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SUPERINTENDENCIA DE INDUSTRIA Y COMERCIO

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SUPERINTENDENCIA DE INDUSTRIA Y COMERCIO
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Tra. 11 PATENTE/MI
Evs: 378 FASENACIONAL/
Act 444 RESPUESTAREQUE Folios: 8

Referencia: Expediente No. 06.122.180

Solicitud de Patente de Invención titulada: "Derivados de amino-5,5-difenilimidazolona para la inhibición de β -secretasa."

Solicitante: Wyeth

RESPUESTA AL AUTO NOTIFICADO POR FIJACIÓN EN LISTA NO. 29
DEL 26 DE ENERO DE 2007, OFICIO NO. 886 (EXAMEN DE FORMA)

ÁLVARO CORREA ORDÓÑEZ, mayor de edad y vecino de Bogotá D.C., identificado tal como aparece al pie de mi firma, en mi carácter de apoderado de la sociedad en referencia, doy respuesta al auto emanado por ese Despacho dentro del término legal.

Como respuesta a su requerimiento se han revisado todos y cada uno de los nombres de los inventores y se encontró diferencia en uno solo de los nombres que corresponde al del inventor GUNAWAN, Iwan Suwandl, cuyo nombre por error se había escrito como NAWAN, Iwan Suwandl. De esta manera queda aclarado el error en la escritura de los inventores.

Adicionalmente, presento copia simple del Reporte Preliminar Internacional sobre Patentabilidad Capítulo I.

Atentamente,



ÁLVARO CORREA ORDÓÑEZ
C.C.No.79.143.366 de Usaquén
T.P.20.281

PATENT COOPERATION TREATY

PCT

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

(PCT Rule 44bis)

Applicant's or agent's file reference AM101475	FOR FURTHER ACTION See item 4 below	
International application No. PCT/US2005/020720	International filing date (day/month/year) 14 June 2005 (14.06.2005)	Priority date (day/month/year) 16 June 2004 (16.06.2004)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant WYETH		

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 7 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).

Date of issuance of this report 20 December 2006 (20.12.2006)	
The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Authorized officer Simin Bahariou e-mail: pt09@wipo.int

Form PCT/IB/373 (January 2004)

PATENT COOPERATION TREATY

REC'D 07 OCT 2005

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From the
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/US2005/020720

International filing date (day/month/year)
14.06.2005

Priority date (day/month/year)
16.06.2004

International Patent Classification (IPC) or both national classification and IPC
C07D401/10, C07D403/10, C07D405/14, A61K31/178, A61P25/28

Applicant
WYETH

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 usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, 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 56.1bis(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 three 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:



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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2005/020720

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Box No. I Basis of the 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 the 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:

Box No. II Priority

1. ☒ The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43bis.1 and 64.1) is the claimed priority date.
2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2005/020720

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Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
☒ claims Nos. 10-12 with respect to industrial applicability

because:

- ☒ the said international application, or the said claims Nos. as above relate to the following subject matter which does not require an international preliminary examination (specify):

see separate sheet

- ☐ the description, claims or drawings (indicate particular elements below) or said claims Nos. are so unclear that no meaningful opinion could be formed (specify):
- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☐ no international search report has been established for the whole application or for said claims Nos.
- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:
- | | |
|----------------------------|--|
| the written form | ☐ has not been furnished |
| | ☐ does not comply with the standard |
| the computer readable form | ☐ has not been furnished |
| | ☐ does not comply with the standard |
- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.
- ☐ See separate sheet for further details

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2005/020720

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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

1. Statement

Novelty (N)	Yes: Claims	1-15
	No: Claims	
Inventive step (IS)	Yes: Claims	1-15
	No: Claims	
Industrial applicability (IA)	Yes: Claims	1-9, 13-15
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VI Certain documents cited

1. Certain published documents (Rules 43bis.1 and 70.10)

and/or

2. Non-written disclosures (Rules 43bis.1 and 70.9)

see form 210

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Re Item III

Claims 10-12 relate to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iv) PCT. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Article 34(4)(a)(i) PCT).

Re Item V

1. Reference is made to the following document:
D1 : WO 03/094854 A
2. The subject-matter of the present claims is new with respect to D1 (Article 33(2) PCT). The compounds of D1 (cf. examples 1,5,8 and claim 1) differ from the present compounds in that the amino substituent is at position 3 of the imidazolone ring and in that the phenyl rings at position 5 are unsubstituted.
3. The problem to be solved by the present invention may be regarded as the provision of further inhibitors of β -amyloid production, which are useful, for example, in the treatment of Alzheimer's disease.

The solution to this problem proposed in the present claims is considered as involving an inventive step (Article 33(3) PCT) since the compounds of D1 are structurally remote from the present compounds. The scope of claim 1 represents a reasonable generalisation of the compounds tested.

4. Industrial applicability (Article 33(4) PCT)

For the assessment of the present claims 10-12 on the question whether they are industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/US2005/020720

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Re Item VI

	Application No	Publication date	Filing date	Priority date
D2	WO 2005/058311 A	30.06.2005	13.12.2004	15.12.2003

The subject-matter of present claim 1 overlaps with that of D2. The specific embodiments of D2 as listed in the search report of the prior art fall within the area of overlap. The compounds of D2 are inhibitors of BACE1 (see p. 301 ff., cf. present Table VI) and are useful in the treatment of Alzheimer's disease (cf. claim 18).

Said specific embodiments are not present in the priority document of D2. The validity of the present priority has not been considered because the International Searching Authority does not have in its possession a copy of the priority application.

Re Item VII

1. Claim 14 lacks conciseness (Article 6 PCT), since a reference to claim 1 would render the repetition of the definitions for formula I redundant.
2. In claim 6 the number of the claim which is being referred to has been omitted (Article 6 PCT).