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D E C I S I O N
of 26 August 2004

Case Number: W 0027/03 - 3.3.4

Application Number: PCT/EP 02/13429

Publication Number: -

IPC: A61K 38/00

Language of the proceedings: EN

Title of invention:

Use of edg-receptor agonists for the treatment of hypertension

Applicant:

Solvay Pharmaceuticals GmbH
Hans-Böckler-Allee 20
D-30173 Hannover (DE)

Opponent:

-

Headword:

-

Relevant legal provisions:

PCT Art. 17(3) (a)
PCT R. 13.1, 13.2, 13.3, 40, 40(2)c

Keyword:

"Protest: inadmissible"

Decisions cited:

W 0016/92, W 0018/99, W 0002/00

Catchword:

-



Case Number: W 0027/03 - 3.3.4

International Application No. PCT/EP 02/13429

D E C I S I O N
of the Technical Board of Appeal 3.3.4
of 26 August 2004

Applicant: Solvay Pharmaceuticals GmbH
Hans-Böckler-Allee 20
D-30173 Hannover (DE)

Representative: Gosmann, Martin
Solvay Pharmaceuticals GmbH
Patent Department

Decision under appeal: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation of the European Patent Office (International Searching Authority) to pay additional fees dated 11 April 2003.

Composition of the Board:

Chairwoman: U. Kinkeldey
Members: R. Gramaglia
B. Günzel

Summary of Facts and Submissions

- I. On 11 April 2003 the European Patent Office (EPO), acting as International Searching Authority (ISA) for International patent application No. PCT/EP 02/13429 issued an invitation in compliance with Article 17(3)(a) PCT to pay, within a time limit of 30 days, 1 (one) additional search fee, stating that the application did not fulfil the requirements of unity of invention stipulated in Rules 13.1, 13.2 and 13.3 PCT.
- II. In response on 9 May 2003 the applicant paid this additional search fee under protest. No reasons were given as to why the finding of lack of unity of invention by the ISA was not correct, except for the statement that "the applicant believes the international application complies with the requirement of unity of invention".
- III. On 9 October 2003, the review panel of the EPO under Rule 40.2(e) PCT informed the applicant that no refund could be ordered as the statement accompanying the protest was not reasoned.

Reasons for the Decision

1. According to Article 17(3)(a), in conjunction with Rule 40.1 PCT, the additional fee(s) due if the ISA considers that the international application does not comply with the requirements of unity of invention, have to be paid within a prescribed time limit. Rule 40.2(c) PCT provides that the applicant may pay the additional fee(s) under protest, that is,

accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention. It follows from this that the time limit for paying these fees also applies to the filing of the protest and that when paying under protest, the applicant has, at the same time or at least within the time limit stated for the payment, to file with the same authority substantive arguments supporting his opinion that the claimed subject matter complies with the requirement of unity of invention provided for in Rule 13.1 and 13.2 PCT.

2. In the present case no reasons were given by the applicant as to why the finding of lack of unity of invention by the ISA was not correct, but the applicant's statement was confined to the mere assertion that unity was believed to be present. Such assertion, however, is not a reasoned statement for a protest within the meaning of Rule 40.2.(c) PCT because it does not show why the applicant takes that view. However, a protest which has not been - or not been sufficiently - reasoned within the time limit for filing the protest is to be rejected as inadmissible (see decision W 16/92, OJ EPO 1994, 237 and the Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, IX, C, 2.2).

3. In view of the inadmissibility of the protest, there was no legal basis for the invitation to pay the protest fee. Therefore, the protest fee is to be refunded (see also e.g. decisions W 18/99 dated 17 April 2000 and W 2/00 dated 18 October 2000).

Order

For these reasons it is decided that:

1. The protest is rejected as inadmissible.
2. The reimbursement of the protest fee is ordered.

The Registrar:

The Chairwoman:

P. Cremona

U. Kinkeldey