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Aktenzeichen / Case Number / N^o du recours : W 22/90 - 3.3.1

Anmeldenummer / Filing No / N^o de la demande : PCT/US89/05036

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Process for the preparation of 2,4,6-Triiodo-5-
Title of invention: amino-N-alkylisophthalamid acid
Titre de l'invention :

Klassifikation / Classification / Classement : C07C 231/12

ENTSCHEIDUNG / DECISION
vom / of / du 18 September 1990

Anmelder / Applicant / Demandeur : Mallinckrodt Inc.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : N-Alkylisophthalamid acid derivatives/
MALLINCKRODT

EPÜ / EPC / CBE PCT Rule 40

Schlagwort / Keyword / Mot clé : "Invitation to pay additional search fees not
properly reasoned - enumeration of alledged
inventions insufficient"

Leitsatz / Headnote / Sommaire



Case Number : W 22/90 - 3.5.1
International Application No. PCT/US89/05036

D E C I S I O N
of the Technical Board of Appeal 3.1.1
of 18 September 1990

Applicant : Mallinckrodt, Inc.
P.O. Box 5840
St. Louis, Missouri 63134
United States of America

Representative :

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 4 additional fees) of the European Patent Office (branch at The Hague) dated 12 April 1990

Composition of the Board :

Chairman : K. Jahn
Member : P. Krasa
Member : J. Stephens-Ofner

Summary of Facts and Submissions

- I. Following the filing of this International application, the EPO acting as ISA issued an invitation to pay two additional search fees because it considered that the application did not comply with the requirement of unity of invention because certain groups of claims were said to relate to subjects, defined by the problems and their means of solution, being so different from each other so as to form no single general inventive concept.

The applicant paid the additional search fees under protest and contested by a reasoned statement the suggestion of lack of unity.

Reasons for the Decision

1. In accordance with Article 154(3) EPC, the Boards of Appeal are responsible for deciding on the protest raised by the Applicant.
2. The protest complies with Rule 40.2(c) PCT; it is, therefore, admissible.
3. Rule 40.1 PCT stipulates that the invitation provided for in Article 17(3)(a) PCT must specify the reasons why the International application is not deemed to comply with the requirements of unity of invention. The purpose of this Rule is to enable the applicant and, in the case of a protest, also the appeal board to examine whether the request to pay additional search fees owing to lack of unity of the invention is justified. At the least, the considerations that motivated the decision must be readily comprehended from the reasons indicated in the invitation of the ISA.

4. In several decisions the Boards of Appeal have already expressed the view that the requirement to give reasons in an invitation pursuant to Article 17(3)(a) and Rule 40.1 PCT is so fundamental that an unsubstantiated invitation cannot be regarded as legally effective (see e.g. W 4/85, Reasons for the Decision point 3, OJ EPO 1987, 63, 65 and W 7/86, Reasons for the Decision point 3, OJ EPO 1987, 67, 68). While there may be cases where a simple enumeration of the respective subjects may be sufficient for substantiating lack of unity of invention, such straightforward cases will be exceptional and will rarely occur in the chemical field (W 7/86, Reasons for the Decision, point 4).

5. In the Board's judgment, however, the present invitation of the ISA does not contain an acceptably reasoned statement setting out the considerations for the decision in a way which could be readily understood. The invitation to the applicant sets out as reasons for requiring the additional fees, merely the following:
 1. Claims 1-22, 42-45, 49-50: Stoichiometric excess
 2. Claim 23: Use of buffer
 3. Claims 46-48: High dilution.

There were no reasons given by the ISA as to why it considered the three groups of subject-matter as relating to separate inventive concepts in spite of the fact that ~~all these features are process features for the manufacture of the same products.~~

In the case of a protest under Rule 40(2) PCT, where an objection a priori is raised, the only way to determine the

technical problem is to rely on the description of the application. According to the description, the problem underlying the present application is the production of particular iodo-derivatives of isophthalamides with improved yields, enhanced quality and favourable kinetics and productivity (page 5, lines 2 to 18). Without evidence to the contrary, it appears that this problem is solved in all the Claims 1 to 50 and it follows from page 7, lines 1 to 23 of the International application that all the features as listed by the ISA and quoted above may contribute to such purpose.

- 6. The invitation accordingly violated the obligation to specify reasons as laid down in Rule 40.1 in conjunction with Rule 13.1 PCT. Consequently it is not legally effective and accordingly the two additional search fees paid by the Applicant cannot be retained.

Order

For these reasons, it is decided that:

Refund of the two additional search fees is ordered.

The Registrar:

The Chairman:



M. Beer



A. Jahn

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