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**D E C I S I O N**  
**of 11 May 2006**

**Case Number:** W 0025/05 - 3.3.04

**Application Number:** PCT/CA04/00846

**Publication Number:** WO-04/111084

**IPC:** C07K 14/47

**Language of the proceedings:** EN

**Title of invention:**

Compositions and methods for treating arteriosclerosis

**Applicant:**

Queens University at Kingston

**Opponent:**

-

**Headword:**

Artherosclerosis/QUEENS UNIVERSITY

**Relevant legal provisions:**

PCT Art. 17(3)  
PCT R. 40.2

**Keyword:**

"Admissibility of protest - (no)"

**Decisions cited:**

W 0004/87, W 0025/89, W 0018/91, W 0004/92, W 0027/05

**Catchword:**

-



**Case Number:** W 0025/05 - 3.3.04

**International Application No.** PCT/CA04/00846

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.04**  
**of 11 May 2006**

**Applicant:** Queens University at Kingston  
Kingston  
Ontario  
K7L 3N6 (CA)

**Representative:** Miernicki Steeg, C.  
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**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 18 October 2004.

**Composition of the Board:**

**Chair:** U. Kinkeldey  
**Members:** M. Wieser  
C. Holtz

## Summary of Facts and Submissions

- I. International patent application PCT/CA 04/00846 was filed on 11 June 2004 with 106 claims.
- II. The claims referred to peptides enhancing cholesterol ester hydrolase activity (CEH) and to peptides inhibiting acyl CoA: cholesterol acyl transferase (ACAT), to pharmaceutical compositions and conjugates containing these peptides and their pharmaceutical use.
- III. On 18 October 2004 the European Patent Office (EPO), acting as International Searching Authority (ISA), invited the Applicant to pay within the time limit of 45 days fifty-five additional search fees pursuant to Article 17(3)(a) PCT and Rule 40.1 PCT and issued a partial search report on claims 1-12, 18-23, 25-29 and 31-40 (all partly).

The ISA identified the alleged inventive concept of the present application as being the provision of peptides influencing the storage and/or release of cholesterol from inflammatory or atherosclerotic sites by either enhancing the activity of CEH or by inhibiting ACAT.

The ISA, by analysing the disclosure in the documents cited in the partial search report, came to the conclusion that this concept was known from the prior art. As no other technical feature (neither structural nor functional) could be identified that could be considered as a special technical feature within the meaning of Rule 13(2) PCT, each peptide claimed was considered as a separate invention.

The invitation to pay additional search fees stated that the application related to fifty-six groups of invention.

- IV. With letter of 30 November 2004 the Appellant informed the ISA that he paid two additional search fees under protest.

Said letter contained the following paragraph indicating the grounds on which the Applicant's protest was based:

"Applicants respectfully request **rejoining** of the allegedly separate inventions and consequent expansion of the search to further cover Groups 2 to 56. Rejoining creates no undue search burden due to the overlapping nature of the different Groups as set forth by the Examiner. For example, the search already performed on Group I should have identified art relevant to peptides or mimetics thereof having a similar stimulating effect on the activity of cholesterol ester hydrolase that have been separated by the Examiner into other Groups. Further, all Groups as set forth by the Examiner have the unifying general inventive concept of modulating key enzymes related to cholesterol storage and transport."

- V. On 31 March 2005 the ISA communicated to the Applicant the result of its review under Rule 40.2(e) PCT.

It was found that no convincing arguments were provided by the Applicant and that the objection because lack of unity under Rule 13(1)(2) PCT was therefore maintained.

The Applicant was invited to pay a protest fee.

On the same day the ISA transmitted the International search report for the three groups of inventions for which search fees had been paid.

VI. The protest fee was paid on 27 April 2005.

### **Reasons for the decision**

1. Under Article 154(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against additional fees charged by the EPO under the provisions of Article 17(3)(a) PCT.
2. Pursuant to Article 17(3)(a) PCT, if the ISA considers that an international application does not comply with the requirement of unity of invention as set forth in the Regulations, it shall invite the Applicant to pay additional fees. The ISA shall establish the International search report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and, provided the required additional fees have been paid within the prescribed time limit, on those parts of the international application which relate to inventions in respect of which the said fees were paid.
3. Rule 40.2(c) PCT enables the Applicant to pay the additional fees under protest, that is, accompanied by a **reasoned statement** to the effect that the international application complies with the requirement of unity of invention or that the amount of the

required additional fees is excessive. Such protest shall be examined by a review body, which to the extent that it finds the protest justified, shall order the total or partial reimbursement of the additional fees.

Consequently, if the Applicant wishes to pay the additional fees under protest, these fees must be accompanied by the reasoned statement that sets out the protest. Since, according to Article 17(3)(a) and Rule 40.1 PCT, the fees have to be paid within a specified time limit, the protest including the reasoned statement must be made within the same time limit (cf. decision W 4/87, OJ EPO 11/1988, 425; point (3) of the reasons).

4. Applicant's statement in his reply to the invitation to pay additional fees, cited in Section (IV) above, cannot be considered as a reasoned reaction, which would allow the Board to examine the justification of the invitation to pay additional fees.

Said statement, in its first part, only says that, according to Applicant's opinion, rejoining of the fifty-six different groups of invention found by the ISA would not create undue search burden due to the overlapping nature of the different inventions.

In its last sentence the statement says that all groups of inventions found by the ISA have the unifying general inventive concept of modulating key enzymes related to cholesterol storage and transport.

This is exactly what the ISA, in the invitation to pay additional fees, identified as being the alleged

inventive concept of the present application and what the ISA, after consideration of the disclosure in the documents cited in the partial search report, decided to be known from the prior art (see section (III) above).

5. Applicant's protest merely contains unreasoned allegations and unsubstantiated assertions and cannot be regarded as a reasoned statement within the meaning of Rule 40.2.(c) PCT because it does not give any reasons showing why the Applicants take that view.
  
6. Factually the same or very similar cases, wherein the competent Boards decided that a protest under Rule 40.2(c) PCT was inadmissible as it did not include a reasoned statement, are:

Decision W 25/89 of 16 March 1990, wherein the Board decided that although the Applicant's communication to the effect that the additional fee was being paid under protest was received in due time, it could not be said that this communication contained anything which could be interpreted as being a reasoned statement as to why the Applicant considered that the ISA was wrong in their argumentation submitted with the invitation to pay an additional fee (cf point (4) of the reasons).

Decision W 18/91 of 26 July 1992 was concerned with a situation where the Applicant, upon being invited by the ISA to pay an additional search fee, answered:

"This additional fee is paid under protest, since those claims which can be searched relate to a single inventive concept." The competent Board decided that

this statement is only an allegation which cannot be considered as a "reasoned statement" within the meaning of Rule 40.2(c) PCT. Reference was made to decision W 8/89 of 11 December 1990. In point (4) of the reasons the Board judged that the Applicant's protest was inadmissible and that it therefore was not necessary to examine whether the invitation to pay was legally effective, e.g. had been properly reasoned to substantiate lack of unity, since that was a question of substantive law which had to be dealt with on the occasion of substantive examination of the protest which may only be initiated if the protest was admissible (cf decision W 6/88 of 14 April 1989).

A further decision being concerned with this situation and arriving at the same judgement is decision W 4/92 of 26 February 1992.

7. The facts of the present case differ from those of the case underlying decision W 27/05 of 4 April 2006. There the ISA has found that claim 1 of the application did not involve an inventive step according to Article 33(3) PCT and that consequently a common inventive concept underlying the remaining claims was lacking. The ISA identified three groups of claims referring to three different inventions and invited the Applicant to pay two additional search fees. The Applicant paid the fees under protest accompanied by a statement wherein he did not discuss the finding of the ISA that claim 1 did not involve an inventive step, **but** wherein, contrary to the present case, **two additional arguments** were presented why, in the Applicant's opinion, unity existed between the three groups of invention identified by the ISA. The competent Board accepted the very short letter as a



reasoned statement and considered the protest as admissible. However, the Applicant's arguments were not found to be convincing and the protest was refused.

8. In the light of the relevant case law of the Boards of Appeal, the present protest under Rule 40.2(c) PCT is inadmissible.

The additional fees paid by the Applicant shall not be refunded.

## **Order**

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

The protest under Rule 40.2(c) is dismissed as inadmissible.

Registrar:

Chair:

G. Rauh

U. Kinkeldey