



Case Number: W 0013/99 - 3.3.1
International Application No. PCT/ US 98/08470

D E C I S I O N of 18 December 2000
correcting an error in the decision
of the Technical Board of Appeal 3.3.1
of 10 August 2000

Applicant: Hoechst Marion Roussel, Inc.
2110 East Galbraith Road
P.O. Box 156300
Cincinnati
Ohio 45215-6300 (US)

Representative: Gupta, Balaram
2110 East Galbraith Road
P.O. Box 156300
Cincinnati
Ohio 45215-6300 (US)

Subject of the Decision: Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicant against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 4 February 1999.

Composition of the Board:

Chairman: A. Nuss
Members: J. M. Jonk
R. E. Teschemacher

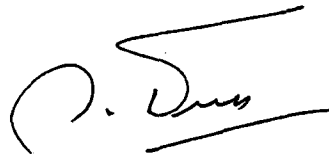
In application of Rule 89 EPC the decision in the protest case W 0013/99 - 3.3.1 of 10 August 2000 is corrected by the substitution of "examination fee" for "search fee" and "search fees" on page 2, section II, fourth line, on page 4, section IV, fourth line, on page 4, point 2, second line, on page 6, point 7, second line and in the order first line.

The Registrar:



N. Maslin

The Chairman:



A. Nuss

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D E C I S I O N
of 10 August 2000

Case Number: W 0013/99 - 3.3.1

Application Number: PCT/US 98/08470

Publication Number: WO 98/52951

IPC: C07D

Language of the proceedings: EN

Title of invention:

Novel triptolide derivatives useful in the treatment of
autoimmune diseases

Applicant:

Hoechst Marion Roussel, Inc.

Opponent:

-

Headword:

Triptolides/HOECHST

Relevant legal provisions:

PCT Art. 34

PCT R. 66, 68

Keyword:

"Failure to submit a first written opinion under
Article 34(2)(c) in conjunction with Rule 66.2 PCT"

"A posteriori objection of lack of unity by the International
Preliminary Examination Authority"

Decisions cited:

W 0006/99

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: W 0013/99 - 3.3.1
International Application No. PCT/ US 98/08470

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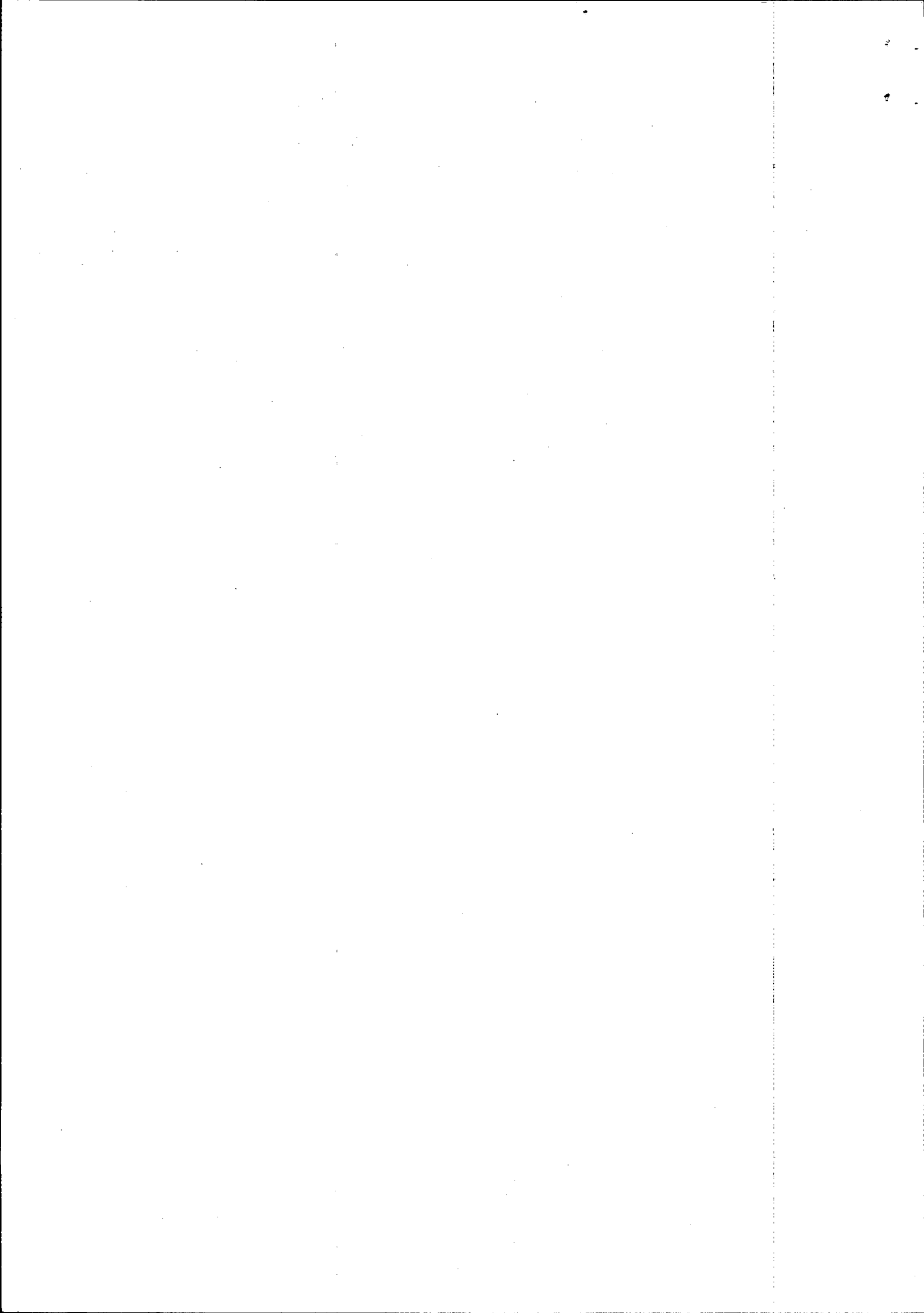
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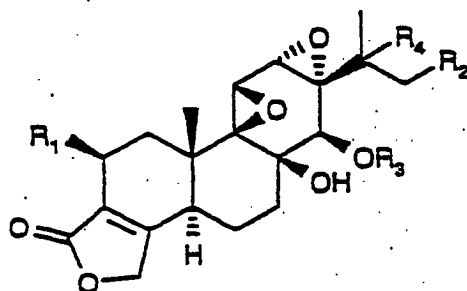


Summary of Facts and Submissions

I. On 27 April 1998 the Applicant filed the international patent application PCT/US 98/08470.

The application comprised Claims 1 to 43, independent Claims 1, 9 and 21 reading as follows:

"1. A compound of the formula:



formula (I)

wherein

R₁ and R₂ are each independently is H or -OR₅;

R₃ is H, -C(=O)(CH₂)_nCO₂H or a suitable amino acid;

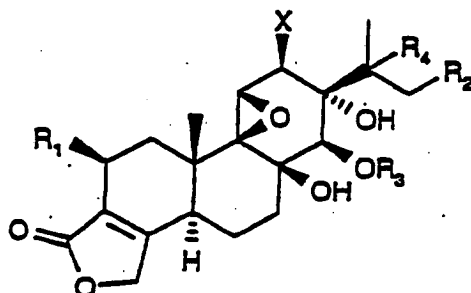
R₄ is H or -OH;

R₅ is H, -C(=O)(CH₂)_nCO₂H or a suitable amino acid;

n is the integer 2, 3, 4, 5 or 6; and

the stereoisomers, enantiomers and pharmaceutically acceptable salts thereof; provided that R₁ and R₂ are H when R₃ is other than H."

"9. A compound of the formula:



formula (II)

wherein

X is I, Br, Cl, F or -CN;

R₁ and R₂ are each independently is H or -OR₅;

R₃ is H, -C(=O)(CH₂)_nCO₂H or a suitable amino acid;

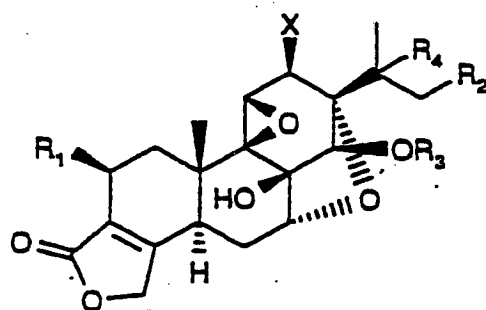
R₄ is H or -OH;

R₅ is H, -C(=O)(CH₂)_nCO₂H or a suitable amino acid;

n is the integer 2, 3, 4, 5 or 6; and

the stereoisomers, enantiomers and pharmaceutically acceptable salts thereof; provided that R₁ and R₂ are H when R₃ is other than H."

"21. A compound of the formula:



formula (III)

wherein

X is I, Br, Cl, F or -CN;

R₁ and R₂ are each independently is H or -OR₅;

R₃ is H, -C(=O)(CH₂)_nCO₂H or a suitable amino acid;

R₄ is H or -OH;

R₅ is H, -C(=O)(CH₂)_nCO₂H or a suitable amino acid;

n is the integer 2, 3, 4, 5 or 6; and

the stereoisomers, enantiomers and pharmaceutically acceptable salts thereof; provided that R₁ and R₂ are H when R₃ is other than H."

II. On 4 February 1999 the EPO as the International Preliminary Examination Authority (IPEA) invited the Applicant under Article 34(3)(a) and Rule 68.2 PCT to restrict the claims or to pay 1 additional search fee of DM 3000,- within 1 month from the above date.

In this invitation the IPEA considered

- (a) that the compounds of the formulae (I), (II) and (III) were prepared in accordance with the reaction schemes A and B as indicated in the application in suit (pages 12 and 18) by using a compound of formula 1 as starting compound;
- (b) that this starting compound was however known from the documents
 - (A) US-A-5 430 054 and
 - (B) US-A-4 005 108;
- (c) that said known starting compound represented the single common link between, on the one hand, the compounds of the formulae (I) and (II), and on the other hand, the compounds of the formula (III); and
- (d) that therefore the application in suit comprised two different inventions, which were not linked together by a single inventive concept, namely:

Invention 1: Claims 1 to 20, and 34 to 39.

Invention 2: Claims 21 to 33, and 40 to 43.

III. On 15 February 1999 the Applicant paid the required additional fee under protest pursuant to Rule 68.3(c). In support of his protest he argued essentially that the Group 1 and Group 2 inventions as indicated by the IPEA were closely related and that there was a common link between them in that all of the novel triptolide

compounds of the formulae (I) to (III) were derived from the starting compound of formula 1, and also had a common use, namely in the treatment of autoimmune diseases, such as rheumatoid arthritis.

- IV. On 12 April 1999 the IPEA invited the Applicant to pay a protest fee of EUR 1022,- pursuant to Rule 68.3(e) PCT, since a prior review of the invitation to pay the additional search fee under Rule 68.3(c)(d) and (e) PCT had resulted in the conclusion that the payment of the additional fee was fully justified. The review panel held that the objection of lack of unity had to be maintained on the basis of the reasons given by the IPEA in its invitation of 4 February 1999.
- V. Also on 12 April 1999 the IPEA informed the Applicant by a first written opinion pursuant to Rule 66 PCT that in the light of the cited prior art the subject-matter of Claims 1 to 33 as originally filed and Claims 34 to 43 as amended under Article 19 PCT was novel, but did not seem to involve an inventive step.
- VI. The Applicant paid the protest fee on 10 May 1999.

Reasons for the Decision

1. The protest is admissible.
2. The IPEA invited the Applicant to restrict the claims or to pay an additional search fee in its invitation dated 4 February 1999, which invitation was confirmed by a review panel under Rule 68.3(c)(d) and (e) PCT as communicated to the Applicant on 12 April 1999. Moreover, also on 12 April 1999, the IPEA submitted to the Applicant a first written opinion pursuant to Rule 66 PCT.

4. However, according to Article 34(2)(c) in conjunction with Rule 66.2 PCT the applicant shall receive at least one written opinion from the IPEA unless it considers, among others, that the international application complies with the PCT Treaty and its Regulations. Thereafter, the applicant has according to Article 34(2)(d) in conjunction with Rule 66.3 PCT the opportunity to respond together, where appropriate, with amendments.

5. Moreover, it is stated in the PCT Preliminary Examination Guidelines (as in force from 9 October 1998), Section IV, Chapter VI, Paragraph VI-5.13, as published in the PCT Gazette, Special issue, No. S-07/1998:

"For each ground of objection, the written opinion should indicate the part of the international application which is deficient and the requirement of the PCT which is not met either by referring to specific Articles or Rules, or by other clear explanation; it should also give the reason for any objection where this is not immediately apparent. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the main claim or claims, and if consequently there is lack of unity of invention between dependent claims, the applicant should be notified of this situation (see also section III-7) in the examiner's first written opinion. If, in the opinion of the examiner, the response of the applicant (see paragraph VI-6.1) does not overcome the objection of lack of unity, the examiner shall adopt the procedure described in paragraphs VI-5.5 to VI-5.9 (*which includes the procedure concerning the invitation to restrict or pay and with respect to additional fees under Rule 68 PCT*). Substantive matter in the said opinion should normally be set out first. The "
(Italic passage added)

6. Thus, under the circumstances of the present case, in which the IPEA noticed that there was an a posteriori lack of unity in the light of documents (A) and (B), the IPEA failed to submit a first written opinion and to give the Applicant the opportunity to reply as required according to said Articles, Regulations and Guidelines under the PCT before it submitted the invitation to restrict or to pay an additional fee.
7. The Board concludes therefore that the payment of the additional search fee and the protest fee was not justified (see also W 6/99 of 7 April 2000, to be published in the OJ EPO).
8. Having regard to this conclusion, it is not necessary to deal with the reasons given by the IPEA for its invitation to restrict or to pay the additional fee dated 4 February 1999.
9. Since the present decision does not relate to the reasons for the objection of lack of unity as such, a repetition of an objection of lack of unity on the basis of the same reasons is not excluded.
10. However, in this context the Board also observes that it follows from Rule 13 PCT and the "Administrative Instructions under the PCT", Section 206, and ANNEX B, Part 1(f) as in force from 1 July 1998 (PCT Gazette S-03/1998):
 - (a) that the mere fact that the application in suit contains independent Claims 1, 9 and 21 of the same category is in itself no reason for an objection of lack unity of invention;

(b) that the subject-matter of said Claims 1, 9 and 21 of the application in suit relates to a situation involving the so-called "Markush practice", in which the requirement of a technical relationship and the same or corresponding technical features as defined in Rule 13.2 PCT shall be considered to be met when the alternatives are of a similar nature; and

(c) that alternatives of chemical compounds shall be regarded as being of a similar nature where the following criteria are fulfilled:

- all alternatives have a common property or activity, and
- a common structure is present, i.e., a significant structural element is shared by all of the alternatives (as explained in said ANNEX B, paragraph (f)(ii)), or
- in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognised class of chemical compounds in the art to which the invention pertains (as explained in said ANNEX B, paragraph (f)(iii)).

Order

For these reasons it is decided that:

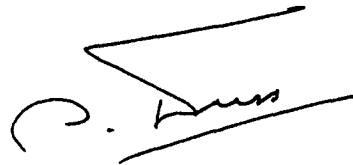
The reimbursement of the additional search fees and the protest fee paid is ordered.

The Registrar:



N. Maslin

The Chairman:



A. Nuss