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**Datasheet for the decision
of 18 October 2006**

Case Number: W 0006/06 - 3.3.04

Application Number: PCT/US2005/010331

Publication Number: WO 2005095651

IPC: C12Q 1/68

Language of the proceedings: EN

Title of invention:

Molecular markers of cisplatin resistance in cancer and uses thereof

Applicant:

Research Development Foundation

Opponent:

-

Headword:

Molecular markers/RESEARCH

Relevant legal provisions:

EPC R. 105(3)
PCT R. 40.2(e)
PCT R. 80.2 and 80.5
RRF Art. 1(b), 2.21, 8(3)

Keyword:

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Decisions cited:

W 0003/95

Catchword:

-



Case Number: W 0006/06 - 3.3.04

International Application No. PCT/US2005/010331

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 18 October 2006

Applicant: Research Development Foundation
402 North Division Street
Carson City, NV 89703 (US)

Representative: FULBRIGHT & JAWORSKI L.L.P.
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Subject of the Decision: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fees) of the European Patent Office (International Searching Authority) dated 22 September 2005.

Composition of the Board:

Chairwoman: U. Kinkeldey
Members: G. Alt
C. Holtz

Summary of Facts and Submissions

- I. The European Patent Office acting as International Searching Authority (ISA) with letter of 22 September 2005 invited the applicant to pay additional fees in accordance with Article 17(3)(a) and Rule 40.1 PCT. The applicant paid the additional fees under protest with letter of 21 October 2005. After review as to the justification for the invitation, the ISA invited the applicant to pay the protest fee within one month from 12 January 2006. The ISA also notified the applicant that failure to pay the protest fee within the time limit indicated would result in the protest being considered withdrawn.
- II. Payment of the protest fee was received by the European Patent Office on 15 February 2006. The protest case was referred to the boards of appeal shortly thereafter.
- III. In a communication faxed on 14 August 2006, the board of appeal notified the applicant of the opportunity to have the time limit for payment of the protest fee to be considered to be met, provided that the applicant fulfilled one of the conditions listed in Article 8(3), (i), (ii) or (iii) of the Rules Relating to Fees (RRF) and additionally paid a surcharge of 10% on the relevant fee. The applicant was invited to present the required evidence and pay the surcharge within two months from the date of the communication.
- IV. With letter of 24 August 2006, the applicant informed the board that it had "decided NOT to pursue the protest of the additional search fees."

Reasons for the Decision

1. Rule 105(3) EPC, last sentence stipulates that a protest shall be referred to the board of appeal for a decision only if the protest fee is paid in due time. Thus, before referring a protest case to the Boards of Appeal, the International Searching Authority (or the International Preliminary Examination Authority) must determine that the applicant has paid the fee within the given time limit.
2. If it is established that an applicant has not met the date for the due payment of the protest fee, he is given the opportunity to have the time limit for the payment considered as being met by meeting the conditions listed in Article 8(3) of the Rules Relating to Fees (RRF). The Rules Relating to Fees apply to fees under the PCT by virtue of Article 1(b) of the Rules Relating to Fees stipulating that fees and costs pursuant to the Patent Cooperation Treaty (PCT) are levied in accordance with the provisions contained in that Rules. The protest fee is mentioned in Article 2.21 of these Rules.
3. There is no sign in the present file allowing the board to conclude that the International Searching Authority (ISA) has noticed the late (see point 5 below) payment of the protest fee. It referred the case to the Boards of Appeal without having invited the applicant to provide evidence under Article 8(3) RRF.

4. As soon as a protest has been referred to a board of appeal for a decision, the case is pending before the board, independently of whether or not the referral was justified (see decision W 3/95 of 23 November 1995, point 5 of the reasons). This board has therefore examined whether the protest fee was paid in time.

5. With mailing date of 12 January 2006 the ISA invited the applicant pursuant to Rule 40.2(e) PCT to pay a protest fee within one month from the date of mailing. According to Rule 80.2 PCT if a period is expressed in months "the period shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred". Thus, pursuant to this Rule the period of one month set by the ISA in its invitation ended on 12 February 2006. This day was however a Sunday.

According to Rule 80.5 PCT if the expiration of any period during which any fee must reach a national office or intergovernmental organization falls on a day on which such office or organization is not open to the public or on which ordinary mail is not delivered, the period shall expire on the next subsequent day on which none of the said circumstances exist. Hence, in the present case, the period for the payment of the protest ended on the 13 February 2006.

However, payment of the protest fee was recorded by the European Patent Office on 15 February 2006.

Hence, the time limit set by the ISA in its invitation of 12 January 2006 for paying was not met.

6. Once the board had determined that the protest fee had not been received within the prescribed time limit, the board, exceptionally, found it procedurally expedient to offer the applicant the opportunity foreseen in Article 8(3) RRF for a revival of the protest in place of the ISA in order not to unnecessarily delay the start of the substantive examination of the protest by a remittal of the case, if the applicant had provided the evidence in accordance with Article 8(3) RRF.
7. The applicant has informed the board that it had decided not to pursue the protest of the additional fees.
8. The legal consequence is that the protest fee is not paid in time, contrary to the provisions of Rule 40.2(e) PCT.
9. The international filing date of the present application is the 28 March 2005. Hence, the PCT in force as of January 2004 is applicable. Rule 40.2(e) PCT stipulates that if the protest fee is not paid within one month from the date of the notification to the applicant of the result of the review, the protest shall be considered withdrawn. In view of Rule 105(3) EPC (see point 1 above) the case is remitted to the ISA to notify the applicant of the failure to pay the protest fee within the due period and the legal consequences thereof.

Order

For these reasons it is decided that:

The case is remitted to the International Searching Authority for further prosecution.

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey