

Abstract

The invitation to pay an additional search fee was not justified because the application complied with PCT Rule 13. The additional fee was thus returned to applicant.

**EPO boards of appeal decisions**

**Date of decision 29 November 1989**

**Summary of Facts and Submissions**

I. The Appellant filed International patent application PCT/GB.... .

II. The European Patent Office (EPO), acting as International Search Authority (ISA), invited the Appellant to pay an additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT, as it considered that the requirement of unity of invention was not satisfied for the following reasons:

"The subjects, defined by the problems and their means of solution, as listed below are so different from each other that no technical relationship or interaction can be appreciated to be present so as to form a single general inventive concept.

1. Claims 1-17:

Method of flash fluorimetric analysis of a specimen; Instrument for fluorimetric analysis with control circuit and flash tube, to provide radiation including reference fluorescence;

2. Claims 18-23:

Optical structure in a fluorimeter; body of material containing optical path arrangement and optical core structure in a fluorimeter."

III. The Applicant paid the additional fee in due time in response to the ISA's invitation but subject to a protest.

IV. In the protest the Applicant essentially argued that Claims 18 to 23 are not so different as not to form a single inventive concept. Indeed the optical structure claimed in the second group of claims is particularly suited for the performance of flash fluorimetric analysis as it is indicated by the features of the body of material to receive and hold optical elements providing radiation paths.

## **Reasons for the Decision**

1. The protest complies with Rule 40.2(c) PCT and is therefore admissible.
2. In the invitation to pay an additional search fee, the International Search Authority stresses the point that the two groups of claims relate to different problems and different solutions so that no technical relationship is present.
3. According to Rule 13.1 PCT, the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

According to Rule 13.2 PCT, Rule 13.1 shall be construed as permitting inter alia in addition to an independent claim for a given process, the inclusion in the same international application of an independent claim for means specifically designed for carrying out the said process.

According to Rule 13.3 PCT and subject to Rule 13.1 PCT it shall be permitted to include in the same international application two or more independent claims of the same category which cannot readily be covered by a single generic claim.

4. The problem underlying the present invention is to provide a method and corresponding devices which are suitable for on-site fluorimetric measurements (see page 5 of the description). Said problem is solved by the method proposed in Claims 1 to 9, by the instrument for fluorimetric analysis according to Claims 12 to 14, by the optical structure claimed in Claims 18 to 20 and 23 and by

5. It is true, as raised by the International Search Authority, that the application includes a group of inventions, i.e. a method of flash fluorimetric analysis, an instrument for fluorimetric analysis, an optical structure formed in a body of material and a body of material containing optical paths. However, the devices are specifically designed for carrying out the process, even if they could eventually have other possible uses, and can therefore be considered as being linked with the process as to form a single general inventive concept (Rule 13.1 and 13.2 PCT).

Rules 13.2 and 13.3 PCT above-mentioned admit the possibility of having more than one independent claim of the same category and more than one category.

6. It follows from the above considerations that the application does comply with Rule 13 PCT and, therefore, the invitation to pay an additional search fee was not justified.

7. As a remark, it is pointed out that Claims 10, 11 and 15 to 17 are so broad that they seem to lose any clear technical meaning and can not be considered as part of the invention.

## **ORDER**

For these reasons, it is decided that:

Refund of the additional search fee is ordered.