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**D E C I S I O N**  
**of 24 November 2000**

**Case Number:** T 0674/97 - 3.3.2

**Application Number:** 92902973.4

**Publication Number:** 0562015

**IPC:** A01N 43/90

**Language of the proceedings:** EN

**Title of invention:**

Safened Herbicidal Sulfonamide Compositions

**Applicant:**

MONSANTO COMPANY

**Opponent:**

-

**Headword:**

Herbicidal sulfonamide/MONSANTO

**Relevant legal provisions:**

EPC Art. 123(2), 113(1), 111(1)

EPC R. 67, 68

**Keyword:**

"Requirements of Article 123(2) - yes - after amendments"

"Reimbursement of appeal fee - no"

"Violation of Appellant's right to be heard - no"

"Substantial procedural violation - no"

**Decisions cited:**

T 0680/93, T 0007/86

**Catchword:**

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Case Number: T 0674/97 - 3.3.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 24 November 2000

**Appellant:**

MONSANTO COMPANY  
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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 15 January 1997  
refusing European patent application  
No. 92 902 973.4 pursuant to Article 97(1) EPC.

**Composition of the Board:**

**Chairman:** P. A. M. Lançon  
**Members:** U. Oswald  
M. B. Günzel

## Summary of Facts and Submissions

- I. European patent application No. 92902973.4 was filed by the Appellant as an international application and published under the international publication number WO92/10098.
  
- II. During the PCT Chapter II phase in response to a written opinion of the International Preliminary Examining Authority the Appellant filed on 6 November 1992 an amended set of claims.

In the regional phase before the EPO the Appellant proceeded with the claims in relation to which the final international preliminary examination report had been drawn up.

The Examining Division issued on 30 January 1995 a first communication referring to the deficiencies mentioned in the international preliminary examination report. These were lack of novelty and lack of inventive step. The Appellant was additionally requested to indicate the basis in the application as filed for the amendments made.

In response the Appellant filed, on 1 April 1995 amendments to the claims. As regards the support for the new claims the Appellant referred to pages 49 to 51 of the description.

In a second communication dated 14 August 1995, the Examining Division raised objections regarding the amendments to the claims filed on 1 April 1995. The communication inter alia contained the following paragraphs:

"The list of compounds cited on pages 49-51 of the description refers to the compounds used in the compound mixtures for which data are reported in the tables of the experimental part of the application. Hence, they may only be considered together with the combinations of compounds which are disclosed in these experiments. The extension of these combinations to any possible combination of compounds following from the explanatory lists on pages 49-51 adds novel combinations of compounds to the original combinations of compounds as exemplified in the description.

Hence, these amendments introduce subject-matter which extends beyond the content of the application as filed contrary to Article 123(2) EPC."

On 18 October 1995 the Applicant filed again an amended version of the claims.

Claim 1 of these claims reads as follows:

(numbering of the compounds in accordance with pp. 49-51 of the description of the application as originally filed and also in accordance with the decision of the Examining Division).

"1. Composition comprising

(a) a herbicidally effective amount of a sulfonamide compound selected from

1. 5,5-Dimethyl-N-(2,6-dichloro-3-methylphenyl)-1,2,4-triazolo[1,5a]pyrimidine-2-sulfonamide,
2. 5-Methyl-N-(2,6-difluorophenyl)-1,2,4-triazolo-[1,5-a]-pyrimidine-2sulfonamide,

3. 5,7-Dimethyl-N-(2-nitrophenyl)-1,2,4-triazolo-[1,5-a]-pyrimidine-2-sulfonamide,
4. ~~5,7-Dimethyl-N-[2-methoxy-6-(trifluoromethyl)phenyl]-1,2,4-triazolo[1,5-a]-pyrimidine-2-sulfonamide,~~
5. 5-Methyl-7-ethoxy-N-(2,6-dichloro-3-methylphenyl)-1,2,4-triazolo-[1,5-a]-pyrimidine-2-sulfonamide,
6. N-(2,6-Difluorophenyl)-3-chloro-4,6-dimethylimidazolo-[1,2-a]pyrimidine-2-sulfonamide,
7. N-(5,7-Dimethyl-1,2,4-triazolo-[1,5-a]-pyrimidine-2-yl)-2,6-dichlorophenyl sulfonamide,
8. ~~5-Fluoromethyl-7-methoxy-N-(2,6-dichlorophenyl)-1,2,4-triazolo-[1,5-a]-pyrimidine-2-sulfonamide,~~ and
9. 5-Methoxy-7-fluoro-N-(2,6-difluorophenyl)-1,2,4-triazolo-[1,5-c]pyrimidine-2-sulfonamide; and

(b) an antidotally effective amount of a compound selected from

1. 4-Pentenenitrile, 2-methyl-2-[(4-methylphenyl)thio],
2. Acetic acid, (diphenylmethoxy)-, methyl ester,

3. Benzenemethanamine, N-[4-(dichloromethylene)-1,3-dithiolan-2ylidene]- $\alpha$ -methyl-, hydrochloride,
4. Phosphorothioic acid, 0,0-diethyl-0-(3-methylphenyl) ester,
5. 5-Thiazolecarboxylic acid, 2-chloro-4-(trifluoromethyl)-, (phenylmethyl ester)
6. Pyrimidine, 4,6-dichloro-2-phenyl-,
7. ~~1H, 3H Naphtho[1,8-cd]pyran 1,3-dione,~~
8. Benzeneacetonitrile,  $\alpha$ -{[(1,3-dioxolan-2-yl)methoxy]imino}-,
9. Acetamide, N,N-Bis(2-propenyl)- $\alpha,\alpha$ -dichloro (also N,N-diallyldichloroacetamide),
10. Oxazolidine, 3-(dichloroacetyl)-5-(2-furanyl)-2,2-dimethyl-,
11. Cis/Trans-piperazine, 1,4-bis(dichloroacetyl)-2,5-dimethyl,
12. 1-Oxa-4-azaspiro[4.5]decane, 4-(dichloroacetyl)- (also 4-dichloroacetyl-1-oxa-4-azaspiro-(4,5) decane),
13. Oxazolidine, 3-(dichloroacetyl)-2,2,5-trimethyl,
14. Oxazolidine, 3-(dichloroacetyl)-2,2-dimethyl-5-phenyl,

15. Acetamide, 2,2-dichloro-N-(1,3-dioxolan-2-yl-methyl)-N-2-propenyl,
16. Ethanone, 2,2-dichloro-1-(1,2,3,4-tetrahydro-1-methyl-2-isoquinolinyl),
17. 1,3-Dioxolane, 2-(dichloromethyl)-2-methyl-,
18. 5-Chloro-8-(cyanomethoxy)quinoline,
19. 1-Methylhexyl-2-(5-chloro-8-quinolinoxy)acetate,
20. 0-(Methoxycarbonyl)-2-(8-quinolinoxy)acetamide oxime, and
21. 4-(Dichloroacetyl)-2,3-dihydro-3-methyl-2H-2,4-benzoxazine."

Regarding support for the new claims the Appellant, stated:

"all remaining compounds are supported by the original description and claims as follows:"

The subsequent paragraphs of the Appellant's submission showed two lists of references to pages and lines. At the end of each list it is stated "and corresponding passages in the description".

III. By a decision dated 15 January 1997 the application was refused under Article 97(1) EPC for failure to meet the requirements of Article 123(2) EPC.

More particularly, the Examining Division held that the

Applicant merely deleted subject-matter from the claims forming the basis for the Examining Division's last communication and therefore the last-filed set of claims contained the same deficiencies regarding Article 123(2) EPC as it did before.

The formulas of herbicides 2, 3 and 9 in amended claims 1 and 6 did not correspond to the formulas of said herbicides as set out in the description as originally filed.

In the Examining Division's view there was also no support for the remaining herbicides in combination with the claimed list of antidotes, namely herbicides 5, 6 and 7. Each of these herbicides was only originally disclosed in combination with specific antidotes and not with the full list of the claimed antidotes.

Arguing that the Applicant had submitted amendments on several occasions during the examination procedure, the Examining Division further held that the Applicant had exhausted its right to provide further amendments.

- IV. The Appellant filed an appeal against this decision. He took the view that the refusal of the application constituted a quasi-abuse of the entitlement to a patent securement process in accordance with, at least, applicable legal stipulations. The decision was unsubstantiated and taken prematurely. Moreover, since the application was reviewed during the PCT Chapter II procedure and at least three times during the European phase and since it appeared that no further amendments were required, there was no reason to state in the decision that the Applicant had exhausted its right to



provide further amendments.

The Appellant, by referring to particular passages in the application text, took the view that each of the herbicide/antidote pairs objected to by the Examining Division could be clearly and unambiguously derived from the application documents as originally filed.

V. Claim 1 of the main request, filed with a letter dated 2 May 2000, on which the present decision is based, differs from claim 1 forming the basis for the decision under appeal only in that antidote formula 21 in claims 1 and 6 has been corrected to read "4-(Dichloroacetyl)-2,3-dihydro-3-methyl-2H-1,4-benzoxazine". The correction has been based by the Appellant on page 50, lines 12/13, of the application as originally filed.

VI. The Appellant requested that the decision under appeal be set aside and that the patent be granted on the basis of the claims of the main request or auxiliary request both filed with the letter dated 2 May 2000 or that the application be remitted to the Examining Division.

The Appellant also requested the reimbursement of the appeal fee.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The Board can agree to the Appellant's submission that claim 1 of the main request relates to a composition

comprising:

(a) a herbicidally effective amount of a sulfonamide compound selected from herbicides 2, 3, 5, 6, 7 and 9, each disclosed under the same reference number in the description as filed on page 50, line 19 to page 51, line 10 and

(b) an antidotally effective amount of a compound selected from the antidotes 1 to 6 and 8 to 21, each disclosed under the same reference number in the description as filed on page 49, line 2 to page 50, line 14.

Taking into account that

- (i) claim 1 of the application as originally filed relates to a composition according to which the herbicides of a general formula I are combined with antidotes of a general formula II or antidotes taken from a long list of individually named compounds, and
- (ii) claim 1 of the main request contains a list of six herbicide compounds falling under the said general formula I and contains a list of twenty antidote compounds falling under said general formula II or being mentioned in the long list of antidotes,

even in the light of the fact that the number of possible combinations is lower than in original claim 1, it is clear that the amendments to claim 1 of the main request do not amount to a selection of individual combinations (see T 7/86, OJ 1988, 381 ff,

particularly point 5.1 of the reasons).

3. Contrary to the situation regarding claim 1, claim 2 of the main request relates to individual pairs of combinations of herbicide 2 with each of the twenty antidotes listed.

Since claim 2 of the main request, corresponds to claim 38 as originally filed, which depends on claims 30 to 36 or 37 originally filed, and since original claims 30 to 36 or 37 mention explicitly each individual antidote of present claim 1, the twenty individual pairs of herbicide 2 with each of the antidotes can be regarded as disclosed in the application as filed.

4. The addition of a co-herbicide according to claim 3 of the main request was disclosed in original claim 41. The combination of present claim 3 with present claim 2 corresponds to claim 49 as originally filed.

5. The co-herbicides of claim 4 of the main request were disclosed in original claims 46 and 48, with the exception of isoproturon and primisulfuron, which are disclosed in the description as filed on page 51 as co-herbicides E and F. The specific combination of herbicide 2 with the co-herbicides acetochlor, metolachlor, butylate, EPCT, alachlor and butachlor can be derived from a combination of original claim 49 with claims 46 and 48.

As far as the combinations of herbicide 2 with co-herbicide E and with co-herbicides F by dependence of claim 4 on claim 2 are concerned, claim 4 results in a generalisation of examples 12 and 16 of the application

as filed.

Examples 12 and 16 disclose the combination of the above herbicide and co-herbicides only in the presence of specific antidotes, namely antidotes 3 and 18 (example 12) and 9, 10 and 13 (example 16).

However, according to claim 41 as originally filed, any type of herbicide, co-herbicide or antidote, provided they fall under the definitions given in that claim, can be combined in the compositions. Therefore, the skilled person is clearly taught that any of the antidotes of claim 1 as filed can be combined with the combination of herbicide 2 with co-herbicides E or F (see decision T 680/93 of 29 November 1994, not published in OJ EPO, point 2 of the reasons).

Consequently claim 4 does not extend the content of the application as filed.

6. Claim 5 of the main request is supported by the originally filed claim 46.

The disclosure of the specific combinations of herbicide 2 with the co-herbicides acetochlor, metolachlor, alachlor and butachlor is given by claim 49 as filed via its dependence on claim 46.

7. Claim 6 of the main request relates to a method for reducing phytotoxicity to crop plants due to herbicidal compounds 2, 3, 5, 6, 7 and 9 (same list as in claim 1 of the main request), alone or in combination with one or more co-herbicides (same list as in claim 4 of the main request), which comprises applying an antidote selected from antidote 1-6, 8-21 (as in claim 1 of the

main request).

The steps of the method are based on claim 57 as filed.

Claim 7 of the main request indicates that the herbicide used in the method is herbicide 2. This claim is supported by original claim 74.

The combinations of herbicides, co-herbicides and antidotes involved in the methods according to claims 6 and 7 of the main request are the same as the combinations involved in the compositions according to claims 1 to 4. Therefore, the argumentation put forward in relation to the compositions according to claims 1 to 4 applies also to the method according to claims 6 and 7.

8. Claims 8 and 9 of the main request correspond to claims 75 and 76 as filed.
9. Finally, the Board can only conclude that the amendments made to the claims of the main request do not extend the content of the application as originally filed, thus satisfying the requirements of Article 123(2) EPC.
10. Accordingly, the decision under appeal relating only to this issue has to be set aside.
11. Since the remaining requirements such as novelty and inventive step under Articles 54 and 56 EPC should first be the subject of examination and decision by the Examining Division, the Board decides to remit the case to the first instance for further prosecution.

12. According to Rule 67 EPC, the reimbursement of appeal fees shall be ordered in the event that the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

The Appellant has requested a reimbursement of the appeal fee, arguing in essence that the application was refused prematurely and that the decision under appeal was not substantiated.

There would be premature refusal and as a consequence a substantial violation of procedure if the Appellant's right to be heard under Article 113(1) EPC, i.e. that a decision of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments, had not been respected.

In the circumstances of the present case, however, the requirements of Article 113(1) EPC were fulfilled in the decision of the Examining Division. The appealed decision was entirely based on grounds, facts and evidence which were already known to the Appellant from the official communication of the Examining Division dated 14 August 1995 (see paragraph II above). Following this communication the Appellant modified the claims but the subject-matter objected to under Article 123(2) EPC was still present in the amended claims and the Appellant did not respond to the Examining Division's objection regarding a lack of disclosure for "novel combinations of compounds" added "to the original combinations of compounds as exemplified in the description".

In accordance with the communication dated 14 August 1995, the text of the decision under appeal explicitly mentions that the amended claims do not meet the requirements of Article 123(2) EPC and clearly indicates the reasons why the Examining Division raised the objections. In this respect it is to be noted that the Examining Division put particular emphasis in both the said last communication and the decision under appeal on a lack of disclosure for all combinations of the claimed herbicides and antidotes.

Accordingly, the requirement for the decision set out in Rule 68(2) EPC that a decision of the European Patent Office, which is open to appeal, shall be reasoned, was also fulfilled in the decision under appeal.

Furthermore, in view of the fact that the Appellant has modified the claims several times during the examination procedure, his right to make amendments of his own volition, set out in Rule 86(3) EPC, has been observed by the Examining Division.

Therefore, no substantial procedural violation on the part of the Examining Division can be recognised and there is no reason for the reimbursement of the appeal fee.

## **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 the claims of the main request filed with the Appellant's letter dated 2 May 2000.
3. The request to reimburse the appeal fee is refused.

The Registrar:

The Chairman:

A. Townend

P. A. M. Lançon