BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS | BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE | CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Publication in the Official Journal ~~Yes~~ / No

File Number: W 2/92 - 3.3.1

Application No.: PCT/US 90/06 754

Publication No.:

Title of invention: Process for dehydrating corticosteroid intermediates

Classification: C07J 43/00

D E C I S I O N
of 4 February 1992

Applicant: Schering Corporation

Headword: Dehydration/SCHERING

PCT Article 34(3)(a), Rules 68.2 and 68.3(c)

Keyword: "Lack of unity (International Preliminary Examination) - No"
"Reimbursement of additional fee"

Headnote

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number : W 2/92 - 3.3.1
International Application No. PCT/US 90/06 754

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 4 February 1992

Applicant : Schering Corporation
2000 Galloping Hill Road
Kenilworth, New Jersey 07033 (US)

Representative : Majka, Joseph T. et al
Schering-Plough Corporation
One Giralda Farms
Madison New Jersey 07940-1000 (US)

Subject of the Decision : **Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fee) of the European Patent Office dated 4 December 1991.**

Composition of the Board :

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

Summary of Facts and Submissions

I. International patent application PCT/US 90/06 754 was filed on 26 November 1990.

II. On 4 December 1991, the European Patent Office, as competent International Preliminary Examining Authority (IPEA), issued an invitation to pay an additional fee in accordance with Article 34(3)(a) and Rule 68.2 PCT.

The IPEA considered that the application did not comply with the requirement of unity of invention as set forth in Rule 13 PCT and indicated that, if the final products of general formula V were known compounds, the application dealt with two different problems:

1. To prepare the compounds of general formula V according to the process A as provided by Claims 1 to 8 and 12.

2. To prepare the compounds of general formula V according to the process B as provided by Claims 1 and 9 to 11.

III. The Applicant paid the additional fee under protest in accordance with Rule 68.3(c) PCT. The Applicant submitted that a fair reading of Claim 1, which is common to both inventions, showed that this claim only covered one invention. The Applicant also argued that whether the compounds of general formula V were novel or not was irrelevant to the work required to conduct preliminary examination of the process claims, which, in any case, were considered to meet the criteria for novelty, inventive step and industrial applicability.

IV. The IPEA has referred the protest to the Board of Appeal for examination in accordance with Rule 68.3(c).

Reasons for the Decision

1. The protest is admissible.

2. Under Article 155(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against an additional fee charged by the EPO under the provisions of Article 34(3)(a) of the Cooperation Treaty.

3. According to the Guidelines for International Preliminary Examination to be carried out under the Cooperation Treaty, which is binding for the EPO acting as an IPEA (cf. the decision G 1/89 of 2 May 1990, OJ EPO 1991, 155), Chapter III, 7.6, although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted with on the basis of a narrow, literal or academic approach. Moreover, the benefit of any doubt should be given to the Applicant. These Guidelines also state that reasons of economy may make it advisable for the Examiner to avail himself of the option referred to in Rule 68.1 PCT by choosing not to invite the Applicant to restrict the claims or to pay additional fees (cf. Guidelines, Chapter III, 7.10).

4. In the light of the above-mentioned Guidelines, the Board is satisfied that the present case is clearly one in which the Examiner should have choosen not to issue an invitation pursuant to Rule 68.1 PCT in respect of lack of unity (cf. also Guidelines, Chapter VI, 5.9). Particularly in the present circumstances, where the lack of unity objection was based on the Examiner's assumption that the

compounds of general formula V were known and the Examiner had found that Claims 1 to 12 satisfied the criteria of novelty, inventive step and industrial applicability (cf. IV of the written opinion issued on 4 December 1991).

5. In any case, even if it could be shown that compounds falling within the scope of the general formula V are known, the Board considers that the two inventions identified by the IPEA are conceptually so close as to represent a single inventive concept since they both relate to a process for the preparation of the same end products from the same starting materials by concomitant dehydration and cyclisation. Therefore, in the Board's judgement, the requirements of Rule 13.1 PCT are satisfied.

Order

For these reasons, it is decided that:

Reimbursement of the additional fee is ordered.

The Registrar

E. Görgmaier

The Chairman

K.J.A. Jahn