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**D E C I S I O N**  
of 19 October 2005

**Case Number:** W 0009/04 - 3.3.01

**Application Number:** PCT/US03/12926

**Publication Number:** WO 2003/091264

**IPC:** C07F 9/38

**Language of the proceedings:** EN

**Title of invention:**

Non nucleoside reverse transcriptase inhibitors

**Applicant:**

Gilead Sciences, Inc.

**Representative:**

Riedl, Peter  
Sternwartstrasse 4  
D-81679 München (DE)

**Headword:**

Declaration of protest/GILEAD SCIENCES

**Relevant legal provisions:**

PCT Art. 17(3) (a)  
PCT R. 40.1, 40.2(c) (e)  
RRF Art. 10b

**Keyword:**

"Declaration of protest - definition - withdrawal - no reimbursement of protest fee"

**Decisions cited:**

W 0003/98, W 0018/99, W 0002/00, W 0001/01, W 0015/02

**Catchword:**

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Case Number: W 0009/04 - 3.3.01

International Application No. PCT/US03/12926

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.01  
of 19 October 2005

**Applicant:** Gilead Sciences, Inc.

**Representative:** Riedl, Peter  
Sternwartstrasse 4  
D-81679 München (DE)

**Subject of the Decision:** 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 18 August 2003.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. International patent application PCT/US03/12926 was filed on 25 April 2003.
- II. On 18 August 2003 the European Patent Office, acting as an International Searching Authority (ISA), raised an objection of lack of unity of invention *a posteriori* and invited the applicant to pay 20 additional search fees under Article 17(3)(a) and Rule 40.1 PCT for the search of the listed inventions.

As reasons for its finding the ISA indicated on page 2 of its invitation that compounds falling within the scope of claim 1 were already known in the prior art, since document D1 disclosed the phosphonoformate compound "Foscarnet" as well as analogues thereof and, that these compounds were inhibitors of RT, (reverse transcriptase). Hence, the technical feature "non-nucleoside reverse transcriptase inhibitor compound comprising a phosphonate group" could no longer serve as special technical feature in the sense of Rule 13 PCT. Therefore, the application lacked unity of invention.

- III. In its reply of 22 September 2003 the applicant requested revision of the invitation to pay additional fees and in particular revision of the explanation on page 2 of the said invitation or alternatively, to publish the international application without search report. As reason the applicant indicated that the observation in D1 according to which Foscarnet and analogues thereof were thought to be inhibitors of the reverse transcriptase was incorrect. The applicant

- further indicated that he wished to pay the search fees for inventions 1 to 4, 10 and 11 and requested debiting of the fees from the representative's account.
- IV. By notification dated 23 January 2004 the review panel within the meaning of Rule 40.2(e) PCT informed the applicant that, with regard to his protest filed on 22 September 2003, it had reviewed the justification for the invitation to pay additional search fees and had come to the conclusion that the invitation was justified. The applicant was invited to pay a protest fee.
- V. In response, with letter dated 20 February 2004 the applicant requested that the protest fee be debited of the representative's deposit account.
- VI. The protest was referred to the Board of Appeal.
- VII. On 16 July 2004 the applicant requested a refund of the protest fee. As reason for this request the applicant submitted that with its letter of 22 September 2003 it had only requested to correct the explanation of the search division for non-unity. It had, however, not questioned that the application included more than one invention nor had it submitted that the amount of required additional fees was excessive. Hence, its letter of 22 September 2003 had been considered incorrectly as a protest and the protest fee had been paid without legal ground and was therefore to be reimbursed. In case its letter of 22 September 2003 was nevertheless considered as a protest the protest was herewith withdrawn. Since the protest fee was intended for further examination of the protest and since

further examination of the protest had not yet started the request for refund of the protest fee was justified.

- VIII. In a communication the Board took the preliminary view that the applicant's letter dated 22 September 2004 was a declaration of a protest, when interpreted on an objective basis. As a consequence, the protest fee could not be refunded, the withdrawal of the protest not having retroactive effect.

### **Reasons for the Decision**

1. Since in its letter of 16 July 2004 the applicant withdrew its protest as an auxiliary measure, the Board no longer has any competence to examine the substance of the ISA's finding of non-unity of invention.
2. As regards the applicants request for a refund of the protest fee paid the Board is unable to endorse the applicant's view that the said fee had also to be reimbursed in case its letter of 22 September 2003 was considered as a protest.

The applicant did not further explain on which legal basis the Board could order the refund of the protest fee under the assumption that examination of the protest as to its substance by the Board had not yet started at the point in time when the protest was withdrawn and the Board sees no legal basis for a refund in the present case. Whether or not a fee can be refunded is not a matter of free discretion. Once paid, a fee can be refunded if it was not due or if there is a specific provision allowing the refund, as is e.g.

the case for the examination fee paid for a European patent application if the applicant withdraws his application early enough (see Article 10b RRF), but undoubtedly there is no corresponding provision for protests.

In the view of the Board the case that an admissible protest has been withdrawn before the Board of Appeal cannot be equated to the cases of inadmissible protests in which boards of appeal have ordered the refund of the protest fee (see e.g. W 15/02 of 27 November 2002, W 1/01 of 18 April 2001, W 2/00 of 18 October 2000, point 4 of the reasons, W 18/99 of 17 April 2000, point 2 of the reasons, W 3/98 of 17 April 2000, point 3 of the reasons).

In the system of examining protests adopted by the EPO under Rule 40.2(e) PCT, as applicable before 1 April 2005 and on the present application, the protest fee is indeed paid by the applicant only for further examination of the protest by the Boards of Appeal after the review panel of the ISA found the invitation to pay further search fees justified. However, a Board of Appeal has no competence to examine a protest as to its substance if it considers the protest to be inadmissible, e.g. for having been late filed or for lack of - sufficient - reasoning.

If, in such a situation, the ISA or IPEA nevertheless invites the applicant to pay the protest fee, such invitation has been considered to be without legal basis since the ISA or IPEA is, for legal reasons, and from the outset of the case, not in a position to provide the service for which the fee is charged.

Therefore, the fee is considered never to have fallen due (see in particular W 3/98 loc.cit) .

By contrast, if an admissible protest has been filed and payment of the protest fee has been required after a negative result of the prior review in accordance with Rule 40.2(e) PCT, the protest fee has fallen due for a service which could be provided by the ISA. Thus, any payment of the protest fee made covers an existing liability of the applicant. Hence, the fee cannot be refunded, if the applicant later voluntarily decides to withdraw his protest pending before a board of appeal.

Furthermore, by contrast with the situations underlying Article 10b RRF in the view of the Board it would not be factually possible to reliably distinguish in protest cases between such cases of withdrawal in which the examination of the protest as to substance by the Board had not yet started when the protest was withdrawn and between such cases where this had already been done. On the contrary such decisions could appear fairly arbitrary and beyond the control of applicants.

3. The Board also finds that the applicant's letter of 22 September 2003 was a protest within the meaning of Rule 40.2(c) PCT. For the declaration of an applicant to constitute a protest it is not necessary as a matter of law that the word "protest" be used. It is sufficient that, when interpreted on an objective basis, the declaration of the applicant expresses what is to be regarded as the essential contents of a protest. According to Rule 40.2(c) PCT any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international

application complies with the requirement of unity of invention. The ISA had based its finding of lack of unity *a posteriori* on the reasoning that document D1 disclosed the phosphonoformate compound "Foscarnet" as well as analogues thereof and that these compounds were inhibitors of RT (reverse transcriptase) and, that hence, the technical feature "non-nucleoside reverse transcriptase inhibitor compound comprising a phosphonate group" of the claim could no longer serve as a special technical feature in the sense of Rule 13 PCT linking the different inventions together. In its reply of 22 September 2003 the applicant contested this finding and submitted that this observation in D1 was incorrect. Thus, the applicant manifestly contested the ISA's basic finding on which its conclusion on lack of unity *a posteriori* relied. Furthermore, the applicant also paid further search fees and indicated, for which inventions these search fees were to be used. Hence, in its way of acting the applicant followed the classic routine of the protest procedure under Rule 40.2(c) PCT. In the international search procedure under the PCT the protest procedure as provided for under Rule 40.2(c) PCT - i.e. the applicant has to pay the additional fees and can then and only thereby contest the ISA's findings - is the only way available to the applicant for attacking the ISA's findings on lack of unity and for possibly achieving a revision of these findings. There is no other communication between the ISA and the applicant. Hence, when after having received an invitation to pay additional fees by the ISA the applicant asked for a revision of the ISA's reasoning forming the basis for its finding on lack of unity and, when it furthermore paid additional search fees, as provided for Rule in 40.2(c) PCT, that constituted a



protest within the meaning of Rule 40.2(c) PCT, when interpreted on an objective basis.

In the present case the applicant moreover confirmed by its later actions having filed a protest. Having been notified by the review panel that after review of its protest filed on 22 September 2003 the invitation was considered justified and that the applicant was invited to pay the protest fee, the applicant, "in response to the notification regarding review of justification for invitation to pay additional search fee" immediately did so and requested that the protest fee be debited from his deposit account. Thus, even at that point in time the applicant still was itself fully of the opinion that it had filed a protest and it still wanted the said protest to be examined by the Boards of Appeal.

It clearly emerges therefrom that with its letter dated 22 September 2003 the applicant intended to, and has filed a protest within the meaning of Rule 40.2(c) PCT, which it withdrew only after the protest procedure had become pending before the Board.

4. As a consequence, the protest fee cannot be refunded.

**Order**

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

The request that the protest fee be reimbursed is rejected.

The Registrar:

The Chairman:

C. Eickhoff

A. Nuss