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D E C I S I O N
of 22 November 1996

Case Number: J 0017/92 - 3.1.1
Application Number: 88118242.2
Publication Number: 0316657
IPC: C07D 239/90
Language of the proceedings: EN

Title of invention:
Substituted quinazolinones as anticancer agents

Applicant:
WARNER-LAMBERT Company

Headword:
Consolidation/WARNER-LAMBERT

Relevant legal provisions:
EPC Art. 96(3)
Legal advice L10/92, L 10/81

Keyword:
"Consolidation permissible"
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee equitable"

Decisions cited:
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Catchword:
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Case Number: J 0017/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal
of 22 November 1996

Appellant: WARNER-LAMBERT COMPANY
(Opponent) 201 Tabor Road
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Decision under appeal: Decision of the Examining Division of the
European Patent Office dated 15 January 1992,
refusing a request for joint processing of
European Patent Application 88 118 242.2 and
Euro-PCT application No. 88 910 271.1

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. C. Perryman
J. P. B. Seitz

Summary of Facts and Submissions

- I. European patent application 88 118 242.2 designating Greece and Spain was filed on 2 November 1988 in the name of the Appellant, claiming the priority date of 3 November 1987 and containing 12 claims. On 25 April 1990 the Appellant filed a request for joint processing of the present application and PCT/US 88/03902 (European application No. 88 910 271.1 designating Austria, Belgium, Switzerland, Germany, France, Great Britain, Italy, Luxembourg, The Netherlands and Sweden) also filed on 2 November 1988 and claiming the same priority of 3 November 1987. On 12 March 1991, the Appellant furnished the statement that the applications to be consolidated were based on the same priority dates and were identical with regard to the description and claims.
- II. On 7 November 1991, a communication of the Examining Division under cover of a Form 2001.2 stated on the cover sheet *inter alia* "...You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the deficiencies within a period of two months....Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn..". In the accompanying annex Legal Advice no 10/81, OJ EPO 9/1981 pages 349 to 355, and in particular page 352 were referred to, and it was indicated why the application for consolidation did not meet the requirements there stated, so that the consolidation was not considered admissible. The Appellant was invited to state whether he requested a formal decision on which an appeal could be lodged.

III. On 5 December 1991, a letter dated 3 December 1991 was received from the appellant. In this letter the Appellant requested explanation of the legal basis under the European Patent Convention for issuing said communication. An inquiry over the phone held on 9 December 1991 revealed that the Appellant disapproved of the covering EPO Form 2001 with which the communication was sent. At the same time, a formal decision was requested.

IV. On 15 January 92 the Examining Division issued a Decision, stated to be appealable, refusing the request for joint processing. The following reasons were given:

"The European Patent Convention is silent on the question of whether applications may be consolidated. This question is dealt with in Legal Advice No. 10/81, OJ EPO 9/1981, pages 349 to 355, wherein also the requirements to be fulfilled for consolidation of proceedings are laid down.

According to Legal Advice No. 10/81, in particular page 352, the texts of the description and claims must be identical both on the date of filing and on the date of the decision consolidating the application.

This condition is not complied with in the present case, since on the date of filing the present application contained 12 claims whereas the Euro-PCT application as originally filed contained 20 claims.

Comparison of the application documents of the two files reveals that claims 1 to 4 correspond; present claim 5 combines Euro-PCT original claims 5, 6, 8, 10, 11 and 15; present claim 6 combines Euro-PCT original claims 7, 9, 12, 13 and 14; present claim 12 does not appear to have been contained in the Euro-PCT original claims version at all.

An amended set of claims corresponding literally to the present one was filed on 25 April 1990 (received on 27 April 1990) in the Euro-PCT case. However, this set of claims has to be disregarded for the purpose of consolidation since also the contents of the application documents as originally filed are to be taken into consideration for the assessment of whether or not the requirements for joint processing are fulfilled (cf. the reasons set out in Legal Advice No. 10/81, loc.cit., page 352, item 9.).

According to what is stated above the Examining Division holds that the requirements for joint processing of European applications Nos. 88 118 242.2 and 88 910 271.1 are not fulfilled.

The Appellant is reminded that according to the European Patent Convention, no consolidation of proceedings is provided for. Therefore, the appellant's request for an explanation of the legal basis of the communication of 7 November is considered to be irrelevant.

Finally, in relation to the appellant's complaint as to the inapplicable accompanying form with which the said communication was transmitted, it is pointed out that the overwhelming majority of communications issued by

the Examining Divisions are those pursuant to Article 96(2) EPC. Therefore, the use of form 2001 has to be regarded as being a minor oversight, the more so as the observations of the Examining Division were clearly and unambiguously set out in the accompanying annex.

In view of the above, the appellant's answer cannot be considered a **bona fide** reply, and the Examining Division sees no purpose in sending any further communication, since these [sic] would result in a literal repetition of what has already been set forth in the official communication of 7 November 1991."

- V. The Appellant appealed alleging that the non-withdrawal of the communication amounted to a substantial procedural violation, and that as the legal advice had no binding status, and the requirement that the text as filed of the applications be identical was inappropriate, the requested consolidation should be ordered.

Reasons for the Decision

1. The appeal is admissible.
2. As stated by the appellant, the legal advice L 0010/81, since replaced by L 0010/92 (OJ EPO 1992, 662) whose text does not differ in any material respect, is not binding on the organs of the EPO. Thus the possibility for consolidation that it interprets into the EPC and the preconditions that it lays down for such consolidation are subject to review by the Boards of Appeal.

3. The Board considers that allowing consolidation is something both permissible and desirable under the European Patent Convention, in accordance with the desire expressed in the preamble to the Convention that such protection may be obtained in the Contracting States by a single procedure for the grant of patents. Consolidation is not only in the interest of applicants, but also in that of the public not to have to take account of two separate European Patents with the same text.

4. However the conditions to be imposed for consolidation should not be more restrictive than necessary. Here the Board considers the condition that the two applications to be consolidated must be word for word identical as filed, too stringent. Where as here an applicant is seeking to consolidate a PCT Euro application for some Contracting states, with a direct European application for other Contracting states, it is not unnatural that the direct European application has been adapted to European requirements, but the Euro PCT application still has claims adapted to the requirements of the applicant's home country. Where, as in the case of the United States, the formal requirements that claims should meet are somewhat different to the requirements of the European Patent Office, it is likely that the wording of the texts as filed of the Euro PCT application and the European application will differ, particularly as regards the formulation of the claims. However if the form of claims with which the applicant wants to proceed in the consolidated applications is acceptable either as an amended set of claims or as being identical to the set of claims as filed, consolidation should be possible.

5. If the set of claims is not acceptable as an amended set of claims in one application, then the applicant will have to take the risk that the applications will have to be separated again, or that he must put forward a text which is acceptable on both applications. This involves the examination division checking the acceptability of the set of claims for both applications. Such work is however justifiable in view of the greater simplicity for the Appellant and all others who might have to consider the patent.

6. The particular differences in this case (see Facts and Submissions IV) relate only to claim dependencies and in the case of claim 12 the introduction of a claim in the first medical use format. Prima facie such an amended set of claims should not prevent consolidation.

7. The Appellant also complained that the Examining Division used the wrong form for its communication, namely one threatening that the application would be refused if a response was not filed. The Examining Division agreed that the form was wrong, but failed to withdraw it, thus taking away from the Appellant the option of tacitly abandoning his request for consolidation. The Board considers this failure by the Examination Division to withdraw the wrong form, and thus to withdraw the threatened sanction of a possible refusal of the application, to amount to a substantial procedural violation, and that in the circumstances reimbursement of the appeal fee is equitable under Rule 67 EPC.

Order

for these reasons it is decided that:

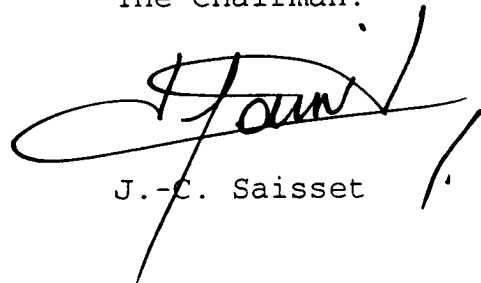
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

NS