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File Number: T 853/91 - 3.3.1

Application No.: 87 311 465.6

Publication No.: 0 273 747

Title of invention: Penam derivatives, production and use thereof

Classification: C07D 499/00

DECISION
of 28 September 1992

Applicant: Suntory Kabushiki Kaisha

Headword: Penam/SUNTORY

EPC Rules 34(1)(c) and 67

Keyword: "Obviously irrelevant subject-matter (no)"
"Reimbursement of appeal fee (no)"



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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 853/91 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 28 September 1992

Appellant : Suntory Kabushiki Kaisha, also known as
Suntory Ltd
1-40, Dojimahama 2-chome
Kita-ku, Osaka 530 (JP)

Representative : Burford, Anthony Frederick et al
W.H. Beck, Greener & Co
7 Stone Buildings
Lincoln's Inn
London WC2A 3SZ (GB)

Decision under appeal : Decision of Examining Division 008 of the
European Patent Office dated 9 August 1991
refusing European patent application
No. 87 311 465.6 pursuant to Article 97(1) EPC.

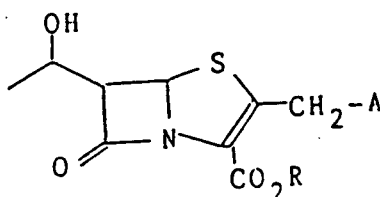
Composition of the Board :

Chairman : K.J.A. Jahn
Members : R.W. Andrews
J.-C. Saisset

Summary of Facts and Submissions

- I. European patent application No. 87 311 465.6 (publication No. 0 273 747) was filed on 24 December 1987. Present Claim 1 reads as follows:

"A Penam derivative represented by the general formula,



wherein R denotes a hydrogen atom or allyl group, and A denotes a 3-tetrahydrofuranyl group or a pharmaceutically acceptable salt thereof.

- II. By a decision dated 9 August 1991, the Examining Division refused the application on the ground that the presence in the description of the data relating to Compounds 18 to 20 was contrary to the requirements of Article 69(1) and Rule 34(1)(c) EPC.
- III. An appeal was lodged against this decision on 21 September 1991 and the prescribed fee duly paid. In his Statement of Grounds of Appeal filed on 21 September 1991, the Appellant argued that there was no prima facie reason for dismissing comparative data on the ground that the comparative compounds to which they relate are novel and that such data was relevant if it provided the reader with information pertinent to the claimed invention.

The Appellant also contended that the interpretation of the claims could not be compromised by the inclusion of the data relating to Compounds 18, 19 and 20 since the

claims clearly and unambiguously require the presence of a (3-tetrahydrofuranyl)methyl radical.

The Appellant also maintained that the skilled reader would understand the relevance of the data concerning Compounds 18, 29 and 20 and that the reason for including this data and the data concerning Compounds 12 to 17 would be absolutely clear to him.

- IV. The Appellant requests that the decision under appeal be set aside and that a patent be granted on the basis of the documents underlying the appeal. The Appellant also requests that the appeal fee be refunded.

Reasons for the Decision

1. The appeal is admissible.
2. Rule 34(1)(c) EPC requires that a European patent application shall not contain any statement or other matter obviously irrelevant or unnecessary under the circumstances.
 - 2.1 The subject-matter in question in the present case concerns data relating to the minimum concentration required to inhibit the growth of certain bacteria by the following compounds:
 - 18 Sodium (5R,6S)-6-(1'(R)-hydroxyethyl)-2-(2"-tetrahydrofuranyl)methylpenam-3-carboxylate;
 - 19 Sodium (5R,6S)-6-(1'(R)-hydroxyethyl)-2-(2"(R)-tetrahydrofuranyl)methylpenam-3-carboxylate; and

20 Sodium (5R,6S)-6-(1'(R)-hydroxyethyl)-2-(2"(S)-tetrahydrofuryl)methylpenam-3-carboxylate.

These three compounds fell within the scope of Claim 1 as originally filed. However, in the light of an objection under Article 56 EPC raised by the Examining Division in its communication of 2 October 1990, the Appellant filed an amended set of claims in which the radical (A) attached via a methylene group to the 2-position of the penam nucleus was restricted to a (3-tetrahydrofuryl) radical (cf. Claim 1 filed on 8 April 1991 and the claim in paragraph I above). This claim covers 6-(1-hydroxyethyl)-2-(3-tetrahydrofuryl)-methylpenam-3-carboxylic acid (including the various isomers thereof), pharmaceutically acceptable salts thereof and the ally ester thereof. Therefore, the extent of protection conferred by this claim is perfectly clear and the skilled addressee of the patent application would immediately realise that the Compounds 18, 19 and 20, although novel, do not fall within its ambit. In the light of this, it cannot be considered that the interpretation of the present claims is compromised by the inclusion of the data relating to these compounds.

2.2 The Examining Division decided that the subject-matter of the present Claim 1 involved an inventive step in the light of the surprising increase in antibacterial activity resulting from the replacement of the 3-tetrahydrofuryl group of the closest prior art compounds disclosed in EP-A-0 199 446 (document (1)); cf. Compounds 15 and 16 of the present application and Examples 47 and 48 of document (1) by a (3-tetrahydrofuryl)methyl group (compound 5 of the amended application).

A skilled person studying the data concerning the minimum inhibition concentrations would consider the above-mentioned increase in antibacterial activity even more

surprising in view of the fact that a similar increase does not occur if the 2-tetrahydrofuryl group of the prior art Compounds 14 and 17 (cf. Examples 39(1) and 45 of document (1)) is replaced by a (2-tetrahydrofuryl)methyl radical (cf. Compounds 18, 19 and 20). Similarly, the skilled person would be equally surprised to discover from this data that the antibacterial activity of the present compounds against all of the tested bacteria is at least as good as that of the corresponding (2-tetrahydrofuryl)-methyl compound, and in most cases is substantially better, whereas this is not the case when comparing the prior art 3-tetrahydrofuryl and 2-tetrahydrofuryl compounds.

In these circumstances the Board finds that the data relating to Compounds 18, 19 and 20 is not obviously irrelevant and therefore cannot represent prohibited matter within the meaning of Rule 34(1)(c) EPC.

Moreover, the retention of the disputed subject-matter in the published patent specification may be of benefit to the proprietor of the patent in any eventual proceedings in the designated Contracting States.

2.3 The skilled person would consider that the reason for including the MIC data relating to Compounds 18, 19 and 20 was to provide him with information relating to how this property varies with changes in the substituent in the 2-position in this particular class of penam derivatives. The skilled person would be particularly interested in Compounds 18 to 20 irrespective of the fact that they are novel compounds, since those are more closely structurally related to the compounds in accordance with Claim 1 than any of the Compounds 12 to 17.

3. In accordance with Rule 67 EPC, reimbursement of an appeal fee shall be ordered when a Board deems an appeal to be

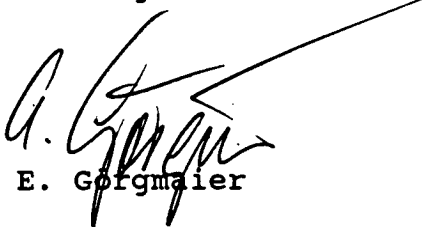
allowable if such an appeal is equitably by reason of a substantial procedural violation. In the Board's view, the Examining Division's refusal of the application was based on a too narrow and restricted interpretation of Rule 34(1)(c). However, the mere fact that the Board does not agree with this interpretation cannot be regarded as a substantial procedural violation which would justify the reimbursement of the appeal fee.

Order

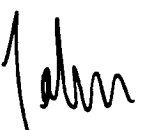
For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Examining Division with the order to grant a patent on the basis of the documents underlying the decision under appeal.
3. The request for the reimbursement of the appeal fee is rejected.

The Registrar:


E. Gorgmaier

The Chairman:


K.J.A. Jahn