to be selected as C₃-C₁₀ alkyl or C₅-C₇ cycloalkyl. Since

it is nowhere taught in document (2) to make such specific combined selections, the Board comes to the conclusion that in document (2) there is no teaching of the presently claimed compounds.

- 3.5 Therefore, the Board concludes that the disclosure of document (2) is not prejudicial to the novelty of Claim 1.

For the same reasons also dependent claims 2 to 6, the composition claims 7 and 8 and the method claims 9 and 10 are novel over the disclosure of document (2).

4. Consequently, the Board comes to the conclusion that the present set of claims is novel over the teachings of documents (2) and (4).
5. Since the decision of the Examining Division only concerned the novelty of the claimed subject-matter over the teachings of documents (2) and (4), 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 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 first instance for further prosecution.
6. Since the Appellant's main request has been allowed to the extent that the Board has considered it, oral proceedings before the Board are not necessary.

Order**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The matter is remitted to the first instance for further examination on the basis of the set of claims filed on 18 August 1997 with the grounds of appeal.

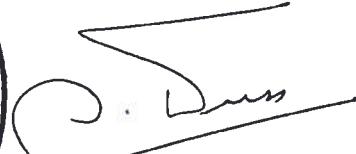
The Registrar:



P. Martorana



The Chairman:



A. Nuss