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Datasheet for the decision of 6 August 2008

Case Number: W 0039/07 - 3.3.01

Application Number: PCT/EP2007/000638

Publication Number: WO 2007/085451

IPC: C07D 261/08

Language of the proceedings: EN

Title of invention:
3,5-Di(aryl or heteroaryl)isoxazoles and 1,2,4-oxadiazoles as S1PI receptor agonists, immunosuppresive and anti-inflammatory agents

Applicant:
NOVARTIS AG

Opponent:
-

Headword:
Isoxazoles and oxadiazoles/NOVARTIS

Relevant legal provisions:
PCT Art. 17(3)(a)
PCT R. 40.1, 40.2

Relevant legal provisions (1973):
EPC Art. 154(3)

Keyword:
"Misleading form inviting the applicant to pay the protest fee although his limited protest was allowed by the review panel - Refund of the protest fee"

Decisions cited:
W 0008/01

Catchword:
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Case Number: W 0039/07 - 3.3.01

International Application No. PCT/EP2007/000638

D E C I S I O N
of the Technical Board of Appeal 3.3.01
of 6 August 2008

Applicant: NOVARTIS AG
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Representative: Georg von Sprecher
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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 18 May 2007.**

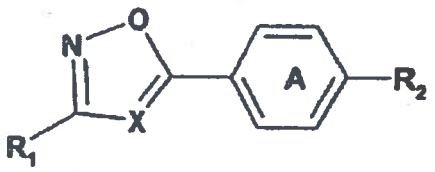
Composition of the Board:

Chairman: J. Jonk
Members: C. M. Radke
T. Bokor

Summary of Facts and Submissions

I. International patent application PCT/EP2007/000638 was filed on 25 January 2007 with thirteen claims.

Independent claim 1 relates to compounds of formula I



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wherein X is -N= or =CH-; and R_1 and R_2 may have the various meanings specified in the claim.

Dependent claims 2 to 6 relate to preferred embodiments of claim 1.

II. On 18 May 2007 the European Patent Office (EPO), acting as the International Searching Authority (ISA) invited the Applicant pursuant to Article 17(3)(a) PCT and Rule 40.1 PCT to pay nine additional search fees.

III. In this invitation to pay the additional fees, the ISA considered that the subject-matter of claim 1 lacked novelty in view of a certain document of the prior art, so that there was no technical feature common to all alternative compounds claimed which defined a contribution over the prior art. Under these circumstances the ISA concluded that the application in suit comprised ten different inventions, *inter alia* a

First Invention (Claims 1-5 (part), 7-13 (part)):

Compounds of formula I wherein R_1 is substituted biphenylyl and R_2 is alkoxy or alkyl optionally substituted by halogen, alkoxy or alkylcarbonyloxy; a

Third Invention (Claims 1-13 (part)):

Compounds of formula I wherein R_1 is substituted biphenylyl and R_2 is R_3-R_4-COOH or R_3-R_4-CO-NH_2; and a

Ninth Invention (Claims 1-13 (part)):

Compounds of formula I wherein R_1 is substituted phenyl, heteroaryl or 4-(phenylalkoxy)phenyl and R_2 is R_3-R_4-COOH or R_3-R_4-CO-NH_2.

IV. With a letter dated 8 June 2007, the Applicant authorised the ISA to charge his account with one additional search fee under protest.

In this letter he disputed that the Third Invention and the Ninth Invention as defined by the ISA were distinct inventions and stated that he submitted the protest for this reason.

He presented arguments which were limited to the issue why he deemed that the Third and the Ninth Inventions met the requirements of unity.

Furthermore, the Applicant requested that the complete subject-matter of claim 6 be additionally searched for the additionally paid search fee.

V. In response to a telephone conversation with the ISA, the Applicant authorised the ISA in his letter dated

11 October 2007 to charge his account with one more additional search fee and requested that the Third Invention and the Ninth Invention be additionally searched.

VI. In a notification pursuant to Article 40.2 (e) PCT dated 29 October 2007, the review panel of the ISA held that the invitation to pay an additional fee was justified in part and invited the Applicant to pay the protest fee.

The review panel came to the conclusion that the Third Invention and the Ninth Invention identified in the invitation to pay additional fees met the requirement of unity and reimbursed one of the two additional search fees paid.

VII. The search report mailed on 2 November 2007 covered the subject-matter of claim 6 and the Third Invention and the Ninth Invention mentioned under point III.

VIII. With a letter dated 1 November 2007, the Applicant authorised the ISA to debit the protest fee from his account.

Reasons for the Decision

1. The protest conforms with the formal requirements of Rule 40.2 c) PCT and is, therefore, admissible.

2. The present application was filed on 25 January 2007, i.e. before the date of entry into force of the EPC 2000. Due to this fact, the Board is competent to

decide on a protest of the Applicant against an additional search fee charged by the EPO as the ISA, and hence has to decide whether or not the additionally paid search fee may be reimbursed (see Article 154(3) EPC 1973 in conjunction with the decision of the Administrative Council of 28 June 2001, the transitional provisions set out in Article 3 of the decision of the President of the EPO dated 24 June 2007 and the chapter II of the Notice of the EPO of the same date (see OJ EPO, Spec. Ed. 3, 2007, 140 and 142) and Rule 40.2 PCT).

3. It is evident from points IV and V above, that the sole request of the Applicant was that the second additional search fee paid under protest for the Ninth Inventions be refunded. Thus the protest is limited to the payment of this fee.

This request was allowed by the review panel of the ISA.

In this context the Board notes that it is unclear why the applicant was invited to pay the second additional search fee after the expiry of the time limit (the time limit set by the original invitation dated 18 May 2007, which time limit expired on 18 June 2007). Such a procedure is not foreseen in the PCT.

4. The Applicant did not present arguments concerning unity of the First Invention with the subject-matter of claim 6 (see point IV above).

As explained in the Notice from the EPO dated 1 March 2005 concerning the protest procedure under the PCT

(lack of unity), OJ EPO 2005, 226, if the review panel finds an invitation was justified only in part, the applicant is invited to pay the protest fee if he wishes the protest to be referred to the Board of Appeal **to the extent it was not allowed** (emphasis added). Thus it is clear that an applicant whose limited protest was entirely allowed does not need to pay a protest fee as a precondition for the announced partial refund of the additional search fees.

5. The Form PCT/ISA/228(April2005) was sent to the Applicant on 29 October 2007. This form communicated the result of the review to the Applicant and invited him "to pay a protest fee". Furthermore, this form stated that "Failure to pay the protest fee ... will result in the protest being considered not to have been made." It is obviously against this background that the Applicant paid the protest fee in spite of the fact that the review panel had entirely accepted his limited protest.

6. In view of the fact that the limited protest was entirely allowed by the review panel, the Board considers the protest to be entirely justified under Rule 40.2 (e) PCT, last sentence, with the effect that the protest fee is refunded (see decision W 8/01 of 28 April 2003, not published in the OJ EPO).

Order

For these reasons it is decided that:

The protest fee is reimbursed.

The Registrar

C. Eickhoff

The Chairman:

J. Jonk