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D E C I S I O N
of 11 December 1998

Case Number: T 1052/97 - 3.3.1

Application Number: 92830427.8

Publication Number: 0526434

IPC: C07D 235/26

Language of the proceedings: EN

Title of invention:
Benzimidazolone derivatives as 5-HT1A and 5-TH2 antagonists

Applicant:
Boehringer Ingelheim Italia S.p.A.

Opponent:
-

Headword:
Benzimidazolone/BOEHRINGER

Relevant legal provisions:
EPC Art. 123(2)

Keyword:
"Amendment of a generic chemical formula - admissible limitation"

Decisions cited:
T 0583/93, T 0288/92

Catchword:
-



Case Number: T 1052/97 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 11 December 1998

Appellant:

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Representative:

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Decision under appeal:

Decision of the Examining Division of the
European Patent Office posted 12 June 1997
refusing European patent application
No. 92 830 427.8 pursuant to Article 97(1) EPC.

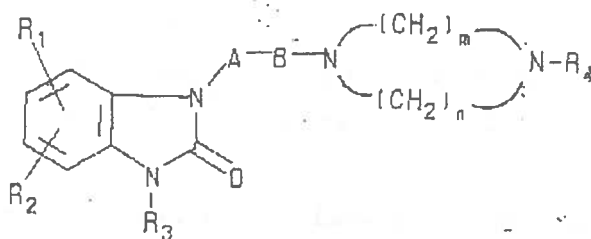
Composition of the Board:

Chairman: A. J. Nuss
Members: J. M. Jonk
W. Moser

Summary of Facts and Submissions

- I. This appeal lies from the Examining Division's decision refusing the European patent application No. 92 830 427.8 (publication No. 0 526 434) on the ground that the subject-matter as claimed did not comply with the requirements of Article 123(2) EPC.
- II. The application as originally filed comprised 18 claims, Claim 1 of which read as follows:

"Compounds of general formula I



wherein

R_1 and R_2 may be at the same time or not a hydrogen atom, halogen, trifluoromethyl, C_{1-6} alkyl, C_{1-6} alkoxy, C_{1-6} alkylthio, C_{1-6} acyl, carboxyl, C_{1-6} alkoxy carbonyl, hydroxy, nitro, amino optionally C_{1-4} alkyl N-mono or di-substituted, C_{1-6} acylamino, C_{1-6} alkoxy carbonylamino, carbamoyl optionally C_{1-4} alkyl N-mono or di-substituted, cyano, C_{1-6} alkylsulphinyl, C_{1-6} alkylsulphonyl, amino sulphonyl optionally C_{1-4} alkyl N-mono or di-substituted, C_{1-4} alkyl N-mono or di-substituted aminosulphonylamino, aminosulphonylamino;

- R₃ is hydrogen, C₁₋₆ alkyl, C₂₋₆ alkenyl or C₂₋₆ alkynyl;
- A is -CO- or -CONH- or it is absent;
- B is a straight or branched, saturated or unsaturated C₂₋₆ alkyl;
- m and n are both independently an integer from 1 to 3;
- R₄ is an aryl, aralkyl, a heteroaryl or heteroaralkyl group, each group being optionally substituted by one or more substituents selected from halogen, trifluoromethyl, cyano, C₁₋₃ alkoxy, C₁₋₄ alkyl and acid addition salts thereof."

III. The decision under appeal was based on amended Claim 1 as filed on 7 October 1996 and Claims 2 to 18 as originally filed.

According to this decision, Claim 1 differed from Claim 1 as originally filed by

- the deletion of all the meanings for the groups R₁ and R₂ except hydrogen, halogen, C₁₋₆ alkyl and C₁₋₆ alkoxy,
- the deletion of the meaning "alkynyl" for the group R₃,
- the deletion of the options "branched" and "unsaturated" for the group B,
- the replacement of the range 1 to 4 by the range 1 to 3 for m and n, and

- the restriction of R_4 to phenyl, naphthyl, benzodioxanyl or pyrimidinyl, each group being optionally substituted by one or more substituents selected from halogen, trifluoromethyl, and C_{1-3} alkoxy.

IV. The Examining Division held that the subject-matter of Claim 1 contravened Article 123(2) EPC, because the definition of the group of compounds resulting from an arbitrary selection of subgroups and substituents was not supported by the patent application as filed.

In this context, the Examining Division held that in view of the Decision T 583/93, a skilled reader could not derive from the description of the patent application in suit whether or not deleted meanings were essential features which had to be maintained in the claim. Moreover, they considered that, in view of the decision T 288/92, point 3.4, the generalisation of specific features of exemplified compounds also contravened the requirements of Article 123(2) EPC.

Since the claims on file were considered not to be allowable under Article 123(2) EPC, they did not examine novelty and inventive step.

V. During the appeal proceedings, the Appellant filed new Claims 1 to 18 on 10 September 1998.

Claim 1 of this set of claims corresponded to the originally filed Claim 1, except that R_1 to R_4 , A, B, m and n in formula I were defined as follows:

R_1 and R_2 may be at the same time or not a hydrogen, halogen, C_{1-6} alkyl or C_{1-6} alkoxy;

R_3 is hydrogen, C_{1-6} alkyl or C_{2-6} alkenyl;

A is -CO- or -CONH- or is absent;

B is a straight, saturated C₂₋₆ alkyl;

m and n are both 2;

R₄ is phenyl, benzyl or naphthyl each group being optionally substituted by one or more substituents selected from trifluoromethyl, fluoro, chloro, methoxy, methyl, ethyl, ethoxy, or

R₄ is benzodioxane or pyrimidine.

VI. The Appellant argued that the subject-matter of this new set of claims met the requirements of Article 123(2) EPC, since the substituents R₁ to R₄ and of A, B, m and n were restricted to definitions derivable by the skilled person from the originally filed patent application. He emphasised that the restriction was not arbitrary, but merely represented an allowable delimitation to the "core" of the invention. Moreover, he argued with respect to the considerations by the Examining Division regarding the decisions T 583/93 and T 288/92, that a skilled person trying to determine the essential features of the claimed invention would firstly consider the examples of the patent application, and that the last mentioned decision did not apply to the present case.

VII. The Appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the set of claims as filed on 10 September 1998, or that the case be remitted to the first instance for further prosecution.

Reasons for the decision

1. The appeal is admissible.
2. The issue to be dealt with is whether or not the subject-matter of the restricted claims contravenes Article 123(2) EPC.
3. The group of benzimidazol-2-one derivatives as defined by formula (I) in present Claim 1 differs from the originally claimed group of compounds in that
 - (a) the meaning of the bridging subgroup "-A-B-" is amended by restricting the meaning of "B" to straight, saturated alkylene groups, thereby deleting branched and/or unsaturated alkylene groups;
 - (b) the heterocyclic group connected to "B" is restricted to a piperazine group, i.e. a heterocyclic group as defined in formula (I) wherein m and n are both 2; and
 - (c) R₁ to R₄ are delimited to the substituents as indicated in present Claim 1.
- 4.1 The present definition of "B" in formula I as a straight, saturated C₂₋₆ alkylene group is supported by page 4, lines 5 and 6, of the patent application as filed. Moreover, as can be derived from the examples (i.e. Compounds 1 to 36) and the disclosure of the preferred compounds (page 19, line 26 to page 20, line 26), this definition represents a preferred embodiment of the claimed invention.

- 4.2 The present definition of m and n in formula I restricting the heterocyclic group to a piperazine group (implying necessarily that m and n are both 2) is based on page 6, lines 6 to 8, of the originally filed specification. Having regard to the examples which, with the exception of Compounds 31 and 36, all relate to compounds having a piperazine ring and in view of the passage of the originally filed specification indicating the most preferred compounds (page 19, line 26 to page 20, line 26), it is clear that this definition also represents a preferred embodiment.
- 4.3 The present definition of the substituents R_1 to R_4 is supported by page 3, lines 5 and 6 (meaning of R_1 and R_2); page 4, lines 2 to 4 (meaning of R_3); page 5, line 26 to page 6, line 5 (meaning of R_4); and the examples of the originally filed application.
- 4.4 Therefore, in the Board's judgment, the group of benzimidazol-2-one compounds as defined in present Claim 1 does not contravene Article 123(2) EPC, since it represents nothing else than a group of preferred compounds already disclosed in the application as filed.
- 4.5 In this context, the Board observes that the Examining Division's point of view that a skilled reader of the present patent application could not derive from its description whether or not deleted meanings were essential features which had to be maintained in Claim 1 cannot be followed, because a skilled reader looking for essential features of the disclosed invention would firstly consider the examples representing the experimental work actually done and the embodiments indicated in the description as the preferred ones. As indicated above, in the Board's judgment, he would have come to the conclusion that the

subject-matter as claimed in present Claim 1 actually forms the core of the invention as set out in the application as filed.

Moreover, the Board notes that in the present case the substituents and subgroups as defined in present Claim 1 do not result from an unallowable generalisation of particular examples. Actually, as follows from the above considerations, they are disclosed in the application as filed. In this context, the Board also notes that the decision T 288/92, point 3.4, relied on by the Examining Division, does not apply to the present case, because in that particular case a substituent, i.e. 2,6-difluorophenyl, was only disclosed in the patent application as part of the structure of certain triazolopyrimidines without any indication in the specification that it could also form part of a group of compounds not containing the triazolopyrimidine ring system.

5. Concerning present Claims 2 to 18, the Board considers that:

Claim 2 corresponds to the originally filed Claim 2;

Claim 3 is supported by the originally filed Claim 3, and page 44, lines 5 and 6 (regarding the last compound);

Claims 4 to 14 are the same as the corresponding claims of the application as filed;

Claim 15 is supported by the originally filed Claim 15; and

Claims 16 to 18 are the same as the corresponding claims of the present application as filed.

6. Thus, having regard to the above considerations the Board concludes that the present set of claims complies with the requirement of Article 123(2) EPC, because its subject-matter is clearly supported by the application as filed.

7. As the Examining Division did not decide on the issues of novelty and inventive step, the Board makes use of its power under Article 111(1) to remit the case to the Examining Division for further prosecution.

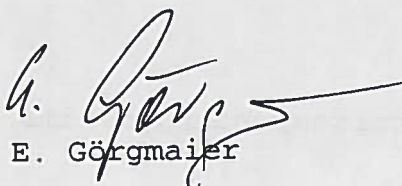
Order

For these reasons, it is decided that:

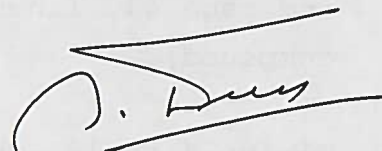
1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

The Registrar:


E. Görgmaier

The Chairman:


A. Nuss