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D E C I S I O N
of 21 September 2005

Case Number: W 0033/04 - 3.3.01

Application Number: 03772300.4

Publication Number: 0312276

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Language of the proceedings: EN

Title of invention:
Substituted 6-(2-halogenphenyl)-triazolopyrimidines

Applicant:
BASF AG

Opponent:
-

Headword:
Triazolopyrimidines/BASF

Relevant legal provisions:
PCT Art. 34
PCT R. 13, 68(2)

Keyword:
"A posteriory objection of lack of unity by the International Preliminary Examining Authority"
"Lack of sufficient reasoning under Rule 68.2 PCT"
"Reimbursement of the additional examination fee and the protest fee"

Decisions cited:
W 0003/94, W 0006/99

Catchword:
-



Case Number: W 0033/04 - 3.3.01

International Application No. PCT/EP/03/12276

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 21 September 2005

Applicant: BASF AG
Carl-Bosch-Str.
D-67056 Ludwigshafen (DE)

Representative: -

Decision under appeal: Protest according to Rule 68.3(c) of the Patent Cooperation Treaty made by the applicants against the invitation of the European Patent Office (International Preliminary Examining Authority) to restrict the claims or pay additional fees dated 3 June 2004.

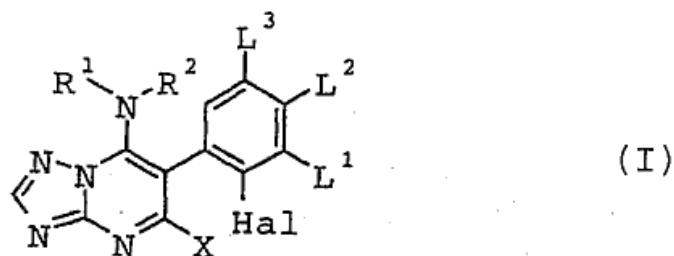
Composition of the Board:

Chairman: A. Nuss
Members: J. Jonk
B. Günzel

Summary of Facts and Submissions

I. On 4 November 2003 the Applicant filed the international patent application PCT/EP 03/12276 (published under number WO 04/041824) comprising a set of 10 claims, claim 1 reading as follows:

"Substituted 6-(2-halogenphenyl)-triazolopyrimidines of formula I



in which

R^1 denote C_1 - C_{10} -alkyl, C_2 - C_{10} -alkenyl, C_2 - C_{10} -alkynyl, or C_4 - C_{10} -alkadienyl, C_1 - C_{10} -haloalkyl, C_2 - C_{10} -haloalkenyl, C_3 - C_{10} -cycloalkyl, phenyl, naphthyl, or

a 5- or 6-membered saturated, unsaturated, or aromatic heterocycle, containing one to four nitrogen atoms or one to three nitrogen atoms and one sulfur or oxygen atom,

wherein R^1 and R^2 radicals may be unsubstituted or partly or fully halogenated or may carry one to three groups R^a ,

R^a is cyano, nitro, hydroxyl, C₁-C₆-alkyl, C₃-C₆-cycloalkyl, C₁-C₆-alkylthio, C₁-C₆-alkylamino, di-C₁-C₆-alkylamino, C₂-C₆-alkenyl, C₂-C₆-alkenyloxy, C₂-C₆-alkynyl, C₃-C₆-alkynyloxy, or C₁-C₄-alkylenedioxy; or

R² denote hydrogen, or a group mentioned for R¹; or

R¹ and R² together with the interjacent nitrogen atom represent a saturated or partially unsaturated 5- or 6-membered heterocycle, containing one to four nitrogen atoms or one to three nitrogen atoms and one sulfur or oxygen atom, which ring may be substituted by one to three R^a radicals;

Hal is halogen;

L¹, L³ independently denote hydrogen, halogen, or C₁-C₄-alkyl;

L² is hydrogen, halogen, C₁-C₄-haloalkyl, or NH₂, NHR^b, or N(R^b)₂,

R^b is C₁-C₈-alkyl, C₃-C₁₀-alkenyl, C₃-C₁₀-alkynyl, C₁-C₆-haloalkyl, C₃-C₆-haloalkenyl, C₃-C₆-haloalkynyl, C₁-C₈-alkoxy-C₁-C₈-alkyl, C₁-C₈-alkylthio-C₁-C₈-alkyl, C₃-C₁₀-cycloalkyl, or C(=O)-A, in which

A is hydrogen, hydroxy, C₁-C₈-alkyl, C₁-C₈-alkoxy, C₁-C₆-halogenalkoxy, C₁-C₈-alkylamino, or di-C₁-C₈-alkylamino;

wherein at least one from L¹, L¹, and L³ is not hydrogen;

X is halogen, cyano, C₁-C₆-alkyl, C₁-C₆-alkoxy, C₁-C₆-haloalkoxy or C₃-C₈-alkenyloxy."

- II. In a communication dated 9 February 2004, the European Patent Office (EPO), acting as International Searching Authority (ISA), invited the applicant pursuant to Article 17(3)(a) and Rule 40(1) PCT to pay one additional search fee.
- III. In this invitation to pay the additional search fee (IPAF), the ISA considered that the application in suit comprised six different inventions, namely:

Invention 1 (claims 1(part), 2(part), and 4-10):

"Triazolopyrimidine derivatives, when R²=hydrogen, R¹=aliphatic group (claim 1,2,4,5); process to make these compounds (claims 6 and 7); their intermediates (claim 8); their fungicidal composition (claim 9) and use of these compounds for controlling phytopathogenic fungi (claim 10)";

Inventions 2 to 5, which are not relevant to this decision; and

Invention 6 (claims 1(part), 3-10):

"Triazolopyrimidine derivatives, when R¹ and R² together form an heterocycle (claim 1,3,4 and 5); process to make these compounds (claims 6 and 7); their intermediates (claim 8); their fungicidal composition (claim 9) and use of these compounds for controlling phytopathogenic fungi (claim 10)".

In this context, the ISA held that the common concept of the subject-matter of claims 1 to 10 was the 7-R¹,R²-amino-6-(2-halophenyl)-triazolopyrimidine structure of compounds having fungicidal activity. However, because of lack of novelty in view of document

(1) WO 98/46608

this common feature could not represent the single inventive concept which could have linked the different subject-matters together.

IV. The applicant paid the additional search fee on 1 March 2004.

V. On 3 June 2004 the EPO as the International Preliminary Examining Authority (IPEA) invited the Applicant under Article 34(3)(a) and Rule 68.2 PCT to restrict the claims or to pay 1 additional examination fee of EUR 1530.00 within 1 month from the above date.

In this invitation the IPEA literally repeated the considerations and conclusions of the ISA concerning unity of invention indicated under point III above. Moreover, it concluded that at the search stage before the ISA only the subject-matter of the inventions 1 and 6 had been searched, and that therefore the applicant only might have an examination with respect to these two inventions.

VI. On 2 July 2004 the applicant paid the required additional fee under protest pursuant to Rule 68.3(c).

In support of his protest he argued essentially that unity of invention existed in view of the novel specific substitution of the phenyl group at the 6-position of the triazolopyrimidine structure.

VII. On 30 July 2004 the IPEA invited the Applicant to pay a protest fee of EUR 1020.00 pursuant to Rule 68.3(e) PCT, since a prior review of the invitation to pay the additional examination 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 3 June 2004, and the fact that the specific substitution of the phenyl ring at the 6-position of the triazolopyrimidine structure was already known from document (1) (compound 62).

VIII. The Applicant paid the protest fee on 14 August 2004.

Reasons for the Decision

1. The protest is admissible.
2. Rule 68.2 PCT stipulates that the invitation under Article 34(3)(a) PCT to pay additional fees must specify the reasons for which the international application is considered to lack unity. This means it

must include a substantiation the applicant can follow, indicating not only the reasons why the single invention as per the independent claim (solution of the technical problem defined against the closest prior art) is not new or inventive, but also why, once the invention's single general inventive concept is dropped, unity no longer exists between the newly defined alternative subject-matter, if this is not clear from that definition.

3. In the case at issue, the IPEA, in the light of the disclosure in documents (1), divided the subject-matter of claim 1 as originally filed (and defined using a Markush formula) into 6 separate inventions, including the relevant inventions 1 and 6 as defined under points III and V above.
4. In the invitation to pay, the sole reason given for the IPEA's non-unity objection was that the common concept of the subject-matter of claims 1 to 10, namely the 7- R^1, R^2 -amino-6-(2-halophenyl)-triazolopyrimidine structure of compounds having fungicidal activity, lacked novelty in view of document (1) and, therefore, could not represent the single inventive concept which could have linked the different subject-matters together. In this context, the review panel also noted that the specific substitution of the phenyl ring at the 6-position of the triazolopyrimidine structure was already known from document (1) (compound 62).
5. The issue is thus whether the IPEA thereby fulfilled its obligation to substantiate its findings.

6. To establish this, the Board must consider, as indicated in point 3 above, not only the PCT and its Regulations but also the PCT Guidelines for International Preliminary Examination as in force from 9 October 1998, in which it is stipulated under III-7 that the assessment of unity of invention is governed by Rule 13 PCT and the details concerning the application of those provisions contained in Section 206 of the Administrative Instructions under the EPC and Annex B thereto.
7. Said Annex B, Part 1(f) specifies certain criteria for assessing the unity of Markush claims, and in particular that for alternatives contained in such claims the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2 PCT are to be considered to be met when **the alternatives are of a similar nature.**

Moreover, it stipulates (Part 1(f)(i)) that alternatives are to be regarded as "**of a similar nature**" where the following criteria are fulfilled:

(A) all alternatives have a common property or activity,
and

(B) (1) a common structure is present, i.e. a **significant structural element is shared by all of the alternatives,**

or

(B) (2) in cases where the common structure cannot be the unifying criterion, all alternatives belong to a **recognised class of chemical compounds** in the art to which the invention pertains,

whereby

- (a) the words "significant structural element is shared by all the alternatives" (in paragraph B(1) above) refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small proportion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art (Part 1(f)(ii));
- (b) the expression "structural element" (also in paragraph B(1) above) may be a single component or combination of individual components linked together (Part 1(f)(ii)); and
- (c) the words "recognised class of chemical compounds" (in paragraph (B) (2) above) means that there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention; in other words, each member could be substituted for the other, with the expectation that the same intended result would be achieved (Part 1(f)(iii)).

8. Furthermore, it is stipulated in said Annex B under Part 1(f)(v), that when dealing with alternatives, if it can be shown that at least one Markush alternative

- is not novel over the prior art, the question of unity of invention shall be reconsidered by the Examiner, and that such a reconsideration does not necessary imply that an objection of lack of unity shall be raised.
9. In the present case, the invitation to pay can therefore be regarded as specifying reasons within the meaning of Rule 68.2 PCT only if it indicates why in this instance the criteria set out in Annex B with respect to the Markush Practice of the Administrative Instructions are not fulfilled.
 10. Thus, in view of the above considerations showing that the IPEA failed to apply in its reasoning the specific criteria for assessing the unity of Markush claims, in particular the criteria relating to unity between the newly defined alternative subject-matters, the Board concludes that more detailed reasons should have been given for the non-unity objection, in line with the relevant PCT Administrative Instructions (see also W 3/94 (OJ EPO 1995, 775)). In their absence, the invitation to pay does not meet the requirements of Rule 68.2 PCT, and therefore does not provide a basis for retaining the additional search fees paid under protest.
 11. Finally, the Board observes that the IPEA did not submit a first written opinion as required according to the decision W 6/99 (OJ EPO 2001, 196) giving the Applicant the opportunity to overcome the *a posteriori* non-unity objection. However, since the invitation to pay the additional examination fee has been considered to be unfounded for the reasons set out above, the Board sees no need to deal with this matter anymore.

Order

For these reasons it is decided that:

1. The invitation to pay the additional examination fee is unfounded.
2. The reimbursement of the additional examination fee and the protest fee is ordered.

The Registrar:

The Chairman:

N. Maslin

A. Nuss