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D E C I S I O N
of 29 January 2004

Case Number: T 0841/03 - 3.3.1

Application Number: 97945516.9

Publication Number: 0937032

IPC: C07C 229/22

Language of the proceedings: EN

Title of invention:

Substituted gamma aminobutyric acids as pharmaceutical agents

Applicant:

WARNER-LAMBERT COMPANY

Opponent:

-

Headword:

Aminobutyric acid compounds/WARNER-LAMBERT

Relevant legal provisions:

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

Keyword:

"Main request: extension beyond the content of the application as filed (yes) - introduction of an unsupported compound feature"

"First auxiliary request: unallowable extension (no) - remittal to the first instance"

Decisions cited:

-

Catchword:

-



Case Number: T 0841/03 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 29 January 2004

Appellant: WARNER-LAMBERT COMPANY
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Morris Plains
New Jersey 07950 (US)

Representative: Tesch, Rudolf, Dr.
Warner-Lambert Company
Legal Division
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 29 January 2003
refusing European application No. 97945516.9
pursuant to Article 97(1) EPC.

Composition of the Board:

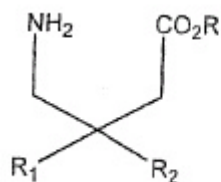
Chairman: A. J. Nuss
Members: J. M. Jonk
J. H. Van Moer

Summary of Facts and Submissions

I. This appeal lies from the decision of the Examining Division refusing the present European patent application 97 945 516.9, published under number WO 98/17627, and relating to "Substituted gamma aminobutyric acids as pharmaceutical agents".

Claim 1 of the application as filed read as follows:

"The compounds of the invention are those of Formula I



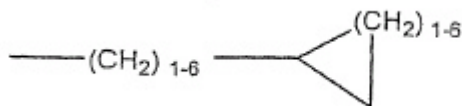
I

or a pharmaceutical acceptable salt thereof wherein:

R is hydrogen or lower alkyl;

R₁ is hydrogen or lower alkyl;

R₂ is ,



straight or branched alkyl of from 7 to 11 carbons,

-(CH₂)₍₁₋₄₎-X-(CH₂)₍₀₋₄₎-phenyl,

wherein X is -O-, -S-, or -NR₃- wherein

R₃ is alkyl of from 1 to 6 carbons, cycloalkyl of from 3 to 8 carbons, benzyl, phenyl,

wherein phenyl and benzyl can be unsubstituted or substituted with from 1 to 3 substituents each independently selected from alkyl, alkoxy, halogen, hydroxy, carboxy, carboalkoxy, trifluoromethyl, amino, and nitro."

II. The Examining Division refused the application on the ground that the subject-matter of Claim 1 of the set of claims filed on 20 April 2001 extended beyond the content of the patent application as filed (Article 123(2) EPC). Said Claim 1 corresponded to Claim 1 as filed, except that:

(i) the term "lower alkyl" with respect to the meaning of R and R₁ has been amended to "C₁-C₄ alkyl",

(ii) with respect to R₂ the meaning "straight or branched alkyl of from 7 to 11 carbons," has been deleted, and

(iii) the meaning of X has been amended by introducing "may not be present".

III. The Examining Division held that said Claim 1 comprised a new group of compounds, which was not clearly and unambiguously derivable from the application as filed due to the amendment "X may not be present". In this context, it considered that the indication of the compound 3-aminomethyl-5-phenyl-pentanoic acid as a preferred compound in the application as filed was not a sufficient support for the generalisation that the

variable X in formula I might be absent, since this generalisation would include every possible combination of X representing a bond with other variables.

- IV. Oral proceedings before the Board were held on 29 January 2004.
- V. The Appellant defended the patentability of the subject-matter of the present application on the basis of the sets of claims filed on 19 December 2003 as main request and as a first and second auxiliary request, respectively.

Claim 1 of the present main request essentially corresponded to the Claim 1 specified above upon which the decision of the Examining Division was based, except that concerning the meaning of X the expression "may not be present" was replaced by "may be absent".

Claim 1 of the present first auxiliary request corresponded to Claim 1 of the present main request, except that "may be absent" was deleted and as a further meaning of R₂ the rest $-(\text{CH}_2)_2$ -phenyl was inserted.

The set of claims according to the present second auxiliary request comprised a Claim 1 corresponding to the originally filed Claim 1 and an independent Claim 8 directed to the compound 3-aminomethyl-5-phenyl-pentanoic acid not falling under scope of Claim 1 of this request.

VI. The Appellant disputed that the claimed subject-matter did not meet the requirements of Article 123(2) EPC. In this context, he essentially argued that the skilled person would immediately understand from the originally filed patent application as a whole disclosing the compound 3-aminomethyl-5-phenyl-pentanoic acid in the description as one of the most preferred compounds and explicitly claiming said compound in Claim 7 that the definition of X in formula I was not complete and clearly comprised the situation that X was absent. No reason was derivable from the application as filed that the information concerning the meaning "X may be absent" was restricted to an individual compound. He also argued that in any case the amendments made in accordance with the two auxiliary requests were clearly supported by said preferred compound.

VII. He requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request, or on the basis of the claims of one of the two auxiliary requests, all filed on 19 December 2003.

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

Reasons for the Decision

1. The appeal is admissible.

2. *Main request*

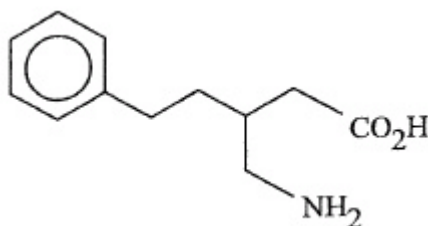
2.1 Compliance with Article 123(2) EPC

2.1.1 Having regard to the decision of the Examining Division the question to be dealt with is whether the amendment concerning the meaning of X in the definition of the compounds of formula I in Claim 1 giving the situation that X may be absent is supported by the patent application as filed.

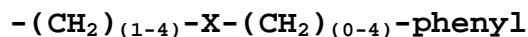
2.1.2 In this context, it is established jurisprudence of the Boards of Appeal that an amendment does not extend beyond the content of the patent application as filed if its subject-matter is directly and unambiguously derivable from said content.

2.1.3 The Appellant submitted that the skilled person in reading the patent application as filed would conclude:

- (a) that one of the most preferred compounds as disclosed in the application as filed (page 3 and in Example 2) and explicitly claimed (Claim 7), namely, 3-aminomethyl-5-phenyl-pentanoic acid having the formula:



did not fall under the scope of Claim 1 for the sole reason that the $-(\text{CH}_2)_2$ -phenyl group did not meet the meaning of R_2 in formula I represented by the formula:

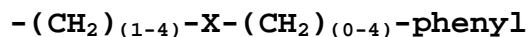


wherein **X** is -O-, -S-, or -NR₃, and

(b) that in these circumstances and in view of the content of the originally filed application as a whole the skilled person would immediately understand that X in this R₂-group could be absent.

2.1.4 The Board agrees with the Appellant that the compound 3-aminomethyl-5-phenyl-pentanoic acid does not fall under the scope of Formula I as defined in the application as filed for the sole reason that the definition of R₂ does not include the group **-(CH₂)₂-phenyl**.

2.1.5 However, the present amendment of the meaning of X in the formula



giving the situation that X can be absent and consequently **R₂** can be an alkylene phenyl, in which the alkylene group has **1 to 8** carbon atoms, does not directly and unambiguously find support in the application as filed. In this context, the Board observes that it is true that the **-(CH₂)₂-phenyl** group can directly and unambiguously be derived from said preferred 3-aminomethyl-5-phenyl-pentanoic acid compound as a possible meaning of **R₂**, but according to the established jurisprudence of the Boards of Appeal this particular group cannot be generalised to a **-(CH₂)₍₁₋₈₎-phenyl** group.

2.1.6 Therefore, the Board concludes that the subject-matter of Claim 1 of this request does not meet Article 123(2) EPC, since it extends beyond the content of the application as filed, and that for this reason the main request cannot be allowed.

3. *First auxiliary request*

3.1 Compliance with Article 123(2) EPC

3.1.1 The subject-matter of Claim 1 of this request corresponds to Claim 1 of the present main request, except that "**is absent**" was deleted and instead as a further meaning of R₂ the rest **-(CH₂)₂-phenyl** was inserted.

3.1.2 The first question to be dealt with is thus whether this amendment in the definition of the compounds of Formula I in Claim 1, giving the situation that R₂ can have said further meaning in combination with the other variables within the scope of Formula I, is supported by the patent application as filed.

3.1.3 Having regard to the application as filed as a whole disclosing the compound 3-aminomethyl-5-phenyl-pentanoic acid as one of the two **more preferred** compounds of the invention as defined by Formula I (see page 3, lines 7 to 9, and Example 2 describing its synthesis), the Board finds that the disclosure of said compound may not be considered in isolation, but must be seen in the context of the disclosed invention, i.e. in the context of Formula I representing a class of compounds comprising each meaning of R₂ in combination with all the other variables as defined in Formula I.

- 3.1.4 Moreover, in view of the fact that the **more preferred** compound 3-amino-methyl-5-phenyl-pentanoic acid does not fall under the scope of Formula I as defined in the application as filed, a skilled person would have immediately realised that not all the intended meanings for R_2 had been indicated in connection with Formula I.
- 3.1.5 Thus, as there exists no doubt that only **for this sole reason the definition of R_2 was incomplete**, and that said compound 3-amino-methyl-5-phenyl-pentanoic acid directly and unambiguously discloses the **$-(CH_2)_2$ -phenyl** group as a more preferred meaning of R_2 , the Board concludes that in this respect the subject-matter of Claim 1 of this request does not extend beyond the application as filed.
- 3.1.6 Furthermore, the Board also finds that the other amendments with respect to Claim 1 as filed as indicated above under point II, sections (i) and (ii) meet Article 123(2) EPC too. The specification of the expression "lower alkyl" is based on page 4, line 6, of the application as filed and in view of the disclosure of the application as filed as a whole and in particular the disclosure of the preferred embodiments the deletion of the meaning "straight or branched alkyl of from 7 to 11 carbons" for R_2 does not lead to a group of compounds representing a novel selection.

4. *Second auxiliary request*

4.1 Since the ground for the refusal of the present application by the Examining Division has been removed by the first auxiliary request, the Board sees no reason to consider this second auxiliary request.

5. *Remittal to the first instance*

5.1 The claims of the first auxiliary request found to be allowable by the Board under Article 123(2) EPC have not been considered by the Examining Division. Therefore, the application in suit in the form of the first auxiliary request needs further examination in order to establish whether it meets the other requirements of the EPC. In these circumstances, the Board finds it appropriate to make use of its power under Article 111(1) EPC and to remit the case to the first instance for further prosecution.

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 Claims 1 to 9 of the first auxiliary request filed on 19 December 2003.

The Registrar:

The Chairman:

N. Maslin

A. Nuss