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Aktenzeichen / Case Number / N^o du recours : W 18/89 - 3.3.1

Anmeldenummer / Filing No / N^o de la demande : PCT/EP 89/00461

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Paromomycin or its derivatives or salts thereof
Title of invention: for parenteral treatment of human parasitic
Titre de l'invention : diseases

Klassifikation / Classification / Classement : A61K

ENTSCHEIDUNG / DECISION

vom / of / du 28 February 1990

Anmelder / Applicant / Demandeur : Farmitalia Carlo Erba S.R.L.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPÜ / EPC / CBE PCT Article 17, Rules 13, 40

Schlagwort / Keyword / Mot clé : Non-unity

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : W 18/89 - 3.3.1
International application No. PCT/EP 89/00461

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 28 February 1990

Applicant : Farmitalia Carlo Erba S.R.L.
Via Carlo Imbonati 24
I-20159 Milano

Representative : Mr G.C. Woods
J.A. Kemp & Co.
14 South Square
Gray's Inn
London WC1R 5EU
GB

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 fee) of the
European Patent Office (branch at
The Hague) dated 18 August 1989.

Composition of the Board :

Chairman : A. Jahn
Members : F. Antony
W. Moser

Summary of Facts and Submissions

- I. On 26 April 1989 the Applicants filed International patent application PCT/EP 89/00461 with the European Patent Office (EPO).
- II. On 17 August 1989, the EPO as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) and Rule 40.1 PCT, an invitation to pay two additional search fees in view of the fact that it considered that the above-identified application did not comply with requirements of unity of invention as set forth in Rule 13 PCT.
- III. By way of reasons for the finding of disunity, the ISA made essentially the following statements:

Visceral leishmaniasis and malaria were two different diseases caused by different parasitic organisms; a priori, thus, there were two different problems. A common inventive concept such as "treatment of parasitic diseases" was not sustainable because prior art already disclosed the use of paromomycin for the preparation of a medicament for the treatment of cutaneous leishmaniasis, this resulting in a posteriori disunity. Furthermore, compositions containing additional active ingredients fell under yet another inventive concept. Accordingly - Claims 13 to 15 remaining unsearched - there were three distinct subjects, each representing a different inventive concept, as follows:

1. Claims 1-4, 16, 19 : Use of compounds of formula I for the manufacture of a medicament for the treatment of visceral leishmaniasis.

2. Claims 5-8, 10-12, 17: Use of a composition comprising compounds of formula I and sodium stibogluconate for the manufacture of a medicament for the treatment of visceral leishmaniasis.

3. Claims 9, 18, 20 : Use of a compound of formula I for the manufacture of a medicament for the treatment of malaria.

IV. By telefax received on 13 September 1989, confirmed in writing on 19 September 1989 and including an appropriate payment voucher, the Applicants paid both additional search fees under protest (Rule 40.2(c) PCT), asserting that all of the claims related to the same invention, the unifying feature being the discovery of new pharmaceutical use for the compound of formula (I). The claims enumerated in "subject 2" were all dependent upon Claim 1 or 16 ("subject 1") and covered the same use of the same compound, though together with an additional compound (Claims 5 to 8 and 17), or they were correspondingly connected with "subject 1", though of a different category (Claims 10 to 12). Concerning "subject 3" the unifying feature was a new pharmaceutical use for a known compound.

Reasons for the Decision

1. Pursuant to Article 154(3) EPC, the Boards of Appeal of the EPO are responsible for deciding on protests raised by Applicants against additional search fees charged by the EPO under Article 17(3)(a) PCT.

2. The protest complies with Rule 40.2(c) PCT and is, therefore, admissible. On the other hand, the invitation indicates reasons as required by Rule 40.1 PCT.
3. The ISA has correctly stated that treatment of leishmaniasis and of malaria are, prima facie, two distinct problems. It was also correct in seeking to establish a common inventive concept before definitely negating unity between "subject 1" and "subject 3". In so doing, the ISA has formulated such a common inventive concept as "treatment of parasitic diseases", and has on this basis arrived at a finding of a-posteriori lack of unity.
 - 3.1. In its Decision W 03/88 "Lubricants/LUBRIZOL" (to be published; headnotes see OJ EPO 1989, No. 6) this Board has held that in considering the requirement of unity of invention, the ISA does not have any obligation or power to carry out an a-posteriori examination, and that any finding of disunity on such a basis is void and of no legal effect. The Board still maintains its view there expressed. Other boards, however, have not followed that Decision (see, for instance, W 44/88; to be published, headnotes in OJ EPO 1989, No. 10). In its further Decision W 12/89 (to be published; headnote see also OJ EPO 1989 No. 10), the Board has therefore submitted the respective legal question to the Enlarged Board, where proceedings are now pending as case G 01/89.

Provided the aforementioned question were critical for the outcome of the present case, the Board would be inclined to refrain from deciding on the present protest until after a decision of the Enlarged Board in case G 01/89.
 - 3.2. There is, however, no such need, because the ISA has formulated the "common inventive concept" in unnecessarily broad terms. In the opinion of the Board, there is a narrower common inventive concept, viz. "parenteral

treatment of parasitic diseases", with regard to which the reasoning of the ISA does not appear to apply; cf. page 4, lines 6 to 10, of the specification in suit, mentioning as disclosed by EP-A-90 587 only a topical composition containing paromomycin for the treatment of cutaneous leishmaniasis, whereas all independent claims of the application in suit are expressly limited to parenteral use.

There is thus no question of an a-posteriori disunity of the last-mentioned common inventive concept. Accordingly, there is no reason for keeping proceedings in abeyance, nor is there any lack of unity between "subject 1" and "subject 3", both falling under the same said common inventive concept.

4. Common to the various claim categories of "subject 2" is use in the manufacture of a medicament for the parenteral treatment or prophylaxis of certain parasitic diseases (viz. malaria or visceral leishmaniasis), or as ingredient of a pharmaceutical composition, or in a process for preparing such composition, in addition to the paromomycin derivatives defined in Claim 1, of the compound sodium stibogluconate. The last-mentioned compound, when used in combination with the paromomycin derivatives of Claim 1, is said to contribute to the solution of the stated problem of the invention, i.e. treatment of visceral leishmaniasis (see page 8, lines 18 to 22, of specification in suit). It therefore falls under the same common inventive concept as specified above for "subject 1" and "subject 3". Hence, there is no disunity between "subject 2" on the one hand and "subject 1" and "subject 3" on the other hand.
5. In view of the above, neither of the additional search fees paid can be retained.

Order

For these reasons, it is decided:

Reimbursement of the two additional search fees paid is ordered.

The Registrar:

The Chairman:

M. Beer

K. Jahn