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Aktenzeichen / Case Number / N^o du recours : W 36/90 - 3.3.1

Anmeldenummer / Filing No / N^o de la demande : PCT/EP 90/00387

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

Bezeichnung der Erfindung: New 3'-(4-morpholinyl)- and 3'-(2-methoxy-4'-
Title of invention: morpholinyl) antracycline derivatives
Titre de l'invention :

Klassifikation / Classification / Classement : C07H 15/252

ENTSCHEIDUNG / DECISION

vom / of / du 4 December 1990

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

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

EPO / EPC / CBE PCT Article 17(3)(a), Rules 13.1 and 40.2(c)

Schlagwort / Keyword / Mot clé: Non-unity a posteriori (no)

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : W 36/90 - 3.3.1
International Application No. PCT/EP 90/00387

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 4 December 1990

Applicant : Farmitalia Carlo Erba S.R.L.
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Representative : Woods G.C.
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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 15 June 1990

Composition of the Board :

Chairman : K.J.A. Jahn
Members : R. W. Andrews
J.-C. Saisset

Summary of Facts and Submissions

- I. Following the filing of this International patent application the EPO, acting as ISA, issued an invitation to pay six additional search fees because it considered that the application did not comply with the requirements of unity of invention because the general problem underlying the invention was not novel or did not involve an inventive step having regard to the five patent specifications revealed by the search.

The Applicant paid two additional search fees under protest. The Applicant contended that in carrying out an "a posteriori" examination at the search stage the ISA has to make assumptions which may be unjustified and in this respect, relied on the decision W 03/88 (OJ EPO, 1990, 126).

Furthermore, the Applicant maintained that there was no detailed argument setting out why the ISA considered that the application related to seven inventions rather than to five, six, eight or any other number.

Reasons for the Decision

1. The protest is admissible.
 - 1.1 As one reason for his protest the Applicant contended that the reasoning behind the decision W 03/88 was correct. In this decision it was held that the ISA does not have any obligation or power under the PCT to carry out an "a posteriori" examination, i.e. an examination as to novelty and/or inventive step, in relation to the requirement of unity of invention (cf. second paragraph of Point 8 of the Reasons). However in its decision G 1/89 of 2 May 1990, the

Enlarged Board of Appeal held that "a posteriori" objections of lack of unity were allowable.

Although this decision of the Enlarged Board of Appeal was issued before the Applicant filed his protest on 13 July 1990, the Board consider that the Applicant is still entitled to rely on the decision W 03/89 since the decision G 1/89 or its Headnote (cf. OJ EPO, 11/1990) had not been published in the Official Journal at this date.

2. In the above mentioned decision of the Enlarged Board of Appeal, it was stated that a posteriori lack of unity objections were allowable provided the consideration by an ISA of the requirement of unity of invention is always made with a view to giving the applicant fair treatment and that the charging of additional fees should only be made in clear cases.
3. Although the ISA based its findings of lack of unity upon a posteriori considerations, it did not give any reasons why such considerations are appropriate in the present case for the purpose of the international search.
 - 3.1 Moreover, in the Guidelines for International Search to be carried out under the PCT as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977 (PCT/INT/5), it is stated that in cases of lack of unity, especially in an "a posteriori" situation, the search examiner may decide to complete the international search for the additional invention(s) together with that for the invention first mentioned, in particular in those cases where the inventions are conceptually very close and none of them requires search in separate classification units. If the search examiner exercises his discretion in this manner then all results should be included in the international search report and

no objection of lack of unity of invention should be raised (cf. Chapter VII, point 12).

In the Board's judgement, the present case is clearly one in which the search examiner should have exercised his discretion in agreement with the above Guidelines since both these prerequisites are met in the present case (C 07 H 15/252).

4. On the basis that an unspecified general problem lacked novelty or did not involve an inventive step, the ISA choose not to exercise its discretion and divided the subject-matter of Claim 1 into seven alleged inventions without giving any reasons as to how it arrived at these particular groups of subject-matter. Such an unreasoned and arbitrary allegation cannot be met with a reasoned statement in reply from the Applicant.

In these circumstances, the Board considers that the request for the payment of six additional search fees is not justified.

Order

For these reasons, it is decided that:

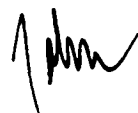
Reimbursement of the two additional search fees is ordered.

The Registrar:



M. Beer

The Chairman:



K.J.A. Jahn