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Boards of Appeal

Chambres de recours

Case Number: T 0859/94 - 3.3.6

**D E C I S I O N**  
of 10 January 2000 correcting errors in the decision  
of the Technical Board of Appeal 3.3.6  
of 21 September 1999

**Appellant:**  
(Proprietor of the patent)

Fuji Photo Film Co., Ltd.  
210 Nakanuma  
Minami-Ashigara-shi  
Kanagawa 250-01 (JP)

**Representative:**

Hansen, Bernd, Dr. Dipl.-Chem.  
Hoffmann Eitle  
Patent- und Rechtsanwälte  
Postfach 81 04 20  
81904 München (DE)

**Respondent:**  
(Opponent)

Konica Corporation  
No. 1 Sakura-machi  
Hino-shi  
Tokyo, 191 (JP)

**Representative:**

Türk, Gille, Hrabal  
Patentanwälte - European Patent Attorneys  
Brucknerstrasse 20  
40593 Düsseldorf (DE)

**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 22 August 1994  
revoking European patent No. 0 177 765 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Krasa  
**Members:** G. N. C. Raths  
M. Lewenton

In application of Rule 89 EPC the decision given in case  
T 859/94 on 21 September 1999 is hereby corrected as follows:

In the Order the words "decision under" are deleted.

The Registrar:

The Chairman:

  
G. Rauh

  
P. Krasa

**Internal distribution code:**

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

**D E C I S I O N**  
of 21 September 1999

**Case Number:** T 0859/94 - 3.3.6

**Application Number:** 85111246.6

**Publication Number:** 0177765

**IPC:** G03C 7/38

**Language of the proceedings:** EN

**Title of invention:**

Silver halide color photographic material

**Patentee:**

Fuji Photo Film Co., Ltd.

**Opponent:**

Konica Corporation

**Headword:**

Colour photographic material/FUJI

**Relevant legal provisions:**

EPC Art. 123(2)

**Keyword:**

"Amendment (not allowable) - generation of a new generic chemical formula - no basis in the application as filed"

**Decisions cited:**

T 0201/83, T 0615/95, G 0001/93

**Catchword:**

An amendment of a generic chemical formula is not admissible under Article 123(2) EPC if it leads - by deleting meanings of residues - to a particular combination of specific meanings of the respective residues, i.e. to a particular structural feature of the compounds concerned which was not disclosed originally and amounts to an inadmissible singling out of a sub-class of chemical compounds (points 2.4.3 and 2.5 of the Reasons for the Decision).



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to Article 102(1) EPC.

**Composition of the Board:**

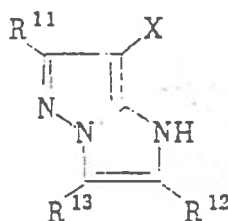
**Chairman:** P. Krasa  
**Members:** G. N. C. Raths  
M. Lewenton

### Summary of Facts and Submissions

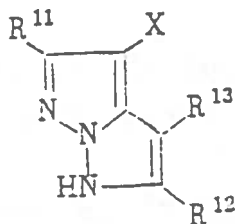
I. This appeal lies from the Opposition Division's decision revoking under Article 102(1) EPC the patent EP-A-0 177 765 (European patent application number 35 111 246.6) which had been opposed by the Respondent (Opponent) on the grounds of lack of novelty and inventive step.

The application as filed comprised 12 claims, whereof Claims 3, 5 and 10 are relevant for this decision:

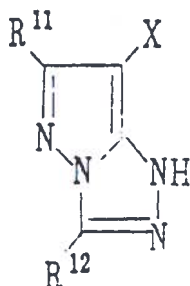
"3. A silver halide colour photographic material as in Claim 2, wherein said coupler is the coupler represented by the formula (III), (IV), (V), (VI) or (VII):



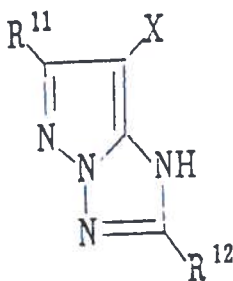
(III)



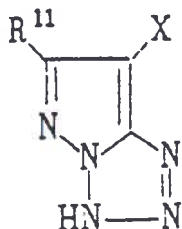
(IV)



(V)



(VI)



(VII)

wherein at least one of  $R^{11}$ ,  $R^{12}$  and  $R^{13}$  in the formulae (III) and (IV) is an alkyl group of  $-C(R^1R^2R^3)$ ;

at least one of  $R^{11}$  and  $R^{12}$  in the formulae (V) and (VI) is an alkyl group of  $-C(R^1R^2R^3)$ ;

$R^{13}$  in the formula (VII) is an alkyl group of  $-C(R^1R^2R^3)$ ;

$R^1$  is a straight chain or branched chain or cyclic alkyl group;

$R^2$  and  $R^3$  each is a hydrogen atom, a halogen atom, an alkyl group, an aryl group, a heterocyclic group, a cyano group, an alkoxy group, an aryloxy group, a heterocyclic oxy group, an acyloxy group, a carbamoyloxy group, a silyloxy group, a sulfonyloxy group, an acylamino group, an anilino group, a ureido group, an imido group, a sulfamoylamino group, a carbamoylamino group, an alkylthio group, an arylthio group, a heterocyclic thio group, an alkoxycarbonylamino group, an aryloxycarbonylamino group, a sulfonamido group, a carbamoyl group, an acyl group, a sulfamoyl group, a sulfonyl group, a sulfinyl group, an alkoxycarbonyl group, an aryloxycarbonyl group, a hydroxyl group, an amino group, or a carboxyl group;

when the substituents represented by  $R^{11}$ ,  $R^{12}$  and  $R^{13}$  in the formulae (III) and (IV) and the substituents represented by  $R^{11}$  and  $R^{12}$  in the formulae (V) and (VI) are substituents other than the alkyl group of  $-C(R^1R^2R^3)$  said substituents each is a hydrogen atom, a halogen atom, an alkyl group, an aryl group, a heterocyclic group, a cyano group, an alkoxy group, an aryloxy group, a heterocyclic oxy group, an acyloxy group, a carbamoyloxy group, a silyloxy group, a sulfonyloxy group, an acylamino group, an anilino group, a ureido group, an imido group, a sulfamoylamino group, a carbamoylamino group, an alkylthio group, an arylthio group, a heterocyclic thio group, an alkoxycarbonylamino group, an aryloxycarbonylamino group, a sulfonamido group, a carbamoyl group, an acyl group, a sulfamoyl group, a sulfonyl group, a sulfinyl group, an alkoxycarbonyl group, an aryloxycarbonyl group, a hydroxyl group, an amino group, or a carboxyl group;

X is a hydrogen atom, a halogen atom, a carboxy group, a group bonded via an oxygen atom, a group bonded via a nitrogen atom, an arylazo group, or a group bonded via a sulfur atom;

when  $R^{11}$ ,  $R^{12}$ ,  $R^{13}$  or X is a divalent group, the coupler of the formula (III), (IV), (V), (VI) or (VII) forms a di- or polymer; and

when  $R^{11}$ ,  $R^{12}$ ,  $R^{13}$  or X is a linking group, the coupler of the formula (III), (IV), (V), (VI) or (VII) constitutes a partial structure of a vinyl monomer, in which said partial structure and the vinyl group are bonded via said linking group."

Claims 5 and 10 were directed to a silver halide colour photographic material comprising a coupler represented by the formulae (VI) and (V), respectively.

II. In its decision the Opposition Division held in essence that

- the subject-matter of Claim 1 of the then pending main request was not new and that
- the respective Claim 1 of all four then pending auxiliary requests contravened Article 123(2) EPC.

III. An appeal was lodged against this decision by the Appellant (Patent Proprietor).

During the appeal procedure, the Appellant submitted various sets of claims; eventually, with the letter of 20 August 1999, the Appellant filed a main request and three auxiliary requests replacing all requests previously on file. Further amendments were filed with respect to the main request and the second auxiliary request with the letter dated 1 September 1999.



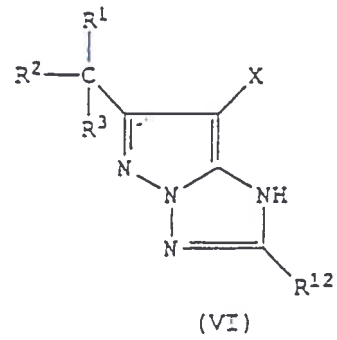
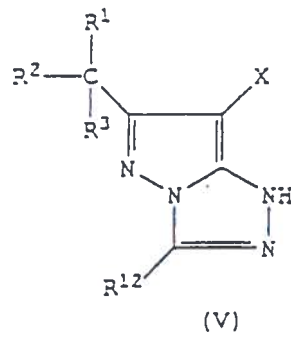
In the course of the appeal procedure, a number of issues were raised by the Respondent and discussed in detail by the parties in their various submissions, inter alia, whether or not the claims according to the main and the auxiliary requests complied with the requirements of Article 123(2)EPC.

IV. Oral proceedings took place on 21 September 1999.

The Appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of a main request submitted during the oral proceedings, or alternatively on the basis of auxiliary requests 1 to 3 submitted by letter of 20 August 1999 as amended by letter of 1 September 1999 and by pages 7, 10 and 14, all submitted during the oral proceedings. The new main request was submitted in response to an indication by the Board that Claim 1 in the main request of 10 August 1999 contained a disclaimer, the admissibility of which was questionable.

Claim 1 of this new main request is quoted as far as necessary in the context of this decision:

"1. A silver halide colour photographic material comprising a support having coated thereon at least one silver halide emulsion layer, in which said silver halide emulsion layer or a layer adjacent thereto contains a magenta image providing pyrazolo-azole magenta coupler being substantially insoluble in a developing solution, characterized in that said coupler is a coupler represented by the formulae (V) or (VI):



wherein R<sup>1</sup> is a straight chain or branched chain or cyclic alkyl group, R<sup>2</sup> and R<sup>3</sup> are each an alkyl group;

R<sup>12</sup> is a hydrogen atom, a halogen atom, an alkyl group, an aryl group, a heterocyclic group, a cyano group, an alkoxy group, an aryloxy group, an acyloxy group, a carbamoyloxy group, a silyloxy group, a sulfonyloxy group, an acylamino group, an anilino group, a ureido group, an imido group, a sulfamoylamino group, a carbamoylamino group, an alkylthio group, an arylthio group, an alkoxycarbonylamino group, an aryloxycarbonylamino group, a sulfonamido group, a carbamoyl group, an acyl group, a sulfamoyl group, a sulfonyl group, a sulfinyl group, an alkoxycarbonyl group, an aryloxycarbonyl group, a hydroxyl group, an amino group or a carboxyl group;

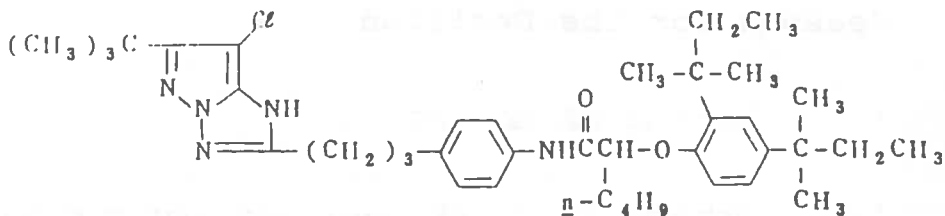
in formula (V) X is a halogen atom and in formula (VI) X is a halogen atom, a group bonded via an oxygen atom or a group bonded via a sulfur atom,

with the proviso that..."

Claim 1 further contained various disclaimers.

The Appellant submitted in essence that, whereas the formulae V and VI of this new Claim 1 and the respective definitions for the symbols R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>12</sup> and X were not explicitly given in the application as filed, this new Claim 1 nevertheless complied with the requirements of Article 123(2) EPC since they were implicitly disclosed in the application as filed. He argued in particular that a skilled person would have understood from the disclosure of compound M-17

( M - 17 )



in used in Examples 1 to 3 of the application as filed and from his common general knowledge that the subject-matter of the new Claim 1 had been disclosed implicitly in the application as filed.

All auxiliary requests 1 to 3 differ from the main request essentially in that their claims are restricted to compounds of formula VI.

In Claim 1 of the auxiliary request 1 the group - C(R<sup>1</sup>R<sup>2</sup>R<sup>3</sup>) has the same meaning as in the main request, i.e. it designates a tertiary alkyl group. In auxiliary requests 2 and 3, R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> are each a methyl group. The further amendments in the auxiliary requests are of no relevance for the present decision.

The Respondent contested the admissibility of the claims of the Appellant's main and auxiliary requests and submitted in particular that the alleged common general knowledge did not exist.

He requested that the appeal be dismissed.

At the end of the proceedings the Board's decision was announced.

### **Reasons for the Decision**

#### 1. *Article 123(2) EPC*

- 1.1 Article 123(2) EPC requires that a European patent (application) may not be amended in such a way that it contains subject-matter extending beyond the content of the application as filed.

The idea underlying this provision is that an Applicant should not be allowed to improve his position during the examination procedure by adding subject-matter not disclosed in the application as filed thus giving him an unwarranted advantage and possibly being detrimental to the legal security of third parties relying on the contents of the application as filed (see G 1/93, OJ 1994, 541, No. 9 of the reasons of the decision). This idea holds of course also in respect to a patent proprietor and the opposition procedure.

- 1.2 The same principle governs also a situation where the amendment results in a limitation of the scope of the claims, be it by the addition of a technical feature, be it by the deletion of originally disclosed meanings from the definitions of symbols of a generic chemical formula standing for a class of chemical compounds.

- 1.3 The Appellant conceded that formulae (V) and (VI) as shown above under point VI were not disclosed explicitly in the application as filed.

Therefore the question to be answered is whether these formulae were implicitly disclosed.

2. *Main request*

- 2.1 Claim 1 of the main request differs in essence from Claim 3 as originally filed in that

- the claim was restricted to formulae (V) and (VI) of original Claim 3 in which formulae however the substituent  $R^{11}$  in the 6-position of both formulae was replaced by  $-C(R^1R^2R^3)$ ;
- $R^2$  and  $R^3$  were restricted to an alkyl group, i.e. all the numerous other meanings given for these two symbols in original Claim 3 had been deleted ;
- the meanings "a heterocyclic oxy group" and "a heterocyclic thio group" had been deleted from the list of meanings for  $R^{12}$ ;
- X in formula (V) was restricted to a halogen atom; in formula (VI) the following meanings "a hydrogen atom, a carboxy group, a group bonded via a nitrogen atom and an arylazo group" were deleted from the original list.

The further differences are of no relevance for the present decision.

2.2 The Board accepts that the **mere** restriction of Claim 1 to only two types of compounds (namely those of formulae V and VI) selected from the five types enumerated in original Claim 3 would not be objectionable since these two alternatives had been clearly disclosed in the application as filed. However, the further amendments result in two sub-classes of the original type of chemical compounds of formulae V and VI which both, **by necessity**, must now have a **tertiary alkyl group as a substituent in the 6-position** of the bicyclic heterocycles.

Apart from the other amendments, it is essentially this **mandatory structural feature** which distinguishes the two classes of compounds now being the subject-matter of Claim 1 from the respective ones of original Claim 3.

It is to be noted that nowhere in the generic part of the application as filed, a tertiary alkyl group was explicitly designated as a **preferred** substituent of the heterocyclic system, let alone, that this substituent has to be in position 6.

2.3 The Appellant submitted that the Examples 1 to 3 of the application as filed demonstrate the superiority in respect to gradation and maximum density of a compound M-17 having a tertiary butyl group in the 6-position of a type VI heterocyclus over both a compound M-16 and a comparative compound which otherwise were both identical with M-17 but contained an isopropyl group or a methyl group, respectively, in the 6-position. He argued that a skilled person, in view of the existing common general knowledge would have concluded therefrom, that tertiary alkyl groups were the preferred substituents in the 6-position and that, therefore, the restriction of the meaning of R<sup>11</sup> to

(R<sup>1</sup>R<sup>2</sup>R<sup>3</sup>)C- with all R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> being alkyl was admissible. He maintained in particular that the skilled person would have understood that the residue in the 6-position (i.e. R<sup>11</sup> or (R<sup>1</sup>R<sup>2</sup>R<sup>3</sup>)C-, respectively) was of interest since according to his common general knowledge he would have known that the residue R<sup>12</sup> acts as a ballast group rendering the couplers non-diffusible and has to be bulky, and that the X-group in the coupling position is a leaving group (application as filed, page 48, lines 3 to 7). Therefore, the actual meaning (or structure) of X and of R<sup>12</sup> would be irrelevant; the decisive information to be gained from the examples for generalization purposes thus would be the tertiary alkyl group. In support of his argument, the Appellant also referred to T 201/83, OJ EPO 1984, 481.

2.4 The Board cannot accept these arguments.

2.4.1 Whereas it is agreed that there exists common general knowledge regarding the general functions of the residues designated by R<sup>11</sup>, R<sup>12</sup> and X, the present case is not concerned with the general principles of a coupler in a colour photographic material but, as confirmed by the Appellant during oral proceedings, with very specific properties and their dependence from specific structural features. Thus, common general knowledge would have been required to allow the suggested generalization of the disclosure of Examples 1 to 3 as filed to cover all 6-tertiary-butyl compounds of type V and of type VI, and, further to conclude that all 6-tertiary-alkyl compounds of formulae V and VI display superior maximum densities and gradation than the respective 6-primary-alkyl and 6-secondary-alkyl compounds. No evidence for such common general knowledge, the existence of which was contested by the Respondent, was provided by the

Appellant. Therefore, the Appellant's argument that the added mandatory structural feature was implicitly disclosed by original Examples 1 to 3 in combination with a skilled person's common general knowledge is not conclusive.

2.4.2 In support of his case, the Appellant referred to decision T 201/83. In that decision the amendment related to the change of the lower limit of a numerical parameter range and it had to be decided whether a particular value taken from an example could serve as an end-point of a particular parameter sub-range, i.e. of the calcium contents of an alloy (T 201/83, Reason for the decision, point 8). This amendment was allowed in view of available information in the specification as filed, in particular, a number of examples demonstrating that the amendment had no influence on the properties of the alloys. Contrary to that, the present case relates to classes of chemical compounds defined by chemical formulae which should be restricted on the basis of three examples demonstrating that the restriction, i.e. the selection of the 6-tertiary-alkyl sub-classes of the compounds of formulae V and VI has a bearing on the properties of the couplers (see above point 2.4.1). Therefore, the decision T 201/81 is not pertinent to the present case.

2.4.3 The Appellant also argued that the deletion of meanings from lists defining substituents of a generic formula to distinguish claimed subject-matter from the state of the art was normal practice in examining procedures in the EPO. This statement is not correct in such generality. To which degree deletions from lists of meanings for various substituents are admissible depends on the circumstances of the specific case. The guiding principle is that such deletions may not lead to a particular combination of specific meanings of the



respective residues, i.e. to a particular structural feature of the compounds concerned (here: R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> all being alkyl and the mandatory 6-position for the resulting tertiary alkyl group) **which was not disclosed originally** (see T 615/95, point 6 of the Reasons of the decision; not published in the OJ EPO). In the present case, the Appellant's "deletions" amounted - as demonstrated above - to an inadmissible singling out of the specific sub-classes of 6-tertiary-alkyl-pyrazolo-triazoles of formulae V and VI encompassed by but not disclosed as such in the application as filed.

- 2.5 In view of the above considerations, the Board concludes that the amendments made by the Appellant on the formulae (V) and (VI) as originally filed generated another invention not disclosed in and not derivable from the original application.

Therefore the amendments made are not admissible under Article 123(2) EPC.

3. *Auxiliary request 1*

Claim 1 of auxiliary request 1 contains the same technical feature as Claim 1 of the main request, i.e. a mandatory tertiary alkyl group in position 6 of the heterocyclic system in formula VI. Auxiliary request 1, thus, suffers from the same deficiency as the latter and is, therefore, not admissible under Article 123(2) EPC.

4. *Auxiliary requests 2 and 3*

In the respective Claim 1 of auxiliary requests 2 and 3, the meanings of all three residues R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> of the group (R<sup>1</sup>R<sup>2</sup>R<sup>3</sup>)C- in position 6 of the heterocyclic system of formula VI have been further restricted to

methyl only, thereby resulting in the mandatory presence of a **tertiary butyl group** in said 6-position. Therefore, this particular combination of meanings of  $R^1$ ,  $R^2$  and  $R^3$  not disclosed originally in combination with the meanings of  $R^{12}$  and X, amounts to a singling out of the sub-class of 6-tertiary-butyl-pyrazolo-triazoles of formula VI which was not disclosed in the generic part of the application as filed. Examples 1 to 3 disclose a particular 6-tertiary-butyl compound (M-17) which, however, cannot serve as a basis for the generalization aimed at (see above point 2.4.1). It follows that the amendments of the respective Claim 1 are not admissible under Article 123(2) EPC.

## Order

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

The decision under appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

P. Krasa