



Aktenzeichen

File Number

Numéro du dossier

T 0578190 - 332

In der Anlage erhalten Sie

- eine Kopie des Berichtigungsbeschlusses
- ein korrigiertes Vorblatt (Form 3030)
- einen Leitsatz / Orientierungssatz (Form 3030)
- \_\_\_\_\_

Please find enclosed

- a copy of the decision correcting errors
- a corrected covering page (Form 3030)
- a headnote / catchword (Form 3030)
- amended page 4 of decision.*

Veillez trouver en annexe

- une copie de la décision rectifiant des erreurs
- une page de garde (Form 3030) corrigée
- un sommaire / une phrase vedette (Form 3030)
- \_\_\_\_\_

Anmeldung Nr. / Patent Nr.:

\_\_\_\_\_

Application No. / Patent No.:

86902725.0

Demande n° / Brevet n°:

\_\_\_\_\_

(soweit nicht aus der Anlage ersichtlich)

(if not apparent from enclosure)

(si le n° n'apparaît pas sur l'annexe)



Case Number : T 0578/90 - 3.3.2

DECISION  
of 23 February 1994  
correcting error in the decision  
of the Technical Board of Appeal 3.3.2  
of 8 December 1992

**Appellant :** RHONE-POULENC AGROCHIMIE SOCIETE ANONYME  
14-20, rue Pierre Baizet  
F - 69009 Lyon (FR)

**Representative :** Patentanwälte  
Beetz sen. - Beetz jun.  
Timpe - Siegfried - Schmitt-Fumian- Mayr  
Steinsdorfstrasse 10  
D - 80538 München (DE)

**Decision under appeal :** Decision of the Examining Division of the European  
Patent Office dated 24 November 1989 refusing  
European patent application No. 86 902 725.0  
pursuant to Article 97(1) EPC.

**Composition of the Board :**

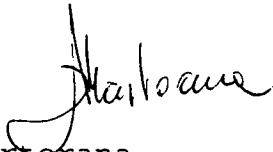
**Chairman :** P.A.M. Lançon  
**Members :** A.J. Nuss  
S.C. Perryman

In application of Rule 89 EPC the decision of 8 December 1992 in the appeal case T 578/90 - 3.3.2 is corrected by cancelling on page 4:

"2. \*\*HEADING OR INTRODUCTORY PARAGRAPH REQ'D PLEASE\*\*".

Please substitute the page 4 by the page attached.

The Registrar:



P. Marterana

The Chairman:



P.A.M. Lançon

alkylsulfinyl, alkylsulfonyl, alkoxy or  
R<sub>4</sub>R<sub>5</sub>NCO-groups,

or

(b) phenyl, R<sub>4</sub>R<sub>5</sub>NCO- or R<sub>6</sub>CON(R<sub>4</sub>)-, wherein R<sub>4</sub>  
and R<sub>5</sub> are individually hydrogen or  
alkyl, and R<sub>6</sub> is hydrogen, alkyl or  
alkoxy,

and

R<sub>3</sub> is hydrogen, cyano, C<sub>1-5</sub>-alkyl or C<sub>1-5</sub>-alkylthio,  
provided that the total number of carbon atoms in R<sub>2</sub>  
and R<sub>3</sub> does not exceed eight and provided further that  
when R<sub>2</sub> is alkyl substituted with alkylthio, R<sub>3</sub> is  
alkyl,

characterized in that they comprise as thermal  
decomposition inhibitors for retarding or inhibiting  
thermal decomposition

- phosphorous acids,
- phosphoric acid,
- an alkali metal monobasic phosphate,
- an alkali metal metaphosphate,
- an alkali metal sulphate,
- an alkali metal bisulfite, and/or
- an alkali metal bicarbonate

in an amount of 0.01 to 95 mass-%, based on the mass  
of the pesticide compound."

- Claim 1 according to the first subsidiary request  
differs from that of the main request in that it relates  
to "a **method** for retarding or inhibiting thermal  
decomposition of organic pesticide compounds of the  
formula ..., characterized by intimately mixing of the  
pesticide compound with .... as thermal decomposition  
inhibitors in an amount of 0.01 to 95 mass-%, based on  
the mass of the pesticide compound".

A		B		C	X
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File Number: T 0578/90 - 3.3.2  
Application No.: 86 902 725.0  
Publication No.: 0 218 698  
Title of invention: Thermally stabilized bis alkylthio-alkylimino-n-alkyl  
carbamates

Classification: A01N 47/24

**D E C I S I O N**  
**of 8 December 1992**

Applicant: RHONE-POULENC AGROCHIMIE SOCIETE ANONYME

Headword: Carbamates/RHONE-POULENC

**EPC** Articles 54, 111(1) EPC

Keyword: Main request:  
"Novelty (no) - pesticidal composition - composition as such  
already known"  
Auxiliary request:  
"Novelty (yes) - method for retarding or inhibiting thermal  
decomposition of organic pesticide compounds"  
"Remittal of the case for further prosecution"

Decisions cited: G 5/83, G 2/88 and T 231/85



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 0578/90 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 8 December 1992

**Appellant :** RHONE-POULENC AGROCHIMIE SOCIETE ANONYME  
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**Composition of the Board :**

**Chairman :** P.A.M. Lançon  
**Members :** A.J. Nuss  
S.C. Perryman

## Summary of Facts and Submissions

- I. European patent application No. 86 902 725.0 was filed on 17 April 1986 and published under No. 0 218 698.
- II. The Examining Division refused the application under Article 97(1) EPC for failure to comply with Article 54 EPC. The decision was based on nineteen claims, filed with letter dated 31 August 1989.
- III. The ground for the refusal was that, in the opinion of the Examining Division, the claimed solid pesticidal composition of thermally stabilised bis alkyl-thio-alkylimino-N-alkyl carbamates lacked novelty having regard to the disclosure of GB-A-2 079 154 document (2). In particular Example 3 of this document disclosed a wetttable powder comprising a carbamate of the claimed formula and 6% of sodium dihydrogen phosphate.

The Examining Division added that having regard to the lack of novelty of the claimed subject-matter, it was not necessary to deal with the formal admissibility of the above-mentioned claims.

- IV. The Appellant lodged an appeal against this decision. Together with the Statement setting out the Grounds of appeal three sets of claims were filed; they served as basis for Appellant's main and subsidiary requests.

The Appellant argued in essence that the decision was based on a very formalistic interpretation of the prior art documents which were not concerned with the thermal stabilisation of the claimed pesticide composition. The sodium dihydrogen phosphate mentioned in Example 3 of (2) was only used as solid diluent whereas the present invention was based on the unexpected finding that the

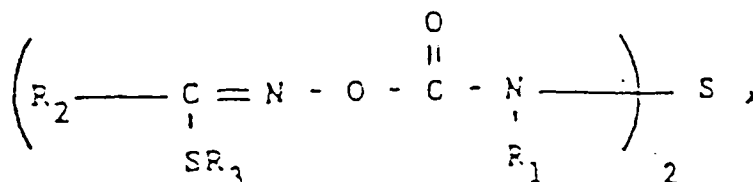
addition of decomposition inhibitors leads to a lower decomposition rate independently on whether the composition is present in the form of a liquid or a dry matter. The fact that the aim of the present invention was novel, would necessarily mean that also the solution was novel. Moreover, according to the Decision T 231/85 of 8 December 1986, the EPO had acknowledged novelty and inventive step for an analogous case where a substance was known as growth regulator and it had been detected that the same substance, in the same kind of composition, could be used as a fungicide.

V. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of one of the three sets of claims received on 4 April 1990.

Oral proceedings were requested only in the event that none of the pending requests should be acceptable.

VI. - Claim 1 according to the main request reads as follows (the Board has underlined the parts which differ from the first subsidiary request)

"1. Pesticidal compositions comprising an effective amount of an organic pesticide compound of the formula



wherein

R<sub>1</sub> is C<sub>1-5</sub>-alkyl;

R<sub>2</sub> is (a) C<sub>1-5</sub>-alkyl, C<sub>1-5</sub>-alkylthio, C<sub>1-5</sub>-alkoxy, C<sub>1-5</sub>-alkanoyl or C<sub>1-5</sub>-alkoxycarbonyl, which may be aliphatically substituted with one or more cyano, nitro, alkylthio,



alkylsulfinyl, alkylsulfonyl, alkoxy or  
R<sub>4</sub>R<sub>5</sub>NCO-groups,

or

(b) phenyl, R<sub>4</sub>R<sub>5</sub>NCO- or R<sub>6</sub>CON(R<sub>4</sub>)-, wherein R<sub>4</sub>  
and R<sub>5</sub> are individually hydrogen or  
alkyl, and R<sub>6</sub> is hydrogen, alkyl or  
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and

R<sub>3</sub> is hydrogen, cyano, C<sub>1-5</sub>-alkyl or C<sub>1-5</sub>-alkylthio,  
provided that the total number of carbon atoms in  
R<sub>2</sub> and R<sub>3</sub> does not exceed eight and provided further  
that when R<sub>2</sub> is alkyl substituted with alkylthio, R<sub>3</sub>  
is alkyl,

characterized in that they comprise as thermal  
decomposition inhibitors for retarding or  
inhibiting thermal decomposition

- phosphorous acids,
- phosphoric acid,
- an alkali metal monobasic phosphate,
- an alkali metal metaphosphate,
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in an amount of 0.01 to 95 mass-%, based on the  
mass of the pesticide compound."

- Claim 1 according to the first subsidiary request  
differs from that of the main request in that it relates  
to "a **method** for retarding or inhibiting thermal  
decomposition of organic pesticide compounds of the  
formula ..., characterized by intimately mixing of the  
pesticide compound with .... as thermal decomposition  
inhibitors in an amount of 0.01 to 95 mass-%, based on  
the mass of the pesticide compound".

- In view of the outcome of the present appeal, it is not necessary to deal with the second subsidiary request.

### Reasons for the Decision

1. The appeal is admissible.
2. **\*\*HEADING OR INTRODUCTORY PARAGRAPH REQ'D PLEASE\*\***
- 2.1 Claims 1 to 5 according to the **main request** are supported by the original description; their subject-matter is indeed directly and unambiguously derivable from Claims 1, 2 and 4 to 9 as originally filed in combination with the original description, in particular page 2, lines 24 ff., page 4, lines 14 ff. and page 10, line 31 to page 11, line 5.

The additional Claims 6 to 10 concern a method for retarding or inhibiting thermal decomposition of the pesticidal compounds referred to in the aforementioned Claims 1 to 5; they are clearly based on the same references in the original disclosure as the composition claims.

- 2.2 Claims 1 to 5 according to the **first subsidiary request** correspond to Claims 6 to 10 of the main request just mentioned.

Since it appears from the disclosure of the present application as a whole that the word "weight" is used in the sense of a weighing result, the Board sees no reason to object to the conversion of the originally used unit "% by weight" into "mass-%".

The requirements of Article 123(2) EPC are accordingly satisfied for both the main and first subsidiary request.

3. As regards the novelty question, the Appellant made reference to T 231/85. This decision was discussed in decision G 2/88.

3.1 Claim 1 according to the present main request relates to pesticidal compositions and thus to a product *per se*. It is generally accepted as a principle underlying the EPC that such a claim confers absolute protection upon the physical entity; that is, wherever it exists - and whatever its context, and therefore for all uses of such physical entity, whether known or unknown. It follows that if it can be shown that such physical entity (in the present case the pesticidal composition of Claim 1) is already in the state of the art, for example in the context of a particular activity (in the present case the wettable powder according to Example 3 of document (2) comprising a carbamate pesticide as defined in present Claim 1 and sodium dihydrogen phosphate (i.e. sodium monobasic phosphate) as a solid diluent), then a claim to the physical entity *per se* (present Claim 1 according to the main request) lacks novelty ( cf. G 2/88, Reasons for the Decision 5, third paragraph).

It is important to recognise that only Article 54(5) EPC expressly provides an exception to the aforementioned general rules for novelty. In contrast to "normal" product claims where a prerequisite for novelty is that the product as defined in the claim has at least one physical parameter which distinguishes it from previously known products, in the case of a claim to "a product for use in a first or subsequent medical use", the product *per se* as defined in the claim does not need to be physically distinguishable from previously known

products in order for the claim to be novel. It is, however, in the decision G 5/83 (OJ EPO, 1985, 64), clearly indicated that this special approach to the derivation of novelty could only be applied to claims to the use of **substances or compositions intended for use in a method referred to in Article 52(4) EPC.**

For these reasons the main request is not allowable.

- 3.2 Claim 1 according to the first subsidiary request relates to "a method for retarding or inhibiting thermal decomposition of organic pesticide compounds".

Although document (2), Example 3, describes mixing of a pesticide carbamate as presently claimed with sodium dihydrogen phosphate as a solid additive, this known "method of use" discloses no more than preparing an appropriate mixture. However, in the absence of any thermal stabilisation effect ascribed to such operation in the prior art document, Claim 1 of the subsidiary request is not open to objection under Article 54 EPC.

On the basis of a proper interpretation of Claim 1 of the subsidiary request in the context of the description of the application, the claimed subject-matter concerns a method including the step of mixing the organic pesticide compound with the inorganic compound to achieve the explicitly stated stabilisation effect; in other words, the first subsidiary request actually defines the use of a particular physical entity to achieve the said "effect", i.e. to perform the claimed function. Consequently, protection is sought not for the mixing operation *per se*, but for the observable technical effect resulting therefrom. From the aforementioned decision G 2/88 it follows indeed that said Claim 1 should not be interpreted literally, as only including by way of technical features a mixing

step and the pesticidal compositions; it should be interpreted as also including as an essential technical feature the function of achieving the retardation or inhibition of thermal decomposition of the pesticidal compound (see point 9, penultimate paragraph of the Reasons for the Decision). Since this functional feature of the claim was neither made available to the public by document (2) nor by any other of the documents cited during the proceedings, the claimed subject-matter according to the first subsidiary request is novel.

4. Since the only ground for refusal indicated in the contested decision was lack of novelty, and since this objection has been overcome by the claims according to the first subsidiary request, the decision under appeal must be set aside. However, a patent may not yet be granted because the examination in respect of the further requirements of the EPC, in particular that of inventive step, still has to be carried out in respect of the said set of claims. For this reason and in order not to deprive the Appellant of the possibility to have any subsequent findings revised by a second instance, the Board considers it appropriate to use its power 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 case is remitted to the Examining Division for further prosecution on the basis of Claims 1 to 5 according to the first subsidiary request received on 4 April 1990.

The Registrar:

The Chairman:

P. Martorana

P.A.M. Lançon