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**Datasheet for the decision
of 14 July 2011**

Case Number: T 0173/08 - 3.3.01

Application Number: 03760999.7

Publication Number: 1513828

IPC: C07D 401/04

Language of the proceedings: EN

Title of invention:

New compounds useful for the treatment of obesity, type II diabetes and CNS disorders

Applicant:

Biovitrum AB (publ)

Headword:

Compounds for treating obesity/BIOVITRUM

Relevant legal provisions:

EPC Art. 123(2)

Relevant legal provisions (EPC 1973):

-

Keyword:

"No response to objections raised in board's communication"
"Added subject-matter (yes)"

Decisions cited:

-

Catchword:

-



Case Number: T 0173/08 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 14 July 2011

Appellant: Biovitrum AB (publ)
S-112 76 Stockholm (SE)

Representative: Höglund, Lars
Biovitrum AB
Patent Department
S-112 76 Stockholm (SE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 18 July 2007
refusing European patent application
No. 03760999.7 pursuant to Article 97(1) EPC
1973.

Composition of the Board:

Chairman: P. Ranguis
Members: L. Seymour
C.-P. Brandt

Summary of Facts and Submissions

I. This appeal lies from the decision of the examining division refusing the European patent application No. 03 760 999.7, based on international application WO 2004/000828, under Article 97(1) EPC 1973.

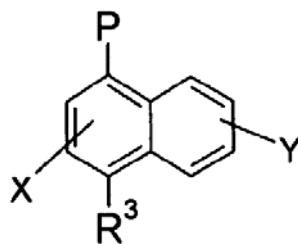
II. The decision under appeal was based on claims 1 to 20 submitted as main and sole request to the examining division under cover of a letter dated 29 June 2007.

The examining division *inter alia* considered the subject-matter of claim 1 of this request to lack of unity and novelty with respect to document (1) (WO 02/100822).

III. The appellant (applicant) lodged an appeal against this decision, and filed a new main request with the statement of grounds of appeal. Oral proceedings were requested on an auxiliary basis. As support for the limitations introduced into claim 1 of this request, the appellant in particular referred to formula (XI) on page 22 of the application as originally filed.

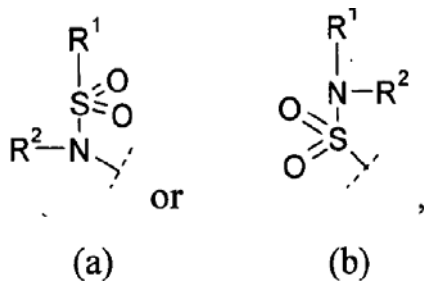
Independent claim 1 of the main request reads as follows (definitions of R^1 , R^2 , X and Y omitted by the board for reasons of conciseness):

"1. A compound of the formula (I):



(I)

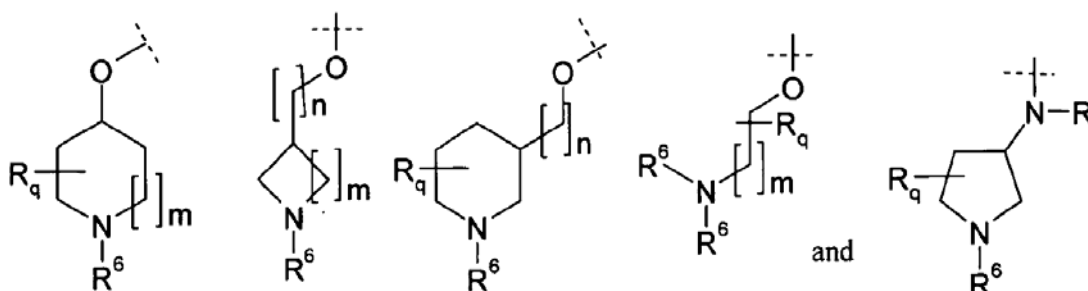
or a pharmaceutically acceptable salt thereof, wherein:
P is any one of formula (a) or (b):



wherein x = 0, 1, or 2 and y = 0, 1, or 2;

...

R³ is a group selected from any one of



wherein R³ is optionally substituted on each carbon atom that allows the substitution with R_q groups, wherein R_q is independently H, or (C₁₋₆) alkyl, and wherein two R_q groups can be present on the same carbon atom simultaneously, wherein

q = 1, 2, 3, 4, 5 or 6,
m = 1 or 2, and
n = 0, 1 or 2;

R⁶ is independently

- (a) H,
- (b) linear or branched C₁₋₆ alkyl,
- (c) benzyl,
- (d) -CH₂-CH₂-OH, or
- (e) -CH₂-CH₂-O-C₁₋₆ alkyl;

provided that

when R¹ = Ar is partially saturated bi-cyclic heterocyclic ring containing a N atom, the N atom in Ar cannot be attached to the S atom in P".

- IV. In a communication sent as annex to the summons to oral proceedings, the board expressed its preliminary opinion that claim 1 of the newly filed main request suffered from deficiencies under Articles 123(2) and 84 EPC.
- V. Oral proceedings took place as scheduled on 14 July 2011, in the absence of the appellant.
- VI. The appellant requested in writing as main and sole request that the decision under appeal be set aside and that a patent be granted in the following version:
 - Claims 1-14 filed with the statement of grounds of appeal.
 - Description pages 1-37 filed with the statement of grounds of appeal.

VII. At the end of the oral proceedings, the decision of the board was announced.

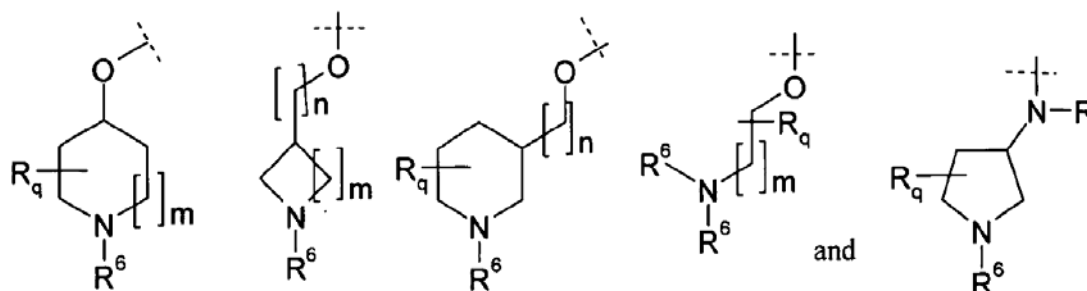
Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123(2) EPC)*

As basis for the limitations in the generic formula in claim 1, the appellant referred to formula (XI) on page 22 of the application as originally filed. However, it is clearly stated on page 22 in the context of formula (XI) that "R³ is as defined in claim 4". It is further noted that this definition is also repeated in corresponding claim 28 of the application as originally filed.

Claim 4 of the application as originally filed reads as follows:

"4. The compound according to claim 1 or 2 wherein R³ is selected from any one of



wherein R^3 can be substituted on each carbon atom that allows the substitution with R_q groups, wherein R_q is independently H, or C_{1-6} alkyl, and wherein two R_q groups can be present on the same carbon atom simultaneously, wherein

$q = 1$ or 2 ,

$m = 1$ or 2 ,

$n = 0$, and

R^6 is independently

(a) H,

(b) C_{1-3} alkyl,

(d) $-CH_2-CH_2-OH$, or

(e) $-CH_2-CH_2-OCH_3$.

As can be seen on comparison of this text with that reproduced above under point III, a considerably broader definition of R^3 has been incorporated into claim 1 of the main request (cf. definitions of q , m , n and R^6). This amounts to an unallowable generalisation of the preferred embodiment disclosed on page 22 of the application as filed, contrary to Article 123(2) EPC.

In the communication accompanying the summons to oral proceedings, the appellant's attention was drawn to this deficiency (see point IV above). The appellant did not make any submissions in response to the board's objection. Hence, the board sees no reason to depart from its preliminary negative opinion concerning compliance with the requirements of Article 123(2) EPC.

Hence, at least on the basis of this objection, the main request is not considered to be allowable. It is therefore not necessary to decide on further objections

raised during the course of examination and appeal proceedings (cf. above points II and IV).

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Schalow

P. Ranguis