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File Number: W 19/92 - 3.3.2

Application No.: PCT/EP91/02011

Publication No.: W09207845

Title of invention: Derivatives of amino acids as inhibitors of renin, methods for their preparation, medicaments containing them and their use

Classification: C07D 401/12

D E C I S I O N  
of 15 September 1992

Applicant: Hoechst Aktiengesellschaft

Headword: Inhibitors of renin/HOECHST

PCT Article 17(3)(a), Rule 40.2(c)

Keyword: "Protest not accompanied by a reasoned statement"



Europäisches  
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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : W 19/92 3.3.2  
International Application No. PCT/EP91/02011

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 15 September 1992

**Applicant :**

Hoechst Aktiengesellschaft  
Zentrale Patentabteilung  
Postfach 80 03 20  
W - 6230 Frankfurt am Main 80 (DE)

**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 30 January 1992.

**Composition of the Board :**

**Chairman :** P.A.M. Lançon  
**Members :** U. Kinkeldey  
C. Holtz

Summary of Facts and Submissions

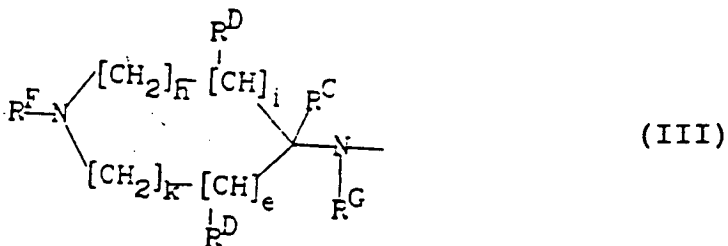
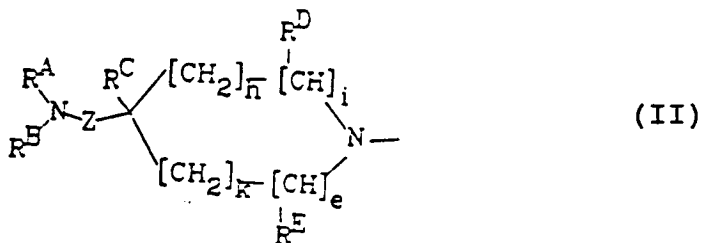
I. The Applicant filed an international patent application PCT/EP 91/02011 with six claims. Claim 1 reads as follows:

"1. A compound of the formula I



in which the residues have the following meaning:

R<sub>1</sub> a residue of formula II or III



in which ...

(It follows a definition of all residues contained in formulas (II) and (III))

...  
or a pharmaceutically acceptable salt thereof."

Claims 2 and 3, being dependent on Claim 1 relate to certain further embodiments; Claim 4 relates to a process for the preparation of compounds of formula (I); Claim 5 relates to the compound for the use as a medicament; Claim 6 relates to a pharmaceutical solution comprising an effective amount of at least one of the compounds as claimed in any of Claims 1 to 3 and 5.

II. The EPO acting as an International Search Authority (ISA) sent an invitation to the Applicant to pay one additional search fee pursuant to Article 17(3)(a) and Rule 40.1 PCT.

III. In the invitation two groups of invention were defined as follows:

"1. Claims 1-6 (partially):

Compounds of formula I wherein  $R_1$  is a residue of formula II, their preparation and pharmaceutical compositions containing them.

2. Claims 1-6 (partially):

Compounds of formula I wherein  $R_1$  is a residue of formula III, their preparation and pharmaceutical compositions containing them."

The ISA stated that Claim 1 of the application related to compounds with renin inhibiting activity which contained as technical feature, which might, a priori, unify the plurality of different inventions embraced by this claim,

at the N-terminal azacyclic acyl or aminoacyl residues in combination with a replacement of the alpha-nitrogen of the amino acid at the P<sub>3</sub>-location by O, C or S.

The object of these modifications was to obtain a better absorption and a longer duration of action in vivo.

At the date of filing of the present application compounds covered by the formula of Claim 1, wherein these modifications had been made for the same reasons where already known (e.g. EP 339 483) and as no other special technical feature could be distinguished, on which a unifying inventive concept could be based, there was lack of unity.

As distinct inventive concepts could be acknowledged the introduction of the residues II and III in the compounds of the general type of formula I.

- IV. The Applicant paid the additional fee under protest pursuant to Rule 40.2(c) PCT. In support of the protest, the Applicant submitted that they were of the opinion that there was unity of the invention because the inhibitors of renin had an essential common structural feature in formula (I).

#### Reasons for the Decision

1. Under Article 154(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against an additional fee charged by the EPO under the provision of Article 17(3)(a) of the PCT.
2. Rule 40.2(c) PCT enables the Applicant to pay the additional fees under protest, "that is, accompanied by a

reasoned statement to the effect that the international application complies with the requirement of unity of invention ..." (emphasis added).

- 2.1 The statement referred to under paragraph IV above shows that in the opinion of the Applicants unity of invention is given because the inhibitors of renin show a common and essential structural feature in formula (I). However, as becomes apparent from the above paragraph III, the ISA acknowledged that the compounds claimed in Claim 1 have a common structural feature, which, however, was considered by the ISA as having been known from the prior art document EP 339 483.
- 2.2 The mere statement in the protest by the Applicants, that the inhibitors of renin as described in the international patent application show a common structural feature in formula (I) thus cannot be considered as a reasoned reaction to the invitation of the ISA which could allow the Board to examine the justification of the invitation to pay an additional fee. The protest thus merely contains an unreasoned allegation.
- 2.3 A reasoning of the protest of that kind might suffice in cases where the facts are so clear that such an utmost short and stringent allegation nevertheless puts the Board into a position to examine whether the invitation to pay additional search fees was valid (e.g. decision W 23/88 of 25 November 1988, not published in the OJ of the EPO). The present case is not of that kind. Whilst it is undisputed that inhibitors of renin have one common structural feature, it is anything but a clear undertaking to examine which common structural feature could be meant after a thorough consideration of the disclosure of the prior art document EP-339 483.

2.4 Therefore, the Applicants protest under Rule 40.2(c) PCT has to be dismissed as inadmissible.

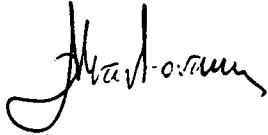
3. The additional fee paid by the Applicant shall not be refunded.

Order

For these reasons, it is decided that:

The protest under Rule 40.2(c) PCT is dismissed as inadmissible.

The Registrar:



P. Martorana

The Chairman:



P. Lançon

Ulvey  
23.9.92  
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