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**D E C I S I O N**  
**of 27 November 2002**

**Case Number:** W 0015/02 - 3.3.1

**Application Number:** PCT/EP 01/14296

**Publication Number:** -

**IPC:** C07D 211/76

**Language of the proceedings:** EN

**Title of invention:**  
Phenyl derivatives

**Applicant:**  
Merck Patent GmbH  
Frankfurter Straße 250  
D-64293 Darmstadt (DE)

**Opponent:**

-

**Headword:**  
Phenyl derivatives/MERCK PATENT GMBH

**Relevant legal provisions:**  
EPC Art. 17(3)(a)  
EPC R. 13.2, 40.2

**Keyword:**  
"Reasoned statement (no) - protest inadmissible"

**Decisions cited:**

-

**Catchword:**

-



**Case Number:** W 0015/02 - 3.3.1  
**International Application No.** PCT/EP 01/14296

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.1**  
**of 27 November 2002**

**Applicant:** Merck Patent GmbH  
Frankfurter Straße 250  
D-64293 Darmstadt (DE)

**Representative:** -

**Decision under appeal:** Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fees) of the European Patent Office (International Searching Authority) dated 1 July 2002.

**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** P. P. Bracke  
B. Günzel

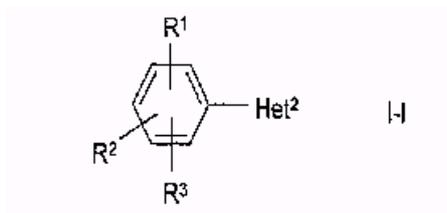
## Summary of Facts and Submissions

- I. International patent application PCT/EP 01/14296 was filed on 5 December 2001 with 25 claims.
- II. On 19 April 2002 the European Patent Office, acting as an International Searching Authority (ISA), informed the Applicant that the ISA had carried out a partial international search on this part of the international application which related to the invention mentioned in claims Nos. 1 to 23 and that the application did not comply with the requirement of unity of invention since there were two inventions claimed. The international search report on the other part of the international application would be established only if an additional fee was paid. Thereby the ISA invited the applicant to pay one additional search fee pursuant to Article 17(3)(a) and Rule 40.1 PCT within a period of 30 days.

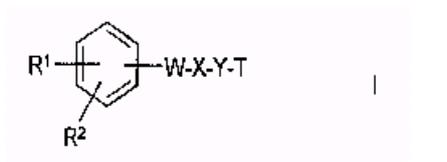
In an annex to this invitation the ISA submitted that the application related to two inventions, namely:

- (i) Claims 1 to 23 relating to compounds of the formula I, their preparation and their use; and
- (ii) Claims 24, 25 relating to intermediates of the formula I-I.

The ISA was of the opinion that the two inventions were not linked by a single general inventive concept according to Rule 13.1 PCT, since the intermediates of formula



(Claims 24 and 25) did not share an essential structural element with the final products of formula



in that the only structural element they shared was not a special technical feature, but merely a component part of the final products.

III. By a letter of 23 April 2002, the applicant paid one additional fee under protest pursuant to Rule 40.2(c) PCT. In his statement he put forward the argument that the intermediates of Claims 24 and 25 had almost all essential properties of the final products and that the intermediates were a part of one and the same invention, which also embraced the final products.

IV. On 1 July 2002, the ISA issued the international search report. Also on 1 July 2002, the ISA issued a communication notifying the Applicant that the ISA had reviewed the justification for the invitation to pay an additional search fee. The Review Panel was of the opinion that the statement that the intermediates of Claims 24 and 25 had almost all essential properties of the final products and that the intermediates were a part of one and the same invention, which also embraced the final products, did not appear relevant to the

question whether essential structural elements were shared by the intermediates of Claims 24 and 25 and the final products of Claim 1. Thus, the letter of protest did not comprise a reasoned statement to the effect that the international application complied with the requirements of unity. As the Review Panel came to the conclusion that the invitation to pay additional fees was justified, the Applicant was invited under Rule 40.2(e) PCT to pay a protest fee within one month.

V. The protest fee was paid with letter of 15 July 2002.

### **Reasons for the Decision**

1. Rule 40.2(c) PCT requires that the payment of an additional fee is accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention.
2. According to the instructions concerning unity of invention, as described in Annex B to the Administrative Instructions, there is unity of invention between intermediate and final products if two requirements are fulfilled, namely:
  - (A) the intermediate and final products have the same essential structural element, in that
    - (1) the basic chemical structures of the intermediate and the final products are the same, or

(2) the chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(B) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

3. The ISA's objection to the unity of invention on the ground that the intermediates of Claims 24 and 25 did not share an essential structural element with the final products was related to requirement (A) in point 2 above.

Since the Applicant neither provided any information as to where the same essential structural element could be seen nor how the basic chemical structures of the intermediates and the final products could be considered the same, the protest did not comprise a reasoned statement to the effect that the application complies with the requirement of unity of invention.

Therefore, the protest does not fulfil the requirements of Rule 40.2(c) PCT and is inadmissible.

**Order**

**For these reasons it is decided that:**

1. The protest under Rule 40.2(c) PCT is rejected as inadmissible.
2. The protest fee is to be reimbursed.

The Registrar:

The Chairman:

N. Maslin

A. Nuss