

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : T 076/89 - 3.3.2

Anmeldenummer / Filing No / N^o de la demande : 84 109 539.1

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 141 927

Bezeichnung der Erfindung: Antiviral guanine derivatives

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C07D 473/18

ENTSCHEIDUNG / DECISION

vom / of / du 10 October 1989

Anmelder / Applicant / Demandeur : BEECHAM GROUP PLC

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Guanine derivatives/BEECHAM

EPÜ / EPC / CBE Art. 113(2); Rule 86(3)

Schlagwort / Keyword / Mot clé : "Amendments - consent of the
Examining Division"
"Discretion of the Examining Division"

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

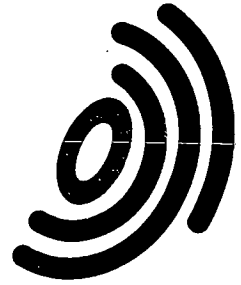
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European Patent
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Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : T 076/89 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal
of 10 October 1989

Appellant : Beecham Group PLC
c/o Beecham Pharmaceuticals
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Representative : P. Jones
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Patents & Trade Marks Dept.
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Decision under appeal : Decision of Examining Division 008
of the European Patent Office
dated 08.07.88 refusing European
patent application No. 84 109 539.1
pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : P. Lançon
Members : P. Krasa
E. Persson

Summary of Facts and Submissions

- I. European patent application No. 84 109 539.1 containing 20 claims was filed on 10 August 1984 and published on 22 May 1985 under No. 141 927.

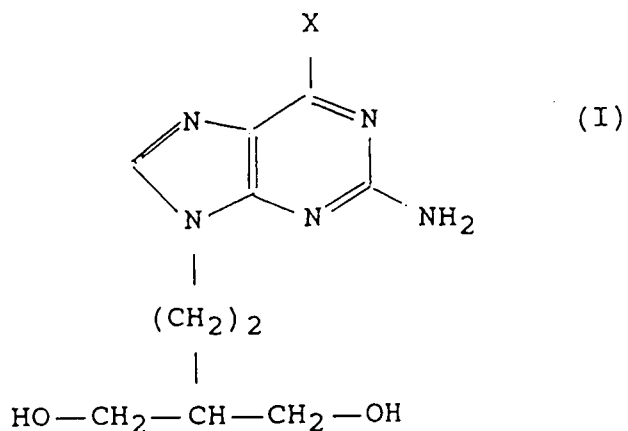
- II. In the European search report the Search Division raised a lack of unity of invention objection and stated that the search was only drawn up for Claims 1 to 18. According to the Search Division these claims - which cover final products, methods for their preparation, compositions comprising them, and particular intermediates for their preparation - constituted a first group of inventions. No search was made for Claims 19 and 20 referring to additional intermediates which, according to the Search Division, constituted a second group of inventions and for which the Appellant had not paid the required further search fee within the fixed time limit.

The Examining Division joined the view of the Search Division regarding lack of unity of invention in a communication dated 26 March 1987. In this communication, objections were also made in respect of the inventive step for the subject-matters covered by Claims 1 to 18.

- III. In his reply received on 29 September 1987 the Appellant filed new Claims 1 to 18 but maintained Claims 19 and 20 unamended.

Claims 1, 18, 19 and 20 read:

1. A compound of formula (I)

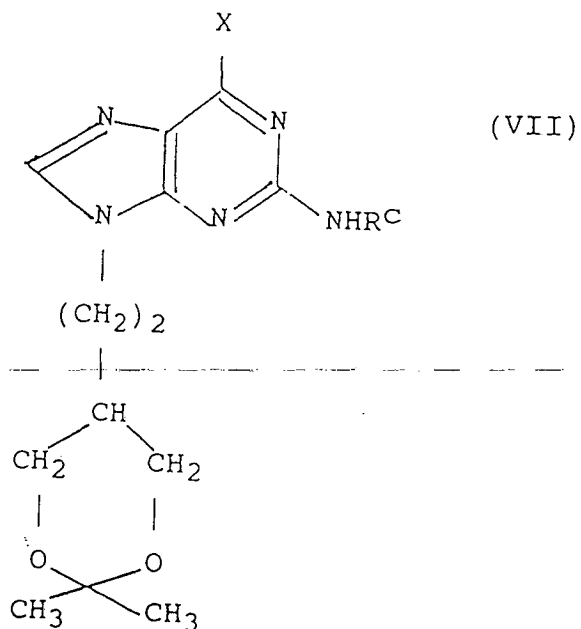


or a salt, phosphate ester or acyl derivative thereof, in which X represents chlorine, straight or branched chain C₁₋₆ alkoxy, phenoxy, phenyl C₁₋₆ alkoxy, -NH₂, -OH or -SH, an acyl derivative is wherein one or both of the hydrogens in the acyclic -OH groups, and/or one of the hydrogen atoms in the -NH₂ group, are replaced by R-C- groups, wherein R is hydrogen,

O

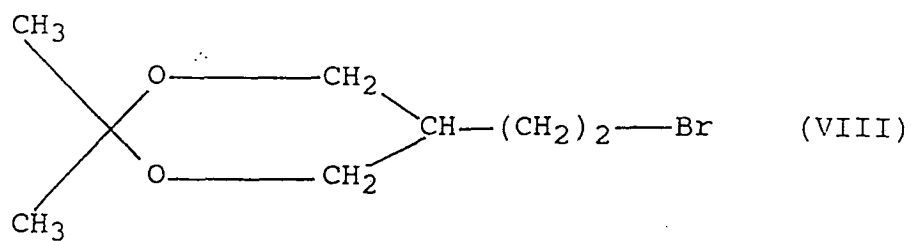
C₁₋₁₈ alkyl, phenyl, phenyl C₁₋₆ alkyl or imidazolyl; with the proviso that, when X is -OH, the compound of formula (I) is in a purity state of greater than 50% by weight of pure compound with respect to the mono- and di-benzyl ethers thereof.

18. A compound of formula (VII)

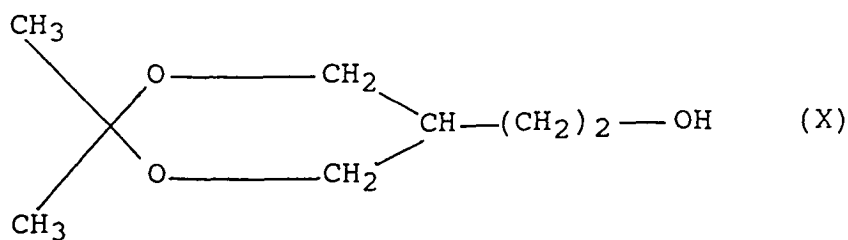


in which X is as defined in Claim 1 and R^C is hydrogen or acyl.

19. A compound of formula (VIII)

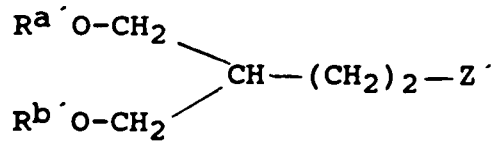


20. A compound of formula (X)



In answer to a further communication of the Examining Division dated 16 October 1987, maintaining the non-unity-of-invention objection, the Appellant filed on 21 December 1987 new Claims 19 and 20 reading:

19. A compound of formula:



wherein

Z' is hydroxy, chloro, bromo or iodo;

Ra' and Rb' are R-C(=O)- groups, as defined in Claim 1;

or

Ra' and Rb' together are >C(CH3)2.

- 20. 5-(2-Hydroxyethyl)-2,2-dimethyl-1,3-dioxan,
5-(2-bromoethyl)-2,2-dimethyl-1,3-dioxan,
2-acetoxymethyl-4-hydroxybut-1-yl acetate, or
2-acetoxymethyl-4-bromobut-1-yl acetate.

IV. In the course of oral proceedings held on 1 June 1988 the Examining Division informed the Appellant that it would not consent to the amended Claims 19 and 20 as required under Rule 86(3) EPC. The Appellant was not prepared to proceed with the original Claims 19 and 20 (together with Claims 1 to 18 as filed 29 September 1987).

At the end of the oral proceedings the Examining Division refused the application. A decision in writing was notified to the Appellant on 8 July 1988, pursuant to Rule 68 EPC.

The Examining Division's reasons were basically as follows:

Novelty and inventive step were acknowledged for the subject-matter of Claims 1 to 18 as was unity of invention of Claims 1 to 20 as last filed. However, the amendment of 21 December 1987 was not accepted under Rule 86(3) EPC: the European examination proceedings were intended to be a quick procedure and in view of the current backlog situation in the EPO the Examining Division was not prepared to give its consent to the broadening of claims at this point in the proceedings.

- V. The Appellant lodged an appeal against the decision on 30 August 1988 simultaneously paying the prescribed fee. In the Statement of Grounds received on 8 November 1988 he submitted inter alia that in the present case no additional work would have resulted for the EPO from the new (broadened) Claims 19 and 20 as the original Claims 19 and 20 had not been searched yet. Thus, there was no justification for the refusal of an amendment not leading to a delay of the examining procedure.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. According to Rule 86(3) EPC amendments to a European patent application require the consent of the Examining Division if filed after receipt of the first communication from the Examining Division and not submitted at the same time as the reply to this first communication.

According to Article 113(2) EPC the existence of a text of the European patent application submitted or agreed to by the Applicant is a mandatory prerequisite for considering a European patent application.

When the Examining Division did not agree to the amendments of 21 December 1987, only the text with the amendments of 29 September 1987, i.e. with the original Claims 19 and 20, could be considered for further examination. As the Appellant did not cancel the amendments of 21 December 1987 and did not agree on further proceedings on the basis of the text without these latter amendments there was no text of the application pending which was submitted or agreed to by the Appellant. Thus the decision to reject the present application amounts to a rejection under Article 97(1) EPC as the requirements of Article 113(2) EPC are not met.

3. The question is whether or not the Examining Division made proper use of its discretion when it did not consent to the amendment of 21 December 1987 i.e. to the new Claims 19 and 20...

3.1 The Board cannot accept the Appellant's view that no delay at all was connected with the filing of the amended claims. Any amendment of claims - and of course also of the description - has to be examined in respect of its formal admissibility, especially under Article 123(2) EPC. This necessarily takes some time. However, the Board is of the opinion that in this case the amendment would not have caused a substantial delay. As soon as the Examining Division came to the conclusion that the lack of unity of invention objection was to be waived, it would have had to request the Search Division to establish an additional European search report for the subject-matter of Claims 19 and 20. The additional European search would

necessarily have resulted in a considerable delay of the examination procedure. The delay caused by the examination of the formal admissibility of the new Claims 19 and 20 (Articles 84 and 123(2) EPC) would have been insignificant in relation to the period of time required for such additional search.

3.2 In addition the following has to be considered:

The new Claims 19 and 20 were obviously filed in an attempt to overcome at least part of the Examining Division's arguments supporting the objection regarding lack of unity of invention which was raised in the Examining Division's first communication and waived only in the course of the oral proceedings. This follows implicitly from the introductory sentence of the covering letter, where it was stated that the Appellant was "... writing in reply to the invitation ... dated 16th October 1987". Indeed, the arguments for the non-unity of invention objection raised by the Examining Division in the communication of 26 March 1986 related inter alia to the different scope of the claims to the final products on the one hand when compared with that of the claims to the intermediates on the other hand. While it is not necessary to investigate whether or not this objection was justified at all, the broadening of the claims filed in the latest answer of the Appellant rendered the scope commensurate in any case.

As the said invitation of 16 October 1987 was dealing with the non-unity of invention issue and in view of the development of the examination procedure up to that stage the Board finds that the new claims were to be understood as a contribution to a settlement of this issue.

The Examining Division was of the opinion that the amendment of Claims 19 and 20 could have been filed in reply to its first communication already. However, the reply to the first communication comprised reasoned arguments and was an attempt to overcome the Examining Division's objections not only to non-unity but also to inventiveness. Thus, it was not excluded that the Examining Division would have waived its objection to non-unity. In this situation it was understandable that the Appellant did not immediately file new claims but, pending the clarification of this matter, waited to do so. In the present case his argumentation was finally convincing and the Examining Division eventually acknowledged unity of invention. This shows that in the present case a procedural delay was inherent to the procedure from the beginning due to an untenable objection of lack of unity of invention raised by the Search Division and maintained at first by the Examining Division.

- 3.3 The Board takes the view that it is in principle up to the Examining Division to exercise its discretion which Rule 86(3) EPC confers to it when the admissibility of an amendment submitted after answering to the Examining Division's first communication is at issue. However, in the Board's judgment, due to the particular circumstances of this case and for the sake of a fair balance between the Appellant's interest in the grant of a patent with the amended claims and the interest of the EPO in avoiding undue delays of the examination procedure, the Board has come to the conclusion that the proposed amendment should have been allowed under Rule 86(3) EPC.
4. As regards Claims 1 to 18, novelty and inventive step are not at issue and the Board sees no necessity to deal with these requirements on its own motion.

5. As regards Claims 19 and 20 as last filed, unity of invention is no more at issue at present. An examination of these claims in respect to novelty and inventive step of their subject-matter will only be possible as soon as an additional European search report dealing with these claims is available.

The Board understands from the wording of No. IV of the Reasons for the Decision ("... the requested amendments do not appear to contravene the requirements of Articles 84 and 123(2), ...") that the Examining Division has not come yet to a final opinion regarding the admissibility of Claims 19 and 20 especially in view of the requirements of Article 123(2). In this respect there seems to be room for some doubt, whether or not the group of compounds now claimed in Claim 19 was indeed disclosed in the application documents as originally filed; this seems to be questionable e.g. for compounds with R^a and R^b being together $\geq C(CH_3)_2$ and Z being Cl or J. In accordance with Article 111(1) EPC the Board deems it appropriate, however, to leave the clarification of this issue to the Examining Division so that the Appellant is not deprived of one level of jurisdiction in this respect.

Order

For these reasons, it is decided that:

1. The impugned decision is set aside.
2. The case is remitted to the Examining Division with the order to proceed with the examination of the application on the basis of Claims 1 to 18 filed on 29 September 1987 and Claims 19 and 20 filed on 21 December 1987.

M. Beer

P. Lançon