

Señores

SUPERINTENDENCIA DE INDUSTRIA Y COMERCIO
DIVISIÓN DE NUEVAS CREACIONES

E. _____ S. _____ D

SUPERINTENDENCIA DE INDUSTRIA Y COMERCIO

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Expediente No. 06-095.137

Solicitud de Patente de Invención titulada: "PROCEDIMIENTO MEJORADO PARA LA PREPARACION DE 9,11 EPOXI ESTEROIDES".

Solicitante: PHARMACIA & UPJOHN COMPANY LLC.

RESPUESTA AL OFICIO No. 13879 NOTIFICADO
POR FIJACION EN LISTA No. 425, DE FECHA 1 DE DICIEMBRE DE 2006
(EXAMEN DE FORMA)

CARLOS R. OLARTE, mayor de edad y vecino de Bogotá, identificado tal como aparece al pie de mi firma, en mi carácter de apoderado de la sociedad en referencia, me permito dar respuesta al auto emanado de ese Despacho, dentro del término legal previsto en el Artículo 39 de la Decisión 486, en los siguientes términos:

1. En respuesta a la única observación del Examinador, me permito aclarar al despacho que la presente solicitud entra en Fase Nacional Capítulo I y no Capítulo II como inicialmente se presentó. Para tal efecto, adjunto copia del Reporte Preliminar Internacional de Patentabilidad, el cual, valga aclarar, no contiene anexos.

Atentamente,



CARLOS R. OLARTE
CC. No. 79.782.747 de Bogotá
T.P. 74.295

Anexo: Reporte Preliminar Internacional de Patentabilidad

From the INTERNATIONAL BUREAU

PCT**NOTIFICATION CONCERNING
TRANSMITTAL OF COPY OF INTERNATIONAL
PRELIMINARY REPORT ON PATENTABILITY
(CHAPTER 1 OF THE PATENT COOPERATION
TREATY)**

(PCT Rule 44bis.1(c))

To:

FULLER, Grover, F., Jr.
Pfizer Inc.
201 Tabor Road
Morris Plains, NJ 07950
ETATS-UNIS D'AMERIQUE

136

OCT

Date of mailing (day/month/year)

05 October 2006 (05.10.2006)

Applicant's or agent's file reference

PHA4302.5

IMPORTANT NOTICE

International application No.

PCT/US2005/009381

International filing date (day/month/year)

22 March 2005 (22.03.2005)

Priority date (day/month/year)

22 March 2004 (22.03.2004)

Applicant

PHARMACIA & UPJOHN COMPANY LLC et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter 1 of the Patent Cooperation Treaty)

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Agnes Wittmann-Regis

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

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Applicant's or agent's file reference PHA4302.5	FOR FURTHER ACTION		See item 4 below
International application No. PCT/US2005/009381	International filing date (<i>day/month/year</i>) 22 March 2005 (22.03.2005)	Priority date (<i>day/month/year</i>) 22 March 2004 (22.03.2004)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant PHARMACIA & UPJOHN COMPANY LLC			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | |
|--|---|
| ☒ Box No. I | Basis of the report |
| ☐ Box No. II | Priority |
| ☐ Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| ☐ Box No. IV | Lack of unity of invention |
| ☒ Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| ☐ Box No. VI | Certain documents cited |
| ☐ Box No. VII | Certain defects in the international application |
| ☒ Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Date of issuance of this report 26 September 2006 (26.09.2006)
	Authorized officer Agnes Wittmann-Regis e-mail: pt06@wipo.int

PATENT COOPERATION TREATY

REC'D 22 AUG 2005

WIPO

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From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

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To:
JANET S. HENDRICKSON
SENNIGER POWERS
#1 METROPOLITAN SQUARE, 16TH FLOOR
ST. LOUIS, MO 63102

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing
(day/month/year) 18 AUG 2005

Applicant's or agent's file reference

FOR FURTHER ACTION

See paragraph 2 below

PHA4302.5

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US05/09381

22 March 2005 (22.03.2005)

22 March 2004 (22.03.2004)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): C07J 71/00 and US Cl.: 540/16, 23

Applicant

PHARMACIA & UPJOHN COMPANY

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Facsimile No. (703) 305-3230

Authorized officer

Barbara P. Basso, Ph.D.

Telephone No. 571-272-1600

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US05/09381

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Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US05/09381

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Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims 1-11	YES
	Claims 12-15	NO
Inventive step (IS)	Claims NONE	YES
	Claims 1-15	NO
Industrial applicability (IA)	Claims 1-15	YES
	Claims NONE	NO

2. Citations and explanations:

Claims 12-15 lack novelty under PCT Article 33(2) as being anticipated by Ng et al. (US 6,180,780)

Ng et al. teach a process for the production epoxy steroid comprising contacting a 9,11-steroid substrate with a peroxide compound in the presence of a solvent (see the entire article, especially col. 40, lines 50-62; col. 42, 10-36; Examples 43-47). The process taught by the reference is encompassed by the instant claims.

Claims 1-11 lack an inventive step under PCT Article 33(3) as being obvious over Ng et al. (US 6,180,780).

Ng et al. teach a process for the production epoxy steroid comprising contacting a 9,11-steroid substrate with a peroxide compound in the presence of a solvent (see the entire article, especially col. 40, lines 50-62; col. 42, 10-36; Examples 43-47).

Claims 1-14 differ from the reference by reciting a ratio from about one to about 7 moles peroxide compound per mole substrate (see sections 0111-0113). However, (a) the reference teaches the process consumes only one to two equivalents of hydrogen peroxide per mole of substrate and (b) optimization of the reaction by changes in the reaction condition, such as changes in reactant concentration, reaction temperature, reaction time etc., is routine in the chemical art, and, thus, within the level of skill of the ordinary artisan in the chemical art. Therefore, the claimed process is prima facie obvious.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US05/09381

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the questions whether the claims are fully supported by the description, are made:

Claims 9-11 are objected to under PCT Rule 66.2(a)(v) as lacking clarity under PCT Article 6 because claims 9-11 are indefinite for the following reason(s): Claim 9 has a period after the definition of R¹⁵ and R¹⁶, i.e., in the middle of the claim.