

Abstract

Protest of the payment of an additional search fee. Appeal of the decision by the IPEA on lack of unity of invention. Protest was unjustified for lack of a reasoned statement.

EPO boards of appeal decisions

Date of decision 29 November 1994

Summary of Facts and Submissions

- I. On 12 July 1993, pursuant to PCT Article 31, a demand for international preliminary examination of international application PCT/US was submitted to the EPO as International Preliminary Examination Authority (IPEA).
- II. On 15 September 1993 the EPO, pursuant to PCT Article 34(3)(a) and Rule 68.2, informed the applicant that the application did not comply with the requirement of unity of invention (PCT Rule 13) for reasons indicated, and invited the applicant to restrict the claims or pay up to four additional fees @ DEM 3 000. The latter is the amount of an international preliminary examination fee as specified in Article 2, Fee Item 19 of the EPC Rules Relating To Fees which came into force on 1 October 1992, which fee is payable under PCT Rule 58 and EPC Rule 104a(2) for each further invention for which the international preliminary examination is to be carried out.
- III. By letter received at the EPO 4 December 1993, the applicant filed amended claims comprising two sets and paid one amount of DEM 3 000. An accompanying letter stated: "This payment is made under protest because the contents of both sets of claims are already contained in the original claims and therefore both sets of claims were already searched. We, therefore, request refund of the International Search Fee for the second set of claims. Each of the two new sets of claims is directed to a single uniform invention."
- IV. In response to the applicant's payment of one additional fee under protest, the EPO review panel, pursuant to PCT Rule 68.3(e) and EPC Rule 104a(3), informed the applicant on 27 January 1994 that the Rule 68.2 invitation was found to be justified and invited the applicant to pay, within one month, a protest fee for the examination of the protest. The invitation set out reasons why the two sets of claims on file related to two inventions not involving a single general inventive concept within the meaning of Rule 13 PCT.

V. On 8 February 1994 the applicant paid the protest fee without comment. In a letter received at the EPO 23. February 1994, which concerned some erroneous bookings to the applicant's deposit account, the applicant observed that the DEM 3 000 had been paid under protest "since the subject matter of the second set of claims was already included in the original PCT claims and, therefore, was already searched under the originally paid searching fee".

VI. On 10 October 1994, pursuant to PCT Rule 68.3(c), EPC Article 155(3) and Rule 104a(3), the protest was referred to the Board of Appeal for a decision.

Reasons for the Decision

1. The protest requests refund of "the international search (sic) fee". However, it is clear that the fee concerned is the DEM 3 000 paid to the IPEA in response to the invitation to restrict or pay additional fees (cf. point II above).

2. PCT Rule 68.3(c) provides that: "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."

2.1. In the event that, as in the present case, the claims are restricted in response to the invitation under PCT Rule 68.2, the protest is, in effect, a contention on the part of the applicant that the reasons specified by the IPEA in the invitation were not cogent as far as they concerned the claims relating to the subject-matter retained in the restricted claims in respect of which additional fees have been paid under protest.

2.2. The sole argument in the statement accompanying the protest is to the effect that the contents of both sets of (amended) claims are already contained in the original claims and therefore both sets of claims were already searched. This argument does not address the point at issue. The right of the IPEA to request additional fees for the international preliminary examination when the application does not meet the requirement of unity of invention is independent of the question whether that group of inventions has been searched. Indeed, it is, in practice, only exercised in relation to inventions which have been searched; cf. PCT Article 34(3)(a), Rules 66.1(e), 68, 70.2(d) and PCT Preliminary Examination Guidelines, Chapter III, 7.10. and Chapter VI, 5.4.

2.3. In the matter of a finding of lack of unity of invention, both the International Search Authority (ISA) and the IPEA exercise a discretion, in borderline cases, whether or not to issue an invitation under PCT Article 17(3)(a) or Article 34(3)(a) respectively. Because of the difference between the tasks of search and

examination, it may be, in appropriate cases, proper for this discretion to be exercised differently by the respective authorities in relation to a given group of inventions. Thus a group of inventions may sometimes be searchable in full within the bounds of a normal case, while the examination of novelty, inventive step, industrial applicability, excluded subject-matter and clarity for each of the inventions might involve a cumulative effort well beyond such bounds. In this connection it has to be remembered also that the International Preliminary Examination Report contains explanations for its conclusions, positive or negative, in relation to each claim examined. The decision of the ISA is not binding on the IPEA (cf. G 2/89, OJ EPO 1991, 166, points 8.1 to 8.2).

2.4. Since the fact that the claims in question were already searched cannot, on its own, constitute a reason for contesting a finding of lack of unity of invention by the IPEA - irrespective of the technical facts of the case - it follows that a protest statement which relies solely on pointing out this fact cannot qualify as a reasoned statement for the purposes of Rule 68.3(c). The same holds for the argument, which may be implicit in the protest statement, that the unitary character of the claims in question can be inferred from the fact that the ISA did not request an additional search fee.

3. Accordingly the protest has to be rejected as inadmissible for lack of a reasoned statement. Under these circumstances neither the additional fee paid by the applicant nor the protest fee is to be refunded.

4. The Board interprets the last sentence of the protest statement as, in effect, an auxiliary submission that the amended claims relate to two inventions rather than the five mentioned in the Rule 68.2 invitation. This was accepted by the review panel and requires no comment by the Board.

5. As regards the action of the review panel in relation to the protest, the Board notes in passing that the function of this panel has been discussed by Technical Board of Appeal 3.3.1 in decision W 4/93, the headnote of which appears in OJ EPO, 6/1994. In points 2 to 2.4 of the reasons for that decision, the need for the review to address the reasons in the protest was emphasised. In that spirit it would have been appropriate in the present case for the review panel to have responded to the protest by pointing out that the invitation was to restrict the claims or pay additional examination fees - referring perhaps to EPC Rule 104a(2) - and that the fact that the two inventions had already been searched (for a single search fee) did not affect the IPEA's right to request additional fees for the examination.

ORDER

For these reasons it is decided that:

The protest is rejected as inadmissible.