

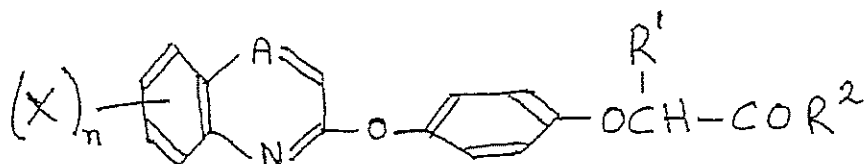
BLO/142/83

PATENTS ACT 1977

IN THE MATTER OF Application
No 80 04144 in the name of
Nissan Chemical Industries Ltd

DECISION

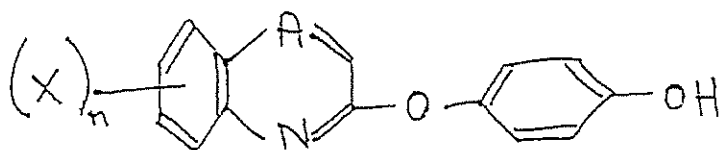
The application as filed relates to certain heterocyclic type phenoxy fatty acid derivatives of the formula



wherein A represents $-CH=$ or $-N=$; X represents a halogen atom; n is 0, 1 or 2; R^1 represents a hydrogen atom or a C_1-C_4 alkyl group; R^2 represents $-OH$; $-O-$ alkyl; $-OM$ (M is an inorganic or organic salt moiety); $-N \begin{matrix} R^3 \\ R^4 \end{matrix}$; $-O-C_2-C_4$ alkenyl; $-O-$ benzyl; $-O-C_1-C_4$ alkoxyalkyl; $-O-$ phenyl; $-O-$ cyclohexyl; $-O-$ halogenoalkyl; $-O-C_2-C_4$ alkynyl or $-O-$ cyanoalkyl and R^3 and R^4 respectively represent a hydrogen atom or a C_1-C_4 alkyl group.

These compounds are characterised by the possession of useful herbicidal properties, and there are further claims to the preparation of such compounds, herbicidal compositions containing them as the active ingredient and the use of such compositions for the control of weeds. Two basic methods are disclosed for the preparation of the active compounds and a number of further processes are indicated for converting such compounds into alternative forms of acid derivative.

Following the issue of the examiner's first report under Section 18(3) the applicants responded in their Agents' letter of 26 November 1982 in which they enclosed inter alia a further page numbered 71 bearing two new claims, 33 and 34, relating respectively to heterocyclic oxyphenols of the formula



wherein A represents $-CH=$ or $-N=$, X represents a halogen atom and n is 0, 1 or 2, and to the specific compound
2-(4-hydroxyphenoxy)-6-chloroquinoxaline.

The accompanying letter made no comment regarding the introduction of such claims, which relate to what are alleged to be novel starting materials for use in one of the processes disclosed for making the herbicides of the invention, namely the process claimed in various degrees of particularity in claims 16 to 21. The applicants were of course entitled to submit voluntary amendments at this stage without fee in accordance with the provisions of Rule 36(3) of the Patents Rules 1982. Having submitted such amendments, however, these are subject to examination for compliance with the Act and Rules and, following such examination, the examiner reported inter alia, in an official letter of 31 January 1983, that the new claims 33 and 34 were open to objection as being a separate invention from the existing claims to final products. Subsequently, in an interview at 6 April 1983 the applicants' Agent sought to persuade the examiner to withdraw his objection in the light of a recent decision of a Technical Board of Appeal in the European Patent Office. This decision, No T57/82, concerned certain copolycarbonates characterised by carbonate structural units derived from hexahydrofuro-(3,2-b)-furan-3,6-diols and found that such copolycarbonates, together with monomeric dihalogenated carboxylic acid esters of such diols, used as one of the starting materials, were to be regarded as encompassed within the same inventive concept. In other words the monomer starting material providing an essential proportion of the condensation polymer repeating units is to be regarded as part of the same invention as the polymer itself. Since the conclusions reached in this decision were expressed in somewhat general terms, it was argued that as a general principle novel starting materials or intermediate products (I use these terms interchangeably to denote final product precursors) should henceforth be regarded as part of the same inventive concept as the final products they are used to prepare. In response the examiner relied upon the findings in the matter of Celanese Corporation of America's application 69 RPC 227, a decision concerned with the matter of unity of invention as between intermediates and final products having regard to the requirements of Section 4(4) of the Patents Act, 1949.

There being no agreement between the examiner and the applicants' Agent the matter came before me at a hearing on 5 July 1983 at which the applicants were represented by their Agent, Mr S C D Bankes of R G C Jenkins & Co.

As I understood Mr Bankes' arguments, regardless of lack of similarity of structure, properties and search requirements, a new intermediate or starting material whose preparation is conceived solely for the purpose of providing novel final products is to be regarded as part of the same inventive concept as the said final products. In support of this contention he cited the above EPO Board of Appeal decision, which he submitted is a decision pertinent to the interpretation of Section 14(5)(d) of the 1977 Patents Act and Rule 22 of the 1982 Patents Rules, since it is based on

the corresponding Article 82 and Rule 30 of the European Patent Convention, the respective wording of which is substantially identical. In any event it was argued that having regard to Section 130(7) and to the specific reference therein to Section 14(5) the Patent Office is bound to apply a similar conclusion to the question of the intermediate and final product relationship unless it is possible to make a meaningful distinction between the circumstances of the EPO decision and those of the present case. Mr Bankes for his part submitted that in respect of the present case there was no such distinction to be made. As regards the Celanese decision Mr Bankes' took the view that this is a precedent which concerned the interpretation of Section 4(4) of the 1949 Patents Act and is no longer pertinent to the present Act, where Section 14(5)(d) now contains a further alternative provision to the effect that the claim or claims shall relate to a group of inventions so linked as to form a single inventive concept. It was his case that this further provision represented a relaxation in the requirements of the 1949 Act and that the wording of Rule 22, while listing some of these relaxations, at the same time envisaged that the list given was not exhaustive so that the applicants' case could also be accommodated as a matter of discretion.

I think it should be said at the outset that a general adoption of Mr Bankes' view that intermediates and final products are part of the same inventive concept would involve a change in what is present Patent Office practice and with this would come a substantial increase in the extent of search required on a significant number of organic chemical inventions. Mr Bankes pointed out, however, that the general ethos of the EPO and national routes for granting patent applications effective in the United Kingdom is that these should be comparable in both requirements and results, an effect which he said would not be obtained if there was a decision adverse to the applicant in the present proceedings. While I do not dispute Mr Bankes' observations with regard to the two alternative routes to the granting of a UK Patent, his conclusions with regard to the present case rely very much on the presumption that the Examining Division of the European Patent Office are in fact interpreting Decision T 57/82 as requiring all novel intermediates and novel final products to be regarded as one and the same invention. However, unless this can be shown to be so I think it would be invidious to call upon the UK Patent Office to change their established practice in order to follow such an interpretation. In fact in response to my enquiry on this point Mr Bankes was unable to provide any information regarding the present EPO interpretation of Decision T 57/82. But following my own subsequent investigation of this matter it seems that it is far from certain that the decision in question is receiving as general an interpretation as Mr Bankes implied. However, I do not propose to make this the basis of what I intimated at the hearing would be a finding against the applicant.

Turning firstly therefore to the wording of Rule 22 I accept that this does not preclude a specific finding in the applicants' favour. On the other hand there is no specific support for a general conclusion of the nature argued by Mr Bankes. Indeed I would not expect that this should be so, since the presumed categories of single inventive concept listed as (a), (b) and (c) have as their basis the practical consideration that in each case an adequate picture of the state of the art can be obtained by confining the search to a single appropriate choice from the various individual types of invention, so associated. The need to perform a second search for a different category of compounds has always provided a criterion for multiplicity of invention and is the basis of the Celanese decision, which I regard as still reflecting Patent Office policy in this matter. I regard the applicants phenolic intermediates as different from their final phenoxy acetic acid products in that they do not possess the vital herbicidal properties that characterise their main invention. At least Mr Bankes was unable to persuade me to the contrary on this point. Moreover, in order to verify the patentability of these intermediates it would be necessary to perform a further search, since that pertaining to the final products would not suffice for this purpose, nor would a single search suffice vice versa.

As to the suggestion that the wording of Section 14(5)(d) of the 1977 Act has extended what was formerly allowed under Section 4(4) of the 1949 Act, I do not accept that this is appropriately demonstrated to be so by a mere comparison of the wording of the two sections in isolation from the context of their respective Acts. Thus, in the earlier of the two Acts the definition of "invention" was not related specifically to the content of the claims and what constituted more than one invention was a matter of Patent Office discretion, which discretion generally included inter alia what is now codified in Rule 22 of the 1982 Patents Rules. On the other hand Section 125(1) of the present Act defines an invention as that forming the subject of a claim, and it follows that each independent claim then falls to be regarded as a distinct invention. Consequently two or more independent claims would fall foul of a unity of invention requirement if it were still worded in the manner of Section 4(4) of the old Act, and to preserve what was commonly allowed as a matter of discretion under that Act an extended form of wording is required in Section 14(5)(d) of the present Act. I do not regard this change of wording as importing any substantial change in the unity of invention requirements between the two Acts, and I therefore regard the arguments advanced in the Celanese decision as still holding good for the present Act. Likewise, I regard the remarks in that decision referring to the Office willingness to accommodate applicants wherever possible in the matter of unity of invention as still being applicable to the present Act. In fact there have been specific

circumstances under the present Act when per se claims for intermediates and for final products have been allowed to proceed as a single invention. I do not think that it would serve any useful purpose for me to attempt to categorise what in many instances are considerations appropriate only to the merits of individual cases, but suffice it to say that I would envisage a monomer/polymer relationship generally reflecting the type specifically identified in EPO decision T 57/82 as being one possible candidate for favourable consideration.

As to whether I am bound to follow this decision in preference to the Celanese decision I would observe that Section 130(7), referred to in this connection by Mr Bankes, is concerned with the question of the interpretation to be placed inter alia on the wording of Section 14(5)(d). Thus, when I need to construe this wording I am permitted, as an exception to normal legal interpretation, to have recourse to the wording of Article 82 of the European Patent Convention, as were their Lordships in the matter of Smith, Kline and French Laboratories Ltd v R D Harbottle (Mercantile) Ltd and Others, [1980] RPC 363, which has been brought to my attention by Mr Bankes. On the matter of the interpretation of the wording of Article 82 of the European Patent Convention I am of course bound by any ruling of the United Kingdom Patents Appeal or higher Courts, but in so far as an authoritative interpretation is given by foreign courts or by an EPO Board of Appeal, the effect of this can only be persuasive. However, I regard the EPO decision T57/82 as being directed more to a question of the exercise of discretion on a particular case than to a general interpretation of the meaning of Article 82. Thus, although the conclusions are expressed in general terms there is nothing in this decision to indicate that the relationship between novel intermediates and novel final products in general was considered in all its aspects for the purposes of laying down a clear overall policy.

The Board of Appeal were clearly not called upon to take into consideration other cases, for example of the type I am being called upon to decide at the present time. That being so I do not consider that there is established a general principle beyond the condensation polymer art for me to take into account. Even were this not so I would feel obliged to point out that the wording of Section 130(7) includes the proviso, "as nearly as practicable". To my mind this proviso has particular importance when it comes to the matter of assessing unity of invention. Although it was Mr Bankes' view that an applicant should receive similar treatment from both offices, it seems to me that the practical considerations arising, for example, from differences in the extent of the search, the methods used for classification and retrieval of search data and the fees required for carrying out a search between the two offices, do not easily lend themselves to identity of discretionary criteria in the matter of unity of invention. It has to be borne in

mind, moreover, that I do not have before me any guidance as to what the particular EPO view would be of the present case other than what can be deduced from decision T57/82, which I have already decided does not help me in the present instance.

In the result, therefore, I am unable to accept Mr Bankes' contention that the present claims 33 and 34 are to be regarded as part of the same invention as the other existing claims. That being so I refuse to allow the application to proceed to grant without suitable amendment. I allow the applicants a period of one month from the date of this decision in which to submit further amendments aimed at overcoming the finding of this decision.

Dated this 15th day of July 1983

D O WESTROP
Superintending Examiner, acting for the Comptroller

PATENT OFFICE