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File Number: W 28/91 - 3.3.2

Application No.: PCT/GB90/01941

Publication No.: W09108737

Title of invention: Pharmacologically active amide carboxylate derivatives

Classification: A61K 31/16

DECISION
of 27 February 1992

Applicant: Fisons plc et al.

Headword: First invitation / FISONS

PCT Article 17(3)(a); Rules 13.1, 40.1 and 40.2(c)

Keyword: "Non-unity a priori (no) - second medical indication for compounds of a general formula and first medical indication (product claims) for compounds of a more restricted formula"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : W 28/91 - 3.3.2
International Application No. PCT/GB90/01941

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 27 February 1992

Applicant : FISONS plc
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Subject of the Decision : Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 1 October 1991.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : A. Nuss
C. Holtz

Summary of Facts and Submissions

- I. The Applicant filed International Patent Application PCT/GB90/01941 on 12 December 1990. The application contained 11 claims.
- II. On 30 May 1991, the EPO acting as International Search Authority (ISA) issued to the Applicant an invitation to pay an additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT. The said invitation indicated that the ISA considered that the above mentioned application related to the following groups of subject-matter which did not satisfy the criteria of unity of invention:
1. Claim 1: Use of a compound of formula I in the manufacture of a medicament for the treatment or prophylaxis of inflammation.
 2. Claims 3 - 11 in part: A compound of formula I, being compound number n-1 of Claim 8 or its pharmacologically acceptable salt, pharmaceutical compositions containing it, and a process for its preparation (n being a number from 2 to 81).

Having regard to Rule 39.1(iv) PCT, the ISA had not carried out a search in respect of Claim 2.

- III. On 26 June 1991, the additional search fee identified in the invitation referred to above was received from the Applicant, together with a protest in accordance with Rule 40.2(c) PCT. The Applicant argued that Claims 3 to 11 clearly represented a novel aspect of the invention claimed in Claim 1. The description, page 1, clearly stated that in its broadest aspect the invention was

concerned with compounds of formula I. Claim 1 was related to the use of such compounds the subsequent Claims 3 to 11 were related to certain of the compounds per se, processes thereto and their use as pharmaceuticals , as allowed by Rule 13.2(i) PCT.

- IV. On 1 October 1991, the ISA issued a modified invitation cancelling and replacing the invitation of 30 May 1991.

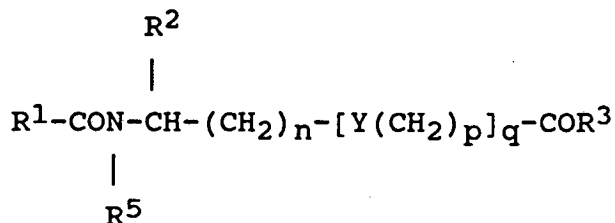
In accordance with the October invitation, the Applicant paid the additional fees under protest on 5 November 1991. This protest is handled by this Board of Appeal under file No. W 0053/91.

Reasons for the Decision

1. As this Board of Appeal, in decision W 53/91 of 19 February 1992, decided to declare the invitation of 1 October 1991 null and void ab initio, the present decision is concerned only with the protest against the invitation of May 1991, as if the October 1991 decision had never existed.
2. The protest is admissible.
3. The present case relates to a protest against a non-unity objection where no examination of the merits of the claim in comparison with the state of the art has been carried out. In other words, in its invitation the ISA did not make reference to any specific prior art which could be detrimental to the patentability of the application. Accordingly, it is apparent that an objection a priori is intended.

4. In the case of a protest where an objection a priori is raised, the only way to determine the technical problem (in contradistinction to the normal approach) is to rely on the description of the application and the provisional acknowledgement of the prior art therein, if given.

5. According to the description, certain compounds having the general formula I



are known together with medical indications including e.g. the reduction of the renal toxicity of a penem or carbapenem antibiotic when concurrently administered with said antibiotic; the use as antibiotic per se or fibrinolytic agents or as hair and scalp conditioners or agents having anthelmintic or cholecystographic activity. Thus, the problem underlying the present application can be seen in providing further medical uses for compounds falling within the scope of general formula I (description, page 2, line 21 up to page 3, line 24). At least as far as the EPO is concerned, subject to a correct formulation, such further medical uses are patentable (cf. decision of the Enlarged Board of Appeal, Gr 05/83, OJ EPO, 1985, 64).

The Applicant has demonstrated that the compounds of formula I and pharmaceutically acceptable derivatives thereof are suitable for solving the problem mentioned above, i.e. providing as a further medical use the treatment of inflammation (cf. description, page 14, line 22 to page 15, line 8).

6. The present Claim 1 is directed to such a use of compounds defined by the general formula I and clearly relates to a second medical indication.

Claims 3 to 11 contain disclaimers over the definition of formula I according to Claim 1. In other words, the subject-matter of Claims 3 to 11 is restricted to a narrower groups of compounds of formula I, which the Applicant believed to be new at the priority date of the application.

It is current practice before the EPO to allow, in the same application, a claim to the use of chemical compounds defined by a general formula, together with a product claim relating to a more restricted group of chemical compounds which fall within the said general formula, in accordance with Rule 13.2 PCT (cf. decision W 13/89 of 12 July 1990, not published in OJ EPO and decision W 5/91 of 10 September 1991, not published in OJ EPO).

There is accordingly no reason a priori why the use defined by Claim 1 (broader definition of formula I - second medical indication) should not be included in the same application as a group of claims relating to pharmaceutical compositions (basing on a narrower definition of formula I - first medical indication) and compounds per se of an even narrower formula I. Moreover, it is to be noted that in the present case the ISA did not raise any objection against the unity of invention within the subject-matter covered by Claims 3 to 11.

It follows from the preceding considerations that the additional fee should be reimbursed.

Order

For these reasons, it is decided that:

Refund of the additional search fee is ordered.

The Registrar:

The Chairman:

P. Martorana

P.A.M. Lançon