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**Datasheet for the decision
of 28 August 2014**

Case Number: T 0336/12 - 3.3.01

Application Number: 06830425.2

Publication Number: 1963304

IPC: C07D401/12

Language of the proceedings: EN

Title of invention:

ISOQUINOLINE DERIVATIVES

Patent Proprietor:

MSD Oss B.V.

Opponent:

Sanofi-Aventis Deutschland GmbH

Headword:

Isoquinoline derivatives / MSD Oss N,V.

Relevant legal provisions:

EPC Art. 123(2)

Keyword:

Main and auxiliary request 1 - Added matter (yes)
Main and auxiliary request 1 - The remaining subject-
matter after the introduction of the disclaimer is not clearly
and unambiguously derivable from the application as filed.

Decisions cited:

G 0001/03, G 0002/10, T 2464/10

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 0336/12 - 3.3.01

D E C I S I O N
of Technical Board of Appeal 3.3.01
of 28 August 2014

Appellant:
(Patent Proprietor)

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(Opponent)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
5 December 2011 concerning maintenance of the
European Patent No. 1963304 in amended form.**

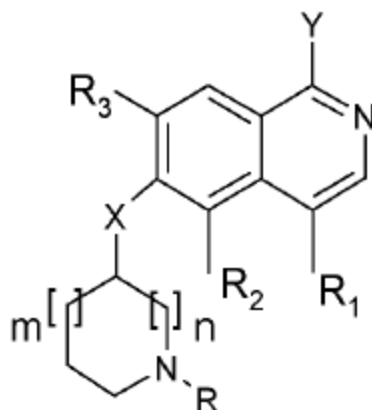
Composition of the Board:

Chairman A. Lindner
Members: J. Ousset
D. Rogers

Summary of Facts and Submissions

- I. The patent proprietor filed an appeal against the interlocutory decision of the opposition division maintaining European patent No. 1 963 304 in amended form.
- II. The opposition division found that the main request was not novel vis-à-vis the disclosure of document (1), that auxiliary requests 1 to 3 contravened article 123(2) EPC and that auxiliary request 4 was not clear. The patent in suit was maintained on the basis of auxiliary request 5.
- III. The appellant filed a new main request and a new auxiliary request 1 with its notice of appeal. Claim 1 of the main request reads as follows:

"1. An isoquinoline derivative having the general Formula I



Formula I

wherein

X is O, S or NH; Y is OH or NH₂; m is 0, 1 or 2; n is 1 or 2;

R₁ is H, when Y is NH₂; or R₁ is H, (C₁₋₄)alkyl or halogen, when Y is OH; R₂ and R₃ are independently H, (C₁₋₄)alkyl or halogen;
R is H or (C₁₋₆)alkyl, optionally substituted with OH, (C₁₋₄)alkyloxy, (C₁₋₄)-alkyloxycarbonyl, (C₃₋₇)cycloalkyl, which may optionally comprise a heteroatom selected from O and S, (C₆₋₁₀)aryl, (C₆₋₁₀)aryloxy or a 5- or 6-membered heteroaryl group comprising 1-3 heteroatoms independently selected from O, N and S, each aryl or heteroaryl group being optionally substituted with 1-3 substituents independently selected from (C₁₋₄)alkyl, (C₁₋₄)alkyloxy, (C₁₋₄)alkylsulfonyl and halogen; or a pharmaceutically acceptable salt thereof,

with the exclusion of the isoquinoline derivatives of formula I wherein

X is O; Y is OH;

m is 0 and n is 2 or m is 1 and n is 1;

R₁ is H, (C₁₋₄)alkyl or halogen;

R₂ and R₃ are independently H, (C₁₋₄)alkyl or halogen and R is H or (C₁₋₆)alkyl optionally substituted with (C₁₋₄)alkyloxy, (C₃₋₇)cycloalkyl, which may optionally comprise a heteroatom selected from O and S, (C₆₋₁₀)aryl, (C₆₋₁₀)aryloxy or a 5- or 6-membered heteroaryl group comprising 1-3 heteroatoms independently selected from O, N, and S, each aryl or heteroaryl group being optionally substituted with 1-3 substituents independently selected from (C₁₋₄)alkyl, (C₁₋₄)alkyloxy, (C₁₋₄)alkylsulfonyl and halogen; but including an isoquinoline derivative which is selected from:

6-(piperidin-3-yloxy)-2H-isoquinolin-1-one (22);

6-[1-(4-fluorobenzyl)piperidin-3-yloxy]-2H-isoquinolin-1-one (23C);

3-[4-(1-oxo-1,2-dihydroisoquinolin-6-yloxy)piperidin-1-ylmethyl]benzotrile (30D) ;
6-[1-(1H-pyrrol-3-ylmethyl)-piperidin-4-yloxy]-2H-isoquinolin-1-one (30H) ;
6-[1-(2-phenoxyethyl)-piperidin-4-yloxy]-2H-isoquinolin-1-one (31A) ;
6-[1-(2-methoxyethyl)-piperidin-4-yloxy]-2H-isoquinolin-1-one (31B) ;
(S)-6-[1-(2-benzyloxyethyl)piperidin-3-yloxy]-2H-isoquinolin-1-one (32A) ;
(S)-6-[1-(2-phenoxyethyl)piperidin-3-yloxy]-2H-isoquinolin-1-one (32C) ;
6-(1-ethylpiperidin-3-yloxy)-2H-isoquinolin-1-one (33A) ;
6-[1-(2-ethylbutyl)piperidin-3-yloxy]-2H-isoquinolin-1-one (33B) ;
6-[1-(4-methoxybenzyl)piperidin-3-yloxy]-2H-isoquinolin-1-one (23D) ;
(S)-6-(piperidin-3-yloxy)-2H-isoquinolin-1-one (24D) ;
(S)-7-methyl-6-(piperidin-3-yloxy)-2H-isoquinolin-1-one (26) ;
(S)-4-bromo-6-(piperidin-3-yloxy)-2-isoquinolin-1-one (27) ;
(S)-4-methyl-6-(piperidin-3-yloxy)-2H-isoquinolin-1-one (28) ;
(S)-5-bromo-6-(piperidin-3-yloxy)-2H-isoquinolin-1-one (29) ;
6-[1-(3-methylbenzyl)piperidin-4-yloxy]-2H-isoquinolin-1-one (30B) ;
6-[1-(4-methoxybenzyl)piperidin-4-yloxy]-2H-isoquinolin-1-one (30C) ;
6-(1-furan-2-ylmethylpiperidin-4-yloxy)-2H-isoquinolin-1-one (30E) ;
6-[1-(3-methoxybenzyl)piperidin-4-yloxy]-2H-isoquinolin-1-one (31F) ;
(R)-6-[1-(2-phenoxyethyl)piperidin-3-yloxy]-2H-isoquinolin-1-one (32E) ;"

Claim 1 of auxiliary request 1 differs from claim 1 of the main request in that compounds (22), (23C), (30D), (30H), (31A), (31B), (32A), (32C), (33A) and (33B) were deleted.

IV. The appellant argued mainly as follows:

- a) Since the specific compounds added to the wording of claim 1 of the pending requests have a basis in the application as originally filed, this amendment did not contravene Article 123(2) EPC.
- b) The scope of claim 1 of the main and auxiliary request 1 did not contain any singling of new specific compounds, such that this had no basis in the application as originally filed. Thus, it did not contravene Article 123(2) EPC.

V. The respondent argued mainly as follows:

- a) The specific compounds added into claim 1 were novel vis-à-vis the disclosure of the granted version and according to the novelty test, this inclusion contravened Article 123(2) EPC, since the same criteria must be applied to assess novelty and a clear and unambiguous disclosure.
- b) The claimed scope of claim 1 of the main and auxiliary request 1 has no basis in the application as originally filed.

VI. The appellant requested that the decision under appeal be set aside and that the patent be maintained upon the basis of the claims of the main request or of auxiliary

request 1, both filed with the statement of grounds of appeal.

VII. The respondent requested that the appeal be dismissed.

VIII. At the end of the oral proceedings, the decision of the board was announced.

Reasons for the Decision

1. The appeal is admissible.

2. *Added matter - Main request*

2.1 Claim 1 contains a disclaimer which was made in order to restore novelty vis-à-vis a prior art document according to Article 54(3) EPC. Moreover, specific compounds falling within the disclaimed scope, but not disclosed in this prior art document, have been added to claim 1, thereby reintroducing subject-matter into the claim which had been excluded by the disclaimer.

2.2 In view of the amendments carried out by the appellant, the board has to assess whether the subject-matter of claim 1 fulfils the requirements of Article 123(2) EPC.

2.3 The opposition division considered that the disclaimer made to restore novelty vis-à-vis prior art according to Article 54(3) EPC was in agreement with the criteria set out in decision G 1/03 (OJ EPO 2004, 413, see Order). The decision of the department of first instance was taken on 14 November 2011 and at that time decision G 2/10 (OJ EPO 2012, 376) was not yet published. This board agrees with the finding in T 2464/10 (see points 6 to 8), according to which the Enlarged Board of Appeal of G 2/10 did not consider that decision G1/03 was

exhaustive as to the conditions that needed to be fulfilled for an amendment that consisted of the introduction of an undisclosed disclaimer to be regarded as allowable under Article 123(2) EPC so that, as a consequence, it has to be evaluated whether or not the remaining claimed subject-matter has a basis in the application as originally filed.

- 2.4 Neither the appellant nor the board was able to refer to a passage of the application as originally filed from which the skilled person would regard this remaining subject-matter as explicitly or implicitly, but directly and unambiguously disclosed in the application as filed. As can be seen from points III and 2.1 above, present claim 1 contains a "double" disclaimer in that in a first step a large group of compounds is disclaimed and then, in a second step, a long list of specific compounds is disclaimed from the disclaimer and thereby reintroduced into the claim. The result of this two-step exclusion is not merely a shortening of one or several lists which, under certain circumstances, might be allowable, e.g. if there is no singling out of new specific combinations. Instead, the modification of a disclaimer which allegedly has a basis in a prior art document by disclaiming thereof specific compounds which are disclosed in the application as originally filed rather than in said prior art document creates new remaining subject-matter which is very different from the disclosure of the application as originally filed so that the requirements of Article 123(2) EPC are not met.

3. *Added matter - Auxiliary request 1*

3.1 Since claim 1 differs only from claim 1 of the main request in that some specific compounds were deleted, the reasons given above for the main request are also applicable to this request.

3.2 This request also contravenes Article 123(2) EPC.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated