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**D E C I S I O N**  
**of 17 April 2000**

**Case Number:** W 0018/99 - 3.3.1

**Application Number:** PCT/US 98/23223

**Publication Number:** WO 99/24405

**IPC:** C07D 233/64

**Language of the proceedings:** EN

**Title of invention:**

H<sub>3</sub> Receptor ligands of the phenyl-alkyl-imidazoles type

**Applicant:**

SCHERING CORPORATION

**Opponent:**

-

**Headword:**

H<sub>3</sub> receptor/SCHERING CORPORATION

**Relevant legal provisions:**

PCT R. 63.3(c)

**Keyword:**

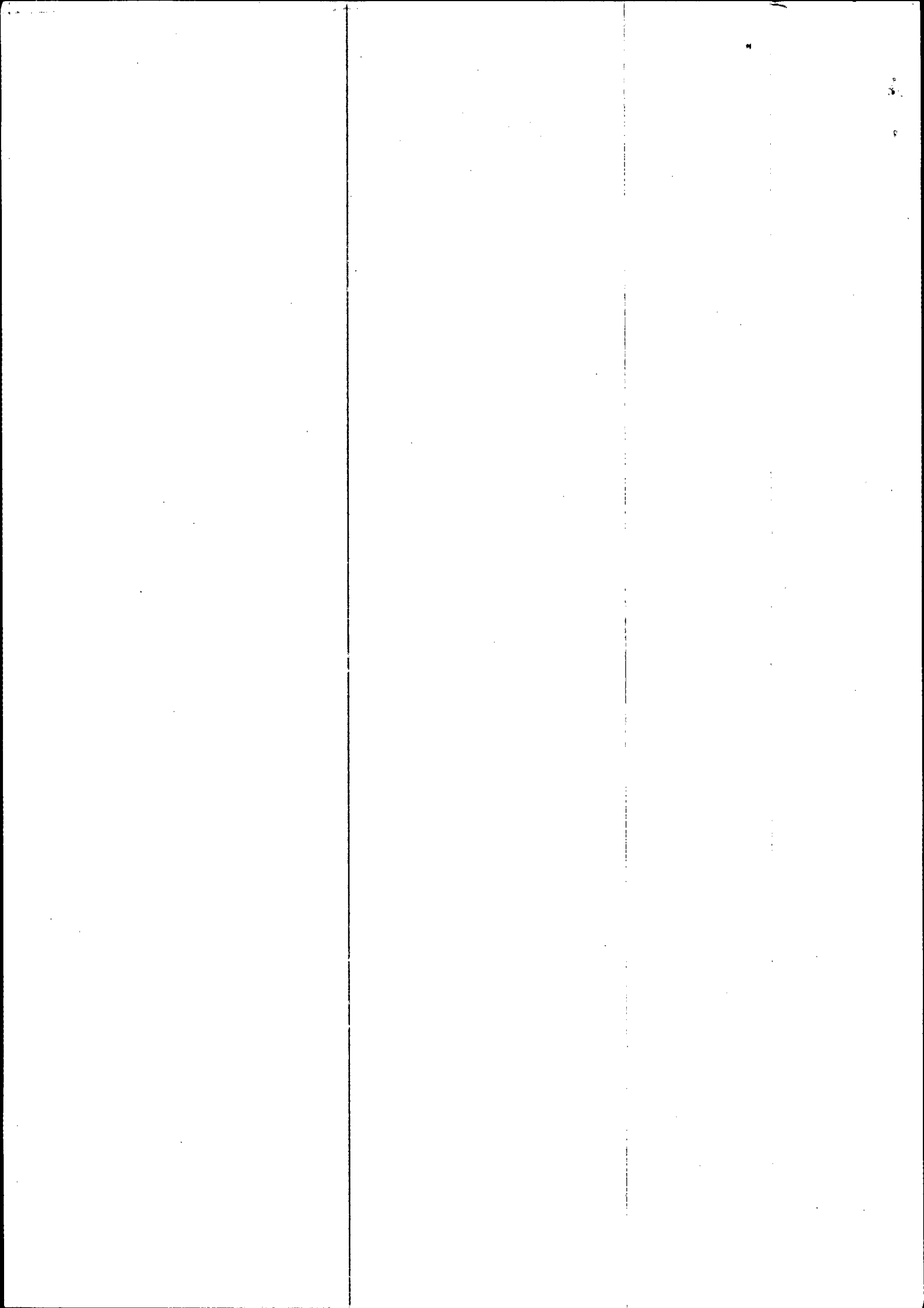
"Statement accompanying the protest not dealing with the substance of the objection to non-unity (not sufficient)"

**Decisions cited:**

W 0016/92, W 0009/94

**Catchword:**

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Boards of Appeal

Chambres de recours

Case Number: W 0018/99 - 3.3.1  
International Application No. PCT/US 98/23223

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 17 April 2000

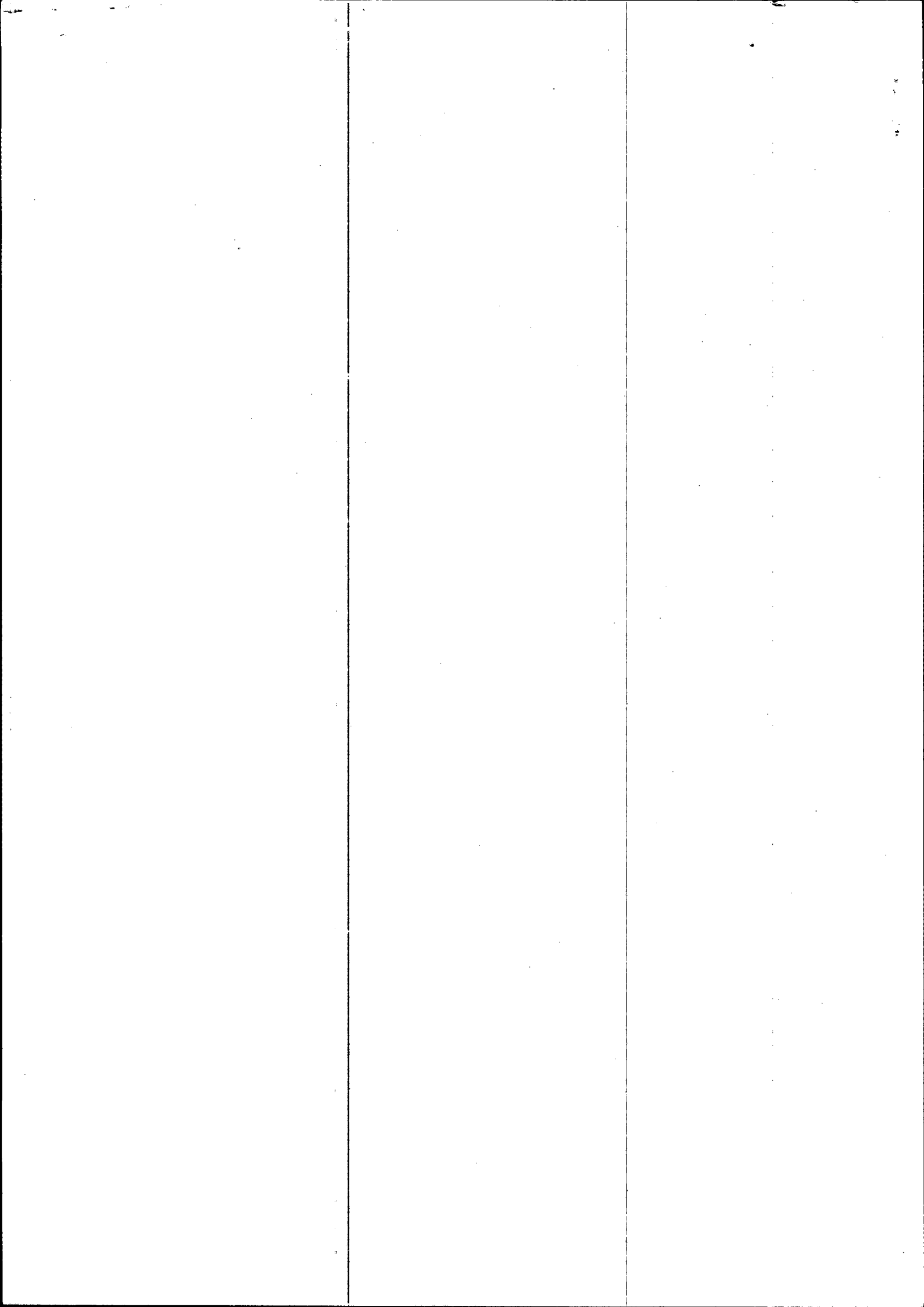
**Applicant:** SCHERING CORPORATION  
2000 Galloping Hill Road  
Kenilworth  
New Jersey 07033-0530 (US)

**Representative:** Jeanette, Henry C.  
SCHERING-PLOUGH CORPORATION  
Patent Department, K-6-1 1990  
2000 Galloping Hill Road  
Kenilworth  
New Jersey 07033-0530 (US)

**Subject of the Decision:** 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 29 July 1999.

**Composition of the Board:**

**Chairman:** A. J. Nuss  
**Members:** R. E. Teschemacher  
P. I. Ranguis



## Summary of Facts and Submissions

- I. International application US 98/93223 was filed on 5 November 1998.
- II. On 29 July 1999, the EPO acting as International Preliminary Examining Authority (IPEA) informed the applicant that the application did not comply with the requirement of unity of invention under Rule 13 PCT as it comprised three groups of inventions which were not linked by a single general inventive concept. The applicant was invited to restrict the claims to one of these groups or to pay two additional examination fees.
- III. On 12 August 1999, the applicant paid the two additional examination fees under protest. He argued that the International Searching Authority (ISA) had not raised an objection of non-unity and had issued a complete search report without inviting the applicant to pay additional search fees. Therefore, the ISA had already determined that there was unity of invention. This determination should be followed by the IPEA.
- IV. In its communication of prior review under Rule 68.3(e) PCT dated 30 August 1999, the IPEA informed the applicant that the requirement for payment of additional examination fees was upheld. The applicant was invited to pay the protest fee within one month. The fee was paid on 13 September 1999.
- V. In a communication from the Board, the applicant was informed that the protest did not deal in substance with the question of unity. In the absence of a proper reasoned statement in accordance with Rule 68.3(c) PCT, it was envisaged that the protest would be rejected as inadmissible. No reply was received.

## Reasons for the Decision

1. As already stated in the Board's communication, Rule 68.3(c) PCT requires that a protest has to be accompanied by a reasoned statement to the effect that the application complies with the requirement of unity of invention. The applicant's statement merely refers to the fact that non-unity was not objected to by the ISA which is irrelevant for the present proceedings since the IPEA may raise the question of unity whether or not this has been done by the ISA (PCT International Preliminary Examination Guidelines III-7.10, PCT Gazette, special issue, 07/1998, page 1, at page 24). The statement fails to deal in substance with the objection substantiated by the IPEA in its communication of 29 July 1999. It does not give any reason why the applicant does not agree with the assessment by the IPEA but is confined to the mere assertion that unity is present. Such assertion, however, is not a reasoned statement for a protest (W 16/92, OJ EPO 1994, 237, concerning Rule 40.2(c) PCT; W 09/94, cited in Case Law of the Boards of Appeal of the EPO, 3rd ed. 1998, IX.C.1.3, concerning Rule 68.3(c) PCT). Therefore, the protest does not fulfil the requirements of Rule 68.3(c) PCT and is inadmissible.
  
2. Since the protest is inadmissible, there was no legal basis for the invitation to pay the protest fee. Therefore, the protest fee is to be refunded.

**Order**

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

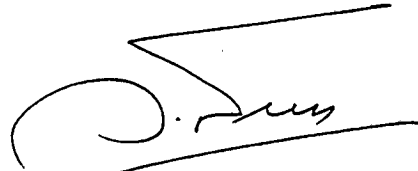
1. The protest under Rule 68.2(c) PCT is rejected as inadmissible.
2. The reimbursement of the protest fee is ordered.

The Registrar:



N. Maslin

The Chairman:



A. J. Nuss

*Te Re*

