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Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 83 302 452.4

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Bezeichnung der Erfindung: Indoline derivatives

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C07D 498/10

## ENTSCHEIDUNG / DECISION

vom / of / du 6 June 1989

Anmelder / Applicant / Demandeur : Imperial Chemical Industries plc

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Chemical Formulae ICI.

EPÜ / EPC / CBE

Art. 84 EPC ; Rules 29(6), 64 EPC ; Guidelines for Examination.

Schlagwort / Keyword / Mot clé :

"Clarity - Structural chemical Formulae set out in Appendix to claims ; relevance of Guidelines"

Leitsatz / Headnote / Sommaire

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 271/88 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 6 June 1989

**Appellant :** IMPERIAL CHEMICAL INDUSTRIES PLC  
Imperial Chemical House Millbank  
London SW1P 3JP  
GB

**Representative :** Smith, Stephen Collyer  
Imperial Chemical Industries PLC  
Legal Department : Patents  
Po Box 6  
Bessemer Road  
Welwyn Garden City  
Herts, AL7 1HD  
GB

**Decision under appeal :** Decision of Examining Division 008 of the  
European Patent Office dated 7 January 1988  
refusing European patent application  
No. 83 302 452.4 pursuant to Article 97(1) EP

**Composition of the Board :**

**Chairman :** P. Lançon  
**Members :** J. Stephens-Ofner  
A. Nuss  
E. Persson  
S. Schödel

## Statement of Facts and Submissions

- I. European patent application No. 83 302 452.4 was filed on 29 April 1983 and published under No. 94184. The claims as originally filed contained numerical references to structural chemical formulae, but not the formulae themselves, which were instead shown on two separate sheets called "Formula Drawings".
- II. In response to the Examining Division's objections under Rule 29(6) EPC to this form of presentation, the Applicant submitted modified claims, the only essential modification being that the appendix showing the structural chemical formulae was designated as "chemical formulae incorporated within claims".
- III. By decision dated 7 January 1988 the Examining Division refused the application in its modified form, largely on the basis that the requirements as to the clarity of claims contained in the EPC implied the principle of their isolated comprehensibility, so that any deviation from that principle needed to satisfy the express provisions of, inter alia, Rule 29(6) EPC.
- IV. The Applicant appealed from the above decision, upon the following principal grounds:
  - (a) Rule 29(6) dealt only with descriptions and drawings, and since structural chemical formulae were neither of these, the Rule was inapplicable;
  - (b) even if Rule 29(6) EPC extended to structural chemical formulae either as descriptions or as drawings, the circumstances of the present case were "exceptional" and therefore satisfied the requirements of the Rule;

- (c) the EPO's DATIMTEX project to digitise all application documents was evidence of its unbureaucratic and pragmatic approach to applicants, as opposed to a formalistic one. Such an approach would permit claims filed in the form which had been refused by the Examining Division because this form avoided the practical difficulties associated with the use of the word-processing equipment when claims to chemical compounds formally embodied their structural as opposed to their molecular or other line-oriented chemical formulae;
  - (d) there was no difficulty in interpreting and using patent application documents containing structural chemical formulae on separate sheets, and indeed this was accepted by some national patent offices in the Contracting States and was even required in the Netherlands Patent Office.
- V. Oral proceedings were held on 6 June 1989, at which the Applicant requested that the decision under appeal be set aside, and that a patent be granted on the basis of the rejected claims (main request) or, in the alternative, that the case be remitted to the Examining Division for further prosecution of the application upon the basis of the claims to be amended as required by the Examining Division, namely by the formal incorporation of the structural chemical formulae into the body of the claims.

### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. Two main issues arise from this appeal: the first, whether or not the claims according to the main request are allowable under the EPC and second, if so, whether the facts of the present case justify their allowance.
3. The key legal issue of principle in this case is the applicability of Rule 29(6) EPC to structural chemical formulae. That Rule gives effect to Article 84 EPC which lays down the fundamental requirements of clarity and conciseness of claims. The Rule provides, "Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings ...". Express guidance for the interpretation of this Rule is given by C-III para. 4.10 of the "Guidelines for Examination in the Patent Office", according to which claims may contain references to descriptions or drawings in circumstances of "absolute necessity". A number of examples of special cases of absolute necessity is given, one of them being inventions concerning chemical compounds some of whose features can be defined only by means of graphs or diagrams, i.e. by structural chemical formulae. These examples are clearly meant to be non-limiting, and therefore allow references to structural chemical formulae in other cases of absolute necessity, depending upon the facts and circumstances of each case.

It is quite evident from the above considerations, that the terms "description" and "drawing" in Rule 29(6) are meant to cover structural chemical formulae, and are therefore used quite differently from their normal logical

acceptation. This interpretation of Rule 29(6) is not affected by the terminology employed in other parts of the Guidelines [Part A, Chapter 10, paragraph 11.11], which deal with the meaning of other rules, e.g. Rule 35(10) EPC. Nor can much help be derived in construing Rule 29(6) EPC from the express wording of Rule 35(11) EPC, as the Appellant attempted to do in support of one of his principal grounds, namely, that Rule 29(6) did not apply to structural chemical formulae.

The Board recognises that the Guidelines are what their title suggests: lines for guidance rather than a set of peremptory instructions. They are not binding : see the general introduction to them, page II, paragraph 1.2. However, in the light of all the facts and arguments in this case the Board concludes that the above interpretation of Rule 29(6) is correct and has therefore been rightly followed by the first instance.

4. Accordingly, the ground of appeal referred to in paragraph IV(a) cannot be accepted. In this connection, the Board wishes to observe that the mere fact that references to structural chemical formulae on separate sheets are accepted and even required by some national patent offices of the Contracting States cannot be relevant, let alone decisive, to the interpretation of the EPC. Furthermore, it is generally accepted by other EPC Contracting States that a claim should normally be complete in itself. There is not much difference between reliance on references to the description and reliance on references to a separate sheet, and one Board has already objected to such references unless absolutely necessary (T 150/82, OJ EPO 1984, 309).
5. This leaves for decision the second main ground, namely whether the facts of the present case amount to "absolute

necessity" within the meaning of Rule 29(6) EPC construed as set out in paragraph 3 above. A number of matters impinge upon the decision on this point. The first one is that this application was not filed in digitised form, so that any pronouncements of the President of the EPO about the DATIMTEX project serve only as evidence of the Office's pragmatic approach to all applications, including digitised ones. The second one is that the Appellant in the course of oral proceedings freely admitted that this case was not a particularly good example of "absolute necessity", either within a strict meaning of that term, or within a more liberal or purposive meaning of it. This is because the structural chemical formulae set out in the Appendix of the modified application of 2 May 1985, could quite readily be rewritten in line-oriented form in the way this was done, for example, on page 5, lines 5-15 of the description of the application in suit, and then easily incorporated into the body of the claims. This admission of the Appellant bears significantly upon the outcome of this appeal, since the Board can only decide the actual case before it. There may well, in the future, be other cases where the requirement of "absolute necessity" in Rule 29(6) EPC will be literally met by an invention relating to chemical products some of whose features can be defined only by means of structural chemical formulae, as provided for in part C-III of the Guidelines. There may also arise other cases where the requirement of "absolute necessity" in Rule 29(6) EPC, though not literally fulfilled, will meet the liberal (or pragmatic) construction, as set out above, of that rule - for example in cases where although the definition of a chemical product could be made by a means other than a structural chemical formula, this could only be done in an extremely cumbersome manner. Lastly, it is probable that in a short space of time word-processing programmes sufficiently powerful to enable the ready incorporation of

structural chemical formulae into the body of the patent claims will be developed and marketed to patent practitioners: indeed the Board is aware that a wordprocessing machine with such a programme is already in use.

8. Be that as it may, the Board finds that, although the formulae in question may be considered as falling within the meaning of Rule 29(6) EPC, the circumstances of the present case do not admit of the conclusion that it is absolutely necessary to rely upon references to such formulae, as requested by the Appellant in his main request. It follows that only the Appellant's auxiliary request is allowable.

**Order**

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

1. The main request is refused;
2. the decision under appeal is set aside;
3. the case is remitted to the Examining Division for further prosecution on the basis of the claims to be amended as originally required by the Examining Division.

**The Registrar:**

M. Beer

**The Chairman:**

P. Lançon