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**D E C I S I O N**  
of 16 September 1997

**Case Number:** T 0205/95 - 3.3.1

**Application Number:** 91304401.2

**Publication Number:** 0457586

**IPC:** C07D 495/04

**Language of the proceedings:** EN

**Title of invention:**

4-alkylamino-6-(C<sub>3-5</sub>-hydrocarbyl)thieno [2,3-b] thiopyran-2-sulfonamide-7, 7-dioxides

**Applicant:**

Merck & Co., Inc.

**Opponent:**

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**Headword:**

Sulfonamide dioxides/MERCK

**Relevant legal provisions:**

EPC Art. 54(3)

**Keyword:**

"Novelty (yes) - after amendment"

**Decisions cited:**

T 0007/86, T 0012/90

**Catchword:**

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Case Number: T 0205/95 - 3.3.1

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 16 September 1997

**Appellant:**

Merck & Co., Inc.  
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Rahway  
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**Representative:**

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**Decision under appeal:**

Decision of the Examining Division of the  
European Patent Office posted 21 October 1994  
refusing European patent application  
No. 91 304 401.2 pursuant to Article 97(1) EPC.

**Composition of the Board:**

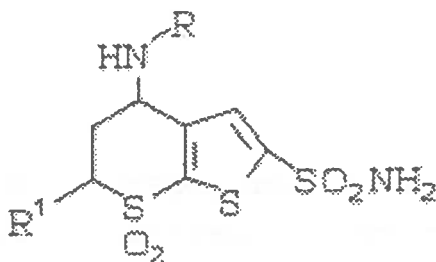
**Chairman:** A. J. Nuss  
**Members:** P. P. Bracke  
S. C. Perryman

## Summary of Facts and Submissions

- I. The appeal lies from the Examining Division's decision, dispatched on 21 October 1994, refusing European patent application No. 91 304 401.2, published as EP-A-0 457 586, due to lack of novelty.

The Examining Division was of the opinion that the subject-matter described in document (A), EP-A-0 453 288, overlapped with the one claimed in the set of claims filed with letter of 25 July 1994, with Claim 1 reading:

- "1. A compound of structural formula:



or diastereomers or enantiomers or mixtures thereof or an ophthalmologically acceptable salt thereof wherein:

R is ethyl, n-propyl or isopropyl; and

- R<sup>1</sup> is (a) C<sub>3-5</sub> alkyl,  
(b) C<sub>3-5</sub> alkenyl, or  
(c) C<sub>3-5</sub> alkynyl,

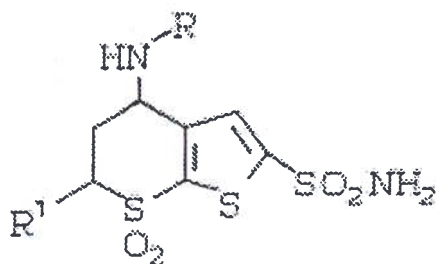
with the exception of the compound **trans-5,6-dihydro-4-isopropylamino-6-propyl-4H-thieno[2,3-b]thiopyran-2-sulphonamide-7,7-dioxide.**" (emphasis added)

More particularly, in the Examining Division's view, the disclaimer (see emphasised text) was not suitable to make the claimed subject-matter novel, since the

teaching of document (A) enabled a skilled person to prepare at least those claimed compounds in which R and R<sup>1</sup> are C<sub>1-4</sub> alkyl (reference was made to T 12/90 of 23 August 1990).

II. The Appellant filed with telefax of 21 August 1997 a set of 9 claims, reading:

"1. A compound of structural formula:



or diastereomers or enantiomers or mixtures thereof or an ophthalmologically acceptable salt thereof wherein:

R is ethyl, n-propyl or isopropyl; and

R<sup>1</sup> is (a) C<sub>5</sub> alkyl,

(b) C<sub>3-5</sub> alkenyl,

(c) C<sub>3-5</sub> alkynyl, or

(d) n-propyl, where R is ethyl or n-propyl."

"2. The compound of Claim 1 wherein R is ethyl and R<sup>1</sup> is n-propyl."

"3. The compound of Claim 1 wherein R is n-propyl and R<sup>1</sup> is n-propyl."

"4. The compound of Claim 1 wherein R is ethyl and R<sup>1</sup> is allyl."

"5. The compound of Claim 2 or Claim 4 which is the trans (S,S) enantiomer or cis (S,R) enantiomer.

"6. The compound of Claim 3 which is the trans ( $\pm$ ) diastereomer."

"7. The compound of Claim 3 which is the trans (-) enantiomer."

"8. An ophthalmological formulation for the treatment of ocular hypertension and glaucoma comprising an ophthalmologically acceptable carrier and a compound of any one of Claims 1 to 7."

"9. The use of a compound of any one of Claims 1 to 7 for the manufacture of a medicament for treating ocular hypertension or glaucoma."

The Appellant submitted that these claims were novel over document (A), since the compounds according to Claim 1 having as R<sup>1</sup> a group (a), (b) or (c) do not overlap in a generic sense with the disclosure of document (A) and neither of the two compounds covered by group (d) is, according to the principle described in T 7/86 (OJ EPO 1988, 381), specifically disclosed in document (A).

III. With telefax of 21 August 1997 the Appellant requested that the appealed decision be set aside and that a patent be granted on the basis of the revised Claims 1 to 9 submitted with that telefax.

## Reasons for the Decision

1. The appeal is admissible.
2. *Amendments*

Claim 1 essentially differs from Claim 1 as originally filed by the fact that R<sup>1</sup> may be

- (a) n-propyl, where R is ethyl or n-propyl, which compounds were both disclosed in the originally filed application (see example 1 and the first and second compound in any of Tables I, II and III), or
- (b) C<sub>5</sub> alkyl, which compounds were disclosed in Claim 1 of the application as originally filed by C<sub>3-5</sub> alkyl.

Claims 2 and 4 correspond with original Claims 2 respectively 3 and, the compound defined in Claim 3 was disclosed as the first and second compound in Table I and the second compound in Table II, whereas the enantiomers defined in Claim 5 were described on page 5, lines 7 to 13 (page 3, lines 26 to 29, of the published version), the diastereomer and the enantiomer defined in Claim 6 respectively 7 correspond with the first respectively second compound of Table I of the originally filed application and the Claims 8 and 9 are duly supported by original Claims 9 and 10.

3. *Novelty*

The application in suit was mainly refused because the disclaimer in the then pending Claim 1 (see the emphasized part of the Claim presented in point I above) was considered not to be suitable to remove the

novelty destroying overlap between the claimed subject-matter and the disclosure of document (A), which belongs to the state of the art according to Article 54(3) EPC.

Since the objected disclaimer no longer figures in present Claim 1 and since by restricting the alkyl group in the definition of R<sup>1</sup> to C<sub>5</sub> alkyl and, where R is ethyl or n-propyl, to n-propyl the overlap with the disclosure of document (A) has been removed, the main reason for refusing the patent application no longer exists.

Since document (A) does not describe compounds as defined in present Claim 1 wherein R<sup>1</sup> is C<sub>5</sub> alkyl, C<sub>3-5</sub> alkenyl or C<sub>3-5</sub> alkynyl and since the two individual compounds according to present Claim 1, wherein R is ethyl or n-propyl and R<sup>1</sup> is n-propyl are not specifically mentioned therein, Claim 1 is novel over document (A). This conclusion is in conformity with the jurisprudence of the Boards of Appeal of the EPO, ruling that a document disclosing polysubstituted chemical substances does not disclose each individual compound if the individual compounds can only be derived from the generic disclosure by selecting one substituent from each of two or more lists of substituents (see T 7/86 OJ EPO 1988, 381, point 5.1 of the reasons and T 12/90 of 23 August 1990, point 3.3 of the reasons).

Moreover, since none of the individual compounds defined in Claims 2 to 7 were disclosed in document (A) and Claims 8 and 9 derive their novelty from the novelty of the compounds defined in Claims 1 to 7, the Board concludes that also these claims are novel over document (A).

4. Since the appealed decision only concerned the novelty of the claimed subject-matter over the teaching of document (A), the Board considers that it would not be appropriate at the present stage of the proceedings to deal with the novelty over other documents and with the further requirements of the EPC, such as the issue of inventive step, as for the Board to do so would deprive the Applicant of the possibility of having these issues decided by two instances. Therefore, the Board has decided to invoke its power under Article 111(1) EPC and to remit the case to the Examining Division for further prosecution.

#### Order

#### For these reasons it is decided that:

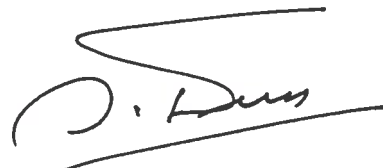
1. The decision under appeal is set aside.
2. The matter is remitted to the Examining Division for further consideration on the basis of the request submitted with telefax on 21 August 1997.

The Registrar:



E. Gorgmaier

The Chairman:



A. Nuss