

Pedro Castillo Pineda & Asociados
ABOGADOS

SUPERINTENDENCIA DE INDUSTRIA Y COMERCIO



No. 07-055671- -00002-0000

Fecha: 2007-09-06 16:26:22 Dep. 2020 NUECREACIONE
Tra. 11 PATENTEIYII Eve: 379 FASENACIONALI
Act. 444 RESPUESTAREQUE Folios: 22

SUPERINTENDENCIA DE INDUSTRIA Y COMERCIO
División de Nuevas Creaciones
E. S. D.

264

Ref: EXPEDIENTE No.07-055671
Solicitud de patente a nombre de
ALLERGAN, INC.

Me refiero al oficio 10143 notificado en el asunto de la referencia y adjunto presento los siguientes documentos:

1-La copia del Informe Preliminar Internacional sobre patentabilidad (informe escrito de la Oficina de Búsqueda Internacional), junto con su traducción en Español.

2-Legalizada por Apostilla, la copia certificada del documento de cesión correspondiente a la solicitud estadounidense No. 11/009.298 del 10 de diciembre de 2004, de la cual se reclamó prioridad en la solicitud internacional No. PCT/US 2005/044501, correspondiente a la presente solicitud de patente.

En consecuencia, pido se ordene la publicación del extracto.

Atentamente,

JERÓNIMO CASTILLO BONILLA
C.C. 79.462.057 Bogotá
T.P. 104167 C.S. Judicatura

TRATADO DE COOPERACIÓN EN MATERIA DE PATENTES

PCT

INFORME PRELIMINAR INTERNACIONAL SOBRE PATENTABILIDAD

(Capítulo I del Tratado de Cooperación en Materia de Patentes)

(Regla 44bis PCT)

No. de Expediente del Solicitante o Apoderado 17693PCTAP	PROCEDIMIENTO POSTERIOR Véase ítem 4 más adelante	
No. Solicitud Internacional PCT/US2005/044501	Fecha Internacional de Presentación (día/mes/año) 08 de diciembre de 2005 (08.12.2005)	Fecha de Prioridad (día/mes/año) 10 de diciembre de 2004 (10.12.2004)
Clasificación Internacional de Patentes (8ª edición, a menos que se indique una edición más antigua) Ver información relevante en el Formulario PCT/ISA/237		
Solicitante ALLERGAN, INC.		

- El presente informe preliminar internacional sobre patentabilidad (Capítulo I) se expide por la Oficina Internacional a nombre de la Oficina de Búsqueda Internacional bajo Regla 44 bis 1(a).
- El presente INFORME comprende un total de 8 hojas, inclusive esta portada

En las hojas adjuntas, cualquier referencia al informe escrito de la Oficina de Búsqueda Internacional debe leerse como referencia al informe preliminar internacional sobre patentabilidad (Capítulo I) en su lugar.

- El presente informe contiene datos con respecto a los siguientes puntos:
 - ☒ Cuadro No. I Base del Informe
 - ☐ Cuadro No. II Prioridad
 - ☐ Cuadro No. III Sin elaboración de un informe sobre novedad, actividad inventiva y posibilidad de aplicación industrial
 - ☐ Cuadro No. IV Falta de unidad de la invención
 - ☒ Cuadro No. V Declaración justificada según Artículo 35(2) con respecto a la novedad, la actividad inventiva y la posibilidad de aplicación industrial; documentos y explicaciones que sustentan esta declaración
 - ☐ Cuadro No. VI Ciertos documentos enumerados
 - ☐ Cuadro No. VII Ciertas deficiencias del registro internacional
 - ☐ Cuadro No. VIII Ciertas observaciones relacionadas con la solicitud internacional
- La Oficina Internacional comunicará este informe a las Oficinas designadas, de acuerdo con las Reglas 44bis. 3c y 93bis.1 pero no antes de la expiración de 30 meses a partir de la fecha de prioridad (Regla 44 bis. 2), excepto donde el solicitante plantea una solicitud expresa bajo el Artículo 23(2).

La Oficina Internacional de la Organización Mundial de la Propiedad Intelectual (WIPO) 34, chemin des Colombettes 1211 Ginebra 20, Suiza	Fecha de la expedición del presente informe 13 de junio de 2007 (13.06.2007)
	Empleado Autorizado Beate Giffo-Schmitt e-mail: pt03.pct@wipo.int

Fax No. +41 22 338 82 70

Formulario PCT/ISA/237 (Enero 2004)

TRATADO DE COOPERACIÓN EN MATERIA DE PATENTES

366

Remitente:

OFICINA DE BÚSQUEDA INTERNACIONAL

PCT

A:

Ver Formulario PCT/ISA/220

INFORME ESCRITO DE LA OFICINA DE BÚSQUEDA INTERNACIONAL

(Regla 43bis.1 PCT)

Fecha de envío
(Día/Mes/Año) Véase formulario PCT/ISA/210 (segunda hoja)

No. de Expediente del Solicitante o Apoderado

PARA ACCIÓN POSTERIOR

1. El presente informe contiene datos con respecto a los siguientes puntos:

- | | | |
|--------------------------|-----------------|--|
| ☐ | Cuadro No. I | Base del Informe |
| ☐ | Cuadro No. II | Prioridad |
| ☐ | Cuadro No. III | Sin elaboración de un informe sobre novedad, actividad inventiva y posibilidad de aplicación industrial |
| ☐ | Cuadro No. IV | Uniformidad deficiente de la invención |
| ☐ | Cuadro No. V | Declaración justificada según regla 43bis.1(a)(i) con respecto a la novedad, la actividad inventiva y la posibilidad de aplicación industrial; documentos y explicaciones que sustentan esta declaración |
| ☐ | Cuadro No. VI | Ciertos documentos enumerados |
| ☐ | Cuadro No. VII | Ciertas deficiencias del registro internacional |
| ☐ | Cuadro No. VIII | Ciertas observaciones relacionadas con la solicitud internacional |

2. ACCIÓN POSTERIOR

Si se expone una petición de examen preliminar internacional, este informe se considerará un informe escrito de la Oficina de Examen Preliminar Internacional ("IPEA"). Sin embargo, esto no se aplica donde el solicitante elige una Oficina distinta de ésta para ser la IPEA, y la IPEA seleccionada ha notificado a la Oficina Internacional bajo Regla 86.1bis(b) que los informes escritos de esta Oficina de Búsqueda Internacional no se considerarán en tal sentido.

Si este informe, tal como se estipula más arriba, se considera un informe escrito de la IPEA, se invita al solicitante a presentar a la IPEA una respuesta escrita, donde se estime apropiado, junto con modificaciones, antes de la expiración de los 3 meses a partir de la fecha de puesta al correo del Formulario PCT/ISA/220, o antes de 22 meses a partir de la fecha de prioridad, la primera que expire más tarde.

Para otros informes, véase el formulario PCT/ISA/220.

3. Para mayores detalles, véase Notas al Formulario PCT/ISA/220

Nombre y dirección postal de la Oficina de Búsqueda Internacional (ISA)



European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4485

Fecha de conclusión de este informe

Ver Formulario PCT/ISA/210

Empleado Autorizado

Seufert, G

Teléfono No. +49 89 2399-8330



Formulario PCT/ISA/237 (portada) (Abril 2005)

**INFORME ESCRITO DE LA OFICINA DE BÚSQUEDA
INTERNACIONAL**

Solicitud Internacional No.
PCT/US2005/044501

4
367

Punto No. I Base del Informe

1. En lo concerniente al **Idioma**, el presente informe se basa en:
 - ☐ la solicitud internacional en el idioma en el cual se presentó
 - ☐ una traducción de la solicitud internacional al _____, que es el idioma de una traducción suministrada para los efectos de la búsqueda internacional (según las reglas 12.3(a) y 23.1 (b))
2. Con respecto a cualquier **secuencia de nucleótidos y/o aminoácidos** divulgada en la solicitud internacional y necesaria para la invención reivindicada, este informe se ha establecido sobre la base de:
 - a. Tipo de material
 - ☐ Un listado de secuencia
 - ☐ Tabla(s) relacionada con el listado de secuencia
 - b. Formato de material
 - ☐ En papel
 - ☐ En medio magnético
 - c. Hora de presentación / entrega
 - ☐ Incluida en la solicitud internacional tal como se presentó.
 - ☐ Presentada junto con la solicitud internacional en medio magnético
 - ☐ Entregada posteriormente a esta Oficina para efectos de búsqueda.
3. ☐ Adicionalmente, en el caso de que se hayan presentado o entregado más de una versión o copia de un listado de secuencia y/o tabla(s) relativa a ella, se aportaron las declaraciones de que la información en las copias subsiguientes o adicionales es idéntica a la contenida en la solicitud, tal como se presentó, o no va más allá de la solicitud, tal como se presentó, según lo apropiado.
4. Comentarios adicionales:

Punto No. V Declaración motivada bajo Regla 43 *bis*.1(a)(i) en cuanto a la novedad, la actividad inventiva y la posibilidad de aplicación industrial; documentos y explicaciones que sustentan esta declaración

1. DECLARACIÓN			
Novedad (N)	Si:	Reivindicaciones	3-6, 8-10, 13-32, 34-64
	No:	Reivindicaciones	1, 2, 7, 11, 12, 33
Actividad Inventiva (IS)	Si:	Reivindicaciones	
	No:	Reivindicaciones	1-64
Posibilidad de Aplicación Industrial (IA)	Si:	Reivindicaciones	1-64
	No:	Reivindicaciones	

2. Documentos y explicaciones:

Véase hoja separada

Se hace referencia a los siguientes documentos:

- D1 JOURNAL OF COMBINATORIAL CHEMISTRY, vol. 1, No. 6, 1999, páginas 534-539,
- D2 WO 95/19964 A (ALLERGAN, INC) 27 de julio de 1995 (1995-07-27)

V. Declaración justificada con respecto a la novedad, actividad inventiva y posibilidad de aplicación industrial

Novedad

La presente solicitud se refiere a compuestos de prostaglandina de acuerdo con la fórmula de la reivindicación 1, su uso en la fabricación de medicamentos para el tratamiento de glaucoma o reducción de la presión intraocular (reivindicación 63) y un líquido oftálmicamente aceptable que los contiene (reivindicación 64).

Los compuestos que caen dentro del ámbito de la reivindicación 1 se anticipan por el documento D1, ver D1, tabla 2, compuestos 12a-j. En consecuencia, se considera que la reivindicación 1, así como las reivindicaciones dependientes 2, 7, 11, 12 y 33, no satisfacen el requerimiento del Artículo 33(2) PCT.

Ninguno de los documentos disponibles del arte previo divulga un compuesto que cae dentro del ámbito de las reivindicaciones 3-6, 8-10, 13-32 y 34-62. Por consiguiente, estas reivindicaciones parecen satisfacer el requerimiento del Artículo 33(2) PCT.

Documento D1 no divulga explícitamente el uso del compuesto en el tratamiento de glaucoma o un líquido oftálmicamente aceptable que comprenda estos compuestos. Por lo tanto, las reivindicaciones 63 y 64, parecen satisfacer el requerimiento del Artículo 33(2) PCT.

Actividad Inventiva

Documento D1 no divulga explícitamente el uso del compuesto en el tratamiento de glaucoma. No obstante, indica claramente que estos compuestos tienen una estructura similar al agonista de receptor EP₂ conocido AH13205, el cual se conoce en el arte para el tratamiento de glaucoma y presión intraocular

(ver D2) y, en consecuencia, pueden tener un potencial para tomar como diana este receptor. Para verificar esta hipótesis el experto sólo necesita llevar a cabo las pruebas necesarias, que se conocen en el arte, ver por ejemplo D2, con el fin de establecer si los compuestos de D1 son útiles o no como agonistas de receptor EP₂. Esto no requiere habilidades inventivas. Por consiguiente, se considera que las reivindicaciones 63 y 64 no satisfacen el requerimiento del Artículo 33(3) PCT.

La presente solicitud no satisface los criterios del Artículo 33(1) PCT, porque el asunto de las reivindicaciones, en la medida en que son novedosas, no implican una actividad inventiva en el sentido del Artículo 33(3) PCT.

Con respecto a D2 y/o D1, que pueden considerarse como el arte previo más relevante, el problema a resolverse por la presente invención puede considerarse como proporcionar agonistas selectivos adicionales de receptor EP₂ de prostaglandina, útiles en el tratamiento de glaucoma e hipertensión ocular.

Tabla 1 que, de acuerdo con el solicitante, debe demostrar la actividad deseada de los compuestos reivindicados, muestra que un número suficiente de los compuestos que caen dentro del ámbito de las reivindicaciones no son activos, no son selectivos o, incluso, más selectivos para otros receptores. Por lo tanto, el problema técnico fundamental de la presente solicitud no se considera resuelto a través de, básicamente, todo el ámbito de las reivindicaciones. En consecuencia, no se cumple el requerimiento del Artículo 33(3) PCT.

Más aún, de acuerdo con las reivindicaciones, el grupo fenilo o heteroarilo en la definición de A puede sustituirse por absolutamente cualquier cosa. Tan amplia definición se considera una generalización no justificada en vista de los compuestos explícitamente preparados y probados. No es creíble que absolutamente cualquier sustituyente en el grupo fenilo o heteroarilo llevará a compuestos con la actividad deseada y, por lo tanto, resolverá el problema técnico, especialmente tomando en cuenta que las cadenas laterales α y ω son determinantes críticas para la afinidad y especificidad del receptor de prostaglandina, ver D1, página 534, columna derecha, renglones 37. Por consiguiente, no se satisfacen los requerimientos del Artículo 33(3).

Adicionalmente, con el fin de que una reivindicación de compuestos que utilizan una fórmula de Markush se considere uniforme, los compuestos

reivindicados deben tener una fracción estructural que sea distinta en vista del arte previo. En vista de D1, tal característica estructural común novedosa no es evidente.

Posibilidad de Aplicación Industrial

No existen objeciones contra la posibilidad de aplicación industrial.

Otras observaciones:

No se considera que el término "profármaco" empleado de principio a fin de las reivindicaciones y la descripción definan claramente y sin ambigüedades el asunto para el cual se busca protección (es decir, la estructura química de los compuestos incluidos en esa definición). El experto en el arte no se encuentra en posición de saber, sin una carga excesiva de experimentación, qué compuestos podrían considerarse profármacos apropiados. Adicionalmente, el término "profármaco" describe simplemente el resultado deseado sin proporcionar las características técnicas necesarias para lograr este resultado. En consecuencia, no se cumplen los requerimientos del Artículo 6 PCT.

El significado de la expresión "un éster o una amida que comprende 0 átomos de carbono" en la definición de Y en las reivindicaciones no es clara.

La reivindicación 35 no es clara por la siguiente razón: La fórmula indica que R⁴ y R⁵ pueden formar un anillo. No obstante, la definición de R⁴ y R⁵ no incluye tal cierre de anillo.

La reivindicación 64 no satisface el requerimiento del Artículo 6 PCT. En primer lugar, en vista de la forma en que se redacta la reivindicación 64, no es claro qué compuestos están comprendidos en el líquido reivindicado. En segundo, parece que la reivindicación intenta definir el asunto en términos del resultado a lograrse, lo cual simplemente equivale a una declaración del problema fundamental, sin proporcionar las características técnicas necesarias para conseguir este resultado.

La suma de m y o como se menciona en la página 7, renglón 15 de la solicitud es inconsistente con las reivindicaciones y otras partes de la descripción, donde se ha dado un rango de 1-4 para la suma de m y o.

Contrario a los requerimientos de la Regla 5.1 (a)(ii) PCT, el arte previo relevante divulgado en el documento D1 no se menciona en la descripción, ni este documento se identifica en ella.

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 17693PCTAP	FOR FURTHER ACTION See item 4 below	
International application No. PCT/US2005/044501	International filing date (day/month/year) 08 December 2005 (08.12.2005)	Priority date (day/month/year) 10 December 2004 (10.12.2004)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant ALLERGAN, INC.		

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 8 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: <table border="0"> <tr> <td>☒ Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td>☐ Box No. II</td> <td>Priority</td> </tr> <tr> <td>☐ Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td>☐ Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td>☒ Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td>☐ Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td>☐ Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td>☐ Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table> 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).	☒ 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
☒ 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															

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70 Form PCT/IB/373 (January 2004)	Date of issuance of this report 13 June 2007 (13.06.2007)
	Authorized officer Beate Giffo-Schmitt e-mail: pti3.pci@wipo.int

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

REC'D 24 MAY 2006

WIPO

PCT

PCT

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/US2005/044501

International filing date (day/month/year)
08.12.2005

Priority date (day/month/year)
10.12.2004

International Patent Classification (IPC) or both national classification and IPC
INV. C07C405/00 A61K31/5575 A61P27/06

Applicant
ALLERGAN, INC.

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") 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:



European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523856 epmu d
Fax: +49 89 2399 - 4465

Date of completion of
this opinion

see form
PCT/ISA/210

Authorized Officer

Seufert, G

Telephone No. +49 89 2399-8330



**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2005/044501

H
375

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
 - ☐ a translation of the international application into , which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) 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:
 - ☐ on paper
 - ☐ in electronic form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in electronic 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:

Reference is made to the following documents:

- D1 JOURNAL OF COMBINATORIAL CHEMISTRY, vol. 1, no. 6, 1999, pages 534-539,
D2 WO 95/19964 A (ALLERGAN, INC) 27 July 1995 (1995-07-27)

V. Reasoned statement with regard to novelty, inventive step or industrial applicability

Novelty

The present application refers to prostaglandin compounds according to the formula of claim 1, their use in the manufacture of medicaments for the treatment of glaucoma or reduction of intraocular pressure (claim 63) and an ophthalmically acceptable liquid comprising them (claim 64).

Compounds falling within the scope of claim 1 are anticipated by the document D1, see D1, table 2, compounds 12a-j. Claim 1 as well as the dependent claims 2, 7, 11, 12 and 33 are therefore not considered to meet the requirement of Art. 33(2) PCT.

None of the available prior art documents discloses a compound falling within the scope of claims 3-6, 8-10, 13-32 and 34-62. These claims appear therefore to meet the requirement of Art. 33(2) PCT.

Document D1 does not explicitly disclose the use of the compound in the treatment of glaucoma or an ophthalmically acceptable liquid comprising these compounds. Claims 63 and 64, therefore, appear to meet the requirement of Art. 33(2) PCT.

Inventive step

Document D1 does not explicitly disclose the use of the compound in the treatment of glaucoma. However, it clearly indicates that these compounds have a similar structure to the known EP₂ receptor agonist AH13205, which is known in the art for

the treatment of glaucoma and intraocular pressure (see D2), and therefore they may have a potential for targeting this receptor. To verify this hypothesis the skilled person merely has to carry out the necessary tests, which are known in the art, see for example D2, in order to establish whether or not the compounds of D1 are useful as EP₂ receptor agonists. This does not require inventive skills. Claims 63 and 64 are therefore not considered to meet the requirement of Art. 33(3) PCT.

The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of the claims as far as they are novel, does not involve an inventive step in the sense of Article 33(3) PCT.

With regard to D2 and/or D1, which may be considered as the most relevant prior art, the problem to be solved by the present invention may be considered as providing further selective prostaglandin EP₂ receptor agonists useful in the treatment of glaucoma and ocular hypertension.

Table 1, which according to the applicant should demonstrate the desired activity of the claimed compounds, shows that quite a number of the compounds falling within the scope of the claims are not active, not selective or even more selective for other receptors. The technical problem underlying the present application is therefore not considered to be solved over basically the whole scope of the claims. The requirement of Art. 33(3) PCT is thus not fulfilled.

Furthermore, according to the claims the phenyl or heteroaryl group within the definition of A can be substituted by absolutely anything. Such a broad definition is considered to be an unreasonable generalisation in view of the explicitly prepared and tested compounds. It is not credible that absolutely any substituent at the phenyl or heteroaryl group will lead to compounds with the desired activity and therefore solve the technical problem, especially taking into consideration that the α - and ω -side chains are critical determinants for prostaglandin receptor affinity and specificity, see D1, page 534, right column, lines 37. The requirements of Art. 33(3) are therefore not fulfilled.

Additionally, in order for a claim to compounds using a Markush formula to be

regarded as uniform, the claimed compounds should have in common a structural moiety which is distinctive in view of the prior art. In view of D1 such a novel common structural feature is not apparent.

Industrial applicability

There are no objections against the industrial applicability.

Further remarks:

The term "prodrug" employed throughout the claims and the description is not considered to clearly and unambiguously define the subject-matter for which protection is sought (i.e. chemical structure of the compounds included in that definition). The man skilled in the art is not in a position to know without undue burden of experimentation which compounds could be considered to be suitable prodrugs. Additionally, the term "prodrug" merely describes the desired result without providing the technical features necessary to achieve this result. The requirements of Art. 6 PCT are therefore not fulfilled.

The meaning of the expression "an ester or an amide comprising 0 C-atoms" in the definition of Y in the claims is not clear.

Claim 35 is not clear for the following reason: The formula indicates that R^4 and R^5 may form a ring. However, the definition for R^4 and R^5 does not include such a ring closure

Claim 64 does not meet the requirement of Art. 6 PCT. Firstly, in view of the way claim 64 is drafted, it is not clear what compounds are comprised in the claimed liquid. Secondly, it appears that the claim attempts to define the subject-matter in terms of the result to be achieved, which merely amounts to a statement of the underlying problem, without providing the technical features necessary for achieving this result.

The sum of m and o as mentioned on page 7, line 15 of the application is inconsistent with the claims and other parts of the description, where for the sum of m and o a range of 1-4

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

International application No.

PCT/US2005/044501

has been given.

Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the document D1 is not mentioned in the description, nor is this document identified therein.

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2005/044501

46
380

**Box No. V Reasoned statement under Rule 43b/s.1(a)(I) with regard to novelty, inventive step or
Industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	3-6, 8-10, 13-32, 34-64
	No: Claims	1, 2, 7, 11, 12, 33
Inventive step (IS)	Yes: Claims	
	No: Claims	1-64
Industrial applicability (IA)	Yes: Claims	1-64
	No: Claims	

2. Citations and explanations

see separate sheet

17

381

APOSTILLE

(Convention de La Haye du 5 octobre 1961)

1. Country: *United States of America*

This public document

2. has been signed by M. K. Carter

3. acting in the capacity of Certifying Officer

4. bears the seal/stamp of U. S. Patent and Trademark Office

Certified

5. at Washington, D.C.

6. the fourteenth of June, 2007

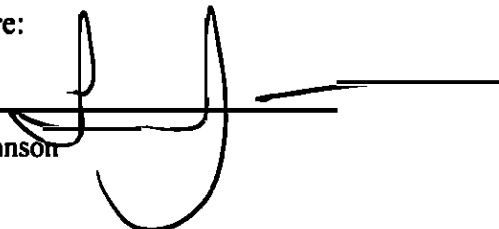
7. by *Assistant Authentication Officer, United States Department of State*

8. No. 07025851-1

9. Seal/Stamp:

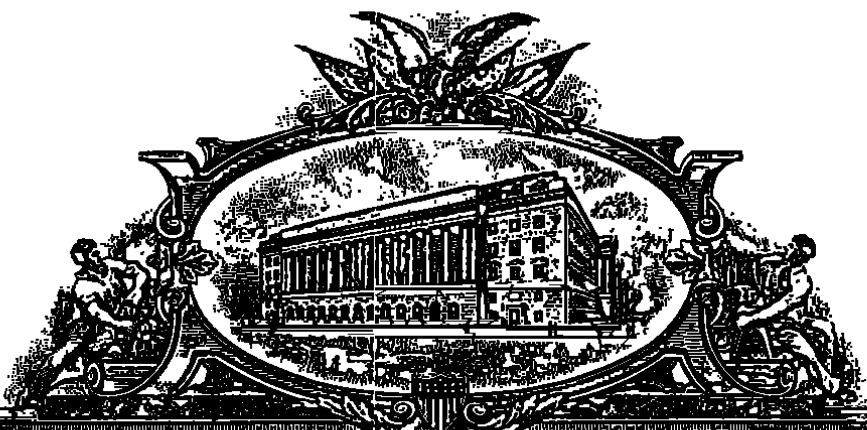
10. Signature:

Sonya N. Johnson



18
382

A 1614614



INDEPENDENT SINGLES OF AMERICA

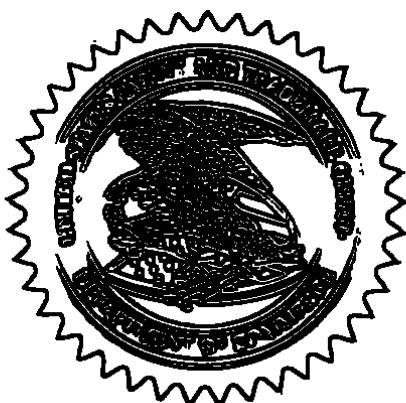
TO ALL TO WHOM THESE PRESENTS SHALL COME:

**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

May 25, 2007

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE
RECORDS OF THIS OFFICE OF A DOCUMENT RECORDED ON
DECEMBER 10, 2004.**

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**




M. K. CARTER
Certifying Officer

12-23-2004

Docket No. 17693 (AP)

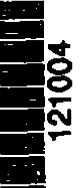
COVER SHEET



102910022

22387 U.S. PTO
11/009298

383



TO: THE COMMISSIONER OF PATENTS AND TRADEMARKS

Please record the attached document(s) or copy(ies):

1. Submission Type:

- ☒ NEW
- ☐ Correction of PTO error (Reel /frame)
- ☐ Corrective Document (Reel /frame)

2. Conveyance Type:

- ☒ Assignment
- ☐ License
- ☐ Merger
- ☐ Security Agreement
- ☐ Change of Name
- ☐ Other: _____

3.

CONVEYING PARTIES	
Names of Conveying Parties	Date of Conveyance
1. YARIV DONDE	DECEMBER 9, 2004
2. JEREMIAH H. NGUYEN	DECEMBER 9, 2004
3.	
4.	

☐ Additional Conveying Parties Attached.

4.

RECEIVING PARTIES	
Names of Receiving Parties	
Name: Allergan, Inc.	
Address 1: 2525 Dupont Drive	
Address 2: Irvine, CA 92612	

☐ Additional Receiving Parties Attached.

5. ☐ If document is an assignment and the Receiving Party is not domiciled in the United States, an appointment of a Domestic Representative is attached.

12/22/2004 ECD/PER 00000136 010045 11009298
01 FC:0021 40.00 DA

PATENT
REEL: 016085 FRAME: 0772

70
384

6.

DOMESTIC REPRESENTATIVE NAME AND ADDRESS
Name:
Address 1:
Address 2:

7.

CORRESPONDENCE NAME AND ADDRESS
Name: Brent A. Johnson (T2-7H)
Address 1: Allergan, Inc.
Address 2: 2525 Dupont Drive, Irvine, CA 92612
Telephone 714-246-4348 and Fax 714-246-4249

8. Total Number of pages of the conveying document, including attachments: 2 pages

9.

APPLICATION NUMBER OR PATENT NUMBER (either; not both for same property)	
Application Number	Patent Number
Application Number	Patent Number

10. If this document is being filed with a NEW patent application, enter the Docket No., Title of the Invention, and date of execution of the Assignment by the first inventor:

Title of Patent Application: **12-ARYL PROSTAGLANDIN ANALOGS**
Docket No.: **17693 (AP)**
Date of Execution by First Inventor: **December 9, 2004**

11. Total Number of Properties Involved: 1

12. The fee amount (37 CFR §3.41) of \$ 40.00

☒ may be debited from our Deposit Account No. 01-0885.
☐ is enclosed as check no. _____.

13. ☒ The Commissioner is authorized to deduct any additional fee amounts due in connection with the filing of this document from Deposit Account No. 01-0885.

To the best of my information and belief, all statements made herein are true, and any attached copy is a true copy of the original document.

Respectfully submitted,

SIGNATURE

Brent A. Johnson

Date:

12/10/04

TYPED or PRINTED NAME: **BRENT A. JOHNSON** REGISTRATION NO. **51.851**

CERTIFICATE OF EXPRESS MAILING UNDER 37 C.F.R. § 1.10

I hereby certify that this Assignment and the additional documents enclosed herein are being deposited with the United States Postal Service on this date December 10, 2004 in an envelope as "Express Mail Post Office to Addressee" Mailing Label number EV193720036US addressed to MS: Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: December 10, 2004

Susan Bartholomew

Name of person mailing paper

Susan Bartholomew
Signature of person mailing documents

PATENT
REEL: 016085 FRAME: 0773

ASSIGNMENT 385

WHEREAS IWE, YARIV DONDE and JEREMIAH H. NGUYEN both of ORANGE COUNTY, CALIFORNIA (hereinafter referred to as ASSIGNOR), have invented and own a certain invention entitled **12-ARYL PROSTAGLANDIN ANALOGS** for which application for Letters Patent of the United States was executed by me herein.

WHEREAS, Allergan, Inc., having its principal place of business at 2525 Dupont Drive, Irvine, CA 92612 (hereinafter referred to as ASSIGNEE), is desirous of acquiring the entire interest in, to and under said invention and in, to and under Letters Patent or similar legal protection to be obtained therefor in the United States and in any and all foreign countries.

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN, be it known that in consideration of the payment by ASSIGNEE TO ASSIGNOR of the sum of One Dollar (\$1.00), the receipt of which is hereby acknowledged, and for other good and valuable consideration, ASSIGNOR hereby sells, assigns and transfers to ASSIGNEE the full and exclusive right, title and interest to said invention in the United States and its territorial possessions and in all foreign countries to all Letters Patent or similar legal protection in the United States and its territorial possessions and in any and all foreign countries to be obtained for said invention by said application or any continuation, divisional, renewal, substitute or reissue thereof or any legal equivalent thereof in a foreign country for the full term or terms for which the same may be granted. ||

ASSIGNOR hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment and sale;

ASSIGNOR further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said application, said invention and said Letters Patent and legal equivalents in foreign countries as may be known and accessible to ASSIGNOR and will testify as to the same in any interference or litigation related thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue and enforce said application, said invention and said Letters Patent and said equivalent thereof in any foreign country which may be necessary or desirable to carry out the purposes thereof. |

IN WITNESS WHEREOF, I/We have hereunto set hand and seal this

9 day of December, 2004 [Signature]
YARIV DONDE

State of CALIFORNIA)
) ss:
County of ORANGE)

On December 9, 2004 before me, Susan Bartholomew, Notary Public, personally appeared YARIV DONDE and JEREMIAH H. NGUYEN, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument and acknowledged to me that he/she executed the same in his/her authorized capacity, and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

[Signature]
Notary Public



IN WITNESS WHEREOF, I/We have hereunto set hand and seal this

9 day of December, 2004 [Signature]
JEREMIAH H. NGUYEN

State of CALIFORNIA)
) ss:
County of ORANGE)

On _____ before me, Susan Bartholomew, Notary Public, personally appeared YARIV DONDE and JEREMIAH H. NGUYEN, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument and acknowledged to me that he/she executed the same in his/her authorized capacity, and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Notary Public

See above certificate