

Abstract

The Boards of Appeal declined to consider the Applicant's protest against payment of additional fees for searching because the statement was not considered sufficiently "reasoned".

EPO boards of appeal decisions

Date of decision 14 September 1992

Summary of Facts and Submissions

I. International patent application No. PCT/US.... comprising 21 claims was filed on 11 October 1991.

II. On 3 March 1992, the EPO acting as International Searching Authority (ISA) sent an invitation to the Applicant to pay, within 45 days, an additional search fee in accordance with Article 17(3)(a) and Rule 40.1 PCT.

In this invitation it was stated that the application related to two groups of subject-matter not having the same inventive concept. Therefore, the requirement of unity of invention was not met. The Applicant was informed that the payment of the additional fee could be made under protest, in accordance with Rule 40.2(c) PCT.

III. The Applicant paid the additional search fee under protest on 16 April 1992. The letter accompanying the payment contained the following sentences:

"Payment is made under protest. It is hereby requested that the International Search Report be drawn up on the full invention."

However, it was not accompanied by a reasoned statement that the application complied with the requirement of unity of invention.

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

Reasons for the Decision

1. Under Article 154(3) EPC the Boards of Appeal are responsible for deciding on a protest made by an Applicant against an additional fee charged by the EPO under the provisions of Article 17(3)(a) of the Patent Cooperation Treaty (PCT).

2. Rule 40.2(c) PCT enables the Applicant to "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 ...".

This makes it clear that if an Applicant wishes to pay additional fees under protest, then not only the additional fees must be paid, but also the reasoned statement that sets out the protest must be submitted within the specified time limit (cf. Decision W 4/87, OJ EPO 1988, 425).

From the extract from the Applicant's letter referred to in paragraph III above, it is clear that the Applicant wanted to pay the additional fee under protest. However, he did not give any reason indicating why, in his opinion, his application complied with the requirement of unity of invention, since the sentences quoted alone cannot be considered to be a "reasoned statement" within the meaning of Rule 40.2(c) PCT.

Therefore, the Applicant's protest under Rule 40.2(c) PCT has to be dismissed as inadmissible.

3. Consequently, the additional fee paid by the Applicant shall not be refunded.

ORDER

For these reasons, it is decided that:

The protest under Rule 40.2(c) PCT is dismissed as inadmissible.