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Bezeichnung der Erfindung: 5-HETERO-OR ARYL-SUBSTITUTED-IMIDAZO
Title of invention: (2,1-a)ISOQUINOLINES
Titre de l'invention :

Klassifikation / Classification / Classement :

ENTSCHEIDUNG / DECISION

vom / of / du 6 June 1988

Anmelder / Applicant / Demandeur : Sandoz-Erfindungen Verwaltungsgesellschaft M.B.H.

Patentinhaber / Proprietor of the patent / Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

PCT Art. 17(3)(a) and Rules 13 to 13.4 and 40.2c

Kennwort / Keyword / Mot clé : Requirement to state reasons in the invitation to pay additional search fee

Leitsatz / Headnote / Sommaire

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Case Number: W 14/88
International Application No. PCT/EP88/00[illegible]

DECISION
of the Technical Board of Appeal 3.3.2
of 6 June 1988

Applicant : Sandoz A.G.
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A-1235 Vienna (AT)

Representative : A.E. Norris et al
c/o Sandoz A.G.
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Subject of this decision : Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fee) of the European Patent Office (branch at The Hague) dated 21 March 1988

Composition of the Board :

Chairman : P. Lançon
Members : S. Schödel
E. Persson

Summary of Facts and Submissions

I. On 13 January 1988 the Applicant filed an International Patent Application PCT/EP88/00021 with the European Patent Office. The application included 11 claims. Claims 1, 3, 5 and 7 were independent claims directed to chemical compounds, whereas Claim 10 related to a process for preparing these compounds and Claim 8 referred to a pharmaceutical composition.

II. On 21 March 1988 the European Patent Office, as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) and Rule 40.1 PCT, on Form PCT/ISA 206, an invitation to pay two additional search fees since it considered that the above-mentioned application did not comply with the requirements of unity of invention.

The reasons for the alleged non-compliance were expressed in the following terms:

The combination of categories of independent claims does not belong to any of those mentioned in Rule 13.2 PCT and the subjects defined by the problems and their means of solution as listed below do not present a sufficient technical relationship or interaction so as to form a single general inventive concept.

1. Claims 1, 2, 10 (partially): Compounds of formula I as PAF inhibitors,

2. Claims 3, 4, 10 (partially): Compounds of formula Ib as anti-tumor compounds,

3. Claims 5 to 10 (partially): Compounds of formula Ia, pharmaceutical compositions, process and intermediates for their preparation.

No reference was made to Claim 11 in the invitation.

III. On 5 April 1988 the two additional International Search Fees identified in the invitation referred to above were received from the Applicant, together with a protest in accordance with Rule 40.2(c) PCT. This protest stated that the invention provided a clearly defined compound group which possessed advantageous pharmaceutical properties, in particular as PAF inhibitors. Fully within this compound group were two sub-groups which concern novel compounds of formula I (designated Ia for convenience) and compounds of formula I having additionally anti-tumor activity (designated Ib for convenience). Therefore, there was an underlying single general inventive concept and the subject-matter of all the claims clearly belonged in a single application.

Reasons for the Decision

1. Pursuant to Article 154(3) EPC and Article 9 of the agreement between WIPO and the EPO the Boards of Appeal of the EPO are responsible for deciding on protests made by Applicants against additional search fees charged by the EPO under Article 17(3)(a) PCT (OJ 1978, 249).

2. Since the Applicant has paid the additional fees in time to the EPO as ISA under protest, accompanied by a reasoned statement to the effect that the international application complied with the unity requirement, the protest is admissible under Rule 40.2(c) PCT.

3. According to Rule 40.1 PCT, the invitation to pay additional fees provided for in Article 17(3)(a) PCT shall, inter alia, specify the reasons for which the application is not considered as complying with the requirement of unity of invention.

In several decisions the Boards of the EPO have already consistently expressed the view that an indication of reasons is an essential prerequisite for such an invitation to be legally effective. Only in certain straightforward cases where the list of claimed subject-matter itself made the reasons obvious why it was considered that various claims lacked unity, could express reasoning be dispensed with (W 04/85 - OJ EPO 1987, 63; W 07/86 -OJ EPO 1987, 67; W 09/86 - OJ EPO 1987, 459).

4.1 In the present instance, no such exceptional straightforward distinctions between the three separate inventions as specified above by the ISA can be immediately recognised. Nor do the reasons given by the ISA sufficiently specify why there should be a lack of unity of invention in view of the particular circumstances of this application. These reasons contain in fact no more than a mere statement to the effect that there is no single inventive concept involved. Such a statement cannot be considered as fulfilling the requirement laid down in Rule 40.1 PCT for giving specified reasons. Moreover, according to the problem depicted in the introductory part of the description, which must be taken as the point of reference, the invention is concerned with the provision of pharmacologically valuable 5-heteroaryl- and optionally substituted 5-phenyl-imidazo (2,1-a)isoquinoline derivatives. A closer analysis reveals that all the groups of compounds disclosed in Claims 1, 3 and 5 as

well as Claim 7 (this last not having been specifically dealt with by the ISA) follow this line, whereby Claims 3, 5 and 7 relate to sub-groups, fully covered by formula I of Claim 1, the compounds of which latter are useful as PAF inhibitors (platelet activating factor). In view of this relationship as to the chemical structure of the compounds and their properties the possibility is not ruled out without further consideration, that all three subject-matters contribute to the solution of the problem and are to this extent linked together to form a single general inventive concept. Thus the presence of claims to particular sub-groups (of formula Ib additionally having anti-tumour activity and Ia per se, respectively) does not affect the overall unity devolving from the general formula I.

In the absence of more detailed reasons, therefore, it is not clear to the Board on what basis the ISA concluded that the subjects defined by the problems and their means of solution did not present a sufficient technical relationship or interaction to satisfy Rule 13.1 PCT. Prima facie the opposite is true.

In this connection the Applicant's commentary in the introductory description on the contents of the documents of the state of the art cited by him does not give rise, without at least a preliminary examination of the documents themselves, to any direct hint or indication which would lead to an unfavourable finding with regard to unity of invention.

4.2 Furthermore the objection raised by the ISA under Rule 13.2 EPC is inappropriate. Rule 13.2 applies in the case where there are independent claims in different categories. In the present case, however, all the

independent claims belong to the same category, since they are all product claims.

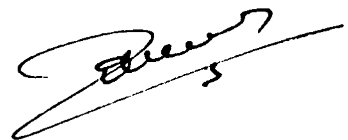
5. Accordingly, the invitation was issued disregarding the obligation to specify reasons laid down in Rule 40.1 in conjunction with Rule 13.1 PCT. Consequently, it is not legally effective and the additional fees paid by the applicant cannot be retained.

Order

For these reasons, it is decided that:

Reimbursement of the two additional fees to the applicant is ordered.

The Registrar: The Chairman:



F. Klein P. Lançon

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