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**Datasheet for the decision
of 30 November 2006**

Case Number: T 0557/03 - 3.3.01

Application Number: 95903885.2

Publication Number: 0736010

IPC: C07D 213/30

Language of the proceedings: EN

Title of invention:

An enantioselective process for the preparation of chiral triaryl derivatives and chiral intermediates for use therein

Applicant:

Celltech R&D Limited

Opponent:

-

Headword:

Chiral triaryl compounds/CELLTECH

Relevant legal provisions:

EPC Art. 84, 111(1), 123(2)

Keyword:

"Clarity and support (yes)"

"Remittal for further prosecution (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0557/03 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 30 November 2006

Appellant: Celltech R&D Limited
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Representative: Marsden, John Christopher
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 23 December 2002
refusing European application No. 95903885.2
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: A. Nuss
Members: J. Jonk
J. Van Moer

Summary of Facts and Submissions

- I. This appeal lies from the decision of the Examining Division refusing the present European patent application 95 903 885.2 (published under number WO 95/17386), which relates to an enantioselective process for the preparation of chiral triaryl derivatives and chiral intermediates for use therein.
- II. The decision was based on Claims 1 to 15 filed on 12 November 2001.

Independent Claim 1 concerned:

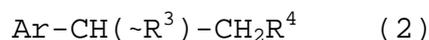
A compound of formula (1)



where Ar and R⁴, which may be the same or different, each represents a C₆₋₁₂ monocyclic or bicyclic aryl group, a C₁₋₉ monocyclic or bicyclic heteroaryl group containing one to four heteroatoms selected from oxygen, sulphur and nitrogen, or such an aryl or heteroaryl group substituted by up to four substituents R⁵ as defined in the claim; and Aux is the residue of a chiral (R- or S-) auxiliary.

Independent Claim 11 related to:

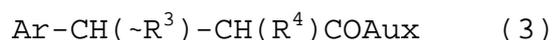
A process for the preparation of an R- or S-isomer of a compound of formula (2)



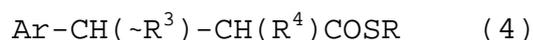
where Ar, R³ and R⁴, which may be the same or different, each represents an optionally R⁵-substituted aryl or heteroaryl group as defined for Ar and R⁴ in claim 1, and the wavy line (~) means that the configuration of -CH(~R³)- is either R or S, which comprises in a first step reacting a compound of formula (1)



[where Ar and R⁴ are as just defined and Aux is the residue of a chiral (R- or S-) auxiliary], with an R³-containing organometallic reagent [where R³ is as just defined] to yield a compound of formula (3)



followed, in a second step, by cleavage of the compound of formula (3) with a thiol RSH (where R is for example a C₁₋₄ alkyl or C₆₋₁₂ aryl C₁₋₃ alkyl group) in the presence of a base to yield a thioester of formula (4)



and followed in a final step by decarbonylation of the thioester of formula (4) to yield the desired R- or S-isomer of formula (2).

III. The application in suit was refused on the ground that the subject-matter of said set of claims did not meet the requirements of Article 84 EPC, since the expression "residue of a chiral (R- or S-) auxiliary" as the meaning of the rest Aux in the formulas (1) and (3) was not considered to clearly define the matter for which protection was sought.

- IV. Together with the summons to oral proceedings submitted on 13 September 2006 the Board communicated to the Appellant that according to the established jurisprudence of the Boards of Appeal Article 84 EPC had to be interpreted as meaning not only that a claim had to be comprehensible from a technical point of view, but also that it had to indicate all the essential features which were necessary for solving the technical problem with which a patent application was concerned. The requirement that the claims be supported by the description reflected the general legal principle that the extent of a patent monopoly, as defined by the claims, should correspond to the technical contribution to the art. Claims should not therefore extend to subject-matter which would still not be at the disposal of a skilled person after reading the description.
- V. Oral proceedings before the Board were held on 30 November 2006.
- VI. The Appellant defended the patentability of the application in suit on the basis of Claims 1 to 15 filed on 29 June 2006 as main request and two auxiliary requests submitted on the same date.

These three requests had in common that they comprised a process claim corresponding to Claim 11 indicated under point II above, i.e. a claim still containing the expression "residue of a chiral (R- or S-) auxiliary" as the meaning of the rest Aux in the formulas (1) and (3).

However, in view of the objections of the Board with respect to this expression in the light of the established jurisprudence of the Boards of Appeal with respect to Article 84 EPC, as indicated under point IV above, and in particular having regard to the fact that it appeared from the description of the application in suit that the technical problem underlying the application in suit seemed only to be credibly solved by using the residue of N-(1R)-10,2-bornanesultam or N-(1S)-10,2-bornanesultam as the chiral auxiliary "Aux", the Appellant finally defended the patentability of the subject-matter of the application in suit solely on the basis of a new set of Claims 1 to 11, in which the rest "Aux" of the formulas (1) and (3) had been defined accordingly.

VII. The Appellant requested that the decision under appeal be set aside, and that a patent be granted on the basis of the request filed during the oral proceedings.

VIII. At the conclusion of the oral proceedings the Board's decision was pronounced.

Reasons for the Decision

1. The appeal is admissible.

2. *Amendments (Article 123(2) EPC)*

2.1 Present Claim 1 is supported by Claim 11 as filed in combination with the description as filed, page 8, lines 16 to 28, with respect to the groups Ar, R³ and R⁴; page 9, lines 13 and 14, and page 11, lines 5 to 34

concerning the number and nature of group R⁵; and page 6, lines 24 to 26, with respect to the chiral auxiliary Aux.

Claims 2, 3 and 4 are supported by the originally filed Claims 12, 13 and 15, respectively.

Claim 5 is supported by in the subject-matter indicated above with respect to present Claim 1.

Claims 6 and 7 find their support in Claims 5 and 6 as filed, respectively, in combination with page 9, lines 13 and 14, of the description as filed.

Claims 8, 9 and 10 are supported by the originally filed Claims 7, 8 and 9, respectively, in combination with page 9, lines 13 and 14, of the description as filed.

Claim 11 corresponds to Claim 10 of the application as filed.

2.2 Therefore, the Board concludes that the subject-matter of the present claims does not extend beyond the application as filed, and consequently meets the requirement of Article 123(2) EPC.

3. *Clarity and support in the description under Article 84 EPC*

3.1 The application in suit was refused on the ground that the subject-matter of the claims then on file did not meet the requirements of Article 84 EPC, since the expression "residue of a chiral (R- or S-) auxiliary"

as the meaning of the rest Aux in the formulas (1) and (3) was not considered to clearly define the matter for which protection was sought.

3.2 According to the present claims the expression "Aux" in the formulas is now defined as being the residue of a chiral auxiliary N-(1R)-10,2-bornanesultam or N-(1S)-10,2-bornanesultam. By this restriction of the claimed subject-matter not only a technical feature appearing essential for the claimed invention has been introduced, but also the contribution to the art has been properly reflected, so that the claims do not extend anymore to subject-matter which would not be at the disposal of a skilled person after reading the description.

3.3 Therefore, the Board also concludes that the requirements of Article 84 EPC that the claims shall be clear and be supported by the description have been met.

4. *Remittal (Article 111(1) EPC)*

4.1 Having so decided, the Board has not, however, taken a decision on the whole matter, since the essential feature of the appeal proceedings is to consider whether the decision which has been issued by the first instance is correct. Therefore, and in view of the fact that the first instance only decided upon the issue of clarity and support under Article 84 and did not have an opportunity to consider the patentability of the subject-matter of the present claims with respect to other essential issues, the Board considers it appropriate to exercise its power conferred on it by Article 111(1) EPC to remit the case to the Examining Division.

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.

The registrar:

The Chairman:

N. Maslin

A. Nuss