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**Datasheet for the decision
of 27 February 2007**

Case Number: T 1247/04 - 3.3.01

Application Number: 01905404.8

Publication Number: 1261598

IPC: C07D 313/00

Language of the proceedings: EN

Title of invention:

Internal 1,15-lactones or fluprostenol and related
prostaglandin F_{2α} analogs and their use in the treatment of
glaucoma and intraocular hypertension

Applicant:

Cayman Chemical Company, Inc.

Opponent:

-

Headword:

Prostaglandin F_{2α}/CAYMAN CHEMICAL COMPANY, INC.

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

"All the requests: amendments - supported by the application
as filed (no) - disclaimer (no) - G 1/03 not applicable"

Decisions cited:

G 0001/03

Catchword:

-



Case Number: T 1247/04 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 27 February 2007

Appellant:

Cayman Chemical Company, Inc.
The laws of the state of Colorado
1180 East Ellsworth
Ann Arbor
MI 48108 (US)

Representative:

West, Alan Harry
R.G.C. Jenkins & Co.
26 Caxton Street
London SW1H 0RJ (GB)

Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 17 May 2004
refusing European application No. 01905404.8
pursuant to Article 97(1) EPC.

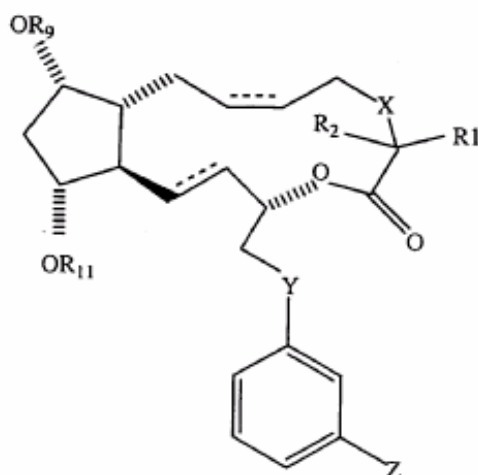
Composition of the Board:

Chairman: A. Nuss
Members: P. Ranguis
J. Van Moer

Summary of Facts and Submissions

- I. This appeal lies from the decision of the Examining Division to refuse the European patent application No. 01905404.8 (Publication number 1 261 598).
- II. The set of claims before the Examining Division was filed by letter received on 29 October 2003 and contained seven claims. Claim 1 reads as follows:

"1. A compound of the general formula:



Formula I

wherein X is O, S, NH, or CH₂;

R₁ and R₂ are the same and are either H, CH₃ or F;

R₉ is H, or C₁-C₂₀ straight chain, saturated or unsaturated or branched acyl;

R₁₁ is H, or C₁-C₂₀ straight chain, saturated or unsaturated or branched acyl, provided that if both R₉ and R₁₁ are H, X is S or NH if Y is O or CH₂;

----- represents any combination of a single bond, or a *cis* or *trans* double bond;

Z is H, Cl, Br, I, CF₃, CH₃, or C₁-C₁₀ straight chain or branched alkyl;

and

Y is O, S, NH or CH₂; provided that if R₁ = R₂ = H or F and X is CH₂, Y = S or NH."

III. In the communication dated 10 January 2003, the Examining Division pointed out that

compounds 28 and 30 to 32 of document

(1) Chemical abstract 1978: 104 768, prostaglandine lactones, derived from JP-A-52 001 034

fell within the claimed subject-matter.

Examples 24 and 26 of document

(2) GB-A-1 554 026

disclosed also compounds overlapping the claimed area.

Examples 41 and 42 of document

(5) J. Med. Chem. (1983), 26, 1089-1099 were relevant for the novelty of the claimed subject-matter.

In the communication according to Rule 71a EPC, the Examining Division was of the opinion that the provisos introduced into Claim 1 (see point II above) in response to the communication dated 10 January 2003 defined groups of compounds not originally disclosed in the application as filed in contravention of Article 123(2) EPC. In its decision, the Examining Division referred directly to this prior communication and refused the application.

IV. In the statement of grounds of appeal the Appellant defended as sole request the application in suit on the basis of the set of claims as refused (see point II above).

V. In the communication accompanying the summons to oral proceedings, the Board made *inter alia* the following remark:

"In accordance with consistent practice, the term "disclaimer" is used as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas.

In the Board's judgment the amendments to Claim 1:

"provided that if both R₉ and R₁₁ are H, X is S or NH if Y is O or CH₂"

and

"provided that if R₁ = R₂ = H or F and X is CH₂, Y = S or NH"

might not be considered as disclaimers in the sense indicated but as a selection (not disclosed or otherwise supported in the application as originally filed) of some species within the general definition of Claim 1.

That might contravene the requirements of Articles 84 and 123(2) EPC."

VI. With a letter received on 26 January 2007, the Appellant submitted two further sets of seven claims as first and second auxiliary requests. Claim 1 of the first auxiliary request was the same as that of the main request.

Claim 1 of the second auxiliary request resulted from the following amendments with respect to Claim 1 of the main request (see point II above):

the feature "provided that if both R₉ and R₁₁ are H, X is S or NH if Y is O or CH₂" was deleted and the following features were added at the end of the claim:

"provided that the compound is not
(15S)-15-methyl-PGF_{2α} 1,9-lactone;
(15S)-2,2-difluoro-15-methyl-PGF_{2α} 1,9-lactone;
PGF_{2α} 1,9-lactone;
13,14-didehydro-PGF_{2α} 1,9-lactone;
17-Phenyl-18,19,20-trinor-PGF_{2α} 1,15-lactone;
16-PhO-17,18,19,20-tetranor-PGF_{2α} 1,15-lactone; or
17-PhO-18,19,20-trinor-PGF_{2α} 1,15-lactone."

VII. Oral proceedings took place on 27 February 2007. The Board was informed by a letter received on 19 February 2007 that the Appellant would not be represented at these oral proceedings. The oral proceedings were thus held in the absence of the duly summoned Appellant in accordance with Rule 71(2) EPC.

VIII. The Appellant submitted the following arguments in the written proceedings:

In the light of the decision G 1/03 (OJ EPO 2004, 413) the objections of the Examining Division regarding the provisos present in Claim 1 were not proper. The provisos in Claim 1 were introduced to distinguish the claimed subject-matter from the disclosure of documents (1) and (2). These provisos were acceptable because they fell within the definition of acceptable provisos (disclaimers) set out in that decision, and in particular because they:

"restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention;" (see order, point 2.1).

In the present case, neither document was concerned with compositions for the treatment of conditions for the eye, let alone treatment of the particular disease condition for which the applicant has provided an effective treatment.

Documents (1) and (2) did not disclose the subject-matter of Claim 1 of the three present requests.

IX. The Appellant requested in writing that the decision under appeal be set aside and a patent be granted on the basis of the main request submitted by letter received on 29 October 2003 or alternatively on the

basis of the first auxiliary request ("second request") and second auxiliary request ("third request") submitted by letter received on 26 January 2007.

- X. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main and first auxiliary request

2. *Amendments*

- 2.1 The subject-matter of Claim 1 of the main request and the first auxiliary request is identical.

- 2.2 Compared with Claim 1 as originally filed, present Claim 1 was amended to incorporate the features

"provided that if both R₉ and R₁₁ are H, X is S or NH if Y is O or CH₂"

and

"provided that if R₁ = R₂ = H or F and X is CH₂, Y = S or NH"

(see point II above). Those amendments have no basis in the application as filed, and this was eventually conceded by the Appellant in the statement of grounds of appeal.

2.3 Article 123(2) EPC states that a European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. However, an amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed (see G 1/03, OJ EPO 2004, 413).

The Appellant argued that the provisos in Claim 1 were introduced to distinguish the claimed subject-matter from the disclosure of document (1) and (2) in accordance with the criteria defined in the above cited decision.

The question is, therefore, whether the amendments, namely the two provisos, can take the benefit of the exception established by the Enlarged Board of Appeal to the general principle established by Article 123(2) EPC.

2.4 In its decision, the Enlarged Board of Appeal stated that "in accordance with consistent practice, the term "disclaimer" is used hereafter as meaning an amendment to a claim resulting in the incorporation therein of a "negative" technical feature, typically excluding from a general feature specific embodiments or areas" (see point 2 of the reasons).

2.5 The Board, therefore, maintains the opinion expressed in its communication (see point V above) that the two

"provisos" are **not** "negative technical feature and cannot be considered as "disclaimers" in the sense of the decision G 1/03 which thus does not apply in the present case.

2.6 The two provisos can only be viewed as a selection of compounds not supported by the application as filed in contravention of Article 123(2) EPC.

2.7 If the Board had admitted the Appellant's view that the "positive" proviso *a contrario* excluded the compound not included in said proviso, the requirements set out in decision G 1/03 would not have been met either, since, from the documents (1), (2) and (5), it appears that chemical compounds

17-Phenyl-18,19,20-trinor-PGF_{2α} 1,15-lactone,
16-Phenoxy-17,18,19,20-tetranor-PGF_{2α} 1,15-lactone,
16-(3-trifluoromethylphenoxy)-tetranor-PGF_{2α} 1,15-lactone,
16-(3-chlorophenoxy)-tetranor-PGF_{2α} 1,15-lactone,

are disclosed (see formulae of compounds 28, 30 to 32 of document (1); Examples 24 and 26 of document (2) and compounds 41 and 42 of document (5)). The purported exclusion does not reflect the prior art disclosure (see G 1/03, point 2.2, Order).

2.8 Since Claim 1 of the main and first auxiliary requests do not meet the requirements of Article 123(2) EPC and since the Board can only decide on a request as a whole, the main and the first auxiliary requests are to be rejected.

Second auxiliary request

3. *Amendments*

3.1 Claim 1 comprises the same **second** proviso as defined in Claim 1 of the main request. For the same reasons as set out above this proviso is not a disclaimer in the sense of G 1/03 (op.cit) and is in breach of Article 123(2) EPC. Claim 1 is, therefore, to be rejected.

3.2 Since Claim 1 of the second auxiliary request does not meet the requirements of Articles 123(2) and since the Board can only decide on a request as a whole, the second auxiliary request is also to be rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss