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**Datasheet for the decision
of 4 March 2008**

Case Number: W 0037/07 - 3.3.04

Application Number: PCT/DK2007/000070

Publication Number: WO2007093177

IPC: C07K 14/825, A61K 38/00

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Title of invention:
Metallothionein-derived peptide fragments

Applicant:
Berezin, Vladimir

Opponent:
-

Headword:
Metallothionein-derived peptide/BEREZIN

Relevant legal provisions:
PCT Art. 17(3)(a)
PCT R. 13, 40

Keyword:
"Admissibility of the protest (no)"

Decisions cited:
G 0001/89, W 0020/06

Catchword:
-



Case Number: W 0037/07 - 3.3.04

International Application No. PCT/DK2007/000070

D E C I S I O N
of the Technical Board of Appeal 3.3.04
of 4 March 2008

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Subject of this 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 31 July 2007.

Composition of the Board:

Chair: U. Kinkeldey
Members: M. Wieser
T. Bokor

Summary of Facts and Submissions

- I. International patent application no. PCT/DK2007/000070 published as WO 2007/093177 and having the title "Metallothionein-derived peptide fragments" was filed on 12 February 2007 with 75 claims.

Claims 1, 8 and 9 read as follows:

- "1. A peptide comprising at most 25 contiguous amino acid residues comprising an amino acid motif of the formula: S/D/E-(x)_n-S/D/E-K/S, wherein (X)_n is a sequence of any amino acid residues, and n is an integer from 4 to 6."
- "8. The peptide according to any of the preceding claims, wherein the peptide comprises about 15 amino acid residues, such as from 13 to 17 amino acid residues."
- "9. The peptide according to claim 8, said peptide comprising an amino acid sequence selected from the following sequences:
KKSSCSCSPVGS AK (SEQ ID NO:1)
AQGSISKGASDKSS (SEQ ID NO:2)
MDPNSSSAAGDSST (SEQ ID NO:3)
SAGSSKSKEKSTTS (SEQ ID NO:4)
AQGSICKGASDKSS (SEQ ID NO:5)
MDPNCSCAAGDSST (SEQ ID NO:6)
SAGSCKCKEKSTTS (SEQ ID NO:7)
KGGEEAEAEAEK (SEQ ID NO:8),
or a fragment, or a variant thereof."

II. On 31 July 2007, the European Patent Office (EPO), acting in its capacity as International Searching Authority (ISA) under Article 16 PCT and Article 154 EPC, informed the applicant that the application did not comply with the requirement of unity of invention (Rule 13.1 PCT) and invited the applicant to pay within a time limit of one month seven additional search fees in accordance with Article 17(3)(a) PCT and Rule 40.1. PCT.

III. In the invitation to pay additional fees, the ISA defined inventions 1 to 8 to which the application related as follows:

"1. claims: 1-75 partially

peptide comprising Seq ID NO:1, first and second medical use, Ab, kit and composition comprising said peptide

2. claims: 1-75 partially

peptide comprising Seq ID NO:2, first and second medical use, Ab, kit and composition comprising said peptide

3. claims: 1-75 partially

peptide comprising Seq ID NO:3, first and second medical use, Ab, kit and composition comprising said peptide

4. claims: 1-75 partially

peptide comprising Seq ID NO:4, first and second
medical use, Ab, kit and composition comprising
said peptide

5. claims: 1-75 partially

peptide comprising Seq ID NO:5, first and second
medical use, Ab, kit and composition comprising
said peptide

6. claims: 1-75 partially

peptide comprising Seq ID NO:6, first and second
medical use, Ab, kit and composition comprising
said peptide

7. claims: 1-75 partially

peptide comprising Seq ID NO:7, first and second
medical use, Ab, kit and composition comprising
said peptide

8. claims: 1-75 partially

peptide comprising Seq ID NO:8, first and second
medical use, Ab, kit and composition comprising
said peptide"

IV. In the invitation, the ISA stated that in view of the disclosure of the present application, the technical problem to be solved was the provision of compounds which are capable of promoting neuron survival and/or

differentiation. The solution to this problem in its broadest form was represented by peptides (<26 amino acids) comprising an amino acid motif of the general formula S/D/E-(x)4 or 6-S/D/E-K/S of claim 1.

However, peptides comprising this formula were known in the prior art. Document D1 for instance revealed a 10 amino acids long peptide comprising the amino acid motif S/D/E-(x)6-S/D/E-K/S. The structural motif as claimed in claim 1 was thus not new and could therefore not be considered as special technical feature.

Claim 9 suggested peptides comprising Seq ID Nos: 1 to 8 to solve the above identified problem. The objective technical problem to be solved was the provision of further peptides besides those claimed in claim 9. However, besides the amino acid motif of the formula S/D/E-(x)4 or 6-S/D/E-K/S of claim 1, which was not new, no common special technical feature for the 8 peptides could be identified that would define an appreciable contribution over the prior art. The application therefore split up into 8 independent groups of inventions, each of them being characterized by a sequence comprising one of Seq ID Nos: 1 to 8.

- V. The communication of 31 July 2007 also contained the results of the partial international search.

- VI. With letter dated 30 August 2007, the applicant paid one additional fee for invention 7 under protest. The protest fee was also paid.

The applicant submitted that the peptide of document D1 had no relation to any of the peptides designated as inventions 1 to 8 of the application.

The applicant requested that the ISA withdraws the objection of lack of unity since the main invention had been searchable. Further, the applicant requested the reimbursement of the additional search fee paid with the protest.

- VII. On 25 October 2007, the ISA invited the applicant to pay a protest fee (unless such fee had already been paid) and informed the applicant that a prior review had reached the conclusion that the invitation to pay additional search fees was justified. It was indicated that the protest fee had already been paid on 31 August 2007.

Reasons for the Decision

1. Given that the international application under consideration has an international filing date of 12 February 2007, the protest is subject to the provisions of the PCT as in force from 1 April 2006.
2. The Board is competent to decide on the protest, following decision W 20/06 of 3 April 2007, points 1 to 9 of the Reasons.

Admissibility of the Protest

3. Rule 40.2(c) PCT enables the Applicant to 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 ...". If the applicant decides to pay the additional fee under protest, therefore, it must be accompanied by a statement setting out the reasons for the protest. Since under Article 17(3)(a) and Rule 40.1 PCT this fee must be paid within the specified time limit, it follows that the statement must also be submitted within the same time limit (see "Case Law of the Board of Appeal of the European Patent Office", 5th edition 2006, Chapter IX.C.3.2).

4. In the invitation to pay additional fees, the ISA stated that the claimed subject-matter did not fulfil the requirement of unity of invention since peptides of the general formula of claim 1 were known from the prior art, notably from document D1 which revealed a ten amino acid long peptide comprising the amino acid motif S/D/E-(x)6-S/D/E-K/S. The ISA concluded that the structural motif as claimed in claim 1 was not new and could therefore not be considered as special technical feature. Consequently, the claimed subject-matter split up into 8 independent groups of invention.

Although the ISA has not specified exactly which of the peptides disclosed in document D1 it was referring to, the Board considers that a peptide comprising the amino acid motif S/D/E-(x)6-S/D/E-K/S can easily be identified from the Table of document D1, i.e. the document first mentioned in the Annex to the invitation to pay additional fees. Hence the reader of said invitation can understand that the ISA has raised a non-unity objection *a posteriori*, based on its finding

that claim 1 lacks novelty over a specific peptide disclosed in document D1.

5. Having regard to the applicant's letter dated 30 August 2007 with which one additional search fee for invention 7 and the protest fee were paid, the Board cannot recognize any substantive argument(s) supporting the applicant's opinion that, despite the arguments communicated by the ISA, the claimed subject-matter still complies with the requirement of unity of invention.

5.1 In said letter, the applicant alleges that "the invitation by the ISA under Art. 17(3)(a) and Rule 40.1 PCT is unjust" and that "the invitation is not adequately substantiated", which latter statement cannot be followed by the Board for the reasons set out in point 4 above. The applicant further gives a summary of the findings of the ISA and states that "[t]he search revealed prior art document D1 (Trojan et al.), comprising a peptide comprising the general formula of claim 1".

5.2 The Board is unable to find in the applicant's letter a statement that the above quoted finding by the ISA is wrong. Rather, the applicant states that "[t]he peptide of D1 has no relation to any of the peptides, designated inventions 1-8, of the present application". This sentence however relates to the peptides identified in inventions 1 to 8, and not to the general formula of claim 1, and is in fact the only statement in the applicant's letter which could possibly qualify as a reasoning addressing the actual non-unity objection raised by the ISA.

However, said sentence cannot be regarded as a reasoned statement within the meaning of Rule 40.2(c) PCT because it does not provide the Board with any reasons as to why the application, and in particular inventions 1 and 7, as identified by the ISA, should be considered unitary. As the applicant does not contest the ISA's finding that claim 1 lacks novelty over document D1, it would, in order for unity to be present, still be necessary that inventions 1 and 7 shared a "special technical feature" in accordance with Rule 13.2 PCT, which feature would have to make a contribution to the prior art, i.e. must not be shared by the peptides of the prior art including document D1. In his letter, the applicant does however not offer any kind of information what this special technical feature shared by inventions 1 and 7 might be. The question whether or not the prior art peptide of document D1 has any "relation to any of the peptides, designated inventions 1-8" is irrelevant in this context, as it does not relate to the presence of a special technical feature. Therefore, no adequate substantiation has been provided by the applicant with his protest.

- 5.3 For the sake of completeness, it is pointed out that the applicant's comment that "the main invention was searchable" can also not be considered as representing the necessary reasoning of the protest, since the issue of unity of invention, as laid down in the provisions of Rule 13.1 and 13.2 PCT, is not related to the question whether or not the claimed subject-matter is searchable. Neither can the mere repetition of case law relating to non-unity, as represented by decision

G 1/89, which has been cited by the applicant in his letter, be considered as a reasoning of the protest.

6. In view of the above, the Board concludes that the applicant's protest has not been sufficiently reasoned and is thus inadmissible. Consequently, the additional search fee paid by the applicant cannot be refunded.

Order

For these reasons it is decided that:

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

The Registrar:

The Chair:

P. Cremona

U. Kinkeldey