

Abstract

The Board of Appeal decided that a protest was inadmissible because it was filed after the expiry of the prescribed time limit.

EPO boards of appeal decisions

Date of decision 12 June 1987

Summary of Facts and Submissions

I. The Applicant filed International patent application PCT/US 86/01 592 on 31 July 1986. On 14 November 1986, the EPO acting as International Search Authority (ISA) sent to the Applicant an invitation to pay additional search fees in accordance with Article 17(3)(a) and Rule 40.1 PCT. The invitation indicated that the ISA considered that the application does not comply with the requirements of unity of invention, and set out 23 groups of claims. The invitation also stated that the Applicant was invited within 45 days from the date of mailing (i.e. by 29 December 1986) to pay the additional fees, and that such payment could be made under protest, in accordance with Rule 40.2 (c) PCT.

II. By letter dated 21 November 1986, but not received at the ISA until 7 January 1987, the Applicant paid an amount to cover one additional search fee in respect of a specified part of the application, under protest, and such letter contained a statement to the effect that the Applicant considered that the application complies with the requirement of unity of invention and that the amount of the required additional fee is excessive. (Although the amount originally sent covered 22 additional fees, it was clarified by a telephone conversation on 17 February 1987 between the Applicant's representative and the ISA that only one additional fee was intended to be paid, and it was agreed that the excess amount would be refunded.)

III. The ISA has referred the protest to this Board of Appeal for examination in accordance with Rule 40.2 (c) PCT.

Reasons for the Decision

1. The Board notes that the additional fees were not paid, and the letter of protest was not received by the ISA, until after expiry of the time limit of 45 days which was fixed by the ISA. This raises the question whether or not the protest is admissible.

2. The PCT provides a procedural system which is designed to ensure that every international application, and every international search report in respect of an international application, is published reasonably quickly. Thus after an international application is filed at a receiving office, following a formal examination, a "search copy" of the application must be transmitted to the ISA promptly after receipt of the application, and in any case by the expiry of thirteen months from the priority date (see Article 12 and Rules 22 and 23 PCT). The time limit for the ISA to establish the international search report is then three months from receipt of the search copy, or nine months from the priority date, whichever is the later (see Article 18 and Rule 42 PCT).

3. Within such time limit, the ISA operates under the procedure set out in Article 17 PCT. In particular, if the ISA considers that the application does not comply with the requirement of unity of invention, it shall invite the Applicant to pay additional fees. In that context, Article 17(3)(a) PCT states that the ISA shall establish the international search report on those parts of the international application which relate to the "main invention", and, "provided the required additional fees have been paid within the prescribed time limit", on those parts of the application in respect of which the additional fees were paid.

Rule 40.3 PCT prescribes that the time limit provided for in Article 17(3)(a) PCT shall be fixed in each case by the ISA; and that "it shall not be longer than 45 days, from the date of invitation". In the present case a time limit of 45 days was fixed by the ISA, and expired on 29 December 1986. Since the additional fees were not paid within the prescribed time limit under Article 17(3)(a) the international search report should not have been established beyond those parts of the application which relate to the main invention.

4. Rule 40.2 (c) PCT states: "Any Applicant may 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 or that the amount of the required additional fee is excessive...." This makes it clear that if an Applicant wishes to pay the additional fee under protest, the additional fee must be accompanied by the reasoned statement that sets out the protest. Since, in accordance with Article 17(3)(a) and Rule 40.3 PCT as set out above, the additional fee must be paid within the specified time limit, it is also clear that the protest must be made within the same time limit. In the present case, as noted previously, the additional fee was not paid, and the protest was not received by the ISA, until after the time limit fixed by the ISA had expired. The PCT does not specifically provide a sanction in the event that such time limit is not complied with. However, having regard in particular to the fact that the time limit of up to 45 days fixed under Rule 40.3 PCT is within the context of the three months time limit provided by Rule 42 PCT, in the Board's view the clear intention of the PCT is that this time limit must be strictly observed. Thus, on

the proper interpretation of Article 17(3)(a) and Rule 40.3 PCT in their context as set out above, in the Board's judgement (subject to the possible application of Article 48 PCT as discussed below) neither the payment of the additional fee nor the protest can be regarded as having any legal effect.

5. In the case of the late payment of the additional fee, the sanction for the late payment should have been that the service in respect of which the fee was paid, namely the additional search, should not be provided. The international search report was only required to be established in respect of the main invention. As a consequence, the additional fee which was paid belatedly under protest should be refunded. Furthermore, the Board rejects the late-filed protest as inadmissible.

6. The above findings are subject to the possible application of Article 48 PCT to the facts of the case. In relation to Article 48(2) PCT, Article 122 EPC provides for possible re-establishment of rights, and any application under Article 122 EPC would be decided by the department competent to decide on the omitted act.

ORDER

For these reasons, it is decided that:

1. The protest under Rule 40.2 (c) PCT is rejected as inadmissible.
2. The additional fee which was paid under protest should be refunded.