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**D E C I S I O N**  
of 9 March 2001

**Case Number:** T 0925/96 - 3.3.1

**Application Number:** 93301325.2

**Publication Number:** 0559363

**IPC:** C07D 401/04

**Language of the proceedings:** EN

**Title of invention:**  
3-Phenyl-5-pyridyl triazoles and their use as insecticides

**Applicant:**  
KUMIAI CHEMICAL INDUSTRY Co., LTD., et al

**Opponent:**  
-

**Headword:**  
Triazoles/KUMIAI

**Relevant legal provisions:**  
EPC Art. 54, 111(1)

**Keyword:**  
"Novelty (yes) - selected combination of substituents not clearly and unambiguously disclosed in the prior art"  
"Remittal to the first instance for further prosecution"

**Decisions cited:**  
T 0012/81, T 0007/86, T 0012/90, T 1154/97, T 1129/97

**Catchword:**  
-



Case Number: T 0925/96 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 9 March 2001

**Appellant:** KUMIAI CHEMICAL INDUSTRY CO., LTD.  
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Taitoh-ku  
Tokyo (JP)

**Representative:** Ede, Eric  
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**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office posted 24 June 1996  
refusing European patent application  
No. 93 301 325.2 pursuant to Article 97(1) EPC.

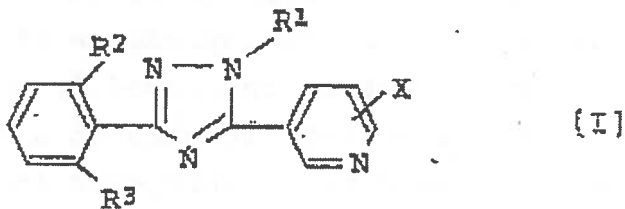
**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** J. M. Jonk  
J. P. B Seitz

### Summary of Facts and Submissions

- I. This appeal lies from the decision of the Examining Division refusing European patent application No. 93 301 325.2, published under No. 0 559 363, and relating to 3-Phenyl-5-pyridyl triazoles and their use as insecticides.
- II. The decision was based on Claims 1 to 7 as originally filed, Claim 1 reading as follows:

"A triazole derivative having the following general formula [I]:



(wherein R<sup>1</sup> is a lower alkyl group, R<sup>2</sup> and R<sup>3</sup> are same or different halogen atoms and X is a chlorine atom located at 2- or 6-position)."

- III. The Examining division held that the subject-matter of the claims lacked novelty in view of document (C) Research Disclosure, June 1987, pages 356 and 357.

In this context, it held in particular that there was an overlap between the compounds of said document (C) and those of the application in suit, and that this overlap was novelty destroying in view of the earlier decision T 12/90.

Moreover, it held that the patent application in suit did not meet the requirements of Article 84 EPC, because of lack of clarity of the expressions "and/or the like" (found throughout the description) and "are not intended as limitations thereof" (found on page 12).

- IV. The Appellant argued that the subject-matter of the claims was novel, since document (C) did not disclose any compound falling under the scope of Claim 1, and because, in accordance with the jurisprudence of the Boards of Appeal, it could not be concluded from the mere presence of reactants or substituents in a list together with other reactants or substituents in another list that each potential compound would thereby be disclosed in the form of a concrete reproducible teaching. Moreover, he submitted that the compounds of Claim 1 of the present application compared to those of document (C) showed improved properties as an insecticide. In support to this submission, he filed a test-report on 23 October 1996.

Furthermore, he filed amended pages 3, 5, 7, 8, 10, 11, 12, and 15 to 18 in order to remove the unclear expressions objected to by the Examining Division under Article 84 EPC.

V. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of Claims 1 to 7 as originally filed as main request, or on the basis of one of three sets of claims filed on 23 October 1996 as the first, second and third auxiliary request, respectively.

He also requested with letter dated 17 November 2000 to remit the case to the first instance for further prosecution on the basis of the present main request.

Furthermore, he requested oral proceedings if none of these requests would be allowable.

### Reasons for the Decision

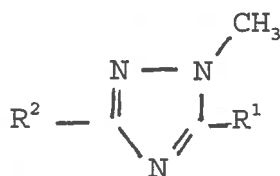
1. The appeal is admissible.

2. *Main request*

2.1 In view of the fact that the Appellant removed the objections put forward by the Examining Division under Article 84 EPC, the substantive issue to be dealt with is whether the subject-matter of the originally filed Claims 1 to 7 is novel in view of document (C).

3. *Novelty*

3.1 Document (C) discloses 1,2,4-triazole compounds, which are especially useful to control mites and sucking insects, having the formula I:



wherein R<sup>1</sup> is mono-, di- or trisubstituted phenyl or 3-pyridyl with at least one substituent in ortho position, wherein the substituents may be fluorine, chlorine, bromine, iodine, methyl, halogenomethyl, methoxy, cyano or trifluoromethylthio, and

R<sup>2</sup> is 2-fluorophenyl, 2-chlorophenyl, 2-bromophenyl, 2-iodophenyl, 2-tolyl, 2-cyanophenyl, 2-methoxyphenyl, 2,4-difluorophenyl, 2,4-dichlorophenyl, 2-chloro-4-fluorophenyl, 2-fluoro-4-chlorophenyl, 2,6-difluorophenyl, 2,6-dichlorophenyl, 2-chloro-6-fluorophenyl, 2,4,6-trifluorophenyl, 2-chloro-4,6-difluorophenyl,

and the salts thereof (emphasis added).

Furthermore, it discloses 52 examples of 1,2,4-triazole compounds, none of them falling within the scope of Claim 1 of the present patent application.

- 3.2 On the other hand, Claim 1 of the present patent application relates - as indicated above - to a group of 1,2,4-triazole compounds which are characterised by 2,6-dihalogenophenyl substituents and monosubstituted ortho-chloro-3-pyridyl rests.
- 3.3 Therefore, there exists a relatively small generic overlap between the group of compounds as claimed in Claim 1 of the present patent application and the group of 1,2,4-triazole compounds of formula I as defined in document (C), whereby the area of overlap results from specifically selecting from a first broad generic group of substituted phenyl or 3-pyridyl rests as defined under R<sup>1</sup> in formula I of document (C) (i) a 3-pyridyl rest, (ii) having only one substituent (iii), being a

chlorine atom and (iv) being located at the 2- or 6-position, and from selecting from a second group of substituents listed under R<sup>2</sup> of formula I of said document particularly substituted phenyl groups.

- 3.4 Concerning the question of assessing novelty under the EPC, the Board firstly observes that it is a generally applied principle that for concluding lack of novelty, there must be a direct and unambiguous teaching in a prior art document, which would inevitably lead the skilled person to something falling within the scope of what is claimed. This generally applied principle has also been incorporated in the Guidelines for examination in the EPO (see Part C, Chapter IV, under point 7, in particular points 7.2 and 7.5).

In this context, the Boards of Appeal developed with respect to novelty of compounds or compositions a further principle, namely, that a substance resulting from a **specific combination of elements** requiring the selection of elements (e.g. starting compounds or substituents) from at least two lists or generic groups should normally be regarded as novel (see e.g. T 12/81, point 13 of the reasons, OJ EPO 1982, 296, and T 7/86, point 5.1 of the reasons, OJ EPO 1988, 381).

Moreover, this further principle has also been considered by the Boards of Appeal to be applicable in cases of **generic overlap of families of compounds**. However, in such cases the assessment of novelty depends on the factual issues of the particular case (see e.g. T 12/90 dated 23 August 1990, and T 1154/97 dated 17 November 2000).

- 3.5 In the present case, the overlapping matter involves - as indicated under point 3.3 above - multiple selections from two lists of variables. Moreover, in

the Board's judgment, document (C) does not comprise any pointer leading the skilled person directly and unambiguously to select compounds having the specific combination of substituents characterising the compounds of Claim 1 of the application in suit. Therefore, the Board concludes, in accordance with the established jurisprudence of the Boards of Appeal, that the claimed group of compounds has not been made available to the public in the sense of Article 54(2) EPC.

3.6 It is true, that in this context the Examining Division in support of its novelty objection referred to the decision T 12/90. However, this decision concerns a case, in which the originally claimed group of compounds lacked novelty in view of two explicitly disclosed examples falling in the area of overlap, and a newly defined area of overlap excluding said two examples could not be considered novel yet (see points II and V of the Facts and Submissions and point 2.5 of the Reasons for the Decision). On the other hand, the present patent application concerns a case, in which - as indicated above - the prior art document (C) did not disclose any compound falling under the scope of present Claim 1, in spite of the fact that said document (C) explicitly disclosed 52 examples of triazole compounds of formula I. Therefore, in the Board's judgment, this decision is based on quite different facts, and consequently not applicable to the present case.

3.7 Furthermore, the Examining Division held, that the claimed subject-matter lacked novelty in view of the existing generic overlap and the fact that three examples in document (C) related to compounds containing an ortho-chloro-3-pyridyl substituent and that a number of other examples in said document



related to compounds having a 2,6-difluorophenyl, 2,6-dichlorophenyl or a 2-chloro-6-fluorophenyl substituent, which showed that these possibilities were clearly envisaged in document (C).

However, said examples merely relate to **individualised compounds falling outside the existing area of overlap**. Therefore, the Board also cannot accept this novelty objection, since the skilled person would not immediately and unambiguously derive a group of compounds having the specifically claimed combination of substituents, neither from said examples, nor from the teaching of document (C) as a whole.

- 3.9 Thus, in view of the above considerations, the Board concludes that the subject-matter of Claim 1 must be considered novel with respect to the cited document (C).

Furthermore, the subject-matter of the dependent Claims 2 and 3 relating to preferred embodiments, the subject-matter of Claim 4 concerning an insecticide containing a compound as claimed in present Claim 1, and the process Claims 5 to 7 must be considered novel for the same reasons.

4. *Auxiliary requests*

- 4.1 In the light of the above findings, it is not necessary to consider the Appellant's auxiliary requests.

5. *Remittal*

- 5.1 Although the Board has come to the conclusion that the subject-matter of the claims of the present main request is novel and therefore meets the requirement of Article 54(1) and (2) EPC, the present application

still needs further examination in order to establish whether the claimed subject-matter fulfils the other requirements of the EPC. In this context, the Board observes that it should be examined whether the definition of the substituent R<sup>1</sup> as a "lower alkyl group" complies with Article 84 EPC. The fact that said definition did not represent an obstacle in assessing novelty should not be understood in the sense that it necessarily has a generally accepted meaning in the art (see T 1129/97 of 26 October 2000 to be published in the OJ EPO).

- 5.2 However, having regard to the facts that the function of the Boards of Appeal is primarily to give a judicial decision upon the correctness of the decision of the first instance, and that the Examining Division did not decide on the requirement of inventive step, the Board makes use of its competence under Article 111(1) EPC to remit the case to the Examining Division for further prosecution on the basis of the claims of the present main request. This will not preclude the Appellant to further amend these claims as may become necessary.

**Order**

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

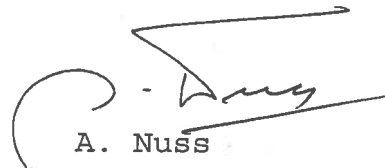
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the Claims 1 to 7 as originally filed.

The Registrar:



N. Maslin

The Chairman:



A. Nuss

