

Publication in the Official Journal ~~Yes~~ / No

File Number: T 792/90 - 3.3.1

Application No.: 86 903 132.8

Publication No.: 0 221 958

Title of invention: 3-Aminopropoxyphenyl derivatives their preparation and  
pharmaceutical compositions containing them

Classification: C07D 209/08

D E C I S I O N  
of 21 February 1991

Applicant: Louis, William John

Proprietor of the patent:

Opponent:

Headword: Aminopropoxyphenyl derivatives/Louis

EPC Article 84, Rule 29(6), Rule 67

Keyword: "Clarity of claim" - "Reference to Examples (no)"  
"Listing of chemical entities (yes)"

Headnote



Case Number : T 792/90 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 21 February 1991

**Appellant :** Louis, William John  
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**Representative :** Jones, H.M.M.  
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**Decision under appeal :** Decision of Examining Division 005 of the  
European Patent Office dated 11 June 1990  
refusing European patent application  
No. 86 903 132.8 pursuant to Article 97(1) EPC

**Composition of the Board :**

**Chairman :** K.J.A. Jahn  
**Members :** R.W. Andrews  
J-C. Saisset

## Summary of Facts and Submissions

- I. European patent application No. 86 903 132.8, which was filed under the Patent Cooperation on 13 May 1986, was refused by a decision of the Examining Division 005 of the European Patent Office dated 11 June 1990.
- II. The stated ground for the refusal was that original Claim 14, which referred to compounds of Formula I listed in Examples 1 to 39, was not allowable in view of the terms of Rule 29(6) EPC.
- III. A Notice of Appeal together with the Grounds therefor were filed on 13 August 1990. The prescribed fee was paid on 10 August 1990.

In these grounds the Appellant contended that, in view of Article 164(2) EPC, Rule 29(6) EPC is unequivocally subordinate to Article 84 EPC. Therefore, the Examining Division's decision was wrong since, if a claim is clear within the terms of Article 84 EPC, it cannot then be rejected on the basis that it does not meet the requirements of Rule 29(6) EPC.

The Appellant argued that the present case is distinguishable from that decided in T 150/82 since the process claims under consideration in this earlier appeal did not satisfy the requirements of Article 84 EPC as to clarity, whereas the present claim relates to clearly defined compounds per se and, therefore, meets the requirements of Article 84 EPC.

The Appellant also alleged that there were several substantial procedural violations which justify the refund of the appeal fee.

IV. The Appellant requests that the case be remitted to the Examining Division for further prosecution on the basis of the specification as it stood following the Appellant's responses dated 23 March, 26 March and 15 May 1990. Claim 13, in accordance with this request, reads as follows:

"Any one of the compounds of Formula I listed in Examples 1 to 39 herein".

Alternatively, as an auxiliary request, the Appellant requests that the above Claim 13 be replaced by Claim 13 filed with the grounds of appeal on 13 August 1990. Claim 13 in accordance with this request comprises a list of the compounds of Formula I disclosed in Examples 1 to 39. The compounds are defined by means of the definition of the symbols A, W, X, R, R<sup>1</sup>, R<sup>3</sup>, Y, Z and n in the said formula.

The Appellant also requests the refund of the appeal fee.

#### Reasons for the Decision

1. The appeal is admissible.
2. Article 164(2) EPC provides that, in the case of conflict between the provisions of the Convention and those of the Implementing Regulations, the provisions of the Convention shall prevail. However, it must be emphasised that for an Implementing Regulation to be subordinate to the Convention, there must be a conflict between that Regulation and the Convention.

- 2.1 The present Appeal is concerned with Article 84 and Rule 29(6) EPC. Article 84 specifies that the claims shall be clear and concise and be supported by the description. Rule 29 EPC implementing Article 84 EPC deals with the form and content of the claims. In particular, Rule 29(6) EPC requires that claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings.
- 2.2 In the Board's judgement, there is no conflict between the requirements of Article 84 EPC and the provisions of Rule 29(6) EPC and, in the absence of such conflict, the provisions of Rule 29(6) EPC, which is an integral part of the Convention (cf. Article 164(1) EPC), cannot be lawfully disregarded. Thus, the claims of a European patent must not only be clear but also comply with the requirements of Rule 29 EPC.
- 2.3 Claim 13 in accordance with the main request is clearly in a form which is contrary to the express provisions of Rule 29(6) EPC. Although in certain circumstances exceptions to this Rule are allowable, the Appellant has not shown that, in the application under appeal, it is absolutely necessary to rely on the reference to Examples 1 to 39. In fact, it is clear from the Appellant's auxiliary request that such a reference is unnecessary.

In view of the terms of Article 78(3) EPC, which requires that a European patent application must satisfy the conditions laid down in the Implementing Regulations, the Examining Division's decision to refuse the application under Article 97(1) EPC was correct.

Therefore, the Appellant's main request is refused.

2.4 The Appellant's argument that the present case is distinguishable from that decided in the Decision T 150/82 (cf. OJ EPC 1984, 309) cannot be followed. It is true that the Claims 17 to 21 of this European patent application were process claims, however, it is clear from points 3 and 4 of this decision (cf. page 313) that the Board rejected the above-mentioned claims solely on the ground that they did not comply with the express provisions of Rule 29(6) EPC.

3. Claim 13 in accordance with the Appellant's auxiliary request claims the 39 individual compounds disclosed in the examples.

3.1 In the Decision T 156/82 of 9 January 1984 (unpublished) it was considered permissible to claim thirteen alternative individual compounds in a dependent claim since, in the Board's judgement, such a claim complied with the requirements of Article 84 EPC.

Although the Board in that particular case considered the claim to be concise within the meaning of Article 84 EPC, it pointed out that an objection based on this requirement may be justified if, for example, a claim in this form results in a lack of comprehensibility.

3.2 In the Board's judgement, Claim 13 in accordance with the Appellant's auxiliary request fulfills the requirements of Article 84 EPC with respect to clarity and conciseness and is also readily comprehensible. However, the claim does not appear to be allowable since the definition of the symbol R<sup>3</sup> for the compound of Example 6 has been amended in a seemingly inadmissible manner. Nevertheless, this

deficiency can and should be rectified in the subsequent proceedings.

4. In accordance with Rule 67 EPC, reimbursement of an appeal fee shall be ordered when a Board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. However, this question only arises if the Board deems the appeal allowable. It is true that the decision of the Examining Division has to be set aside and the case remitted to the first instance for further prosecution on the basis of the Appellant's auxiliary request. Nevertheless, the Appellant fails with his main request which, in effect corresponds with the request underlying the decision under appeal. In these circumstances the Board cannot be considered to have rendered a decision in the Appellant's favour. Moreover, there was no substantial procedural violation within the meaning of Rule 69 EPC. Therefore, for these reasons the appeal fee cannot be reimbursed.

**Order**


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

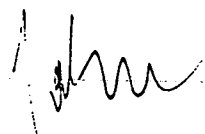
1. The decision under appeal is set aside.
2. The main request is rejected.
3. The case is remitted to the Examining Division for further prosecution on the basis of Claims 1 to 12 and 14 to 17 filed on 26 March 1990, wherein Claim 1 is amended as requested in the letter filed on 17 May 1990, and Claim 13 of the auxiliary request filed on 13 August 1990.

4. The request for reimbursement of the appeal fee is rejected.

The Registrar:

The Chairman:

  
E. Görgmaier

  
K.J.A. Jahn

*Handwritten notes:*  
LWS  
Jahn