

### Abstract

The protest against the payment of additional ISA search fees was denied because the comment that "in our view the claims do not lack unity" is only an unsubstantiated assertion, and cannot be regarded as a reasoned statement within the meaning of Rule 40.2.(c) PCT as it does not give any reasons showing why the applicants take that view.

## **EPO boards of appeal decisions**

**Date of decision 6 May 1992**

### **Summary of Facts and Submissions**

- I. On 27 September 1991 the applicants filed international application No. PCT/... .
- II. By letter dated 24 January 1992 the European Patent Office as International Searching Authority (ISA) invited the applicants under Article 17(3)(a) and Rule 40.1 PCT to pay three additional search fees, on the grounds that the international application lacked unity of invention. ...
- III. On 24 February 1992 the applicants paid the additional search fees but requested that they be refunded. Their request was substantiated only by the following clause: "since in our view the claims do not lack unity".

### **Reasons for the Decision**

...

2. Rule 40.2(c) PCT provides that applicants "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".
3. A request that additional search fees be refunded constitutes a protest. It follows from Rule 40.2(c) PCT however that applicants paying the additional fees under protest must give grounds in support of that protest. The comment that "in our view the claims do not lack unity" is only an unsubstantiated assertion, and cannot be regarded as a reasoned statement within the meaning of Rule 40.2.(c) PCT because it does not give any reasons showing why the applicants take that view. Under consistent Board of Appeal case law (cf. W 4/87, OJ EPO 1988, 425), this substantive reasoned statement must also be filed

within the 30-day time limit under Article 17(3)(a) and Rule 40.3 PCT for paying the fees.

4. The protest was filed within the said time limit (ending the day after Sunday, 23 February 1992), but not adequately substantiated. It must therefore be rejected as inadmissible. 5. For this reason, the additional search fees paid by the applicants cannot be refunded.

## **ORDER**

For these reasons it is decided that: The protest under Rule 40.2(c) PCT is rejected as inadmissible.

**Remarks: Revised PCT Regulations entered into force on 1 July 1992. Rule 40.2(c) PCT however -and with it the requirement that protests be substantiated - remains unchanged. Abridged version of the decision**