

Publication in the Official Journal ~~Yes~~ / No

File Number: T 907/90 - 3.3.1

Application No.: 87 104 237.0

Publication No.: 0 242 610

Title of invention: Substituted amilides of oleic, linoleic or linolenic acid
as inhibitors of acyl-coa: cholesterol acyltransferase

Classification: C07C 103/60

D E C I S I O N
of 5 March 1992

Applicant: WARNER-LAMBERT COMPANY

Headword: Substituted anilides/WARNER-LAMBERT

EPC Article 123(2)

Keyword: "Limitation of a claim by a feature derivable from all examples
(allowed)"

Headnote



Case Number : T 907/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 5 March 1992

Appellant : WARNER-LAMBERT COMPANY
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Decision under appeal : Decision of Examining Division of the European
Patent Office dated 15 June 1990 refusing
European patent application No. 87 104 237.0
pursuant to Article 97(1) EPC.

Composition of the Board :

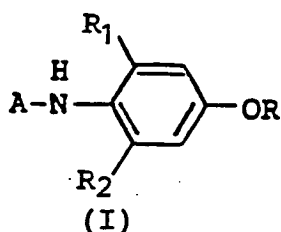
Chairman : K.J.A. Jahn
Members : R.K. Spangenberg
J.A. Stephens-Ofner

Summary of Facts and Submissions

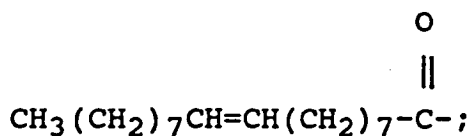
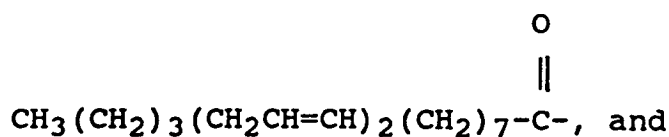
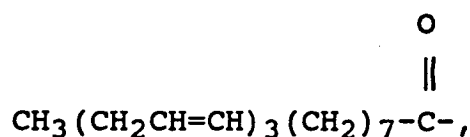
I. The Appellant is the applicant of European patent application No. 87 104 237.0, corresponding to EP-A-242 610. The appeal, which was filed, accompanied by the payment of the appropriate fee, on 8 August 1990, lies against the decision of the Examining Division of the EPO dated 15 June 1990, by which the application was refused.

II. The decision under appeal was based upon Claims 1 to 8 for all Contracting States except AT, GR and ES and Claims 1 to 6 for the Contracting States AT, GR and ES, both submitted on 17 August 1989 in response to a communication of the Examining Division. Claim 1 of the first set of claims read as follows:

"A compound having the formula I



wherein A is selected from



wherein R_1 , and R_2 are independently straight or branched alkyloxy of from one to four carbon atoms; and

wherein R is straight or branched alkyl of from one for four carbon atoms."

Claims 2 to 4 of this set related to specific compounds of formula I, Claim 5 was directed to corresponding pharmaceutical compositions, Claim 6 to the use of the claimed compounds for the manufacture of a pharmaceutical for inhibiting the intestinal absorption of cholesterol and Claim 7 to a method of preparing the compounds of Claim 1, while Claim 8 depended from Claim 7. The second set of claims comprised only method and use claims, Claims 1, 2 and 6 of this set being substantially identical with Claims 7, 8 and 6 of the first set. The Examining Division further considered an alternative wording of the respective Claims 1 which did not change their technical substance. The only reason stated for refusal was that the two sets of amended claims, in both their alternative wordings, did not meet the requirements of Article 123(2) EPC, because they contained a limitation of the possible positions of the substituents R_1 and R_2 which could not be unambiguously derived from the original application documents.

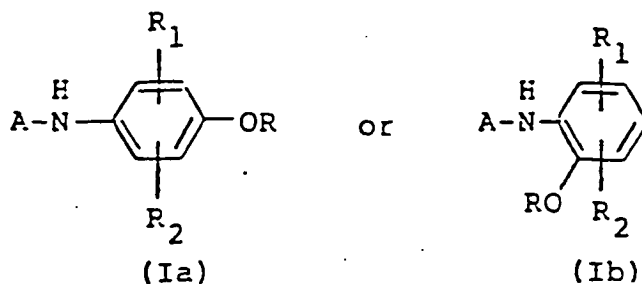
III. A Statement of Grounds of Appeal was received on 4 October 1990. The Appellant submitted that the claims at present on file were properly based on the application documents as filed, since the limitation to the particular positions of the substituents R_1 and R_2 was disclosed in all six compounds mentioned as being preferred in the application as filed. A person skilled in the art would therefore unambiguously understand that the substitution pattern now being claimed was the preferred one not only

in the context of the "preferred examples", wherein R₁ and R₂ were both methoxy or both ethoxy, but also in the broader context of the present claims.

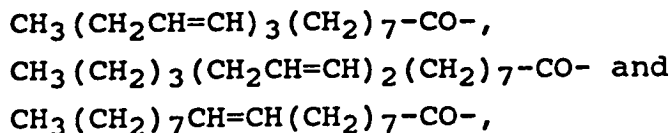
- IV. The Appellant requested that the decision under appeal be set aside and the patent be granted on the basis of one of the alternative wordings of the two sets of claims refused by the Examining Division. In case that the Board felt unable to allow the appeal, he requested oral proceedings. In a teletype received on 4 March 1992, after a telephone conversation with the Rapporteur, the Appellant further stated that he intended to abandon the patent after a decision on the allowability of the amendment, relating to a question of law of general interest, had been taken.

Reasons for the Decision

1. The appeal is admissible.
2. The only issue to be decided in the present appeal is whether or not the amended Claims in the wording recited in Part II above are in conformity with the requirements of Article 123(2) EPC. The amendment in dispute being the same for both sets of claims the reasons given below in respect of Claim 1 of the first set of claims are also applicable to Claim 1 of the second set.
 - 2.1 According to page 3, lines 18 to 35 of the description as filed the application related to a group of chemical compounds useful for inhibiting the intestinal absorption of cholesterol, having one of the following chemical structures Ia or Ib:



where A is selected from



where R₁ and R₂ are independently selected from straight or branched alkyl from one to four carbon atoms, straight or branched alkyloxy from one to four carbon atoms, or halogen,

and where R is straight or branched alkyl of from one to four carbon atoms.

More specifically, it was stated on page 4, lines 18 to 29, that "examples of preferred compounds" were the following:

(Z)-N-(2,4,6-Trimethoxyphenyl)-9-octadecenamide
 (Z,Z)-N-(2,4,6-Trimethoxyphenyl)-9,12-octadecadienamide
 (Z,Z,Z)-N-(2,4,6-Trimethoxyphenyl)-9,12,15-octadecatrienamide
 (Z)-N-(2,4,6-Triethoxyphenyl)-9-octadecenamide
 (Z,Z)-N-(2,4,6-Triethoxyphenyl)-9,12-octadecadienamide
 (Z,Z,Z)-N-(2,4,6-Triethoxyphenyl)-9,12,15-octadecatrienamide.

It is therefore true that the subject-matter of the amended claim in dispute, cited in paragraph II above, is

not described expressis verbis in the application as filed.

2.2 However, when answering the question whether or not the limitation of the original Claim 1 has any basis in the application as filed, a literal interpretation of the application is inappropriate, since the notional person skilled in the art, to whom any technical information is addressed, would not stick to the wording, but would consider the content of any document in the light of the common general knowledge which forms part of his professional skill. This person would, therefore, be aware of the fact that any possibility to render the general information given on page 3 of the original description more concrete implies a particular choice among the few substitution patterns comprised by the generic formula Ia, since, in practice, each substituent must be linked to a particular carbon atom of the phenyl ring. In the Board's judgment, therefore, he would necessarily have read the rest of the description with a view to obtaining further essential information. In this respect, a skilled person would have paid particular attention to the worked examples and other specific information, such as the list of the "preferred examples", since this is normally the basis from which this information can be derived. These "preferred examples" clearly disclose the 2,6-position of the substituents R_1 and R_2 , and, in the Board's judgment, no reason is derivable from the application as filed, why the person skilled in the art should have believed that the information concerning these positions was restricted to each individual compound in the list of the "preferred examples". On the contrary, such narrow and literal interpretation of the information content of the application ignores the skilled man's ability for abstract thought, which would lead him to the conclusion that the 2,4,6-substitution pattern for compounds of the formula Ia

stands in the forefront of consideration. Moreover, this pattern is clearly derivable from the general statements on page 3 of the description as filed, since the number of carbon atoms in the alkoxy groups may be from one to four, and is in no way restricted to one and two. The fact that this restriction is a feature of the preferred examples does not prevent the person skilled in the art from unambiguously inferring, from the description as filed, the class of compounds now claimed as a specific sub-class of the class of compounds comprised by the original Claim 1, since no reason exists why the substitution pattern of the phenyl ring should depend on the number of carbon atoms in the substituents.

- 2.3 The same considerations apply with respect to the Z-configuration around the carbon-carbon double bonds in the substituent A, which configuration is also a feature of all "preferred examples", since in respect of this feature, too, no reason exists why it should be relevant to the substitution pattern of the phenyl ring.
3. In these circumstances, it is not necessary to consider the alternative wording of present Claims 1 as proposed by the Appellant. However, the application is not yet ready for grant. It follows from the decision under appeal, that Claims 1 of the two sets of claims have not yet been finally examined, since in particular inventive step was only affirmed for the three individual compounds mentioned in Claims 2 to 4 of Set 1 and 3 to 5 of Set 2. Moreover, it is clear that Claim 7 of the first set and Claim 2 of the second set are marred by a contradiction, since they are directed to the production of the products of the respective Claims 1, and mention starting-materials which are unsuitable for obtaining these products. The Board therefore deems it appropriate to remit the case to the Examining Division for further prosecution.

During this further prosecution the Examining Division should also take account of the content of the second paragraph of the telecopy received on 4 March 1992 and may at first find out whether or not the Applicant wishes to proceed further with the application.

Order

For these reasons, it is decided that:

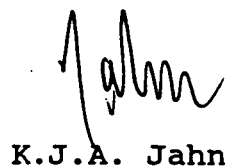
1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division for further prosecution.

The Registrar:



E. Gorgmaler

The Chairman:



K.J.A. Jahn