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**Datasheet for the decision
of 18 February 2011**

Case Number: T 1719/08 - 3.3.01

Application Number: 01929361.2

Publication Number: 1282615

IPC: C07D 311/60

Language of the proceedings: EN

Title of invention:

Chroman derivatives as estrogenic compounds

Applicant:

N.V. Organon

Headword:

Chroman derivatives/ORGANON

Relevant legal provisions:

EPC Art. 123(2), 84, 83

Relevant legal provisions (EPC 1973):

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Keyword:

"Remittal of main request after definition of the term

"prodrug"

"Amendments allowable (yes)"

"Clarity (yes)"

"Sufficiency of disclosure (yes)"

Decisions cited:

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Catchword:

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Case Number: T 1719/08 - 3.3.01

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 18 February 2011

Appellant: N.V. Organon
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NL-5349 AB Oss (NL)

Representative: Kraak, Hajo
N.V. Organon
Global Patent Department
P.O. Box 20
NL-5340 BH Oss (NL)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 9 April 2008
refusing European patent application
No. 01929361.2 pursuant to Article 97(2) EPC.

Composition of the Board:

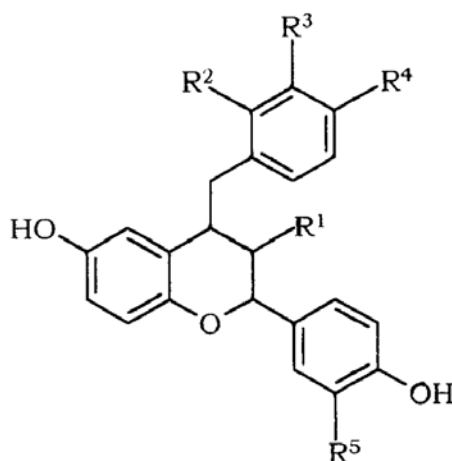
Chairman: P. Ranguis
Members: L. Seymour
L. Bühler

Summary of Facts and Submissions

I. This appeal lies from the decision of the examining division refusing the European patent application No. 01 929 361.2, based on international application WO 01/64665, under Article 97(2) EPC.

II. Claim 1 of the application documents forming the basis of the decision under appeal, filed with letter of 9 January 2007, reads as follows:

"1. A chroman compound having formula 1



Formula 1

in which

R¹ is (1C-4C)alkyl, (2C-4C)alkenyl or (2C-4C)alkynyl,
and independently R¹ has a cis-orientation in
relation to the exocyclic phenyl group at the 2-
position of the skeleton;

R⁴ is H, Hal, CF₃, OH or (1C-2C)alkyloxy;

R², R³, and R⁵ are independently H, Hal, CF₃,

(1C-4C)alkyl, (2C-4C)alkenyl or (2C-4C)alkynyl;

or a prodrug thereof."

In its decision, the examining division considered that the application did not comply with the requirements of Articles 83 and 84 EPC, owing to the presence of the feature "a prodrug thereof" in claim 1 of the refused request.

- III. The appellant (applicant) lodged an appeal against this decision, and requested that the decision of the examining division be set aside and that a patent be granted on the basis of the application documents forming the basis of the decision under appeal. The appellant further requested reimbursement of the appeal fee. Oral proceedings were requested in the case that the board intended to decide otherwise.
- IV. In the communication sent as an annex to the summons to oral proceedings, the board expressed its preliminary opinion on the allowability of the requests on file in view of the requirements of Articles 83 and 84 EPC.
- V. With its letter of 17 January 2011, the appellant submitted a main request and an auxiliary request to replace that previously on file.

The main request differed from the previous main request in that the feature "a prodrug thereof" in claim 1 had been replaced by the following definition:
"a prodrug thereof
wherein the hydroxy groups at the 6 position and the 4-phenyl position of the skeletons of Formula 1 are substituted by alkyloxy, alkenyloxy, acyloxy, aroyloxy, alkoxy-carbonyloxy, sulfonyl groups or phosphate groups,

wherein alkyl is methyl, ethyl, propyl, isopropyl, butyl, sec-butyl, tert-butyl, hexyl, octyl, capryl, or lauryl;

alkenyl is ethenyl or 2-butenyl;

acyl is 1-oxoalkyl;

aroyl is benzoyl".

In claim 1 of the auxiliary request, the feature "or a prodrug thereof" was deleted.

- VI. With its letter of 1 February 2011, following a further communication by the board, the appellant withdrew its requests for oral proceedings and reimbursement of the appeal fee. In addition, the appellant resubmitted the main request filed with its letter of 17 January 2011 together with a description adapted thereto.
- VII. By letter of 8 February 2011, the board informed the appellant that the oral proceedings due to take place on 1 March 2011 were cancelled.
- VIII. The appellant (applicant) requested in writing that the decision under appeal be set aside and that a patent be granted on the basis of the application documents filed as main request with letter of 1 February 2011, or alternatively on the basis of the auxiliary request filed with letter of 17 January 2011.

Reasons for the Decision

1. The appeal is admissible.

2. *Main request - Amendments (Article 123(2), Rule 139 EPC)*

The definition of the term "prodrug" introduced into claim 1 finds its basis on page 2, lines 24 to 29, and page 3, lines 22 to 33, of the application as originally filed.

For the sake of completeness, it is noted that the definition "R⁴ is H", introduced during the examination procedure and not objected to by the examining division, is to be regarded as being an obvious correction under Rule 139 EPC, in view of dependent claim 2 and the numerous examples in the application as originally filed wherein R⁴ is H (see Scheme 3 and Example 5).

Accordingly, the amended application documents meet the requirements of Article 123(2) EPC.

3. *Main request - Clarity (Article 84 EPC)*

The expression "a prodrug thereof" objected to by the examining division has now been defined in a precise manner in terms of specific substituents at the two hydroxyl groups depicted in formula 1 (cf. point V above). In view of these clear structural features, the person skilled in the art is immediately able to distinguish the chemical compounds belonging to the claimed group from those not encompassed by it.

The definition of "prodrug" in the description has been adapted accordingly (see page 2, line 24 to page 3, line 20, filed with the letter 1 February 2011).

Thus, the main request overcomes the objections under Article 84 EPC raised by the examining division.

4. *Main request - Sufficiency of disclosure (Article 83 EPC)*

In view of the information provided in the description of the application as filed, the board is satisfied that the compounds defined in claim 1 may be prepared without undue burden. Moreover, in the absence of evidence to the contrary, the board sees no reason to doubt that the compounds now encompassed by the term "prodrug" actually fulfil the stated function.

The board thus concludes that the application in suit discloses the invention as now claimed in a manner sufficiently clear and complete for it to be carried out by the person skilled in the art.

Consequently, the requirements of Article 83 EPC are met.

5. It follows from the considerations outlined under points 3 and 4 above that the reasons for the refusal of the present patent application by the examining division have been removed.

The examination of the application in suit can thus be resumed on the basis of the main request.

The board has noted some possible redundancies in the definitions given on page 3, lines 22 to 33, in view of the preceding restrictions in the definition of the

term "prodrug". Any corrective action is left to the appellant and the examining division.

Under the present circumstances, the board exercises its power under Article 111(1) EPC and remits 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 examining division for further prosecution on the basis of the following application documents:
 - Description pages 1 to 13 filed with letter of 1 February 2011
 - Claims 1 to 6 filed with letter of 1 February 2011

The Registrar:

The Chairman:

M. Schalow

P. Ranguis