Abstract
The Enlarged Board of Appeal was asked to clarify whether a substantive examination in respect of novelty and inventive step is necessary in situations where there is lack of unity.

EPO boards of appeal decisions

Date of decision 29 June 1989

Summary of Facts and Submissions

I. On 24 October 1988, the Applicant filed international patent application ... with the United States Patent and Trademark Office. The European Patent Office was the designated Office within the meaning of Article 2(xiii) PCT. The application contained 39 claims, Claims 1 to 7, 8 to 21, 22 to 27 and 31 to 35, which relate to lubricating compositions, Claims 28 to 31 which relate to certain polysuccinate esters contained in the said composition, and Claims 36 to 39 which relate to methods for reducing the internal friction of an internal combustion engine in which lubricating compositions according to some of the preceding claims are used. The broadest of the four independent composition claims is Claim 1 which reads as follows: "A lubricating composition comprising a major amount of a mineral oil of lubricating viscosity and a minor amount of at least one polysuccinate ester having a molecular weight between about 1 000 and about 4 000, and which is essentially free of cycloaliphatic groups, and wherein succinic groups of the polysuccinate ester contain alkyl or alkenyl substituents having from about 4 to about 28 carbon atoms."

II. On 10 April 1989, the European Patent Office as competent International Searching Authority (ISA) issued, pursuant to Article 17(3)(a) EPC and Rule 40.1 PCT, an Invitation to pay six additional search fees (DEM 12 570) in view of the fact that it was considered that the above identified application did not comply with the requirements of unity of invention as set forth in Rule 13.1 PCT. This Invitation was based on the result of a preliminary search which revealed in particular the following document: US-A-3 117 091. The Invitation to pay stated that this document destroyed the novelty of the subject-matter of Claims 1 and 2, and that therefore lubricating compositions containing poly-succinate esters of various sub-groups, being structurally different from each other, no longer form part of a common inventive concept. The ISA therefore identified six groups of claims which belonged to different inventive concepts.

III. On 23 May 1989 the Applicant paid one additional search fee under protest, pursuant to Rule 40.2(c) PCT, and requested that this additional fee be

refunded. He disputed that the subject-matter of Claim 1 was anticipated by the above identified document since it does not relate to polymeric succinate esters as claimed in the application. Furthermore he submitted that the claims of the application relate to compounds and methods of making them, and compositions containing them, and therefore meet the requirements of Rule 13.1(i) PCT. The Applicant also drew attention to the Decision W 03/88 of this Board (OJ EPO 1990, 126) where in a similar situation (non-unity a posteriori) the refund of the additional search fees was ordered.

Reasons for the Decision

1. Pursuant to Article 154(3) EPC, the Boards of Appeal of the EPO are responsible for deciding on protests made by an Applicant against an additional search fee charged by the EPO under the provisions of Article 17(3)(a) PCT.

2. Both the Invitation to pay and the protest comply with the requirement of Rule 40 PCT and are admissible. 3. In the Board's view, Article 112(1)(a) EPC empowers a Board of Appeal of its own motion to refer a question of law which arises out of a case which is before it under Article 154(3) EPC to the Enlarged Board of Appeal, in order to ensure uniform application of the law, or if an important point of law arises.

4. In Decision W 03/88 dated 8 November 1988, this Board examined the powers that are given to an International Searching Authority (ISA) under the Patent Cooperation Treaty (PCT), and held that the ISA does not have any obligation or power under Article 17(3)(a) PCT, prior to establishing the international search report, to carry out a substantive examination of the international application with respect to novelty and inventive step in relation to its consideration of the requirement of unity of invention set out in Rule 13.1 PCT. Two subsequent decisions of different Boards of Appeal have specifically declined to follow the above Decision. In Decision W 44/88 dated 31 May 1989 (OJ EPO 1990, 140), it was held that the ISA was both authorised and obliged under the PCT to determine whether the requirement of unity of invention was satisfied on an "a posteriori" basis, which necessarily requires an assessment of novelty and inventive step. In Decision W 35/88 dated 7 June 1989 it was held that the requirement of unity of invention set out in Rule 13.1 PCT must have the same meaning in both Chapter I and Chapter II of the PCT. On this basis, together with the fact that in accordance with an Agreement dated 1 January 1988 between the EPO and WIPO, the EPO was obliged to follow the "Guidelines for International Search under the PCT" issued by WIPO and dated 18 November 1977, which expressly refer to the possibility of lack of unity of invention "a posteriori", it was held that the ISA should carry out an examination of inventive step in order to decide upon unity of invention. The

Board notes that the above-mentioned Guidelines indicate that a consideration of the requirement of unity of invention on an "a posteriori" basis is discretionary, whereas the above-mentioned Decisions indicate an obligation in this respect. In the view of this Board, what is stated in these two Decisions does not disturb the reasoning set out in Decision W 03/88 as to the proper interpretation of the relevant requirements of the PCT. Furthermore, this Board does not accept that the existence of either the Agreement dated 1 January 1988 or the Guidelines referred to above can alter the primary obligation of both the ISA and the Boards of Appeal to apply the law as set out in the PCT and as properly interpreted. For these reasons this Board would wish to follow its previous Decision W 03/88, in deciding upon the present case. It is thus clear that within the Boards of Appeal there is no uniform application of the law concerning the power and obligations of an ISA under Article 17(3)(a) PCT. This state of affairs is undesirable.

ORDER

For these reasons, it is decided that:

The following questions of law are referred to the Enlarged Board of Appeal:

1. Does an International Searching Authority have the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Article 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in Rule 13.1 PCT?

2. If an International Searching Authority does have such power, in what circumstances does it have an obligation to carry out such a substantive examination?

3. Is the above-identified Agreement dated 1 January 1988 binding either upon the EPO when acting as ISA, or upon the Boards of Appeal of the EPO?