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D E C I S I O N
of 6 September 2001

Case Number: T 0772/98 - 3.3.1

Application Number: 94906210.3

Publication Number: 0682658

IPC: C07D 257/04

Language of the proceedings: EN

Title of invention:

Process for preparing tetrazole-5-carboxylic acid derivatives

Applicant:

SMITHKLINE BEECHAM PLC

Opponent:

-

Headword:

Tetrazole/SMITHKLINE BEECHAM PLC

Relevant legal provisions:

EPC Art. 54, 111(1), 113(2)
EPC R. 67

Keyword:

"Novelty (no) - claimed product inevitable result of known process - interpretation of technical feature"
"Remittal (no) - claim not novel"
"Auxiliary request (not allowable) - amorphous - text neither submitted nor agreed"

Decisions cited:

T 0666/89

Catchword:

-



Case Number: T 0772/98 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 6 September 2001

Appellant: SMITHKLINE BEECHAM PLC
New Horizons Court
Brentford
Middlesex TW8 9EP (GB)

Representative: Waters, David Marin, Dr.
Smithkline Beecham plc
Corporate Intellectual Property
Two New Horizons Court
Brentford
Middlesex TW8 9EP (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 1 April 1998
refusing European patent application
No. 94 906 210.3 pursuant to Article 97(1) EPC.

Composition of the Board:

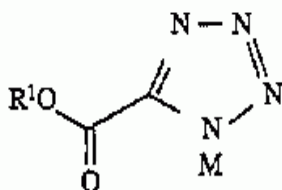
Chairman: A. J. Nuss
Members: R. Freimuth
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal lodged on 28 May 1998 lies from the decision of the Examining Division posted on 1 April 1998 refusing European patent application No. 94 906 210.3 (European publication No. 682 658), which was filed as international application published as WO 94/18178.
- II. The decision of the Examining Division was based on claims 1 to 4 submitted with the letter dated 17 December 1997 according to the then pending request. Independent claim 4 read as follows:

"4. A compound of the structure (V):

(V)



in which R¹ is ethyl and M is sodium, isolated in solid form."

- III. The Examining Division held that the subject-matter of claim 4 lacked novelty in view of document

(1) EP-A-323 885.

That document disclosed the claimed sodium salt of ethyl tetrazole-5-carboxylate in the form of an intermediate in the reaction mixture. This compound was precipitated from that reaction mixture, i.e. was in solid form, since the solvent and the temperature of the reaction mixture in document (1) were the same as

in the preparation process of the present application. The feature "isolated" could not confer novelty to claim 4 which was directed to a product as such, as it was a process characteristic which had no meaning for the characterisation of a product *per se*.

IV. The Appellant (Applicant) quoted from his written submissions made before the Examining Division. He argued that process claims were of little value because the sodium salt of ethyl tetrazole-5-carboxylate was likely to be manufactured by one company and sold to another company to form the free tetrazole carboxylate and to use this compound. Thus, it would be relatively easy to avoid infringement. The Appellant could not understand why the Examining Division considered claim 4 to lack novelty. Even if the prior art described suspensions of the sodium salt of ethyl tetrazole-5-carboxylate it did not describe it in an isolated form. The Appellant believed that the use of the parameter "isolated" was perfectly clear and that the invention could not be adequately defined in any other way.

The Appellant objected that the Examining Division "did not give any reasons for its decision" under appeal and did not answer the simple question "where the claimed salt isolated in solid form is described in the prior art". Not responding to that essential point, thus, made an appeal necessary, and as a consequence the reimbursement of the appeal fee was due.

V. The Appellant requested in writing that the decision under appeal be set aside and that the application be granted in its current form or auxiliarily, that the case be remitted to the Examining Division for further

prosecution or that the application be granted with only the allowable claims, and furthermore requested the reimbursement of the appeal fee.

- VI. Oral proceedings were held on 6 September 2001 in the absence of the Appellant who, after having been duly summoned, informed the Board that he would not attend. At the end of the oral proceedings the decision of the Board was given orally.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Novelty*

- 2.1 The only substantive issue arising from this appeal is whether or not the subject-matter of claim 4 is novel over document (1), which is stated in the decision under appeal as being the sole ground for refusal of the application.

- 2.2 Document (1) discloses at page 2, lines 45 to 56 the process of reacting ethyl cyanofornate with sodium azide in the presence of trifluoroacetic acid. This reaction process of the prior art is identical to the process described at page 3 and in example 1 of the present application for preparing the sodium salt of ethyl tetrazole-5-carboxylate. Consequently, the same compound as that claimed is the result of the reaction process disclosed in document (1). That finding has never been contested by the Appellant.

2.3 According to the reaction process specifically disclosed in document (1) the reaction mixture of ethyl cyanofornate and sodium azide is heated (page 2, line 47) in the solvent 2,6-lutidine (page 2, line 55) and is then cooled to room temperature (page 2, line 48). Example 1 of the present application operates that reaction process in the same way, namely by heating the reaction mixture in the same solvent 2,6-lutidine and then cooling it to room temperature; in example 1, this operation results in the precipitation of white crystals, i.e. in the solid form of the sodium salt of ethyl tetrazole-5-carboxylate. Since the relevant operating conditions indicated in document (1) comply with those described in example 1 of the present application, the specific reaction process of that prior art document must inevitably result also in the precipitation of the solid form of that compound. According to established jurisprudence of the Boards of Appeal a reaction process specifically described in a prior art document makes available to the public the product not explicitly identified when this product is the inevitable result of that process (see decision T 666/89, OJ EPO 1993, 495, point 6 of the reasons). In the present case, thus, the process specifically disclosed in document (1) makes available to the public the solid form of the sodium salt of ethyl tetrazole-5-carboxylate as this form is the inevitable product resulting from that process.

2.4 With respect to the further feature indicated in claim 4 that the sodium salt of ethyl tetrazole-5-carboxylate is "isolated" in the solid form, the Appellant has neither alleged, let alone provided any evidence of, any generally applicable definition for the expression "isolated" as such nor is the Board

aware of any. Thus, that feature cannot be accorded any definition having general validity.

In any case, here the description of the present application specifies the meaning of the term "isolated" at page 4, lines 6 to 9 which reads: "In the present process, the salts (IV) readily precipitate out from the mixture, leaving behind undesirable hazardous by-products (and any unreacted starting materials which may be re-used in subsequent reactions) and...". The salts of general formula (IV) comprise the individual salt according to present claim 4 (page 3, line 15). Thus, in brief, the expression "isolated" in the sense of the present application is to be construed as meaning merely to precipitate the salt from the reaction mixture.

As set out in detail in point 2.3 above, document (1) already discloses the precipitation of the solid form of the sodium salt of ethyl tetrazole-5-carboxylate from the reaction mixture. Thus, the solid form of the compound made available to the public by that document is "isolated" in the sense of the present application.

2.5 To summarize, document (1) discloses the sodium salt of ethyl tetrazole-5-carboxylate isolated in solid form in the sense of the present application, i.e. the subject-matter of claim 4. For these reasons, the Appellant's allegation that the isolated solid form of this compound was not described in that document, is not supported by the facts.

3. The Board concludes from the above, that document (1) anticipates the subject-matter of claim 4. Since a decision can only be taken on a request as a whole,

none of the further claims need to be examined. In these circumstances, the Appellant's main request must be rejected for lack of novelty pursuant to Articles 52 (1) and 54 EPC.

Auxiliary requests

4. The Appellant requested subsidiarily that the case be remitted to the Examining Division for further prosecution. However, to order the first instance to proceed on the basis of the only pending claims, i.e. claims 1 to 4 according to the main request, makes no sense as the Board has found claim 4 to lack novelty (see point 3 above). For these reasons, the Board exercises its discretionary power conferred to it by Article 111(1), second sentence, first alternative, EPC to rule itself within the competence of the department of first instance on the non-compliance of the present claims with the requirements of the EPC with the consequence that Appellant's first auxiliary request is rejected as well.

5. Furthermore, the Appellant requested subsidiarily that the application be granted with only the allowable claims, without identifying what these claims are supposed to be.

Article 113(2) EPC stipulates that the European Patent Office shall consider and decide upon the application only in the text submitted to it, or agreed by the Appellant-Applicant. In the present auxiliary request, the Appellant neither submitted nor agreed to a specific text of the application, i.e. a set of claims to be considered "allowable" in the Appellant's sense. The EPC, however, entrusts the Board only with the

power to decide on a specific text submitted to it, or agreed by the Appellant-Applicant, whereas it is up to the Appellant-Applicant to formulate on its own any text of a claim he wishes a patent to be granted with. An amorphous request not identifying the claims sought but leaving it to the Board to identify "allowable" claims for itself is not consistent with the requirements of the EPC. For these reasons, the Appellant's second auxiliary request must be treated as inadmissible.

Reimbursement of the appeal fee

6. It is a prerequisite of Rule 67 EPC that the appeal be allowed in order that reimbursement of the appeal fee can be ordered. Since in the present case the appeal is unsuccessful, already for this reason alone the Appellant's request for the reimbursement of the appeal fee fails.

Nevertheless, the Appellant's allegation that the Examining Division did not give "any reasons for its decision", which would amount to a substantial procedural violation, needs consideration. This is a serious allegation but the facts do not bear it out. The decision of the first instance comprises a section headed "Reasons for the decision" wherein the Examining Division gave detailed reasons for its finding that claim 4 lacked novelty vis-à-vis document (1). The Appellant may not agree with that finding nor with the reasons given, but a divergence of view between the Examining Division and the Appellant on the substantive issue of novelty does not amount to any procedural violation.

Furthermore, the Appellant alleged that the Examining Division did not respond to the Appellant's simple question "where the claimed salt isolated in solid form is described in the prior art", thus making an appeal necessary. The Board observes that the EPC does not provide the Appellant with any legal basis for urging the Board to direct the Examining Division to respond to the Appellant's "question". In any case, the Board considers that the Examining Division answered this question in the reasons given in the decision under appeal, albeit not in the Appellant's favour. An appeal was thus necessary only because the Appellant wished to challenge the reasoned finding of lack of novelty of the Examining Division.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for the reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

N. Maslin

A. Nuss