

Commissioner's decision

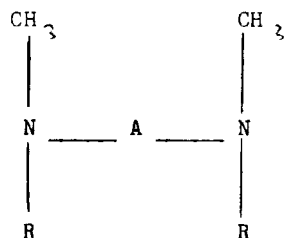
Section 41: Diamines and addition salts of diamines used as medicines and non-medicines. Claims 17 to 22 are refused because they cover diamine salts, which are medicines. The examiner's refusal is confirmed.

Pursuant to s 47(5) of the Patent Rules, applicant L'Oréal has requested a review of the examiner's final action in patent application 227,052, (Class 260/597.7). The inventors are Bernard Jacquet and Gérard Lang, and their application is entitled "New diamines, their preparation and use".

The examiner dismissed claims 17 to 22 for failure to comply with the requirements of s 41 of the Patent Act. These claims relate to certain new diamines and their addition salts with acids.

Diamine addition salts have interesting germicidal and, in particular, bactericidal and fungicidal properties, which make them useful in chemotherapy. As such, they must be restricted to the process by which they are manufactured. Following the examiner's refusal, applicant withdrew all claims for the salts themselves (claims 23 and 24). At the same time, he declared that claims 17 to 22 should not be refused, because they relate to the diamines themselves, that is, to free amines, while it is only amine salts that are medicines. Actually, the only independent claim for a product (17) is made for diamines and their addition salts. The claim reads as follows:

Diamines with general formula I:



and their addition salts . . .

Therefore, claims 18 to 22, which depend directly or indirectly on claim 17, are not restricted to free amines. Diamine salts are also diamines, because there are amino radicals in their molecules. Thus, if claim 19, for example, relies on the diamines in claim 17, it necessarily covers the salts mentioned in claim 17. If claim 18 had been restricted to free diamines, the salts would have been excluded, but this was not the case. We conclude that claims 17 to 22 cover free amines and amine salts as well. We cannot agree with applicant's statement in his letter of December 12, 1979, p 3:

Claims 17 to 22 do in fact relate to free amines. . . .

To settle all the issues, we must also determine whether the free diamines are also governed by s 41, even if they were claimed separately, that is, without the salts.

The grounds for the examiner's refusal were stated as follows:

Claims 17 to 22 involve free amines used as intermediates in preparing the salts defined in claims 23 and 24 (see examples of preparation of these salts on pages 17 and 18). These amines are therefore governed by s 41(1) pursuant to the Commissioner's decision published in the Patent Office Record on January 21, 1975.

The fact that the applicant employs these intermediates in the preparation of polymers with cosmetic properties in no way alters the fact that they are also compounds "intended for medicine".

The examiner cited the Cheney decision, also published in (1975) 17 Canadian Patent Reporter (2d) 165. References to this decision will be to this publication.

Applicant argued that, since free amines cannot be used to prepare cationic polymers for cosmetics, the provisions of s 41 do not apply. He explained that the polymers moisturize and soften the skin and that this is a non-medical use.

He added that their germicidal, bactericidal and fungicidal properties make them useful as preservatives for leather and paper. It should, however, be noted that when the polymers are used on human skin, their germicidal and bactericidal properties have a therapeutic effect on skin tissue.

In arguing against Cheney, applicant stated:

Actually, this case concerns intermediates, whose only utility lies in the production of medicines. Similarly, in the British decision (39 CPR 163) on which the Commissioner of Patents relied in Lee C Cheney, products were involved whose sole use was in the production of food products.

He further said:

At page 172 of Cheney, it is even indicated explicitly that this decision is not applicable to products which could be used in the preparation of medicines, but which have another use outside the area of medicine:

Whether it would also apply
to chemical substances
whose intended use is
non-medicinal but which may
also be capable of being
used to prepare medicines .
. . we need not determine
here.

In Cheney, the intermediate products, which by themselves would have prevented access to the penicillins, were the only commercial means available for preparing a certain type of penicillin. Applicant stated:

In Cheney, the Commissioner of Patents seems to have based his decision primarily on the fact that the intermediates claimed were key products in the commercial manufacture of known penicillins, and were an essential step in preparing other penicillins. In this case, protection of the intermediates would have resulted in preventing access to these important penicillin derivatives.

He argued that this case is different, because:

. . . it is well known that amine salts can always be prepared directly without going through the free amine stage.

Nevertheless, in the specification, on lines 22 to 25 of page 5, for example, we find:

Formula I diamine salts are prepared by the usual methods, by the addition of Formula X-H acids to Formula I diamines, with X defined as above.

Since both applicant and the examiner cited Cheney, we have carefully studied this decision, particularly pages 169 to 173, published at (1975) 17 CPR (2d).

The decisions which were considered in Cheney clearly indicate that s 41 and the expression "intended for medicine" should be broadly interpreted, and that this interpretation applies to all precursors for the preparation of medicinal compounds. Therefore, free diamines and diamine salts are intended for medicine.

We do not think it is important that the precursors provide the only means of manufacturing the medicines. It was a supplementary ground in Cheney, but the other reasons are sufficient for holding that s 41 applies here.

Applicant emphasized the following statement from Cheney:

Whether it would also apply to chemical substances whose intended use is non-medicinal but which may also be capable of being used to prepare medicines within the meaning of Parke, Davis v Fine Chemicals, supra, at pp 66-7, we need not determine here.

He indicated that this decision is not "applicable to products which can be used in the preparation of medicines, but which have another use outside the area of medicine."

However, the excerpt cited does not go so far. If the intended use is non-medicinal, but the product is incidentally suited to a medicinal use, it is possible to argue that it is not intended as a medicine; but if the product is intended for non-medicinal use and also for use as a medicine, then it is intended for medicine.

According to the specification, the products were clearly intended to be used as medicines. See, for example, page 8, line 16 to page 9, line 13.

We find, therefore, that the substances under consideration, free diamines and also their salts, are intended for medicines. We also find that claims 17 to 22 inclusive cover diamine salts which are themselves medicines, and finally, that a number of other cosmetic uses have a medicinal character because they improve the skin and free it of bacteria. We recommend that the refusal of claims 17 to 22 be confirmed.

(sgd)

G Asher

Chairman of the Patent Appeal Board

I concur with the findings of the Patent Appeal Board and refuse claims 17 to 22. Pursuant to the provisions of s 44 of the Patent Act, the applicant has six months to appeal this decision or to withdraw these claims.

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Commissioner of Patents

Dated at Hull, Quebec

This 4th day of September, 1981