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File Number: W 2/93 - 3.3.1

International
Application No: PCT/US 90/06251

Publication No.: W091/06537

Title of invention: Substituted Indole-, Indene-, Pyranoindole- and
Tetrahydrocarbazole-Alkanoic Acid Derivatives as
Inhibitors of PLA₂ and lipoxxygenase

Classification: C07D 215/14

D E C I S I O N
of 31 March 1993

Applicant: American Home Products Corporation

Headword: Alkanoic acids/AMERICAN HOME PRODUCTS

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

Keyword: "Admissibility of protest (yes) - principle of good faith"
"Lack of unity (International Preliminary Examination) - inadequate
reasons"
"Reimbursement of additional fees"



**Europäisches
Patentamt**

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Patent Office**

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des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : W 2/93 - 3.3.1
International Application No. PCT/US 90/06251

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 31 March 1993

Applicant : American Home Products Corporation
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New York
New York 10017 (US)

Representative : Connelly, M.J.
Wyeth Laboratories
Huntercombe Lane South
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Berks SL6 0PH (GB)

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 15 November 1992.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : R.W. Andrews
J.A. Stephens-Ofner

Summary of Facts and Submissions

I. International patent application PCT/US 90/06251 was filed on 27 October 1990.

II. On 15 November 1991, the European Patent Office, as competent International Preliminary Examining Authority (IPEA), issued an invitation to restrict or pay three additional fees in accordance with Article 34(3)(a) and Rule 68.2 PCT within one month.

The IPEA considered that, for the reasons given in the communication of the ISA of 10 April 1991, the application did not comply with the requirement of unity of invention as set forth in the Regulations.

III. By a telex of 6 December 1991, with written confirmation being received on 10 December 1991, the Applicant requested an extension of the term for response to this invitation to two months, the maximum time allowed under Rule 68.2 PCT.

By a telex dated 10 January 1992, the IPEA refused this request on the ground that the term for completion of the International Preliminary Examination Report would expire on 27 January 1992.

IV. In a telephone conversation with the IPEA on 13 January 1992, the Applicant stated that he would pay the additional fees immediately and requested examination of the whole application. As can be inferred from the Applicant's letter, faxed on 15 January 1992, the Examiner acting for the IPEA confirmed that the Applicant could pay the additional fees under protest so that the matter could be reviewed with a view to a possible refund thereof.

As a consequence to this telephone conversation the Applicant paid the additional fees under protest in accordance with Rule 68.3(c) PCT on 15 January 1992. Written confirmation of the telexed reasoned statement was received on 21 January 1992.

- V. The protest was referred to the Board of Appeal for examination in accordance with Rule 68.3(c) PCT on 26 January 1993; i.e. over one year after the filing of the protest.

Reasons for the Decision

1. Although the Applicant did not comply with the invitation to restrict or pay three additional fees within the initially prescribed time limit of one month, the Board considers that, in the circumstances of the present case, the protest is admissible.
- 1.1 In accordance with the established jurisprudence of the Boards of Appeal, measures taken by the EPO in proceedings before it should not violate the reasonable expectations of parties to such proceedings (principle of good faith).

In the light of the telephone conversation of 13 January 1993, the Applicant could have reasonably expected that, despite the telex of 10 January 1992 refusing his request for an extension of the term for response to the invitation in accordance with Article 34(3)(c) and Rule 68.2 PCT, the IPEA had, in fact, changed its mind and extended the term for response to two months. Therefore, having regard to the good faith existing between the EPO and its users, the Board finds that the protest must be regarded as having been filed in time.

2. Under Article 155(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against additional fees charged by the EPO under the provisions of Article 34(3)(a) of the Corporation Treaty.
3. Rule 68.2 PCT stipulates that the invitation provided for in Article 34(3)(a) PCT must specify the reasons why the International application is not deemed to comply with the requirements of unity of invention. The purpose of setting out reasons is to enable the Applicant and, in the case of a protest, also the appeal body to examine whether the requirement to pay additional fees is justified. In the Board's judgment, the requirement to give reasons in an invitation pursuant to Article 34(3)(a) and Rule 68.2 PCT is so fundamental that an unsubstantiated invitation cannot be regarded as legally effective.
 - 3.1 In the present case, the invitation of the IPEA cannot be considered as containing an acceptable reasoned statement setting out the grounds for the invitation. The reasons relied on in the present invitation were still those that the ISA had put forward in the invitation to pay additional search fees issued pursuant to Article 17(3)(a) and Rule 40.1 PCT dated 10 April 1991. According to the ISA, there was lack of unity a posteriori since the documents, US-A-4 041 169 and DE-A-1 816 993, disclosed compounds falling within the scope of the Markush formula of Claim 1.

However, in the light of the international search report, the Applicant submitted to the International Bureau of WIPO on 28 October 1991 an amendment and statement under Article 19(1) PCT in which amendment of Claim 1 by the addition of a proviso statement was requested. On the same date the Applicant filed two replacement sheets as required by Rule 46.5(a) PCT.

From the above, it is clear that Claim 1 before the IPEA was different from the one considered by the ISA. In these circumstances, an invitation relying on the same reasons that had been put forward by the ISA in its invitation cannot be considered to fulfill the obligation to specify reasons as laid down in Rule 68.2 PCT. Therefore, the invitation is not legally effective and, consequently, the three additional examination fees must be reimbursed.

4. The Board also wishes to express its strong disapproval of the inordinately long period of time it took for this matter to be placed before the Board of Appeal (cf. paragraph V of the Summary of Facts and Submissions).

Order

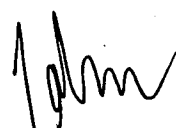
For these reasons, it is decided that:

Reimbursement of the three additional fees is ordered.

The Registrar:


E. Gorgmaier

The Chairman:


K.J.A. Jahn